UNITED STATES PATENT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

Mailed: [illegible]

Paper No. 17

| | | |
|---|---|---|
| In re Application of | : | |
| Nancy F. Dean, et al. | : | |
| Serial No. 09/333,564 | : | DECISION |
| Filed: June 21, 1999 | : | ON PETITION |
| For: COMPLIANT FIBROUS THERMAL | : | |
| INTERFACE | : | |

This is in response to the petition filed October 02, 2000, requesting that the above-identified application be granted Special Status under Section 708.02 (VIII) of the MPEP.

The petition has been considered and found to comply with the requirements set forth under the above noted sections. Accordingly, the petition is granted.

The petition is GRANTED.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

David G. Latwesen, Ph D.
Wells, St. John
601 West First Avenue, Suite 1300
Spokane, WA 99201

UNITED STATES DEPARTMENT OF COMMERCE
Pat nt and Trad mark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Date: 11/2/01

To: SPE, Art Unit 1771

From: Director's Office, CP3 8D19
17B2

Subject: Petition for accelerated examination

A petition for accelerated examination, pursuant to MPEP 708.02 (VIII), has been filed in this application.

In order to respond to this request as promptly as possible, please complete the questions below and return to the Director's Office - CP3-8D 19 by COB 11/9/01.

| | Yes | No |
|---|---|---|
| **1. Are all the claims directed to a single invention (no restriction required)?** | [✓] | [ ] |
| a. If "no", has the petitioner made an election in the petition? | [ ] | [ ] |
| b. If "no", has a restriction requirement been made by examiner? | [ ] | [ ] |
| If "no" to (b), give to examiner for telephone restriction only | | |
| c. If "yes" to (b), was election made without traverse? | [ ] | [ ] |
| If "no" to (c), return to secretary for "DENIAL" of petition. | | |
| **2. Is the field of search listed in the petition correct:** | | |
| **a. Classes and subclasses?** | [✓] | [ ] |
| If "no", please list all reasonable, additional classes/subclasses_____ | | |
| **b. Publications? (If applicable)** NA | [✓] | [ ] |
| If "no", please list all reasonable publications_____ | | |
| **c. Foreign patent IPC classes/subclass? (If applicable)** NA | [ ] | [ ] |
| If "no", please list all reasonable, additional IPC classes/subclasses_____ | | |
| **d. Database searches, e.g., Chemical Abstract? (If applicable)** | [ ] | [ ] |
| If "no", please list all reasonable, additional databases NA | | |
| **3. Has a search been performed by a foreign patent office, e.g., is an EPO, JPO, or WIPO d cument present in the application file or supplied by applicant, and is the document for an equivalent f reign application?** | [✓] | [ ] |
| a. If "yes", does the document list an IPC type search? | [✓] | [ ] |
| b. If "yes" to (a), are the IPC classes/subclasses reasonable?(Optional) | [ ] | [ ] |

PLEASE RETURN THIS SHEET AND THE APPLICATION TO THE DIRECTOR'S SECRETARY UPON COMPLETION.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

SCHWEGMAN LUNDBERG WOESSNER & KLUTH
PO BOX 2938
MINNEAPOLIS MN 55402

COPY MAILED

MAY 19 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Gebhardt, et al. | : | |
| Application No. 09/333,724 | : | ON PETITION |
| Filed: June 15, 1999 | : | |
| Attorney Docket No. 2050.007US1 | : | |

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed April 10, 2006

The petition under 37 CFR 1.181 is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181". Extensions of time under 37 CFR 1.136(a) are permitted. No fee is required for a renewed petition.

The above-identified application became abandoned for failure to timely file a response to the non-final Office action mailed August 12, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under 37 CFR 1.136(a) were purchased. Accordingly, no reply having received, the above-identified application became abandoned on November 13, 2005. The mailing of this decision precedes the mailing of a Notice of Abandonment.

Petitioner argues that the August 12, 2005 Office action was improperly mailed to the prior address of record, due to the fact that petitioner had filed a "NOTIFICATION OF CHANGE OF CORRESPONDENCE ADDRESS" on April 7, 2005. However, there is no indication in the file that the person signing that change of correspondence address, Russel D. Slifer (Reg. No. 39,838), was empowered with a power of attorney to prosecute the application. As set forth in 37 CFR 1.33, once an oath or declaration has been filed, the only parties entitled to change the correspondence address are: (1) a registered patent attorney or agent of record; (2) as assignee as provided for under 37 CFR 3.71(b); or (3) all of the applicants for patent.

It was not until a revocation of power of attorney was filed by the assignee on January 11, 2006 that the correspondence address was properly changed to the above address of record.

Petitioner may wish to consider reviving the abandoned application pursuant to 37 CFR 1.137(b).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Gebhardt, et al. | : | |
| Application No. 09/333,724 | : | ON PETITION |
| Filed: June 15, 1999 | : | |
| Attorney Docket No. 2050.007US1 | : | |

This is a decision on the petition to revive under 37 CFR 1.137(b), filed July 21, 2006

The petition under 37 CFR 1.137(b) is **GRANTED**.

The above application became abandoned for failure to timely file a response to the non-final Office action mailed August 12, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under 37 CFR 1.136(a) were purchased. Accordingly, no reply having received, the above-identified application became abandoned on November 13, 2005. Applicants filed a petition to withdraw the holding of abandonment on April 10, 2006. However, the petition was dismissed in a decision mailed on May 19, 2006.

With the instant petition, applicants paid the petition fee, made the proper statement of unintentional delay, and submitted the required reply in the form of an amendment.

The matter is being forwarded to Group Art Unit 2623 for consideration of the amendment filed July 21, 2006.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

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**MINNEAPOLIS MN 55402-0938**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bryan C. Gebhardt et al | : | |
| Application No. 09/333,724 | : | DECISION GRANTING PETITION |
| Filed: June 15, 1999 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 2050.007US1 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed January 10, 2008, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). *See* 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on December 18, 2007 cannot be refunded. If, however, this application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2623 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Karen Creasy
Petitions Examiner
Office of Petitions

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission). Petitioner is advised that the Issue Fee Transmittal Form* ***must*** *be completed and timely submitted to avoid abandonment of the application.*

**UNITED STATES DEPARTMENT OF COMMERCE**
**COMMISSIONER FOR PATENTS**
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ALEXANDRIA, VA 22313-1450

| | |
|---|---|
| Date | : 11/4/2009 |
| Patent No. | : 7,582,343 B1 |
| Serial No. | : 09/334,054 |
| Inventor(s) | : Johnson et al. |
| Issue Date | : Septtember 1, 2009 |
| Title | : **ELASTOMERIC ARTICLE WITH FINE COLLOIDAL SILICA SURFACE TREATMENT, AND ITS PREPARATION** |
| Doc./File No. | **SSK-4** |

Re: Certificate of Correction

Consideration has been given your request for a certificate of correction, for the above-identified patent under the provisions of Rule 1.322.

Respecting the alleged error(s) in the References Cited, the patent is printed in accordance with the record, since there is no record of a 1449 or 892 with reference(s) considered by the Examiner.

In view of the foregoing, your request in this matter is denied.

Further consideration will be given concerning this matter upon receipt of a request for **Reconsideration** (reconsideration should be accompanied by supporting document(s) such as, amendment, postcard receipt, 1449/892, etc.) and should be filed and directed to Decisions & Certificates of Correction Branch.

**Ernest C. White, *LIE* (703) 756-1590**
Mary F. Diggs, *Supervisor* (703) 756-1580
Decisions & Certificates of Correction Branch

DORITY & MANNING, P.A.
POST OFFICE BOX 1449
GREENVILLE SC 29602-1449

ecw

UNITED STATES PATENT AND TRADEMARK OFFICE

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POST OFFICE BOX 1449
GREENVILLE, SC 29602-1449

Mail Date: 04/23/2010

| | | |
|---|---|---|
| **Applicant** | : DAVID W. JOHNSON | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7582343 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/334,054 | : OF WYETH |
| **Filed** | : 06/15/1999 | : |
| | | : |

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A). Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154 (b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

MAIL

NOV 22 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
Eric D. Del Sesto, et al.

Application No. 09/334,131
Filed: June 15, 1999
For: AUTOMATED RETIREMENT OF INTERACTIVE APPLICATIONS USING RETIREMENT INSTRUCTIONS FOR EVENTS AND PROGRAM STATES

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request for Withdrawal as attorney or agent filed on September 01, 2004.

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys/agents of record are withdrawn.

All future communications from the Office will continue to be directed to the address listed above until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

cc : OPTV/BLAKELY
12400 Wilshire Boulevard, 7th Floor
Los Angeles, CA 90025-1030

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/334,160 | 06/16/1999 | SCOTT D. AUGUSTINE | AUGA01000014 | 5012 |

7590 08/20/2008

Terrance A. Meador
Arizant Inc.
10393 West 70th Street
Eden Praire, MN 55344

| EXAMINER |
|---|
| RAM, JOCELYN DEBRA |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3739 | 14 |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/20/2008 | 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Terrance A. Meador
Arizant Inc.
10393 West 70th Street
Eden Praire, MN 55344

| | |
|---|---|
| Patent No. 6,210,428<br>Issue Date: April 3, 2001<br>Appl. No.: 09/334,160<br>Filed: June 16, 1999<br>For: Thermal Blanket | **DECISION DENYING PETITION**<br>*37 CFR 1.324* |

This is a decision on the petition filed June 13, 2001 to correct inventorship under 37 CFR 1.324.

The petition is denied.

The statement from the inventor, Douglas Augustine, being added cannot be signed by the wife of the deceased inventor or a legal representative. See 37 CFR 1.324(b)(1) and MPEP 1481.02.

Linda J. Sholl
Special Program Examiner
Technology Center 3700
571-272-4391

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

RAY G WILSON
5645 QUEMAZON
LOS ALAMOS, NM 87544

MAILED

JUN 28 2005

Director's Office
Group 3700

Paper No. 20

*In re* Application of
DAVIS, JEFFREY
Application No.: 09/334,208
Filed: June 15, 1999

**DECISION ON PETITION**

This is a decision on petitioner's request filed May 19, 2003, requesting withdrawal of the holding of abandonment of the above-identified application because the applicant did not receive the Office communication mailed on December 16, 2002 at the correspondence address of record. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is dismissed.

The showing required to establish nonreceipt of an Office communication must include: (1) a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and (2) a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See MPEP 711.03(c) IA.

The instant application does not comply with item (2) above.

From petitioner's statements, it appears that petitioner believes that a Change of Address during the time in question may have contributed to the alleged non-receipt of the Office Action. It is noted that petitioner states that a Change of Correspondence Address Application was filed in February 2003. However, a review of the application file indicates that the address of record was changed to 5645 Quemazon, Los Alamos, NM 87544 in a Change of Correspondence Address that was filed in October 2002, which was before the Notice of Allowance was mailed December 16, 2002. So the Notice of Allowance was mailed to 5645 Quemazon, Los Alamos, NM 87544.

Petitioners may file a renewed petition, without fee, addressing the points raised above. Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision, 37 CFR 1.181(f). No extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." Alternatively, petitioners may wish to consider filing a petition to revive under 37 CFR 1.137. The rules and MPEP sections cited may be found on the USPTO website at: www.uspto.gov.

Richard A. Bertsch

Richard A. Bertsch, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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RAY G WILSON
5645 QUEMAZON
LOS ALAMOS, NM 87544

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of Davis | : | |
| Application No. 09/334,208 | : | Decision on Petition |
| Filing Date: June 15, 1999 | : | |
| Attorney Docket No. DAVIS100 | : | |

This is a decision on the renewed petition under 37 CFR 1.181, filed July 11, 2005, to withdraw the holding of abandonment.

The petition is **granted.**

Facts:

A Notice of Allowance, Notice of Allowability, Interview Summary, and Examiner's amendment were mailed on December 16, 2002.

The Office did not receive a reply to the Notices.

A Notice of Abandonment was mailed on April 29, 2003.

A petition to withdraw the holding of abandonment was filed on May 19, 2003.

Petitioner contended the December 16, 2002 papers were never received.

A decision by Technology Center 3700 dismissing the petition was mailed June 28, 2005.

The instant renewed petition was filed on July 11, 2005. The file was transferred to the Office of Petitions on March 7, 2006.

The renewed petition includes addition evidence to establish non-receipt of the December 16, 2002 papers.

Analysis:

A review of the evidence or record indicates petitioner has supplied a satisfactory showing of non-receipt of the December 16, 2002 papers.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The Notice of Allowance and Notice of Allowability mailed December 16, 2002 are vacated.

The Office notes a $130 petition fee was submitted with the first petition to withdraw the holding of abandonment. No petition fee is required for a petition to withdraw the holding of abandonment under 37 CFR 1.181. Therefore, a refund of the $130 fee will be scheduled.

Technology Center Art Unit 3746 will be informed of the instant decision and the examiner will mail new copies of all the papers originally mailed December 16, 2002, and the period for reply will be based on the mailing date of the new papers.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

PTO/SB/47 (04-05)
Approved for use through 05/31/2006. OMB 0651-0016
U.S. Patent and Trademark Office; U. S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

# "FEE ADDRESS" INDICATION FORM

**Address to:**
**Mail Stop M Correspondence**
**Commissioner for Patents**
**P.O. Box 1450**
**Alexandria, VA 22313-1450**

**INSTRUCTIONS :** Only an address represented by a Customer Number can be established as the fee address for maintenance fee purposes (hereafter, fee address). A fee address should be specified when the patentee would like correspondence related to maintenance fees to be mailed to a different address than the correspondence address for the application.
When to check the first box below: If the fee address for the patent and/or application number(s) you indicate is to be established with, or changed to, an existing Customer Number.
When to check the second box below: If a Customer Number representing the fee address has to first be established so it can then be associated with the patent and/or application number(s) you indicate.
For more information on Customer Numbers, see the Manual of Patent Examining Procedure (MPEP) § 403.

Please recognize as the "Fee Address" under the provisions of 37 CFR 1.363 the address associated with:

☐ Customer Number: _____

***OR***

☐ Request for Customer Number (PTO/SB/125) attached hereto
in the following listed application(s) for which the Issue Fee has been paid for patent(s).

| PATENT NUMBER (if known) | APPLICATION NUMBER |
|---|---|
| | |

Completed by (check one):

☐ Applicant/Inventor _____ Signature

☐ Attorney or Agent of record _____ (Reg. No.) _____ Typed or printed name

☐ Assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) _____ Requester's telephone number

☐ Assignee recorded at Reel _____ Frame_____ _____ Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more that one signature is required, see below*.

☐ *** Total of _____ forms are submitted.**

This collection of information is required by 37 CFR 1.363. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND COMPLETED FORMS TO THIS ADDRESS.
**SEND TO: Mail Stop M Correspondence, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**
*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.*

# Privacy Act Statement

The **Privacy Act of 1974 (P.L. 93-579)** requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether disclosure of these records is required by the Freedom of Information Act.
2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.
3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.
4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).
5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.
6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).
7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (*i.e.*, GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.
8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspection or an issued patent.
9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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APR 0 3 2003

Technology Center 2100

Paper No. 8

Jeffrey Van Myers
P.O. Box 130
Driftwood, TX 78619

| | | |
|---|---|---|
| In re Application of: | ) | |
| Michael L. LONGWELL et al | ) | |
| Application No.: 09/334,238 | ) | **DECISION ON PETITION UNDER 37** |
| Filed: June 16, 1999 | ) | **C.F.R. § 1.181 TO WITHDRAW** |
| For: METHOD AND APPARATUS FOR | ) | **HOLDING OF ABANDONMENT** |
| ERROR DETECTION AND | ) | |
| CORRECTION | ) | |

This is a decision on the petition filed August 05, 2002 under 37 CFR § 1.181(a) to withdraw the holding of abandonment of the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to respond in a timely manner to the Office Action mailed September 27, 2001 In the apparent absence of a response to the September 27, 2001 communication, the application was held abandoned and a Notice of Abandonment was mailed June 28, 2002.

The petition indicates that a complete response was in fact timely-filed with a certificate of mailing dated January 28, 2002. Attached to the petition is a date-stamped copy of a return postcard stamped February 14, 2002 acknowledging timely receipt by the Office of an amendment and twelve (12) sheets of Drawings. Petitioner also submitted a copy of the amendment and twelve sheets of Drawings.

The original amendment and twelve sheets of Drawings, acknowledged as having been received in the USPTO on February 14, 2002 are not of record in the application file and cannot be located. However, M.P.E.P. § 503 states that "A post card receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO."

For the above stated reasons, the petition is **GRANTED**. The Notice of Abandonment is hereby withdrawn.

The application file is being forwarded to the Technology Center support staff for processing of the

amendment and will then be forwarded to the Examiner for appropriate action.

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software and
Informaiton Security

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE

Paper No. 40

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L STREET, NW
WASHINGTON, DC 20037

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Director's Office
Office of Patent Publication

| | | |
|---|---|---|
| In re Application of | | |
| RICHARDSON, SANDRA, et al. | : | |
| Application No. 09/334,256 | : | **DECISION ON PETITION** |
| Filed: June 16, 1999 | : | |
| Attorney Docket No. M3653.0001/P | : | |

This is a decision on the Petition To Withdrawal An Erroneous Holding Of Abandonment Under 37 CFR § 1.181(A), received in the United States Patent and Trademark Office (USPTO) on August 23, 2005.

The petition is **GRANTED**

The application was held abandoned for Applicant's failure to timely file a reply to the Office letter —Notice Of Drawings Inconsistency — mailed July 12, 2005.

Petitioner states that the Applicant's timely submitted, on June 13, 2005 the Response To Notice Of Drawing Inconsistency and three (3) sheets of Figures. Also, that the serial number and filing date of the timely filed response was incorrect.

The Office acknowledges receipt of the Response To Notice Of Drawing Inconsistency with Figures 11-13 on June 13, 2005.

Under current Office procedure, a response that has an incorrect application number is handled in accordance with MPEP 508.03. If a paper having an incorrect application number contains sufficient information to identify the correct application and was timely filed, the holding of abandonment will be withdrawn. In reviewing the papers submitted, it is concluded that the information contained thereon was sufficient to associate the papers with the instant file.

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Therefore, the holding of abandonment is hereby withdrawn.

As requested, Figures 11-13 will be cancelled.

Telephone inquires relating to this matter may be directed to the undersigned in the Office of Patent Publication at 703-308-9250.

Thomas Hawkins

Thomas Hawkins
Paralegal Specialist
Office of the Director
Office of Patent Publications

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

**DICKSTEIN SHAPIRO LLP**
**1825 EYE STREET NW**
**WASHINGTON DC 20006-5403**

| | | |
|---|---|---|
| In re Application of | : | |
| Sandra Richardson et al | : | |
| Application No. 09/334,256 | : | ON PETITION |
| Filed: June 16, 1999 | : | |
| Attorney Docket No. M3653.0001/P | : | |

This is a decision on the petition, filed September 12, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on April 14, 2005, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 3625 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Petitions Examiner
Office of Petitions

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

# RAM Fee History Query

Revenue Accounting and Management

Name/Number: 09334256

Total Records Found: 13

Start Date: Any Date

End Date: Any Date

| Accounting Date | Sequence Num. | Fee Type | Fee Code | Fee Amount | Mailroom Date | Payment Method |
|---|---|---|---|---|---|---|
| 09/13/2006 | 00000058 | 1 | 1801 | $790.00 | 09/12/2006 | CC |
| 09/13/2006 | 00000059 | 1 | 1464 | $130.00 | 09/12/2006 | CC |
| 04/15/2005 | 00000355 | 1 | 1501 | $1,400.00 | 04/14/2005 | CC |
| 04/15/2005 | 00000356 | 1 | 1504 | $300.00 | 04/14/2005 | CC |
| 04/15/2005 | 00000357 | 1 | 8001 | $15.00 | 04/14/2005 | CC |
| 04/10/2002 | 00000103 | 1 | 122 | $130.00 | 04/09/2002 | CK |
| 01/24/2002 | 00000032 | 1 | 120 | $320.00 | 01/22/2002 | CK |
| 12/26/2001 | 00000083 | 1 | 119 | $320.00 | 12/21/2001 | CK |
| 12/11/2000 | 00000005 | 1 | 103 | $54.00 | 12/08/2000 | DA 041073 |
| 12/11/2000 | 00000006 | 1 | 102 | $240.00 | 12/08/2000 | DA 041073 |
| 08/26/1999 | 00000203 | 1 | 105 | $130.00 | 08/24/1999 | CK |
| 08/26/1999 | 00000204 | 1 | 581 | $40.00 | 08/24/1999 | CK |
| 06/25/1999 | 00000116 | 1 | 101 | $760.00 | 06/16/1999 | DA 041073 |

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Paper No. 14

T R FURMAN
BRISTOL-MYERS SQUIBB COMPANY
100 HEADQUARTERS PARK DRIVE
SKILLMAN, NJ 08558

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OFFICE OF PETITIONS

In re Application of
Stewart A. Cederholm-Williams
Application No. 09/334,325
Filed: June 16, 1999
Attorney Docket No. CV0276A

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 16, 2001, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed July 28, 2000, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 29, 2000.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified

application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address of currently of record until such time as appropriate instructions are received to the contrary.

The above-identified application is being revived solely for purposes of continuity with a continued prosecution application (CPA) filed on October 16, 2001.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Technology Center 1633 for further processing.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: ARTHUR E JACKSON
DECHERT, PO BOX 5218
PRINCETON, NJ 08648

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 9

STEPHEN E FELDMAN
12 EAST 41ST STREET
NEW YORK, NY 10017

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OFFICE OF PETITIONS

In re Application of :
Alan Perkins :
Application No. 09/334,327 : ON PETITION
Filed: June 16, 1999 :
Attorney Docket No. :

This is a decision on the petition under 37 CFR 1.137(b), filed December 14, 2001, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 22, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 23, 2001.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $460 extension of time submitted with the petition on December 14, 2001 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Technology Center AU 2171.

Wan Laymon

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

United States Patent and Trademark Office

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Paper No. 10

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AUG 21 2002

OFFICE OF DIRECTOR
GROUP

George J. Primak
13480 Huntington
Pierrefonds, Quebec
Canada H8Z 1G2

AIR MAIL

In re Application of )
ROUGEOT et al. )
Application No. 09/334,671 )
Filed: June 17, 1999 )
For: Indirect X-ray Image Detector for Radiology )

DECISION ON PETITION TO RESET PERIOD FOR REPLY

This is a decision on the petition filed on July 23, 2002, requesting that the Office action mailed on March 26, 2002, be remailed and the period for reply be reset.

The petition is **granted**.

Petitioner has provided a statement that the Office action mailed on March 26, 2002, has not been received by the practitioner. Petitioner requests that the Office action be remailed and the period for reply be restarted along with the remailing of the Office action.

A review of the application file indicates that the March 26, 2002, Office action was not mailed to the correspondence address provided in the Declaration and Power of Attorney filed on June 17, 1999. In view of the mailing of the Office action to an incomplete address, and the resulting failure of the applicant to receive the mailed action, the petition to reset the period for reply is hereby granted.

The application file is being forwarded to technical support staff for Technology Center 2800 for remailing of the Office action of March 26, 2002 to the proper correspondence address. The period for reply will be restarted along with the remailing of the Office action.

Henry H. Phan

Hien H. Phan, Special Program Examiner
Technology Center 2800 - Semiconductors, Electrical
and Optical Systems and Components
(703) 308-7502

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 30

Carlson Gaskey & Olds
400 West Maple Road, Suite 350
Birmingham, MI 48009

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OFFICE OF PETITIONS

In re Application of
Foster et al.
Application No. 09/334,974
Filed: June 17, 1999
Attorney Docket No. 60.137-163; 115-3189-U

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 22, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed February 1, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on May 2, 2002.

The application is being forwarded to Technology Center AU 1745 for further processing.

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond

Latrice Bond
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 12

**PILLSBURY WINTHROP LLP**
**INTELLECTUAL PROPERTY GROUP**
**PO BOX 10500**
**McLEAN, VA 22102**

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NOV 2 6 2003

**OFFICE OF PETITIONS**

In re Application of
Andrew Mark Ward et al
Application No. 09/334,986
Filed: June 17, 1999
Attorney Docket No. CPW-5036/US

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 8, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 27, 1999, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 28, 2000.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Technology Center AU 1754.

Wan Laymon
Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6188372
Issue Date: February 13,2001
Application No. 09335089
Filed: June 17,1999
Attorney Docket No. 1823/OF448

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed May 8,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of May 8,2009 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6188372 | 2001-02-13 | 09335089 | 1999-06-17 | 447363-640005 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Nathan T. Lewis/ | Date (YYYY-MM-DD) | 2009-05-08 |
| Name | Nathan T. Lewis | Registration Number | 56218 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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Alexandria, VA 22313-1450
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**RICHARD J RODRICK**
**BECTON DICKINSON AND COMPANY**
**1 BECTON DRIVE**
**FRANKLIN LAKES, NJ 07417**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| David J. Wright et al | : | |
| Application No. 09/335,218 | : | ON PETITION |
| Filed: June 17, 1999 | : | |
| Attorney Docket No. P-4423 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed March 19, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." No additional fee is required with any renewed petition. Petitioner is advised that this is **not** a final agency action decision.

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). This petition lacks item (1) above.

A petition to revive cannot be granted where there is an outstanding requirement. In the instant case, there was no response to the outstanding official action submitted. Accordingly, the petition to revive cannot be granted until such time as the outstanding response requirement is received.

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

**By hand:** Crystal Plaza Two, Lobby
2011 South Clark Place
Room 1B03
Arlington, VA 22202

**By fax:** (703) 872-9306
Attn: Office of Petitions

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 306-5685.

Wan Laymon

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**RICHARD J RODRICK**
**BECTON DICKINSON AND COMPANY**
**1 BECTON DRIVE**
**FRANKLIN LAKES, NJ 07417**

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JUL 2 9 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| David J. Wright et al | : | |
| Application No. 09/335,218 | : | ON PETITION |
| Filed: June 17, 1999 | : | |
| Attorney Docket No. P-4423 | : | |

This is a decision on the renewed petition under 37 CFR 1.137(b), filed June 24, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 306-5685.

This matter is being referred to Technology Center AU 1634.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. ~~10~~ 21

Scott W. Doyle
Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 300
McLean, VA 22102

MAIL

JAN 13 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
FREEMAN et al. :
Application No. 09/335,372 :
Filed: June 17, 1999 :
For: **COMPRESSED DIGITAL-DATA SEAMLESS VIDEO SWITCHING SYSTEM** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request to Withdraw as Attorney/Agent of record filed on October 22, 2003.

A grantable request to withdraw as attorney/agent of record must do the following:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

The Request to Withdraw as Attorney is **DISMISSED AS MOOT**.

Attorneys requesting withdraw are not of record due to a Revocation of Power of Attorney filed by Assignee on December 10, 2003.

All future communications from the Office will be directed to the address listed above until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office. A courtesy copy of the decision will be sent to the petitioner at the address below.

The file is being returned to TC 2600 central files to await action.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4701

cc:
DORSEY & WHITNEY, LLP
INTELLECTUAL PROPERTY DEPARTMENT
370 SEVENTEENTH STREET
SUITE 4700
DENVER CO 80202-5647

#26
DW

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

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OFFICE OF THE DIRECTOR
TC 3600

DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
2101 L STREET NW
WASHINGTON D.C. 20037-1526

Paper No. 26

In re Application of :
John R. Plate, et al. :
Application No. 09/335,377 :
Filed: June 17, 1999 :
For: FORKLIFT STABILIZING APPARATUS

**DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

This is in response to applicant's Petition to Withdrawal the Holding of Abandonment filed in the United States Patent and Trademark Office on January 28, 2004.

The petition is **GRANTED** in view of the following evidence of timely filing :

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____.

☐ Certificate of Mailing/Transmission signed on _____.
and supported by a statement under 37 C.F.R. 1.8(b)(3).

☐ Hand Delivery Receipt of the specific documents submitted
dated _____.

☐ Certificate of Transmission of CPA under 37 C.F.R. 1.6 filed on _____.

☐ Express Mail Receipt under 37 C.F.R. 1.10 dated _____.

☒ Originally sent response filed October 14, 2003 has been found and matched with the application.

Applicants surrendered U.S. patent 5,639,119 has been entered into the file. The application is being forwarded to the examiner for prompt action on the response.

cps/2/24/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

APR 20 2005

JOHN P. WHITE
COOPER & DUNHAM LLP
1185 AVENUE OFTHE AMERICAS
NEW YORK NY 10036

| | |
|---|---|
| In re Application of | : |
| Jason D. Banon et al | : |
| Serial No.: 09/335,581 | : PETITION DECISION |
| Filed: June 18, 1999 | : |
| Attorney Docket No.: 2690/68556-B | : |

This is in response to the petition under 37 CFR 1.181, filed February 1, 2005, for withdrawal of abandonment of the above identified application.

A review of the file history shows that the examiner mailed an Office action to applicants on August 24, 2004, setting a one month time period for reply and deeming the reply filed May 21, 2004, to be non-responsive. The examiner then mailed a Notice of abandonment to applicants on December 15, 2004, in view of applicants' failure to reply to the Office action of November 18, 2003, but prior to the expiration of six months from the Office action of August 24, 2004.. Applicants filed this petition and a responsive amendment on February 1, 2005. In view of the above facts the Notice of Abandonment was mailed in error and is withdrawn and the application is restored to pending status with the mailing of this decision

The petition is **GRANTED**.

**The application will be forwarded to the examiner for further action.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

Jasemine C. Chambers
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

PHILIPS INTELLECTUAL PROPERTY
& STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR, NY 10510

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APR 24 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Moulsley | : | DECISION ON PETITION |
| Application No. 09/335,608 | : | |
| Filed: June 18, 1999 | : | |
| Atty Docket No. PHB-34-257 | : | |

This is a decision on the PETITION UNDER 37 CFR 1.137(b) TO REVIVE AN ABANDONED APPLICATION FOR UNINTENTIONAL DELAY filed March 23, 2006.

The petition is **GRANTED**.

The above-identified application was abandoned for failure to timely file a proper reply to the final Office action mailed August 23, 2005. This Office action set a shortened statutory period for reply of three (3) months from the mail date of the action. No proper reply having been received and no extension of time obtained the application became abandoned effective November 24, 2005. A Notice of Abandonment was mailed on March 27, 2006.

On petition, petitioner submitted a Request for Continued Examination (RCE) and submission under §1.114, paid the petition fee, and made the required statement of unintentional delay.

The application file is being forwarded to Technology Center 2661 for consideration of the RCE and submission.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 273-3219.

Nancy Johnson
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 25

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OCT 1 5 2002

OFFICE OF PETITIONS

John S. Pratt
Kilpatrick Stockton
1100 Peachtree, Suite 2800
Atlanta, GA 30309

In re Application of
O'Reilly et al.
Application No. 09/335,614
Filed: June 18, 1999
Attorney Docket No. 05213-0610

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 27, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply to file a proper reply to the non-final Office action mailed October 20, 2000. A three-month extension of time was filed on April 20, 2001. A Notice of Abandonment was mailed on July 30, 2001.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

The file is being forwarded to Technology Center AU 1653 for further processing.

BEST AVAILABLE COPY

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
For Patent Examination Policy

Cc: Kilpatrick Stockton
607 14th Street, NW
Suite 900
Washington, DC 20005

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UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 16

HIMANSHU S. AMIN
AMIN & TUROCY, LLP
24TH FLOOR, NATIONAL CITY CENTER
1900 EAST 9TH STREET
CLEVELAND, OH 44114

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APR 2 5 2003

OFFICE OF PETITIONS

In re Application of :
Matthew J. Conway et al :
Application No. 09/335,640 :
Filed: June 18, 1999 :
Attorney Docket No. MS-68(116627 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 14, 2003, to revive the above-identified application.

The petition is **GRANTED**.

**The two-month period for filing an appeal brief in triplicate (accompanied by the fee required by 37 CFR 1.17(c)), runs from the date of this decision.**

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed May 28, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 29, 2002.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application file is being forwarded to Technology Center 2100 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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HIMANSHU S. AMIN
AMIN & TUROCY, LLP
24TH FLOOR, NATIONAL CITY CENTER
1900 EAST 9TH STREET
CLEVELAND OH 44114

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OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Matthew J. Conway et al | : |
| Application No. 09/335,640 | : DECISION GRANTING PETITION |
| Filed: June 18, 1999 | : UNDER 37 CFR 1.137(b) |
| Attorney Docket No. MS-68(116627 | : |

This is a decision on the petition under 37 CFR 1.137(b), filed July 26, 2006, to revive the above-identified application.

The petition is **GRANTED**.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue fee and publication fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance of July 25, 2005, is accepted as having been unintentionally delayed.

The evidence submitted with the petition to establish nonreceipt of the Notice of Allowance mailed July 25, 2005 is incomplete.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This matter is being referred to Patent Publication.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper 26

FINNEGAN, HENDERSON, FARABOW, GARRETT
& DUNNER, LLP. 1300 I STREET, N.W., SUITE 700
WASHINGTON DC 20005-3315

COPY MAILED

MAY 28 2004

OFFICE OF PETITIONS

In re Application of
Jennifer D. Tousignant et al.
Application No. 09/335,689
Filed: June 18, 1999
Attorney Docket Number: 6969.0028

DECISION GRANTING PETITION
UNDER 37 CFR 1.182

This is a decision on the petition filed March 17, 2004, under 37 CFR 1.182, requesting entry of an amendment to the specification to insert a reference to an earlier-filed application pursuant to the provisions of 35 U.S.C. § 119(e).

The petition is **GRANTED**.

The above-noted abandoned application failed to make a specific reference the prior-filed application, namely 60/089,879, filed June 19, 1998, prior to the abandonment of the instant application. Petitioner now requests that the abandoned application be amended by inserting a reference to the earlier-filed application. The instant petition is accompanied by an amendment to include a reference to the prior-filed application in the first line of the specification following the title of the invention.

35 U.S.C. § 120 permits entry of a subsequent amendment to an abandoned application in applications filed prior to November 29, 2000 to include the benefit of an earlier filing date for purposes other than prosecution. *See* Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136 (DC DC 1976).

In view thereof, the request for entry of an amendment to insert a reference to the above-noted earlier filed application is granted.

The amendment has been entered. A corrected filing receipt which includes the reference to the prior-filed application accompanies this decision on petition.

The application is being forwarded to Technology Center 1635 for entry of the amendment filed March 17, 2004. Afterwards, the application will be returned to Files Repository.

Telephone inquiries related to this matter should be directed to the undersigned Petitions Attorney at 703-305-4497.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 5/30/07

Paper No.: _____

TO SPE OF : ART UNIT 1746

SUBJECT : Request for Certificate of Correction for Appl. No.: 09335761 Patent No.: 6431189

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

Valerie Jackson
Certificates of Correction Branch
703-308-9390 ext. 114

Thank You For Your Assistance

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

- [X] Approved — All changes apply.
- [ ] Approved in Part — Specify below which changes **do not** apply.
- [ ] Denied — State the reasons for denial below.

Comments: _____

MICHAEL BARR
SUPERVISORY PATENT EXAMINER

SPE

1746
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

46
47
48
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98

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6050735 | 2000-04-18 | 09/335,833 | 1999-06-18 | T001-P0050 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Stephen T. Bang/ | Date (YYYY-MM-DD) | 2008-06-10 |
| Name | Stephen T. Bang | Registration Number | 48926 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6050735
Issue Date: April 18,2000
Application No. 09335833
Filed: June 18,1999
Attorney Docket No. T001-P00050-

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed June 10,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 10,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JEFFREY A. SEDLAR
GENERAL MOTORS CORPORATION
LEGAL STAFF, MAIL CODE 482-C23-B21
P.O. BOX 300
DETROIT, MI 48265-3000

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JUL 3 0 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Nickolas Edward Sargent et al :
Application No. 09/335,851 :
Filed: June 14, 1999 :
Attorney Docket No. H-205168 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 17, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure submit the issue fee in a timely manner in reply to the Notice of Allowance mailed November 21, 2000, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on February 22, 2001.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

There is no indication that petitioner has submitted an Issue Fee Transmittal Form (PTOL-85b). Accordingly, if petitioner desires to have the information normally found thereon printed on the patent, the attached blank Issue Fee Transmittal Form should be completed and returned to the Publishing Division, Box Issue Fee, within ONE MONTH from the mail date of this decision.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application is being forwarded to the Publishing Division.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Blank Issue Fee Transmittal PTOL-85

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Paper No.11

TIMOTHY J. OYER
WOLF, GREENFIELD & SACKS, P.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2211

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|---|---|
| In re Application of | : |
| Pierick; Anderson; Cha; Chen; | : |
| Stevenson; and Laing | : |
| Application No. 09/335,946 | :DECISION ACCORDING STATUS |
| Filed: June 18, 1999 | :UNDER 37 CFR 1.47(a) |
| For: INJECTION MOLDING OF POLYMERIC | : |
| MATERIAL | : |

This is in response to the "Petition Under 37 CFR 1.47(a)," filed March 2, 2000 with a (Certificate of Mail Date of February 28, 2000), and Supplemented on August 14, 2000.

The petition is granted.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application.

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

Telephone inquiries regarding this decision should be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 1722 for examination in due course.

Frances Hicks

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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SUNG W. CHA
MAKOPOO, SINSU-DONG
69-14 SEOUL, KOREA

In re Application of
Pierick; Anderson; Cha; Chen; Stevenson and Laing
Application No. 09/335,946
Filed: June 18, 1999
For: INJECTION MOLDING OF POLYMERIC MATERIAL

Dear Mr. Cha:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to Karen Creasy at (703)305-8859. Requests for information regarding your application should be directed to the File Information Unit at (703)308-2733. Information regarding how to pay for and order a copy of the application,

or a specific paper in the application, should be directed to Certification Division at (703)308-9726 or 1(800)972-6382 (outside the Washington D.C. area).

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Examination Policy

TIMOTHY J. OYER
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OFFICE OF PETITIONS

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

In re Application of
Vorbach et al
Application No. 09/335,974
Filed: June 18, 1999
Attorney Docket No. 2885/21

ON PETITION

This is a decision on the petition, filed September 6, 2001, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on July 30, 2001 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

The application is being forwarded to Technology Center 2100 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1]**The request to apply the previously paid issue fee to the new Notice must be made in writing and should be accompanied by the new Issue Fee Transmittal Form PTOL-85(b), along with a copy of this decision.**

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Alexandria, VA 22313-1450
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KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

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APR 2 4 2006

**OFFICE OF PETITIONS**

In re Application of
Kevin Curtis et al
Application No. 09/336,031
Filed: June 18, 1999
Attorney Docket No. 2698/36

DECISION ON PETITION
TO WITHDRAW
FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed September 16, 2005.

The petition is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Michelle M. Carniaux behalf of all attorneys of record.

All attorneys/agents of record have been withdrawn.

Applicants are reminded that there is no attorney of record at this time.

The correspondence address of record has been changed and the new correspondence address is the address indicated below.

Telephone inquires concerning this decision should be directed to Wan Laymon at 571-272-3220.

This application is being referred to Technology Center AU 3624.

for

David Bucci
Petitions Examiner
Office of Petitions

cc: CHRISTOPHER R. GLEMBOCKI
BANNER & WITCOFF
1001 G STREET, N.W., SUITE 1100
WASHINGTON, DC 20001

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Paper No. 8

KIRT S O NEILL ESQ
AKIN GUMP STRAUSS HAUER & FELD
300 CONVENT STREET
SUITE 1500
SAN ANTONIO, TX 78205

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SEP 1 1 2001

OFFICE OF PETITIONS

In re Application of :
August H. Beck III :
Application No. 09/336,204 :
Filed: June 18, 1999 :
Attorney Docket No. 063007.0010 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 30, 2001, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 3, 2000, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on January 4, 2001.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Technology Center AU 3671.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: AKIN GUMP STRAUSS HAUER & FELD
P.O. BOX 12870
SAN ANTONIO, TX 78212

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 2023

November 6, 2000

Derek P. Freyberg
Heller Ehrman White & McAuliffe
525 University Avenue
Palo Alto, Ca 94301

In re application of:
Terrence R. Green et al
Serial No.: 09/336,392
Filed: June 18, 1999
For: MEDICAL DEVICE HAVING ANTI-INFECTIVE AND CONTRACEPTIVE PROPERTIES

DECISION ON PETITION

This is a decision on the petition filed September 25, 2000, to withdraw the holding of abandonment in the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. 1.113 in timely manner to the Notice to File Missing Parts of Application mailed July 16, 1999. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned on August 17, 1999. A Notice of Abandonment was mailed on April 19, 2000.

The evidence submitted in sufficient to establish that the applicants' attorney never received the Notice to File Missing Parts of Application.

The filing receipt is enclosed.

Telephone inquiries concerning this matter may be directed to Doshie E. Day at (703) 308-3640.

Doshie Day

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 9

Dara L. Onofrio
233 Broadway
Suite 2702
New York, NY 10279-2799

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**FEB 0 5 2002**

**OFFICE OF PETITIONS**

In re Application of
Rolf Steiger et al.
Application No. 09/336,462
Filed: June 18, 1999
Attorney Docket No. ICH-286

: DECISION DISMISSING PETITION
: UNDER 37 CFR 1.183

This is a decision on the petition under 37 CFR 1.183 filed on January 7, 2002, requesting that the requirement to pay the extension of time fee in the above-identified application be waived.

A first Office action was mailed in the above-identified application on June 15, 2001, setting a three-month shortened statutory period for reply. In response, on January 7, 2002, applicant filed an amendment and a petition under 37 CFR 1.183, and in the alternative, petition for extensions of time.

Petitioner argues that the extension of time fee should be waived because due to the events of September 11th and aftermath, a timely response to the Office action was unable to be filed prior to the expiration of the shortened statutory period. In the petition, the petitioner states that the office of the applicant's attorney was located in a building two blocks away from the World Trade Center; the telephone and electricity services in the attorney's office were interrupted; and the mail to the attorney's office was delayed due to "anthrax" threats. Petitioner requests that the extension of time fees be waived due to these extra-ordinary circumstances.

37 CFR 1.183 states:

> In an extraordinary situation, when justice requires, any requirement of the regulations in this part <u>which is not a requirement of the statutes</u> may be suspended or waived by the Commissioner or the Commissioner's designee, *sua sponte*, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h). (Emphasis added).

35 U.S.C. 41(a) (8) states that:

> The Director <u>shall</u> charge the following fees:
>
> ...
>
> (8) For petitions for 1-month extensions of time to take actions required by the Director in an application-
> (A) on filing a first petition, $110
> (B) on filing a second petition, $270; and
> (C) on filing a third or subsequent petition, $490. (Emphasis added)

Since the requirement to pay the extension of time fee is a requirement of the statute, the Commissioner is without authority to waive this requirement. It is well settled that the use of "shall" in a statute is the language of command, and where the directions of the statute are mandatory, then strict compliance with the statutory terms is essential. Farrel Corp. v. U.S. Int'l Trade Comm'n, 942 F.2d 1147, 20 USPQ2d 1912 (Fed. Cir. 1991). The payment of the statutory fee is obligatory upon the applicant and the collection of the statutory fee is likewise obligatory upon the Office. Boyden v. Commissioner of Patents, 441 F.2d 1041, 1043, 168 USPQ 680, 681 (D.C. Cir. 1971), cert. denied, 404 US 842, 171 USPQ 321 (1971). The Office has no discretion to proceed in the absence of such payment.

While it is unfortunate that applicant was unable to filed the amendment prior to the expiration of the shorten statutory period due to the events of September 11th and aftermath, the Office is without authority to waive the extension of time fee.

In view of the above, the petition to waive the requirement to pay the extension of time fee is dismissed.

After mailing of this decision, the $130.00 petition fee for the petition under 37 CFR 1.183 and the three-month extension of time fee of $920.00 will be charged to counsel's deposit account No. 50-1541 as authorized in the petition.

The application is being returned to Technology Center Art Unit 1774 for consideration by the examiner of the amendment filed January 7, 2002.

Inquiries concerning this decision may be directed to the undersigned at (703) 308-3858.

Joni Y. Chang

Joni Y. Chang
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

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In re application of
Steiger et al.
Serial No. 09/336,462
Filed: June 18, 1999
For: RECORDING SHEETS FOR INK JET PRINTING

DECISION ON PETITION

This is a decision on applicant's request on February 22, 2002, requesting that the time for responding to the Office Action, dated June 15, 2001, be reset due to the events of September 11th and aftermath because a timely response to the action was unable to be filed prior to the September 15, 2001 deadline.

**DECISION**

The instant response is accepted as a petition under 37 CFR 1.181 (no fee), and is considered pursuant to MPEP 710.06 which relates to resetting the period for response due to late receipt of a PTO action. Since the maximum extendable period for reply has expired, the Office action cannot be remailed and the period for reply set in the action cannot be restarted. If a reply has not been filed within the time period, the applicant may file a petition to revive under 37 CFR 1.137(a).

The Petition is **DISMISSED**.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

Dara L. Onofrio
233 Broadway
Suite 2702
New York, NY 10279-2799

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Paper No. 14

In re application of
Rolf Steiger
Serial No. 09/336,462
Filed: June 18, 1999
For: RECORDING SHEETS FOR INK JET PRINTING

DECISION ON PETITION

This is a decision on the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed May 8, 2002 for failure to respond to the office action dated June 15, 2001. Applicants assert that a response and three-month extension of time were timely submitted by the Applicant's on December 10, 2001.

**DECISION**

Since petitioner asserts that the papers were filed in a timely manner, the request is accepted as a petition under 37 C.F.R. 1.181 (no fee). A review of the petitioner's evidence provided with the instant petition indicates that the request has merit. The evidence, being a date stamped post card receipt from the USPTO and a certificate of mailing by applicants, is sufficient to establish that applicants did mail a response on December 10, 2001.

Therefore, the Notice of Abandonment dated March 26, 2002 is hereby withdrawn. Hence, the case is returned to pending status. The application shall be returned to the LIE for entering of the response (note: the three-month extension of time has already been charged to the account). After such is completed, the case will then be forwarded to the examiner for prompt consideration.

The Petition is **GRANTED**.

Richard V. Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

Dara L. Onofrio
233 Broadway
Suite 2702
New York, NY 10279-2799

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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1133 BROADWAY
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OFFICE OF PETITIONS

In re Application of :
Steiger :
Application No. 09/336,462 : ON PETITION
Filed: June 18, 1999 :
Attorney Docket No. ICH 286 :
For: RECORDING SHEETS FOR INK JET PRINTING

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, or in the alternative, under 37 CFR 1.137(a), or in the alternative, under 37 CFR 1.137(b), to revive the above-identified application. All petitions were filed in the same paper on May 12, 2004. The Office apologizes for the delay in addressing the petitions.

The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **DISMISSED**.

The petition under 1.137(a) to revive the application is **DISMISSED**.

The petition under 37 CFR 1.137(b) to revive the application is **GRANTED**.

The above-identified application became abandoned for failure to properly reply to the final Office action, mailed August 12, 2003. Petitioner filed an amendment after final and a request for a two month extension of time and required fee on January 14, 2004 (certificate of mailing date January 12, 2004). The amendment after final failed to place the above-identified application in *prima facie* condition for allowance, as stated in the February 23, 2004 Advisory Action. The application became abandoned on January 13, 2004. The filing of the instant petitions precedes the mailing of a Notice of Abandonment.

## PETITION UNDER 37 CFR 1.181

Petitioner requests that the holding of abandonment be withdrawn. Petitioner argues that applicant acted with promptness, diligence, and good faith in timely filing the January 14, 2004 (certificate of mailing date January 12, 2004) amendment. Petitioner asserts that because the February 23, 2004 Advisory Action was mailed after the expiration of the extendable six (6) month deadline for response to the August 12, 2003 final Office action, that it was not possible for petitioner to timely respond.

Petitioner is informed that the application became abandoned due to applicant's failure to submit a proper reply to the August 12, 2003 final Office action, **not** for failure to respond to the February 23, 2004 Advisory Action. Filing an amendment after final that failed to place the application in *prima facie* condition for allowance did not toll the period for reply to the August 12, 2003 final Office action or shift the burden of prosecution on the Office.

The application is properly held abandoned. The petition under 37 CFR 1.181 to withdraw the holding of abandonment is **dismissed**.

## PETITION UNDER 37 CFR 1.137(A)

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) the petition fee as set forth in § 1.17(l);

(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

This petition does not satisfy requirement (3).

Regarding (3), the showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term 'unavoidable' "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

In the instant case, petitioner has failed to provide adequate evidence that the delay was unavoidable. Petitioner is reminded that after a final action, there are only five possible replies: (1) a Notice of Appeal, (2) a continuing application, (3) a 37 CFR 1.129(a) submission, if appropriate, (4) an amendment after final that makes the case ready for issuance or (5) a RCE. To be a proper reply, an amendment after final must eliminate all of the Examiner's objections and rejections, and thus place the case in *prima facie* condition for allowance.

Petitioner's amendment after final failed to eliminate all of the Examiner's objections and rejections. The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last Office action, or refusal to admit the same, shall not operate to save the application from abandonment. "[T]he admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135." See 37 CFR 1.116(a).

Petitioner's failure to appreciate that the filing of a proposed amendment under 37 CFR 1.116 on January 14, 2004 (certificate of mailing date January 12, 2004) did not relieve petitioner of the

above-identified application is unfortunate, but it is not unavoidable delay. The abandonment of an application subject to a final Office action is not "unavoidable" within the meaning of 35 USC 133 and 37 CFR 1.137(a) in the situation in which the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. At 53162, 1203 Off. Gaz. Pat. Office at 89 (response to comment 66).

Petitioner is reminded that an Advisory Action does not start a new period for response. The application became abandoned because petitioner did not submit a proper reply to the final Office action.

The petition under 37 CFR 1.137(a) is **dismissed**. Pursuant to petitioner's authorization, the $110.00 fee for filing a petition under 37 CFR 1.137(a) will be charged to deposit account no. 50-1541.

**PETITION UNDER 37 CFR 1.137(B)**

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

Applicant has submitted a reply in the form of a CPA and preliminary amendment. Effective July 14, 2003, CPA practice was eliminated as to utility and plant applications. Any request for a CPA filed on or after July 14, 2003 in a utility or plant application is improper, regardless of the filing date of the utility or plant application in which the CPA is filed. An improper CPA is treated as a RCE. Since the improper CPA in this case was filed with a preliminary amendment and the

January 14, 2004 (certificate of mailing date January 12, 2004) after final amendment could be a proper submission, the improper CPA will be treated as a proper RCE. Petitioner has submitted an acceptable statement of the unintentional nature of the delay in responding to the August 12, 2003 final Office action and pursuant to petitioner's authorization, the Office will charge the petition fee of $1,330.00 to deposit account no. 50-1541 shortly.

The petition under 37 CFR 1.137(b) is **granted**.

After the mailing of this decision the application will be forwarded to Technology Center 1700 for further examination.

Telephone inquiries pertaining to this matter may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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OFFICE OF PETITIONS

In re Patent No. 7,250,202 :
Issue Date: July 31, 2007 :
Application No. 09/336,462 : ON PETITION
Filed: June 18, 1999 :
Attorney Docket No. ICH-286 :

This is a decision on the petition filed October 29, 2007, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **Dismissed**.

Applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 3.81(b).

37 CFR 3.81(b), effective June 25, 2004, reads:

> *After payment of the issue fee:* Any request for issuance of an application in the name of the assignee submitted after the date of payment of the issue fee, and any request for a patent to be corrected to state the name of the assignee, must state that the assignment was submitted for recordation as set forth in § 3.11 **before issuance of the patent**, and must include a request for a certificate of correction under § 1.323 of this chapter (accompanied by the fee set forth in § 1.20(a) and the processing fee set forth in § 1.17(i) of this chapter [emphasis added]. *See also* MPEP 1481.01.

The Office attempted to charge deposit account no. 50-1541 to obtain the $130.00 processing fee. However, there were insufficient monies ($100.00) in the deposit account. Accordingly, the petition cannot be granted at this time.

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[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (571) 273-8300
ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3215.

Charlema Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

ONOFRIO LAW
107 SHAD ROW
PIERMONT NY 10968

COPY MAILED

JUN 18 2008

OFFICE OF PETITIONS

In re Patent No. 7,250,202 :
Issue Date: July 31, 2007 :
Application No. 09/336,462 :
Filed: June 18, 1999 :
Attorney Docket No. ICH-286 :

ON PETITION

This is a decision on the renewed petition filed June 2, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3215. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch will be notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Charlema Grant
Petitions Attorney
Office of Petitions

[1] *See* MPEP 1309, subsection II; and Official Gazette of June 22, 2004.

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OCT 18 2005

ALAN MITCHELL
FREEHILLS
101 COLLINS STREET
MELBOURNE, VIC 3000
AUSTRALIA

**AIR MAIL**

ROGER D EMERSON
EMERSON & ASSOCIATES
4421 RANCHWOOD SPUR
AKRON OH 44333-1343

(for Patent Owner)

In re US Patent No. 6,113,233 of:
Robert G. Miller
Issued Date: September 5, 2000
Application Serial No.: 09/336,520
Filed: June 18, 1999
For: LENS COVER SYSTEM

DECISION RETURNING PAPERS

This is a decision returning a communication, filed September 30, 2005, by Alan Mitchell concerning U.S. patent No. 6,113,233. The communication is being returned as being an improper paper that is not eligible for entry into the patent file.

U.S. patent No. 6,113,233 was issued on September 5, 2000, to Robert G. Miller. There is no indication that Alan Mitchell submitted the communication on behalf of the inventor and/or the patent owner or that a copy of the communication was served on the patent owner.

The U.S. Patent and Trademark Office lacks statutory authority to consider papers, filed by a party other than the patent owner, that are not properly filed pursuant to 35 USC 301 (citation of prior art), 35 USC 302 (request for *ex parte* reexamination), or 35 USC 311 (request for *inter partes* reexamination). The rules governing these sections of the statute requires that a copy of the paper be served on the patent owner, if such paper is filed by a party other than the patent owner.

The communication filed on September 30, 2005, was not submitted as a request for reexamination or as a reissue application of the patent.

35 USC 301 and 37 CFR 1.501 provide for citing prior art consisting of patents and printed publications in patent files by any person at any time. The communication filed by Alan

Mitchell is not and does not qualify as a citation of prior art within the meaning of 35 USC 301 and 37 CFR 1.501.

Accordingly, the communication is not eligible for entry in the patent file, and, therefore, will not be considered and is being returned with this decision.

However, a copy of this decision will be made of record and a copy of the communication is enclosed for the patent owner.

Information regarding U.S. patent practice and procedure may be obtained by accessing the U.S. Patent and Trademark Office web site at www.uspto.gov or by consulting an attorney/agent who is registered to practice in front of the U.S. Patent and Trademark Office.

Janice A. Falcone

Janice A. Falcone, TC Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

Enclosures: Communication filed September 30, 2005 to Alan Mitchell and copy thereof to patent owner

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6193589
Issue Date: February 27,2001
Application No. 09336581
Filed: June 21,1999
Attorney Docket No.

:

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

:

This is a decision on the electronic petition, filed August 19,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of August 19,2009 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6193589 | 2001-02-27 | 09336581 | 1999-06-21 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

◉ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Sole Patentee | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature. | | | |
| Signature | /BEN KHALAJ/ | Date (YYYY-MM-DD) | 2009-08-19 |
| Name | BEN KHALAJ | | |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Paper No.

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, NW, SUITE 600
WASHINGTON DC 20005-3934

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Cheryl D. Senter, et al. | : | |
| Application No. 09/336,589 | : | ON PETITION |
| Filed: June 21, 1999 | : | |
| Attorney Docket No. SP036.C5 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee filed November 8, 2002.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on July 2, 2002, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

After receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2183 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy
(703) 305-9220

---

[1]The request to apply the issue fee to the new Notice must be made in writing and should be accompanied by the new Issue Fee Transmittal Form PTOL-85(b), along with a copy of this decision. Additionally, if the issue fee has increased from the previously paid issue fee, the balance due must be submitted. **Failure to *timely* r qu st *in writing* that the previously paid issue fee be applied towards the new N tic and payment of any balance due will result in the abandonment f the application.**

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MAIL Paper No. 13

KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK NY 10022-2585

JAN 21 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

| | | |
|---|---|---|
| In re Application of: | : | DECISION |
| Hasegawa et al. | : | SUA SPONTE |
| Application Serial No.: 09/336,636 | : | WITHDRAWING |
| Filed: June 18, 1999 | : | HOLDING OF |
| For: DIGITAL SUBSCRIBER LINE COMMUNICATING SYSTEM AND A TRANSCEIVER IN THE SYSTEM | : | ABANDONMENT |

This is a decision, *sua sponte*, withdrawing the holding of abandonment of the above-identified application.

A final Office action was mailed on October 30, 2002, setting a three (3) month shortened statutory period for response. A response was filed on January 29, 2003 (paper No. 10) and a resulting Advisory action was mailed on February 6, 2003 (paper No. 11). In the apparent absence of a timely filed response placing the application in condition for allowance, or other appropriate action, the application was considered abandoned. A notice of abandonment had not yet been mailed.

Although no petition or request to withdraw the holding of abandonment in this application has been filed, the holding of abandonment is withdrawn and the application restored to pending status in view of the December 18, 2003 submission of facsimile copies of a request for Continued Prosecution Application (CPA), request for extension of time, a preliminary amendment and stamped postcard receipt which itemizes aforementioned items (all stamped with the same Express Mail receipt in number).

The original CPA request, acknowledged as having been received in the USPTO on March 28, 2003 (based on the post card receipt), is not of record in the application file and cannot be located. However, M.P.E.P. § 503 states that "A post card receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO."

The application is being forwarded to the Technology Center's technical support staff for processing of the CPA request. Thereafter, the application will be forwarded to the examiner for appropriate action.

Jin Ng, Director
Technology Center 2600
Communications
(703) 305-4800

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Paper No. 37

LISA A HAILE PHD
GRAY CARY WARE & FREIDENRICH LLP
4365 EXECUTIVE DRIVE
SUITE 1100
SAN DIEGO CA 92121-2133

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| | | |
|---|---|---|
| In re Application of<br>Matthias G. Von Herrath<br>Application No. 09/336,672<br>Filed: June 17, 1999<br>Attorney Docket No. SCRIP1100 | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision on the petition to revive under 37 CFR 1.137(a), filed December 4, 2003 (Certificate of Mailing dated December 2, 2003).

The petition is **DISMISSED** for involving a moot issue.

The above-identified application was held abandoned for failure to timely reply to the final Office action mailed December 31, 2002. A Notice of Abandonment was mailed on April 21, 2003, prior to the end of the maximum six month statutory period for response. Applicant filed an Amendment and a Notice of Appeal on June 30, 2003, made timely by obtaining a three month extension of time.

A Notice of Rescinded Abandonment was mailed on December 8, 2003.

The application file is being forwarded to Technology Center 1600 for consideration of the Amendment and Notice of Appeal.

Telephone inquiries should be directed to the undersigned at (703) 305-0272.

Cliff Congo
Petitions Attorney
Office of Petitions

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Technology Center 2100

STAAS & HALSEY LLP
1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005

In re Application of:
Sumiyo OKADA
Application No. 09/336,706
Filed: June 21, 1999
For: MESSAGE DISPLAY METHOD AND INFORMATION EXCHANGE SYSTEM AND STORAGE MEDIUM

**DECISION ON PETITION UNDER 37 C.F.R. § 1.181**

This is a decision on the petition filed December 11, 2006 under 37 CFR § 1.181 to invoke Supervisory Authority of the Commissioner and require the Examiner to withdraw the Final rejection mailed September 14, 2006.

The petition is **DISMISSED AS MOOT**.

On December 11, 2006, applicant's counsel filed a petition to the Director under 37 CFR § 1.181 to seek relief from actions of the Examiner in relation to the Final Office action mailed September 14, 2006.

A review of the record indicates that on January 12, 2007, applicant filed a proper Request for Continued Examination (RCE) with the required fee, a preliminary amendment and a petition for one (1) month extension of time. A proper Request for continued Examination lifts the finality of the earlier office action.

Accordingly as petitioner's relief has already been given the petition is **DISMISSED AS MOOT.**

Any inquiry concerning this decision should be directed to John Follansbee at (571) 272-3964.

John Follansbee
Technology Center 2100
Computer Architecture, Software, and Information Security

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 24

Blakely Sokoloff Taylor & Zafman
12400 Wilshire Boulevard, 7th Floor
Los Angeles, CA 90025

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DEC 3 0 2002

OFFICE OF PETITIONS

In re Application of :
Mark C. Leifer :
Application No. 09/336,933 : ON PETITION
Filed: June 21, 1999 :
Attorney Docket No. 15685.P024 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 16, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 to the final Office action mailed January 3, 2002, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 CFR 1.136(a) have been obtained. Accordingly, the application became abandoned on April 4, 2002.

This application is being revived solely for purposes of continuity with a continued prosecution application (CPA) filed on December 16, 2002.

Telephone inquiries regarding this decision should be directed to Latrice Bond at (703) 308-6911.

The application file is being forwarded to Technology Center AU 2684 for further processing.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6129417 | 2000-10-10 | 09336944 | 1999-06-08 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /A. Justin Poplin/ | Date (YYYY-MM-DD) | 2008-10-28 |
| Name | A. Justin Poplin | Registration Number | 53476 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 6129417
Issue Date: October 10,2000
Application No. 09336944
Filed: June 8,1999
Attorney Docket No. CE99047

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 28,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 28,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 3

Pascal & Asociates
P.O. Box 11121
Station H
Nepean, Ontario K2H 7T8
CANADA

**MAIL**

MAY 11 2001

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Jia Xu )
Application No. 09/336,990 )
Filed: June 21, 1999 )
For: METHOD OF SCHEDULING EXECUTIONS OF PERIODIC AND ASYNCHRONOUS REAL-TIME PROCESSES HAVING HARD OR SOFT DEADLINES )

**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed April 27, 2001 and supplemented by the filing of May 8, 2001.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce
(703) 306-4160

cc: Mr. Jia Xu
1 Gilgorm Road
Toronto, Ontario M5N 2M4
CANADA

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Mr. Jia Xu
1 Gilgorm Road
Toronto ON M5N 2M4 CA CANADA

FAX RECEIVED
MAY 26 2005
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jia Xu | : | |
| Application No. 09/336,990 | : | ON PETITION |
| Filed: June 21, 1999 | : | |
| Attorney Docket No. 665P01US | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on February 28, 2005, to revive the above-identified application.

In response to the non-final Office action mailed September 10, 2003, petitioner hereby submits $750 for the petition to revive fee, an amendment, the statement of unintentional delay, as required by 37 CFR 1.137(b), and a supplemental amendment filed March 8, 2005.

Since petitioner has met the requirements to revive this application, pursuant to 37 CFR 1.137(b), the petition is **GRANTED**.

The application file is being referred to Technology Center Art Unit 2127, for consideration of the supplemental amendment filed March 8, 2005.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 12

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON VA 22209-9889

MAIL

MAR 2 6 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
Pirkola, et al.
Application No. 09/337,330
Filed: June 21, 1999
For: MOBILITY WITHIN A PACKET-SWITCHED TELEPHONY NETWORK

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the Petition for Withdrawal of Abandonment, filed September 23, 2003, requesting the holding of abandonment be withdrawn in the above-identified application.

This application was held abandoned for failure to timely file a response to a non-final Office action mailed July 31, 2002. A Notice of Abandonment was mailed April 23, 2003 and re-mailed August 22, 2003.

A review of the record indicates that a Change of Address/Power of Attorney via customer number, was errantly matched with the subject application. Subsequently, the Office action mailed April 23, 2003 and the original Notice of Abandonment were in fact mailed to an errant address.

In view of the above stated reasons there was an irregularity in mailing. Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The petition is **GRANTED**.

The application file will be forwarded to the examiner for update and preparation of a new Office action. The errantly matched Change of Address/Power of Attorney has been removed from the application and matched with the appropriate file.

Allen MacDonald

Allen MacDonald, Director
Technology Center 2600
Communications
(703) 305-9700

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Alexandria, VA 22313-1450
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NOKIA TELECOMMUICATION OYJ
P.O. BOX 300, 0045 NOKIA GROUP
HELSINKI, FINLAND

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AUG 29 2008

In re Application of
Juha Matti Pirkola, et al.
Application No. 09/337,330
Filed: June 21, 1999
Attorney Docket No. NOKIA.33US

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed May 6, 2008, to revive the above-identified application.

The petition is **GRANTED**.

A review of the record discloses that this application became abandoned for failure to timely reply within the meaning of 37 CFR 1.113 to the final Office action, mailed May 25, 2006. A Notice of Abandonment was mailed on January 4, 2007. On May 6, 2008, the present petition was filed. The petition was supplemented with a filing of a Request for Continued Examination (RCE) under 37 CFR 1.114 on June 2, 2008. Thereafter, on July 23, 2008 a Request to Withdraw as Attorney was filed.

It is noted that while a change of address to the offices of Banner & Witcoff was processed in response to a request to withdraw as attorney, it was done in error. The request to change the correspondence address of record is not acceptable as the request was signed by a registered attorney no longer of record and the requested correspondence address is not that of: (1) the first named inventor or (2) the assignee of the entire interest. The correspondence address will be changed to the address of the assignee of entire interest. A courtesy copy of this decision is being mailed to Banner & Witcoff; however, if Banner & Witcoff desires to receive any further correspondence regarding this application, then a proper Power of Attorney and/or change of correspondence address should be filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a RCE under 37 CFR 1.114, including the fee of $810; (2) the petition fee of $1,540; and (3) an adequate statement of unintentional delay.

This application is being referred to Technology Center AU 2617 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: BANNER & WITCOFF
SUITE 1200
1100 13TH STREET
WASHINGTON, DC 20005-4051

8/6/6 EME

SPE RESPONSE F CERTIFICATE OF CORRECTION

Paper No.:20060806

#28

**DATE** : August 6, 2006

**TO SPE OF** : ART UNIT 1634

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,653,292

A response is requested with respect to the accompanying request for a certificate of correction:

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-910**
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

☒ **Approved** **All** changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

**SPE:** Ram Shukla **Art Unit** 1634

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION



PATENT NO. : 6,653,292 B1
APPLICATION NO. : 09/337619
DATED : November 25, 2003
INVENTOR(S) : Krieg et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On Title Page

[75] Inventors: Arthur M. Krieg, Iowa City, IA (US); George
Delete "Weiher" and insert "Weiner" Iowa City, IA (US)
Add --Dennis Klinman, Potomac, MD(US); and Alfred D. Steinberg, Potomac, MD (US)--

Signed and Sealed this

Nineteenth Day of September, 2006

Jon W. Dudas

JON W. DUDAS
*Director of the United States Patent and Trademark Office*

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JJGJr.: 03-02

Paper 25

FOLEY & LARDNER
3000 K STREET, NW/STE. 500
WASHINGTON, DC 20007-5109

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MAR 2 6 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of
Jain
Application No. 09/337,675
Filed: 22 June, 1999
Attorney Docket No. 029318/0497

This is a decision on the petitions filed respectively on 3 December, 2001, for revival of the application under 37 C.F.R. §1.137, section (b) alleging unintentional delay.[1]

The petition under 37 C.F.R. §1.137, section (b) is **GRANTED**.[2]

The record reflects that:

- the instant application for failure to reply timely and properly to a non-final Office action mailed on 10 April, 2001, with

  --a reply filed on 12 September that failed to place the application in condition for allowance,

  --an Advisory Action mailed on 25 September, 2001, and

  --an improper Continued Prosecution Application (CPA) filed (with request and fee for extension of time) filed on 10 October, 2000;

- the improper CPA was treated as an Request for Continued Examination (RCE), however, the RCE was not accompanied by the required submission;

- the application went abandoned after midnight 10 October, 2001;

- a Notice of Improper CPA was mailed on 24 October, 2001;

- the required submission for the RCE was filed contemporaneously with the instant petition.

---

[1] Effective December 1, 1997, the provisions of 37 C.F.R. §1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 C.F.R. §1.137(b). A grantable petition filed under the provisions of 37 C.F.R. §1.137(b) must be accompanied by:
(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
(2) the petition fee as set forth in 37 C.F.R. §1.17(m);
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
(4) any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

[2] The RCE fee was charged/paid upon the filing of the improper CPA and the fee for the petition to revive was charged/paid upon its filing.

The instant application is being forwarded to Technology Center 1600 for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-9199.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No. None

ELAN DRUG DELIVERY, INC.
C/O FOLEY & LARDNER LLP
3000 K STREET, N.W.
SUITE 500
WASHINGTON DC 20007-5109

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OFFICE OF PETITIONS

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| In re Application of | : | |
| Rajeev A. Jain, Jon Swanson, | : | |
| Robert Hontz, John Devane, | : | |
| Jenneth Iain Cumming, Maurice | : | |
| Joseph Anthony Clancy, and | : | |
| Janet Elizabeth Codd | : | DECISION ON TWO PETITIONS |
| Application No. 09/337,675 | : | UNDER |
| Filing Date: June 22, 1999 | : | 37 C.F.R. §§ 1.48 AND 1.183 |
| Attorney Docket Number: | : | |
| 029318/0497 | : | |
| Title: CONTROLLED-RELEASE | : | |
| NANOPARTICULATE COMPOSITIONS | : | |

## Background

This is a decision on the two concurrently filed petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183. Petitioner has requested the correction of the inventorship of the present application, along with the waiver of 37 C.F.R. § 1.48(a)(3)[1].

In short, Petitioner has requested that Gary Liversidge be added as an inventive entity, and that the Office waive the requirement that the applicant provide an oath or declaration by the actual inventors.

With the present submission, Petitioner has submitted the required petition fees, an Application Data Sheet (ADS), a statement by the inventor that is to be added, a declaration that

1 Petitioner has requested the waiver of 37 C.F.R. § 1.64, however this is properly treated as a petition to waive 37 C.F.R. § 1.48(a)(3).

has been executed by this individual, and a statement by the assignee consenting to the addition of this individual as an inventive entity.

The ADS that was submitted concurrently with these petitions cannot be accepted. Petitioner will note that an ADS filed with the application is not required to be signed unless the ADS includes a nonpublication request. Rule § 1.33(b) requires that amendments and other papers, except for written assertions pursuant to 37 C.F.R. § 1.27(c)(2)(ii), filed in the application must be signed by an appropriate party. Therefore, an ADS or a supplemental ADS filed after the filing of an application must be signed in accordance with 37 C.F.R. § 1.33(b).

The petition pursuant to 37 C.F.R. § 1.48 is **DISMISSED**.

The petition pursuant to 37 C.F.R. § 1.183 is **DISMISSED**.

A discussion follows.

## Applicable Rules

37 C.F.R. §1.48(a) sets foth, *in toto*:

(a) Nonprovisional application after oath/declaration filed. If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:
(1) A request to correct the inventorship that sets forth the desired inventorship change;
(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
(4) The processing fee set forth in § 1.17(i); and
(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 C.F.R. §1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may

be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

## Analysis of the Petition Pursuant to Rule § 1.183

Petitioner has requested the waiver of the requirement that all of the inventors other than the inventor being added to the application must execute the new declaration. As such, Petitioner has requested the waiver of 37 C.F.R. § 1.48(a)(3).

In order to submit a grantable petition pursuant to 37 C.F.R. § 1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has not established, *or even asserted*, that either condition exists in this case. The circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules.

**The existence of an extraordinary situation:**

Petitioner has not set forth that an extraordinary situation exists with this present set of facts. *Assuming arguendo* that Petitioner had made this assertion, Petitioner has requested that the Office waive the requirement that the applicant provide an oath or declaration by the actual inventors, however there does not appear to be anything extraordinary about an Applicant who is faced with the requirement that each of the inventors must execute a declaration.

**The question of whether justice requires the waiver of the rule:**

Petitioner has not set forth that justice requires the waiver of 37 C.F.R. § 1.48(a)(3). *Assuming arguendo* that Petitioner had asserted that justice requires the waiver of this rule, it is not understood by the undersigned why justice would require that the Office accept a declaration that has only been executed by one of eight inventors.

## Analysis of the Petition Pursuant to Rule § 1.48

Petitioner has met requirements (1) - (2) and (4) - (5) of Rule § 1.48. Regarding the third requirement, Petitioner has failed to provide an oath or declaration that has been executed by the

actual inventors, as required by 37 C.F.R. § 1.63, and pursuant to the discussion above, this requirement has not been waived.

## Conclusion

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §§ 1.48 and 1.183". This is not a final agency action within the meaning of 5 U.S.C § 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[2], hand-delivery[3], or facsimile[4]. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web[5].

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[6]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

---

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
4 (571) 273-8300- please note this is a central facsimile number.
5 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
6 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

ELAN DRUG DELIVERY, INC.
C/O FOLEY & LARDNER LLP
3000 K STREET, N.W.
SUITE 500
WASHINGTON DC 20007-5109

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MAR 30 2009

OFFICE OF PETITIONS

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| In re Application of | : | |
| Rajeev A. Jain, Jon Swanson, | : | |
| Robert Hontz, John Devane, | : | |
| Jenneth Iain Cumming, Maurice | : | |
| Joseph Anthony Clancy, and | : | |
| Janet Elizabeth Codd | : | DECISION ON TWO PETITIONS |
| Application No. 09/337,675 | : | UNDER |
| Filing Date: June 22, 1999 | : | 37 C.F.R. §§ 1.48 AND 1.183 |
| Attorney Docket Number: | : | |
| 029318/0497 | : | |
| Title: CONTROLLED-RELEASE | : | |
| NANOPARTICULATE COMPOSITIONS | : | |

## Background

This is a decision on the two petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183, concurrently filed on July 3, 2008. Petitioner has requested the correction of the inventorship of the present application, along with the waiver of 37 C.F.R. § 1.48(a)(3).

Receipt of the July 17, 2008 supplement to the petition pursuant to 37 C.F.R. § 1.48(a)(3) petition is acknowledged.

In short, Petitioner has requested that Gary Liversidge be added as an inventive entity, and that the Office waive the requirement that the applicant provide an oath or declaration by the actual

inventors (Petitioner has submitted declarations that have been executed by each of the inventors save Mr. Cumming).
With these submissions, Petitioner has submitted, *inter alia*, the required petition fees, the written consent of the assignee coupled with a statement pursuant to 37 C.F.R. § 3.73(b), a statement from the person being added as an inventor that the error in inventorship occurred without deceptive intention on his part, a Supplemental Application Data Sheet (ADS), and a declaration that has been executed by each inventor save Mr. Cumming.

The petition pursuant to 37 C.F.R. § 1.48(a)(3) is **DISMISSED**.

The petition pursuant to 37 C.F.R. § 1.183 is **DISMISSED**.

A discussion follows.

## Applicable Rules

37 C.F.R. § 1.48(a) sets foth, *in toto*:

(a) Nonprovisional application after oath/declaration filed. If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:
(1) A request to correct the inventorship that sets forth the desired inventorship change;
(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
(4) The processing fee set forth in § 1.17(i); and
(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 C.F.R. § 1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

## Analysis of the Petition Pursuant to Rule § 1.183

With this petition, Petitioner has requested the waiver 37 C.F.R. § 1.64. This request is being treated as a request for the waiver of 37 C.F.R. § 1.48(a)(3).

In order to submit a grantable petition pursuant to 37 C.F.R. § 1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

Petitioner has asserted, *much less established*, that either condition exists in this case. As such, the circumstances of this case do not demonstrate an extraordinary situation, much less one where justice requires waiver of the rules.

*Assuming arguendo* that Petitioner had made these two assertions, there does not appear to be anything extraordinary about an Applicant who is faced with the requirement that each of the inventors must execute a declaration, and that justice requires the waiver of the Office requirement that the declaration be executed by each inventor.

## Analysis of the Petition Pursuant to Rule § 1.48(a)(3)

Petitioner has met requirements (1) - (2) and (4) - (5) of Rule § 1.48. Regarding the third requirement, Petitioner has failed to provide an oath or declaration that has been executed by the actual inventors, as required by 37 C.F.R. § 1.63, and pursuant to the discussion above, this requirement has not been waived.

## Conclusion

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. §§ 1.48 and 1.183". This is not a final agency action within the meaning of 5 U.S.C § 704.

Petitioner will note that **a grantable petition pursuant to 37 C.F.R. § 1.47(a) must be filed, before the Office will accept a partially-executed declaration.**[1]

---

1 See MPEP §§ 409, 409.03, 409.03(a), and 409.03(d).

It is noted that the Arthur, Elliott, and Willis declarations of facts each refer to Internet searches that were performed for non-signing inventor Cumming. Petitioner may wish to consider submitting a Rule 1.47(a) petition, along with a copy of these searches, so as to place the Office in a position where it can be determined whether the searches were sufficiently broad so as to provide a reasonable chance at locating this individual.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,[2] hand-delivery,[3] or facsimile.[4] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[5]

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[6]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
4 (571) 273-8300- please note this is a central facsimile number.
5 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
6 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No.

ELAN DRUG DELIVERY, INC.
C/O FOLEY & LARDNER LLP
3000 K STREET, N.W.
SUITE 500
WASHINGTON DC 20007-5109

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FEB 16 2010

OFFICE OF PETITIONS

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| In re Application of<br>Rajeev A. Jain, Jon Swanson,<br>Robert Hontz, John Devane,<br>Jenneth Iain Cumming, Maurice<br>Joseph Anthony Clancy, and<br>Janet Elizabeth Codd<br>Application No. 09/337,675<br>Filing Date: June 22, 1999<br>Attorney Docket Number:<br>029318/0497<br>Title: CONTROLLED-RELEASE<br>NANOPARTICULATE COMPOSITIONS | DECISION ON TWO RENEWED PETITIONS PURSUANT TO 37 C.F.R. §§ 1.48 AND 1.183 |

## Background

This is a decision on the two renewed petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183, concurrently filed on April 15, 2009. Petitioner has requested the correction of the inventorship of the present application, along with the waiver of 37 C.F.R. § 1.48(a)(3).

In short, Petitioner has requested that Gary Liversidge be added as an inventive entity, and that the Office waive the requirement that the applicant provide an oath or declaration by the actual inventors (Petitioner has submitted declarations that have been executed by each of the inventors save Mr. Cumming).

The renewed petition pursuant to 37 C.F.R. § 1.48(a)(3) is **DISMISSED.**

The renewed petition pursuant to 37 C.F.R. § 1.183 is **DISMISSED.**

A discussion follows.

## Applicable Rules

37 C.F.R. § 1.48(a) sets foth, *in toto*:

(a) Nonprovisional application after oath/declaration filed. If the inventive entity is set forth in error in an executed § 1.63 oath or declaration in a nonprovisional application, and such error arose without any deceptive intention on the part of the person named as an inventor in error or on the part of the person who through error was not named as an inventor, the inventorship of the nonprovisional application may be amended to name only the actual inventor or inventors. Amendment of the inventorship requires:
(1) A request to correct the inventorship that sets forth the desired inventorship change;
(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
(3) An oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or § 1.47;
(4) The processing fee set forth in § 1.17(i); and
(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter).

37 C.F.R. § 1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(h).

## Procedural History

Two petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183 were concurrently filed on July 3, 2008. The former was supplemented via a submission on July 17, 2008. Petitioner provided, *inter alia*, the required petition fees, the written consent of the assignee coupled with a statement pursuant to 37 C.F.R. § 3.73(b), a statement from the person being added as an inventor that the error in inventorship occurred without deceptive intention on his part, a Supplemental Application Data Sheet (ADS), and a declaration that has been executed by each inventor save Mr. Cumming.

Both petitions were dismissed via the mailing of a single decision on March 30, 2009, which indicated, *inter alia*, that a petition pursuant to 37 C.F.R. § 1.47(a) would need to be filed.

The requirement for a petition pursuant to 37 C.F.R. § 1.47(a) is hereby withdrawn.

Analysis of the Renewed Petition Pursuant to Rule § 1.183

This renewed petition is being construed to contain a request for the waiver of 37 C.F.R. § 1.48(a)(3), which requires the submission of an oath or declaration by the actual inventors (each of the actual inventors have executed the declaration that was provided with the submissions of July 3, 2008 and July 17, 2008, but for Mr. Cumming, who allegedly cannot be located.)

In order to submit a grantable petition pursuant to 37 C.F.R. § 1.183, Petitioner must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985).

With this renewed petition, Petitioner has asserted, but has not established, that either condition exists in this case. More specifically, the record does not support a finding that non-signing joint inventor Cumming cannot be located. Petitioner has actual knowledge that the last-known address is no longer valid.[1] With the original petition, it was asserted that Internet searches that were performed for non-signing inventor Cumming.[2] However, the electronic record does not contain a copy of either the search terms or the search results. Without a copy of the search terms, the Office cannot ascertain whether the searches were sufficiently broad so as to provide a reasonable chance of success. Without a copy of the search results, the Office cannot ascertain whether any promising leads were obtained. As the record does not presently support a finding that Mr. Cummings cannot be located, the record does not support a finding that an extraordinary situation exists, such that justice requires the waiver of Rule 1.48(a)(3).

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1 Original petition pursuant to 37 C.F.R. § 1.183, paragraph 4.
2 Original petition pursuant to 37 C.F.R. § 1.183, paragraphs 3 and 6. See also Arthur declaration of facts (two online directories and two online search engines were searched), Elliott declaration of facts (one online search engine was searched), and Willis declaration of facts (two online search engines were searched).

Analysis of the Renewed Petition Pursuant to Rule § 1.48(a)(3)

With the original petition, requirements (1) - (2) and (4) - (5) of Rule § 1.48 were satisfied. Regarding the third requirement, Petitioner has failed to provide an oath or declaration that has been executed by the actual inventors, as required by 37 C.F.R. § 1.63, and pursuant to the discussion above, this requirement has not been waived.

Conclusion

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Second Renewed Petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail,[3] hand-delivery,[4] or facsimile.[5] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[6]

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[7]

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

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3 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
4 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
5 (571) 273-8300- please note this is a central facsimile number.
6 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
7 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No.

ELAN DRUG DELIVERY, INC.
C/O FOLEY & LARDNER LLP
3000 K STREET, N.W.
SUITE 500
WASHINGTON DC 20007-5109

**MAILED**

MAR 29 2010

**OFFICE OF PETITIONS**

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|---|---|
| In re Application of<br>Rajeev A. Jain, Jon Swanson,<br>Robert Hontz, John Devane,<br>Jenneth Iain Cumming, Maurice<br>Joseph Anthony Clancy, and<br>Janet Elizabeth Codd<br>Application No. 09/337,675<br>Filing Date: June 22, 1999<br>Attorney Docket Number:<br>029318/0497<br>Title: CONTROLLED-RELEASE<br>NANOPARTICULATE COMPOSITIONS | DECISION ON TWO SECOND RENEWED PETITIONS PURSUANT TO 37 C.F.R. §§ 1.48 AND 1.183 |

This is a decision on the two second renewed petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183, concurrently filed on March 11, 2010. Petitioner has requested the correction of the inventorship of the present application, along with the waiver of 37 C.F.R. § 1.48(a)(3).

The renewed petition pursuant to 37 C.F.R. § 1.48(a)(3) is **GRANTED.**

The renewed petition pursuant to 37 C.F.R. § 1.183 is **DISMISSED AS MOOT.**

Two petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183 were concurrently filed on July 3, 2008. The former was supplemented via a submission on July 17, 2008. Petitioner provided, *inter alia*, the required petition fees, the written consent of the assignee coupled with a statement pursuant to 37 C.F.R.

§ 3.73(b), a statement from the person being added as an inventor that the error in inventorship occurred without deceptive intention on his part, a Supplemental Application Data Sheet (ADS), and a declaration that has been executed by each inventor save Mr. Cumming.

Both petitions were dismissed via the mailing of a single decision on March 30, 2009.

Two renewed petitions pursuant to 37 C.F.R. §§ 1.48 and 1.183 were concurrently filed on April 15, 2009. Each was dismissed via the mailing of a single decision on February 16, 2010.

With these second renewed petitions, Petitioner has submitted a declaration that has been executed by formerly non-signing joint inventor Cumming.

A corrected filing receipt has been included with this decision.

The Technology Center will be notified of this decision, and jurisdiction over this application is transferred to the Technology Center, so that the application may receive further processing. The Technology Center's support staff will notify the Examiner of this decision, so that the present application can receive further processing in due course.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.[1] All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

Encl. corrected filing receipt

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1 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

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

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 09/337,675 | 06/22/1999 | 1615 | 2006 | 029318/0497 | 35 | 3 |

**CONFIRMATION NO. 9275**

**CORRECTED FILING RECEIPT**

31049
Elan Drug Delivery, Inc. c/o Foley & Lardner
3000 K Street, N.W.
Suite 500
Washington, DC 20007-5109

*OC000000040825002*

Date Mailed: 03/29/2010

Receipt is acknowledged of a CPA in this non-provisional patent application. The application will be taken up for examination in due course. Applicant will be notified as to the results of the examination. Any correspondence concerning the application must include the following identification information: the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

**Applicant(s)**

RAJEEV A. JAIN, NORRISTOWN, PA;
JON SWANSON, NORTH WALES, PA;
ROBERT HONTZ, NEWTOWN SQUARE, PA;
JOHN DEVANE, ATHLONE, IRELAND;
KENNETH IAIN CUMMING, DUBLIN, IRELAND;
MAURICE JOSEPH ANTHONY CLANCY, CO Kildare, IRELAND;
JANET ELIZABETH CODD, Westford, IRELAND;
gary Liversidge, Westchester, PA;

**Power of Attorney:**

Arthur Schwartz--22115
Sybil Meloy--22749
Richard Linn--25144
Harold Wegner--25258
Richard Schwaab--25479
Kenneth Krosin--25735
Peter Mack--26001
David Blumenthal--26257
William Ellis--26874
Charles Schill--27590

**Domestic Priority data as claimed by applicant**

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 07/20/1999

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 09/337,675**

**CPA Filed on:** 02/28/2001

**Projected Publication Date:** Not Applicable

**Non-Publication Request:** No

**Early Publication Request:** No
**Title**

CONTROLLED-RELEASE NANOPARTICULATE COMPOSITIONS

**Preliminary Class**

424

## PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not result** in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at http://www.uspto.gov/web/offices/pac/doc/general/index.html.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, http://www.stopfakes.gov. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

# LICENSE FOR FOREIGN FILING UNDER

## Title 35, United States Code, Section 184

## Title 37, Code of Federal Regulations, 5.11 & 5.15

**GRANTED**

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign AssetsControl, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

**NOT GRANTED**

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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Paper No. 7

NASH & TITUS, LLC
3415 BROOKEVILLE ROAD
SUITE 1000
BROOKEVILLE MD 20833

COPY MAILED

JUL 0 3 2003

OFFICE OF PETITIONS

In re Application of
Ramasubbu Jevanthi et al.
Application No. 09/337,945
Filed: June 22, 1999
Attorney Docket No. ARMY-111A

ON PETITION

This is a decision on the petition filed December 16, 2002 under 37 CFR 1.137(b) to revive the above-identified application. The petition is being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

The petition is GRANTED.

This application became abandoned for failure to timely respond to the Notice to File Missing Parts mailed July 21, 1999. This application became abandoned September 22, 1999. Accordingly, a Notice of Abandonment was mailed August 3, 2000.

Petitioner claims that the above identified application is a continuation of application no. 08/590,973 and that a change of address was filed with the parent application on May 9, 1999. Additionally, a copy of the change of address was filed with the above identified application upon filing. Thus, petitioners never received the Notice to File Missing Parts nor the Notice of Abandonment. A review of the file confirms that a change of address was indeed filed with the present application and that the Notices of July 21, 1999 and the August 3, 2000 were mailed to the wrong address.

The fees due at filing on June 22, 1999 were $1306.00 and the Patent Application Transmittal authorized the charge to deposit account no. 21-0380 however, at the time of filing, that account had insufficient funds available to charge the required fees. Since the original transmittal authorized the charge, deposit account no. 21-0380 will be charged $1306.00 plus $130.00 for the surcharge for a late submission.[1] Additionally, in view of the fact that the Notices were mailed to the wrong address, the petition fee in the amount of $1280.00 will be credited back to deposit account no. 21-0380.

The Notice of Abandonment is withdrawn and this application is being forwarded to the Office of Initial Examination for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney in the Office of Petitions at (703) 305-4497.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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[1]While the abandonment is being withdrawn, in order to reinstate the application, the fees not previously paid must still be submitted. In order to expedite the processing of the application and since the authorizations have been provided in the application transmittal, to charge any additional fees due to the deposit account, the agency has proceeded at the direction of the attorney of record.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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**STRIKER STRIKER & STENBY**
**103 EAST NECK ROAD**
**HUNTINGTON NY 11743**

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AUG 2 2 2006
OFFICE OF PETITIONS

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| In re Application of | : | |
| Andreas Stoehrmann et al | : | |
| Application No. 09/337,947 | : | ON PETITION |
| Filed: June 22, 1999 | : | |
| Attorney Docket No. 693 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed January 6, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely reply to the Non-final Office action mailed February 2, 2001, which set a shortened statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on May 3, 2001.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

This application is being revived for the process claims only. Petitioner may not now file a continuing application for the method claims, since the invention to these claims has been abandoned.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This matter is being referred to Technology Center AU 1734.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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JAN 06 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 14

Jay P. Sbrollini
IBM Corporation IP Law Dept
T. J. Watson Research Center
P.O. Box 218
Yorktown Heights, NY 10598

| | |
|---|---|
| In re Application of: Butterworth<br>Application No.: 09/338,035<br>Filed: June 22, 1999<br>Attorney Docket No.: GB919990026US1<br>For: DATA PROCESSING SYSTEMS AND METHOD FOR PROCESSING TASKS IN SUCH SYSTEMS | **DECISION ON PETITION TO ACCEPT CORRESPONDENCE AS TIMELY FILED UNDER NOTICE OF POSTAL EMERGENCY** |

This is a decision on the petition filed August 18, 2003 by Ido Tuchman to withdraw the holding of abandonment under 37 CFR § 1.181 or alternatively as a petition to revive under 37 CFR § 1.137(a). The petition is being considered as a request to accept correspondence that would have been filed except for a postal emergency within the meaning of 35 U.S.C. § 21(a) and 37 CFR § 1.6(e). The notice of postal service interruption and emergency was posted on the USPTO web site on August 15, 2003 and was terminated with the notice dated August 19, 2003.

## BACKGROUND

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| Feb 14, 2003 | Final rejection mailed (Paper No. 6) |
| May 3, 2003 | After-final response filed (Paper No. 7) |
| Jun 2, 2003 | Advisory action mailed (Paper No. 8) |
| Aug 15, 2003 | Request for Continued Examination, extension of time, associate power of attorney, change of address, and amendment filed (Paper Nos. 9-11) |
| Aug 18, 2003 | Petition filed (Paper No. 13) |
| Sep 11, 2003 | Non-final Office action mailed setting new shortened statutory period (Paper No. 12) |

## ISSUES

The petition of August 18, 2003 states the application was abandoned due to a failure to timely respond to the Final Office Action dated February 14, 2003. It is accompanied by a declaration by Ido Tuchman, Reg. No. 45,924. That declaration states a response was being prepared on August 14, 2003, but that due to the blackout that affected the northeastern United States, the practitioner could not print and file the necessary papers. The RCE, amendment, and extension of time were filed by Express Mail on August 15, 2003.

## DECISION

In considering petitioners' submission in accordance with the guidelines set forth in the USPTO notices:

> Correspondence that would have been filed with the USPTO under 37 CFR 1.10 on Thursday, August 14, 2003, through Saturday, August 16, 2003, but which was not filed due to the USPS service interruption, should now be filed under the USPTO under 37 CFR 1.10 with a statement that the correspondence would have been deposited with the USPS ..., but for this designated interruption in the "Express Mail" service of the USPS.

The notice states these provisions "do not provide for the granting of a filing date to correspondence as of the date on which it would have been filed but for other exigencies, such as the unavailability of a computer or word processing equipment."

The practitioner's statement does not indicate whether the papers filed via Express Mail on August 15, 2003 would have been filed under 37 CFR § 1.10 or § 1.8 on August 14, 2003 but for the power outage. That question notwithstanding, the practitioner's statements found in paragraphs 7 and 8 of Ido Tuchman's declaration negate the attempt to have the correspondence accepted as timely due to postal service interruptions. Specifically, the practitioner acknowledges that other exigencies, such as the unavailability of computer equipment precluded the timely filing of the correspondence.

In the alternative, the petition must meet at least three conditions in order to accept the correspondence as timely filed under 37 CFR § 1.8(b):

1. Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
2. Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
3. **Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission.** If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.
   [Emphasis added.]

As the practitioner has noted in the petition, the papers were not filed until August 15, 2003. Therefore, the declaration is not accepted as a personal knowledge statement of the previous timely mailing of the correspondence since the filing needed to occur on or before August 14, 2003.

The papers filed August 15, 2003 included an associate power of attorney with an embedded change of address signed by Derek S. Jennings appointing Ido Tuchman as an associate. As Mr. Jennings himself does not have a power of attorney, he is not empowered to make such an appointment nor is he empowered to change the address of record for this application. Therefore, this petition is being mailed to the last official address of record. See 37 CFR §1.33(a)(2) and MPEP § 405.

The practitioner is also reminded that changes of correspondence address

> should be provided in a manner calling attention to the fact that a change of address is being made. Thus, the mere inclusion, in a paper being filed for another purpose, of an address which is different from the previously provided correspondence address, without mention of the fact that an address change is being made would not ordinarily be recognized or deemed as instructions to change the correspondence address on the file record.

See MPEP § 601.03.

The petition is **DISMISSED**.

The Office erroneously issued an action on the merits in response to applicant's filing dated August 15, 2003. That action is hereby vacated and **withdrawn**.

If the petitioner desires further review of this decision, petitioner should file a Request for Reconsideration within two (2) months of the mailing date of this decision. After that period, the file will be forwarded to the Office of Petitions for consideration of the petition under 37 CFR § 1.137(a). Telephone inquiries should be directed to the undersigned at 703-308-0269.

Josie A Ballato
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

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COMMISSIONER FOR PATENTS
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**MAIL**

MAR 2 3 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 19

Mr. Ido Tuchman
69-60 108th Street
Suite 503
Forest Hills, NY 11375

| | |
|---|---|
| In re Application of: Butterworth<br>Application No.: 09/338,035<br>Filed: June 22, 1999<br>Attorney Docket No.: GB919990026US1<br>For: DATA PROCESSING SYSTEMS AND METHOD FOR PROCESSING TASKS IN SUCH SYSTEMS | **DECISION ON PETITION TO ACCEPT CORRESPONDENCE AS TIMELY FILED UNDER NOTICE OF POSTAL EMERGENCY** |

This is a decision on the request for reconsideration filed February 13, 2004 to withdraw the holding of abandonment under 37 CFR § 1.181. The original petition was considered as a request to accept correspondence that would have been filed except for a postal emergency within the meaning of 35 U.S.C. § 21(a) and 37 CFR § 1.6(e). It was dismissed on January 6, 2004 (see Paper No. 14). The notice of postal service interruption and emergency was posted on the USPTO web site on August 15, 2003 and was terminated with the notice dated August 19, 2003.

While the petitioner's most recent filing remains a request under 37 CFR § 1.181, in fact, the practitioner appears to be requesting either a waiver of the rules under 37 CFR § 1.182 or consideration of a request to revive the application as unavoidably abandoned under 37 CFR § 1.137. Neither of which are under the jurisdiction of the Technology Center director. Therefore, this request has been improperly filed. The petitioner should consider filing his request under 37 CFR §§ 1.182 or 1.137 in order to have the merits of his arguments properly addressed by the Office of Petitions.

The request for reconsideration of the petition is **DENIED**. The holding of abandonment is still proper.

As stated in the previous decision, applicant's filing on August 15, 2003 was outside the six month period and therefore, the application was abandoned. Due to a clerical error the Office entered the amendment and issued an action on the merits in response to applicant's filing. That action was improper, it remains vacated and remains **withdrawn**.

Telephone inquiries regarding this decision should be directed to Josie Ballato, Special Program Examiner at 703-308-0269.

Peter Wong
Director, Technology Center 2100
Computer Architecture, Software, and Information Security

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Alexandria, VA 22313-1450
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DIW 08-04

Paper No. 21

IDO TUCHMAN
69-60 108TH STREET
SUITE 503
FOREST HILLS NY 11375

**COPY MAILED**

**JUN 2 5 2004**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Henry Esmond Butterworth | : | |
| Application No. 09/338,035 | : | ON PETITION |
| Filed: 22 June, 1999 | : | |
| Atty Docket No. UK999026 | : | |

This is a decision on the petition under 37 CFR 1.137(a) filed on 31 March, 2004, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **GRANTED**.

The application became abandoned on 15 May, 2003, for failure to timely file a response to the final Office action mailed on 14 February, 2003, which set a three (3) month shortened statutory period for reply. An amendment after final filed on 3 May, 2003, was found by the examiner not to place the case in *prima facie* condition for allowance, and an Advisory Action was mailed on 2 June, 2003. The RCE, amendment, and extension of time filed on 15 August, 2003, were untimely. Notice of Abandonment was mailed on 10 February, 2004.

The application has been restored to pending status.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply.[1] The three-month extension request and fee of $930.00 filed on 15 August, 2003, was submitted more than six (6) months after the mailing date of the Office action mailed on 14 February, 2003, and therefore is unnecessary. Additionally, a petition fee of $110.00 is due. As such, the balance of $820.00, will be credited to counsel's deposit account, No. 50-0150 as authorized in the present petition.

---

[1] See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

The application file is being forwarded to Technology Center 2100 for consideration of the RCE and amendment filed on 15 August, 2003.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.

D Wood

Douglas I. Wood
Senior Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
www.uspto.g

Paper No. 7

Jay P. Srollini
IBM Corporation IP Law Department
Thomas J. Watson Research Center
P. O. Box 218
Yorktown Heights, New York 10598

**MAILED**

NOV - 8 2002

**Technology Center 2100**

| | | |
|---|---|---|
| In re Application of: Martin J. Trotter | ) | **DECISION ON PETITION UNDER 37** |
| Application No.: 09/338,045 | ) | **C.F.R. § 1.181 TO WITHDRAW** |
| Filed: June 22, 1999 | ) | **HOLDING OF ABANDONMENT** |
| For: MEMORY MANAGEMENT | ) | |

This is a decision on the petition filed October 8, 2002 under 37 CFR § 1.181 to a withdraw the holding of abandonment of the above-identified application.

This application was held abandoned for failure to file a timely response to the Office action of mail date November 27, 2001. A Notice of Abandonment was mailed on October 2, 2002.

In support of the petition, Petitioner provides a copy of (1) a Certificate of Mailing by Margaret Brown, dated February 27, 2002; (2) an Amendment/Response Transmittal with Certificate of Mailing by Margaret Brown, dated February 27, 2002; (3) an amendment filed in response to the Office action of mail date November 27, 2001; and (4) a post card with a PTO stamp indicating receipt at the USPTO on March 05, 2002 of the aforementioned items.

M.P.E.P. § 503 states:

> A post card receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

Petitioner has established that a timely response was filed on February 27, 2002 and the Abandonment was the result of Office error in not matching the response to the application file. Note that the best practice to establish a date of mailing is to include a certificate of mailing for each paper submitted, preferably on the paper itself. (See MPEP 512 sections entitled "Procedure by Applicant" and Use of Stamped Certification").

The petition is **GRANTED**. The Notice of Abandonment is **WITHDRAWN**.

The application file is being forwarded to the Technology Center support staff for processing of the amendment. After processing, the application will then be forwarded to the Examiner for appropriate action.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Security, Architecture, and Software
(703) 306-4160

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Weaver Austin Villeneuve & Sampson LLP - IGT
Attn: IGT
P.O. Box 70250
Oakland, CA 94612-0250

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : RICHARD SNOW | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7637814 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/338,286 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/22/1999 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1498** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A) in a timely manner. Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154(b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 9

FRANK CHAU ESQ
F CHAU AND ASSOCIATES LLP
1900 HEMSTEAD TURNPIKE SUITE 501
EAST MEADOW NY 11554

MAILED

MAR 1 9 2003

Technology Center 2600

ON PETITION

In re Application of:
Young-Chun Kim et al
Application No. 09/338,473
Filed: June 22, 1999
For: **APPARATUS FOR CONTROLLING MULTI-WORD STACK OPERATIONS USING A MULTI-BANK STACK IN DIGITAL DATA PROCESSORS**

This is a decision on the request filed November 25, 2002, to withdraw the holding of abandonment under MPEP 711.03(c)(II) and pursuant to 37 C.F.R. § 1.181(a). No fee is required.

The Notice of Abandonment was mailed September 19, 2002 for failure to respond in a timely and effective manner to the Final rejection mailed November 30, 2001.

Petitioner alleges that no Office communication was received.

Based on MPEP 711.03(c), in absence of any irregularity in the mailing of an Office action, there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office communication must include:

(a) a statement from the practitioner stating that the Office communication was not received by the practitioner;

(b) a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and

(c) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

The petitioner has complied with all the requirements above. Accordingly, the petition is **GRANTED.**

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application file will be forwarded to the TC 2600 Technical Support Staff to issue a new Final rejection and to restart the period for response.

James Dwyer, Director
Technology Center 2600
Communications

**DO NOT SCAN!** Please forward case and paper to address shown below.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/26/07

TO SPE OF : ART UNIT ~~2810~~ 2827

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/338597 Patent No.: 6172938

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

**Angela Green**

Certificates of Correction Branch

703-308-9390 ext. _____

Thank You For Your Assistance

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

TP ☒ **Approved** — All changes apply.

☐ **Approved in Part** — Specify below which changes do not apply.

☐ **Denied** — State the reasons for denial below.

Comments: _____

SPE

2827
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6294475
Issue Date: September 25,2001
Application No. 09338709
Filed: June 23,1999
Attorney Docket No. 4458

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed April 22,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 22,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6294475 | 2001-09-25 | 09338709 | 1999-06-23 | BU.4458 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Matthew E. Connors/ | Date (YYYY-MM-DD) | 2010-04-22 |
| Name | Matthew E. Connors | Registration Number | 33298 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

DATE _____

APPLICATION NUMBER 09/338744

DOC CODE PBT DEC BLA

DOC DATE 09/24/07

DELIVER THE ATTACHED FIFLE/DOCUMENT TO THE TC SCANNING CENTER

CONTRACTOR: THE ATTACHED FILE/DOCUMENT MUST BE INDEXED AND SCANNED INTO IFW WITHIN 8 WORK HOURS; UPLOADING OF THE SCANNED IMAGES SHOULD OCCUR NO LATER THAN 16 WORK HOURS FOLLOWING RECEIPT OF THIS REQUEST

AFTER SCANNING, ORIGINAL DOCUMENTS SHOULD BE BOXED IN ACCORDANCE WITH INSTRUCTIONS

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JJGJR.: 09-07

Paper No: __

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OFFICE OF PETITIONS

WATTS HOFFMANN CO. LPA
P.O. BOX 99839
CLEVELAND OH 44199-0839

In re Application of
White
Application No.: 09/338,744
Filing Date: 23 June, 1999
Attorney Docket No. 04873/056002

DECISION

This is a decision on the petition re-filed on 6 April, 2007, after apparently having been filed originally unsigned on 31 January, 2007, and considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.[1]

**Petitioner does not appear to have been empowered herein, and so the Change of Address filed on 9 April and 26 July, 2007, have not been entered of record. A copy of this decision is being sent to the Petitioner, however, all correspondence will be directed to the address of record (above) until such proper authorization (i.e., Change of Address and a Certificate pursuant to 37 C.F.R. §3.73(b) is filed as required under the Rules of Practice no Change of Address will be entered.**

**Petitioner is given one (1) month–not less than 30 days–from the mail date of this decision to correct this oversight, and the period is not extendable.**

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[1] NOTE: Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected. Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.

The petition as considered under 37 C.F.R. §1.181 is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the decision of the Board of Patent Appeals and Interferences (copy enclosed) mailed on 30 July, 2004, with reply due absent extension of time on or before 30 September, 2004;
- the application went abandoned by operation of law after midnight 30 September, 2004;
- the Office mailed a Notice of Abandonment on 30 November, 2004;
- on 31 January, 2007, Petitioner originally filed the instant petition with, *inter alia*, an averment that he did not receive a copy of the final Office action because the Office apparently failed to enter the Revocation/Power of Attorney filed (with supporting documentation including a certificate under 37 C.F.R. §3.73(b)) on 10 May, 2004 (Petitioner avers a 6 May filing, however, that was the date of submission and not filing)–and so the Office action and the Notice of Abandonment were mailed to the old/wrong address–and made the statements and provided documents required (see the Manual of Patent Examining Procedure provisions discussed below) in support thereof–but the 31 January, 2007, petition was not signed;
- on 6 April, 2007, Petitioner re-asserted the averments of his earlier (31 January, 2007) petition–this time with signed papers.

The Revocation/Power of Attorney filed on 10 May, 2004, has been accepted and entered.

**However, the Change of Address (filed on 9 April and 26 July, 2007) has not been entered because, as discussed above, they were not properly supported as required under the Rules of Practice, and Petitioner is reminded of the time period set forth above within which to correct the deficiencies discussed.**

Notably, the availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner immediate and on-demand information as to events/transactions in an

application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running as to any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)); and those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

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[2] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

**§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.**
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that—

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of—

(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).
[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[3]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[4]

Delays in responding properly raise the question whether delays are unavoidable.[5] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[6]

And the Petitioner must be diligent in attending to the matter.[7] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[8]))

### Allegations as to the Request to Withdraw the Holding of Abandonment

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[3] 35 U.S.C. §133 provides:
**35 U.S.C. §133 Time for prosecuting application.**
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[4] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

[5] See: *Changes to Patent Practice and Procedure*; *Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[6] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[7] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[8] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[9]

The commentary at MPEP §711.03(c) provides:

* * *

**A. Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action**

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

* **

<u>The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt</u> rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of

---

[9] <u>See</u>: <u>Delgar v. Schulyer</u>, 172 USPQ 513 (D.D.C. 1971).

> Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). (Emphasis supplied.)
>
> * * *

Moreover, the regulation places upon Petitioner a diligence requirement to seek relief within two (2) months of the act complained of.

It appears that Petitioner has satisfied the showing as discussed above.

## CONCLUSION

The petition as considered under 37 C.F.R. §1.181 is **granted**, and the 30 November, 2004, Notice of Abandonment is **vacated**.

**The instant application is released to BPAI for further processing, including the re-mailing of the 30 November, 2004, Decision of the Board with a new period of reply, in due course.**

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[10]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

cc:
TAROLLI SUNDHEIM
COVELL & TUMMINO LLP
1300 EAST NINTH STREET/STE. 1700
CLEVELAND, OH 44114

[10] The regulations at 37 C.F.R. §1.2 provide:
**§1.2 Business to be transacted in writing.**
All business with the Patent and 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.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6129544 | 2000-10-10 | 09339052 | 1999-06-23 | USP8641A-SEI |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Raymond Y Chan/ | Date (YYYY-MM-DD) | 2008-11-10 |
| Name | Raymond Y. Chan | Registration Number | 37484 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6129544
Issue Date: October 10,2000
Application No. 09339052
Filed: June 23,1999
Attorney Docket No. USP8641A-SEI

:

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

:

This is a decision on the electronic petition, filed November 10,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of November 10,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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Paper 15

MORRIS E LEWIS
6104 JOYCE DRIVE
CAMP SPRINGS, MD 20748

COPY MAILED

MAY 27 2003

OFFICE OF PETITIONS

In re Application of
Morris Lewis
Application No. 09/339,059
Filed: June 23, 1999
Attorney Docket Number: LEWIS

DECISIONS ON PETITION

This is a decision on the petition under 37 CFR §1.181 filed January 21, 2003 and the petition to revive under 37 CFR §1.137(b), filed February 19, 2003 to revive the above-identified application.

The petition to withdraw the holding of abandonment is **dismissed**.
The petition to revive under 37 CFR 1.137(b) is **granted**.

This above-identified application became abandoned for failure to timely file a response to a non-final Office Action which was mailed on April 12, 2002. The non-final Office Action set a three (3) month shortened statutory period for reply. Petitioner submitted a one month extension of time request and fee in the amount of $55.00 in July (July 8, 2002), August (August 6, 2002) and September (September 10, 2002). The request for extension of time in July was the only timely submission with the appropriate fee in the amount of $55.00. As such the reply period was extended until August 12, 2002. An untimely response to the Office Action was received on October 15, 2002 Accordingly, this application became abandoned on August 13, 2002. A Notice of Abandonment was mailed on December 19, 2002.

## Petition to Withdraw the Holding of Abandonment

Petitioner contends the abandonment of the above-identified application should be withdrawn because he is pro se and petitioner was not aware he was required to submit request for extension of time with appropriate fees pursuant to 37 CFR 1.17(a)(1)-(a)(3).[1] Petitioner further argues he was out of the country, thus he could not return

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[1] **37 CFR §1.17**
Patent application and reexamination processing fees.
(a) Extension fees pursuant to § 1.136(a):
(1) For reply within first month:
By a small entity ( § 1.27(a))..... $55.00
By other than a small entity..... $110.00
(2) For reply within second month:

Examiner Rosen's December 19, 2002 phone call. Petitioner argues the missed phone call should be treated as an Office Action that was never received. (Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971). Lastly petitioner argues the abandonment should be withdrawn because petitioner corrected any deficiencies with the January 21, 2003 "Petition to Correct Extension For Response Payment" and the accompanying $300.[2]

Petitioner's arguments have been considered but they are not persuasive. The fact that the petitioner is prosecuting the above-identified application without benefit of legal representation does not absolve applicant from adhering to the rules governing request for extension of time. Petitioner's lack of knowledge or improper application of the patent statue, rules of practice or the Manual of Patent Examining Procedure (MPEP) does not warrant the withdrawal of the holding of abandonment.[3]

Petitioner's argument that the missed phone call should be treated as an Office Action never received fails because the application was abandoned as a matter of law on August 13, 2002.[4] Petitioner submitted a second payment of $55.00 when the required fee for a two month extension of time was $205.00. Hence, petitioner's request for extension of time was rejected because insufficient funds were submitted to obtain the extension of time. Furthermore, petitioner's reliance on Delgar to equate a missed phone call because one is out of the country to the non-receipt of an Office Action (this includes a Notice of Allowance) is misplaced. Examiner Rosen's phone call was a courtesy.

The "Petition To Correct Extension For Response" and the accompanying $300.00 submitted on January 21, 2003 were untimely. As such petitioner is entitled to a refund of all of the money submitted to obtain extensions of time with the exception of the initial $55.00. Pursuant to 37 CFR §1.136, an extension of time must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8

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By a small entity ( § 1.27(a))..... $205.00
By other than a small entity..... $410.00
(3) For reply within third month:
By a small entity ( § 1.27(a))..... $465.00
By other than a small entity..... $930.00
(4) For reply within fourth month:
By a small entity ( § 1.27(a))..... $725.00

[2]Petitioner submitted three payments of $ 55.00 for a total of $165.00 in attempts of obtaining a three month extension of time. Petitioner was required to submit a total of $465.00 to make a timely submission within three months from the shortened statutory period.

[3] Petitioner is encouraged to contact the Inventor Assistance Center (800)786-9199 and the Office of Independent Inventors (703) 306--5568 to seek clarification of issues during the prosecution of this application.

[4]"Abandonment takes place by operation of law for failure to reply to an Office action ..." MPEP 711.03(c).

USPQ2d 1630, 1631 (Comm'r Pats. 1988). Petitioner's maximum period for request of extension of time expired on October 12, 2002. Accordingly, a treasury check in the amount of $410.00 will be forwarded to petitioner for the money submitted towards a three month extension of time.

Accordingly petitioner is not entitled to withdrawal of abandonment.

**PETITION TO REVIVE UNDER 37 CFR 1.137 (b)**

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:
(1) the required reply, unless previously filed;
(2) the petition fee as set forth in 37 CFR 1.17(m);
(3) a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional"; and
(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c).

The instant petition has been reviewed and found in compliance with the requirements of 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to Technology Center 2100 for further processing of the Amendment submitted on October 15, 2002.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 5-25-07

**TO SPE OF** : **Technology Center** 3641

09/339132

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6416257 B1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:

Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**

If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance**

Elisha Evans
**Certificates of Correction Branch**
***Tel. No. 703-308-9390 EXT 110***

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

- ☐ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☒ **Denied** — State the reasons for denial below.

**Comments:**

Cannot withdraw or add a priority claim after patenting. This is the subject of a reissue application. See MPEP 1402

MICHAEL J. CARONE
SUPERVISORY PATENT EXAMINER

M. J. C

**SPE**

3641
**Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

July 18, 2007

Patent No. : 6416257 B1
Ser. No. : 09/339132
Inventor(s) : Rainey
Issued : June 24, 1999
Title : **SEGMENTAL RETAINING WALL SYSTEM**
Docket No. :

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Cannot withdraw or add a priority claim after patenting. This is the subject of a reissue application. See MPEP 1402.

**In view of the foregoing, your request is hereby denied.**

Future correspondence concerning this matter should be filed and directed to Decisions & Certificates of Correction Branch.

Elisha Evans
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 ext. 110 or (703) 308-8309

Julie Daulton
Merchant & Gould, P.C.
3200 IDS Center, 80 S. Eighth Street
MINNEAPOLIS MN 55402-2215

CBN/eme

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**WENDEROTH LIND & PONACK**
**2033 K STREET NW**
**SUITE 800**
**WASHINGTON DC 20006**

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MAR 1 4 2005

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Norihiko Mizobata :
Application No. 09/339,246 :
Filed: June 24, 1999 :
Attorney Docket No. 1489/P208320 :

This is a decision on the petition, filed March 11, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on December 1, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2666 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No.

**STERNE, KESSLER, GOLDSTEIN & FOX**
**1100 NEW YORK AVENUE, N.W.**
**WASHINGTON DC 20005**

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MAY 1 2 2004

OFFICE OF PETITIONS
ON PETITION

| | |
|---|---|
| In re Application of | : |
| Matthew E. Hansen | : |
| Application No. 09/339,506 | : |
| Filed: June 24, 1999 | : |
| Attorney Docket No. SUL-4034 | : |

This is a decision on the petition, filed May 5, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on February 5, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2877 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE

Paper No. 14

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SEP 07 2004

Director's Office
Office of Patent Publication

JAY A. CHESAVAGE
3833 MIDDLEFIELD RD.
PALO ALTO, CA 94303

In re Application of
Andreas v. Bechtolsheim, et al. :
Application No. 09/339,963 : **DECISION ON PETITION**
Filed: June 25, 1999 :

This is a decision on the Petition To Reconsider Holding Of Abandonment under 37 CFR 1.181(a) and MPEP 711.03(a), received in the United States Patent and Trademark Office (USPTO) on August 6, 2004.

The petition is **DISMISSED.** Any request for reconsideration of this decision, or as explained below, filing a petition seeking revival under 37 CFR § 1.137, must be filed within TWO MONTHS (2) from the mail date of this decision.

The application was held abandoned for applicant's failure to timely file corrected drawings, as required in the Notice of Allowability, mailed January 9, 2004. Accordingly, a Notice of Abandonment was mailed on June 25, 2004.

Applicant states that he made a complete reply to the Notice of Allowance on March 17, 2004. Further, that on March 17, 2004 the applicant mailed to the USPTO, the Fee Transmittal, Issue fee of $1,330 (check), and 11 pages of formal drawings. In support of this assertion, applicant has provided a copy of the Fee(s) Transmittal, the check, and eleven sheets of formal drawings.

In order for a petition to be granted, the evidence must be sufficient according to one of the following standards:

**MPEP 503 (postcard receipt as prima facie evidence)**
**Certificate of Mailing under 37 CFR 1.8(b)**
**"Express Mail" Mailing under 37 CFR 1.10**

Provisions under 37 CFR 1.8(b) requires that the petitioner (1) promptly inform the Office of the previous timely mailing or transmission after becoming aware that the Office has no evidence of receipt of the correspondence, (2) supply copies of the previously mailed correspondence with certificate of mailing thereon, and (3) include a statement which attests to the previous timely mailing.

The Office acknowledges receipt of the Fee(s) Transmittal on March 17, 2004 which bearing a certificate of mailing signed and dated March 17, 2004. However, the Transmittal clearly states:

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper such as an assignment or formal drawings, must have it's own certificate of mailing.

Since, there was no certificate of mailing provided for the formal drawings, the applicant could not satisfy requirement under 37 CFR 1.8(b)(2).

Patent rules under 37 CFR § 1.8 ii states in part: ...The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. *See 37 CFR §1.8 Certificate of mailing or transmission*

37 CFR § 1.10 and MPEP 503 are not applicable since the petitioner has not provided evidence that either of these procedures were used.

The holding of abandonment cannot be withdrawn as this time.

Although this petition for withdrawal of the holding of abandonment is being dismissed, other petition remedies are available for bringing about the withdrawal of the holding of abandonment.

File a petition for Revival of Abandoned Application under CFR § 1.137 (a) or (b). Forms are available at USPTO website http://www.uspto.gov

- Under 37 CFR 1.137(a), a petition for the revival of an ***unavoidably*** abandoned application must be accompanied by the following:

  (1) The required reply to the outstanding Office action or notice, unless previously filed;
  (2) The petition fee set forth in § 1.17(l);
  (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable: and
  (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (c) of this section.
  (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (c) of this section.

- Under 37 CFR 1.137(b), a petition for the revival of an ***unintentionally*** abandoned application must be accompanied by the following:

  (1) The required reply to the outstanding Office action or notice, unless previously filed;
  (2) The petition fee as set forth in § 1.17(m);
  (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional;
  (4) Any terminal disclaimer (and fee as set forth in § 1.20(d) required pursuant to paragraph (c) of this section.

Further correspondence with respect to the petition for revival under 37 CFR 1.137 should be directed to the Office Of Petition at 703-305-9282 or addressed as follows:

By mail: Commissioner for Patents
P O Box 1450
Mail Stop Petitions
Alexandria, VA 22313-1450

Telephone inquires concerning this decision may be directed to the undersigned at 703-305-8380.

Thomas E Hawkins

Thomas E. Hawkins
Paralegal Specialist
Office of the Director
Office of Patent Publication

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JAY A. CHESAVAGE
3833 MIDDLEFIELD ROAD
PALO ALTO, CA 94303

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MAY 1 1 2005

OFFICE OF PETITIONS

In re Application of :
Andreas V. Bechtolsheim et al :
Application No. 09/339,963 : DECISION GRANTING PETITION
Filed: June 25, 1999 : UNDER 37 CFR 1.137(b)
For: MULTI-FUNCTION HIGH-SPEED :
NETWORK INTERFACE

This is a decision on the petition under 37 CFR 1.137(b), filed October 7, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to submit corrected formal drawings on or before April 9, 2004, as required by the Notice of Allowability mailed January 9, 2004. A Notice of Abandonment was mailed on June 25, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of corrected formal drawings which have been approved by the Official Draftsperson (see attachment); (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the drawings are accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Publishing Division.

Frances Hicks
Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Form PTO-948

UNITED STATES PATENT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

Mailed: OCT 19 2001

RPG

Paper No. 6

In re application of
Thaddeus John Novak
Serial No. 09/340,165
Filed: June 28, 1999
For: MICROSPOT TEST KIT AND METHOD FOR CHEMICAL TESTING

DECISION ON PETITION

This is a decision on the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed August 22, 2001 for failure to respond to the Office Action dated November 8, 2000. Applicants assert that they never received the Office Action.

**DECISION**

Since petitioner asserts that the Office Action was never received, the request is accepted as a petition under 37 C.F.R. 1.181 (no fee). A review of the petitioners' evidence provided with the instant petition indicates that the request has merit. The evidence is sufficient to establish that applicants did not receive the Office Action of November 8, 2000. The submitted evidence is a statement that the Office Action was not received, a statement that a search of the file jacket and records was done, to no avail, and a copy of the docket records showing that the Office Action was never received.

Therefore, the Notice of Abandonment of June 22, 2001 is hereby withdrawn. Hence, the case is returned to pending status. The application shall be returned to the LIE for remailing of the Office Action dated November 8, 2000.

The Petition is **GRANTED**.

Richard V. Fisher

Richard V. Fisher, Director
Technology Center 1700
Chemical & Materials Engineering

HEADQUARTERS US ARMY MATERIL COMMAND
Office of the Command Counsel
ATTN AMCC B IP
5001 Eisenhower Avenue
Alexandria, VA 22333-0001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 20

Norman Friedland
11300 U.S. Highway One
Suite 400
North Palm Beach, FL 33408

COPY MAILED

FEB 21 2003

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Frederic Goldstein | : |
| Application No. 09/340,303 | : DECISION GRANTING PETITION |
| Filed: June 28, 1999 | : |
| Attorney Docket No. 227076/014 | : |

This is a decision on the petition under 37 CFR 1.182 filed February 6, 2003, requesting that the above-identified application be accorded a filing date of June 28, 1999, rather than the presently accorded filing date of March 13, 2000.

The above-identified application was deposited on June 28, 1999. A review of the application file and the Office's electronic records of the application reveals that the application deposited on June 28, 1999, included a transmittal letter (one page) entitled "Utility Patent Application Transmittal", Fee Transmittal (one page), a Preliminary Amendment (6 pages), and a Preliminary Drawing Amendment (2 pages) accompanied by 5 sheets of drawings containing Figures 12-16. A review of the transmittal letter reveals that it did not indicate that any pages of specification or drawings were being filed but it did include an incorporation by reference statement which incorporated by reference the entire disclosure of prior application No. 08/902,538. The Preliminary Amendment contained amendments to the specification and claims and included four (4) claims numbered 22-25. No specification was deposited on June 28, 1999.

On July 28, 1999, Initial Patent Examination Division mailed a "Notice to File Missing Parts" stating that the application had been accorded a filing date and requiring an executed oath or declaration in compliance with 37 CFR 1.63 and the $130.00 surcharge set forth in 37 CFR 1.16(e). Since no specification was submitted with the application papers on filing, the application was erroneously accorded a filing date of June 28, 1999.

On September 28, 1999, an executed declaration and the surcharge were filed.

Thereafter, on February 18, 2000, Initial Patent Examination Division mailed a Notice of Incomplete Application stating that application was not entitled to a filing date because the specification is missing. A complete specification including at least one claim as prescribed by 35

U.S.C. 112 was required.

In response, on March 13, 2000, a specification including claims, 3 sheets of drawings containing Figures 1-11, and a copy of an executed declaration were filed. Accordingly, the application was accorded a filing date of March 13, 2000. The specification and drawings filed March 13, 2000 are a true copy of the specification and drawings as originally filed in prior application No. 08/902,538.

Petitioner states that the transmittal letter filed with the application on June 28, 1999 incorporated by reference the parent application No. 08/902,538 and requests that the application be accorded a filing date of June 28, 1999.

In view of the incorporation by reference contained in the application transmittal letter deposited on June 28, 1999, the Office, on petition, may accept a copy of the prior application at a later date (i.e., the copy of the prior application filed on March 13, 2000) and accord the application a filing date of June 28, 1999, the date a request for a divisional application based on prior application No. 08/902,538 was filed.

The petition is granted.

Receipt is acknowledged of the preliminary amendment filed February 6, 2003.

After mailing of this decision, the $130.00 petition fee will be charged to counsel's deposit account No. 06-2000 as authorized in the petition. The petition fee is necessary to correct applicant's filing error.

Thereafter, the application will be returned to Initial Patent Examination Division for further processing including correction of the filing date to **June 28, 1999**, using the copy of the application papers including the specification and the 3 sheets of drawings supplied on March 13, 2000.

Telephone inquiries specific to this matter should be directed to the undersigned at (703) 306-5586.

Eugenia A. Jones

Eugenia A. Jones
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAY 18 2004

Paper No. 31

In re Application of
Fredric Goldstein
Application No. 09/340,303
Filed: June 28, 1999
Attorney Docket No. 227076/014

: DECISION ON PETITION

This is a decision on the petition filed by facsimile transmission on April 16, 2004 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned for failure to file a proper and timely reply to the Office action dated April 25, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is dismissed.

Petitioner alleges that a timely and proper reply to the Office action. On January 20, 2004, petitioner submitted a facsimile copy of that reply. Apparently, the reply was filed by counsel for petitioner, Norman Friedland. Apparently, the reply was filed together with a post card receipt, but the post card receipt was not returned to counsel. The reply was not filed utilizing either 37 CFR 1.8 or 37 CFR 1.10.

37 CFR 1.6 indicates that correspondence is considered to be filed in the Office when it is actually received. 37 CFR 1.8 and 37 CFR 1.10 provide exceptions wherein correspondence will be considered to have been received in the Office on the date that it is mailed or transmitted to the Office, in certain circumstances and upon compliance with certain requirements stated in these regulations. In the absence of direct evidence that the reply was timely filed, that is, either received in the Office on or before July 25, 2003 or received in the Office after July 25, 2003 but on or before October 25, 2003 together with a petition for extension of time under 37 CFR 1.136(a) together with the extension fee petitioner has submitted two verified statements, one by petitioner, and one by Mr. Norman Friedland, counsel of record who prepared the reply to the April 25, 2003 Office action. These statements clearly evidence that the a reply to the Office letter in question, together with a request for extension of time were in fact prepared and mailed to the Office. But they simply do not establish that the reply was filed, *i.e.* received in the Office, on or before October 25, 2003, the last date for filing a reply to the Office letter dated April 25, 2003 permitted pursuant to 35 USC § 133.

Petitioner may submit a renewed petition, without fee, providing any additional evidence which would show that a reply to the Office letter in question was actually received in the Office. Absent such evidence, petitioner should consider filing a petition to revive under 37 CFR 1.137.

PETITION DISMISSED.

E. Rollins-Cross, Director
Technology Center 3700

Fredric Goldstein
Varmdovagen 207
13141 Nacka
Sweden

VIA AIR MAIL

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 34

**FREDRIC GOLDSTEIN**
**VARMDOVGEN 207**
**13141 NACKA,**
**SWEDEN**

COPY MAILED
JUN 14 2004
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Fredric Goldstein | : | |
| Application No. 09/340,303 | : | DECISION GRANTING PETITION |
| Filed: June 28, 1999 | : | UNDER 37 CFR 1.137(b) |
| For: RIBBON CURLING AND SHREDDING DEVICE | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed May 21, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the nonfinal Office action mailed April 25, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were timely obtained. Accordingly, the above-identified application became abandoned on July 26, 2003.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinal Office action of April 25, 2003, is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8680.

The application file is being forwarded to Technology Center AU 3721 for appropriate action as the nature of the case may require.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

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OFFICE OF PETITIONS

In re Application of :
Kiyonobu Kojima, et al. :
Application No. 09/340,739 : ON PETITION
Filed: June 28, 1999 :
Attorney Docket No. 450100-4940 :

This is a decision on the petition, filed May 2, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on April 8, 2005, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2615 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form must be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 13

MAILED

JUN 0 3 2003

Technology Center 2100

Daniel Piotrowski
US Philips Corporation
580 White Plains Road
Tarrytown, NY 10591

| | | |
|---|---|---|
| In re Application of: VAN DRIEL | ) | |
| Application No. 09/341,085 | ) | **DECISION ON PETITION TO** |
| Attorney Docket No. PHN 17,110 | ) | **WITHDRAW HOLDING OF** |
| Filed: July 2, 1999 | ) | **ABANDONMENT UNDER 37 CFR** |
| For: COMMUNICATION SYSTEM WITH | ) | **§1.181** |
| IMPROVED ACCESS NETWORK | ) | |

This is a decision on the petition, filed April 14, 2003 under 37 CFR §1.181 requesting the Withdrawal of the Holding of Abandonment of the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely file a proper reply to the Office letter mailed on July 29, 2002 (which was an advisory action mailed after the final rejection of May 28, 2002).

In support of the petition, petitioner provides (1) a copy of the Notice of Abandonment and cover sheet mailed on March 10, 2003 as Exhibit A, (2) a copy of the advisory action and cover sheet as Exhibit B (3) a copy of several papers filed on September 19, 2002, as Exhibit C, significantly including a request to file a continued prosecution application, (4) a copy of the postcard receipt, significantly including "CPA" among the list of noted documents, with a PTO mail room stamp of September 19, 2002 as Exhibit D.

Petitioner has met the burden of proof set forth in MPEP § 711.03(c) and 37 CFR § 1.181(b). Therefore, the Petition is **GRANTED**.

The Notice of Abandonment is withdrawn.

The application file will be forwarded to the examiner for review of the CPA and associated papers.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(703) 305-9750

BJP
May 16, 2003

UNITED STATES
PATENT AND
TRADEMARK OFFICE

JAN 31 2002

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

JACOBSON PRICE HOLMAN & STERN
400 SEVENTH STREET NW
WASHINGTON DC 20004

#16

In re Application of
Philippe Sauer et al
Serial No.: 09/341,119
Filed: November 18, 1999
Attorney Docket No.: P63712US0

: PETITION DECISION TO RESTART PERIOD FOR REPLY

This is in response to applicant's petition under 37 CFR § 1.181, filed January 17, 2002, requesting restarting of the period for reply.

A review of the file history shows the examiner mailed a Final Office action to applicants on October 19, 2001, setting a three month shortened statutory period for reply. Applicants state that they did not receive the Office action until January 17, 2002, more than two months after the mail date thereof, and provide copies of the docketing receipt stamped first page of the Office action as evidence thereof. Applicants' statement and evidence are acceptable and the period for reply will be adjusted accordingly.

Applicants' petition is **GRANTED**.

**The period for reply to the Office action mailed October 19, 2001, is hereby restarted as of applicants' date of receipt, January 17, 2002. The time period for reply remains as set therein.**

1-28-02 By note mail by office

Should there be any questions regarding this decision, please contact William R. Dixon, Jr., by mail addressed to Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.

2/9/5

Bruce M. Kisliuk
Director, Technology Center 1600

The office mail came 2 wks later

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No. 20

Rader, Fishman & Grauer PLLC
39533 Woodward Avenue
Suite 140
Bloomfield Hills, MI 48304-0610

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JUN 27 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bernd Bretschneider, et al. | : | |
| Application No. 09/341,225 | : | ON PETITION |
| Filed: September 29, 1999 | : | |
| Attorney Docket No. 60680-1281 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed May 21, 2002, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

The application file is being forwarded to Technology Center 1700 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Marianne E. Morgan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 6274389
Issue Date: August 14,2001
Application No. 09341288
Filed: July 8,1999
Attorney Docket No. ICC-164/PCT/

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed October 12,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 12,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6274389 | 2001-08-14 | 09341288 | 1999-07-08 | ICC-164/PCT/ |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ◉ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Kendal M. Sheets/ | Date (YYYY-MM-DD) | 2009-10-12 |
| Name | Kendal M. Sheets | Registration Number | 47077 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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JAN 26 2005

FLYNN THIEL BOUTELL & TANIS
2026 RAMBLING ROAD
KALAMAZOO, MI 49008-1699

| | |
|---|---|
| In re Application of | : |
| Satoshiu Mikami et al | : |
| Serial No.: 09/341,328 | : PETITION DECISION |
| Filed: July 6, 1999 | : |
| Attorney Docket No.: Kinoshita Case 209 | : |

This is in response to the petition under 37 CFR 1.181, filed November 4, 2004, requesting entry of a supplemental Appeal Brief.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on February 24, 2003, setting a three month shortened statutory period for reply, which set forth two different rejections under 35 U.S.C. 103(a) and an objection to new matter added by amendment. Applicants timely filed a Notice of Appeal followed by an Appeal Brief on October 9, 2003. The Appeal Brief under the heading "Issues" sets forth only one prior art rejection as being appealed. In view of the Final Office action, this was incorrect. The examiner, instead of notifying applicants of the deficiency of the Appeal Brief, prepared and mailed an Examiner's Answer on January 27, 2004, in which it was stated that since applicants had not argued the second rejection under 35 U.S.C. 103(a) it appeared that they acquiesced in the rejection.

Upon realization of the error of omission in the original Appeal Brief, applicants prepared and filed a Supplemental Brief on Appeal which included two introductory paragraphs explaining why the supplemental Brief was necessary and the entire previous Brief with additional arguments as to the second rejection under 35 U.S.C. 103(a). On July 6, 2004, the examiner refused entry of the Supplemental Brief on the grounds that it was directed to an issue not raised in the original Brief. Applicants failed to receive this communication until inquiry was made in September, 2004. A second request for entry of the Supplemental Brief was made on September 10, 2004. This request for entry was also refused by communication mailed October 18, 2004. This petition was filed November 4, 2004, requesting the Group Director direct entry of the Supplemental Brief.

DISCUSSION

Applicants argue that the examiner failed to follow Office procedure when finding the original Appeal Brief failed to address an outstanding ground of rejection and advise applicants that the

Appeal Brief, as filed, was defective. (See M.P.E.P. 1206.) A Brief is defective when it fails to address any proposed ground of rejection maintained by the examiner in a Final Office action. Here, the failure to address a ground of rejection appears to have been inadvertent. The Final Office action is drafted such that a first ground of rejection is set forth as in the previous Office action and then applicants' arguments with respect thereto are addressed. Then a second ground of rejection is set forth in such a manner that it could be misinterpreted as a continuation of the examiner's reply to applicants' arguments with respect to the first ground of rejection. The examiner, upon consideration of the Appeal Brief, should have held it defective in failing to address a ground of rejection and required submission of a new Brief. Alternatively the examiner could have accepted the Supplemental Appeal Brief as a new corrected Brief and prepared a new Examiner's Answer.

The petition is **GRANTED**.

**The Supplemental Appeal Brief filed February 23, 2004, is hereby entered as applicants' Appeal Brief. The examiner is directed to prepare an appropriate Examiner's Answer in reply to the Brief, or take other appropriate action.**

**No fee for this petition is required and the petition fee paid of $130.00 will be credited to applicants' Deposit Account No. 06-1382, as directed.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

Bruce M. Kisliuk
Director, Technology Center 1600

1 9 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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WEINGARTEN SCHURGIN GAGNEBY & HAYES
TEN POST OFFICE SQUARE
BOSTON, MA 02109

| | |
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| In re Application of<br>AIURA et al.<br>Serial No.: 09/341,339<br>PCT No.: PCT/JP98/04494<br>Int. Filing Date: 05 October 1998<br>Priority Date: 10 November 1997<br>Attorney's Docket No.: AK-284XX<br>For: METHOD AND APPARATUS FOR POLISHING INNER SURFACE OF CYLINDRICAL PORTION OF ELONGATED CYLINDRICAL WORK | DECISION ON PETITIONS<br>UNDER 37 CFR 1.137(b)<br>AND 37 CFR 1.182 |

This is a decision on applicant's "Petition for Revive Unintentionally Abandoned application under 37 CFR 1.137(b)" and correction of applicant/inventor Aiura's first name, which is treated as a Petition under 37 CFR 1.182 filed in the United States Patent and Trademark Office in 22 April 2002. This is also responsive to applicant's "Supplement to Petition for Revive Unintentionally Abandoned application under 37 CFR 1.137(b)" filed on 30 April 2002. The fee of $1280 for the petition to revive was paid.

## BACKGROUND

On 05 October 1998, applicant filed international application No. PCT/JP98/04494 which claimed priority of an earlier Japanese application filed 10 November 1997.

No Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 10 July 1999.

On 08 July 1999, within 20 months from the priority date of the international application, applicant filed a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the basic national fee and English translation of the international application.

On 30 July 1999, a Notification of Missing Requirements (Form PCT/DO/EO/905) and Notification of Defective Oath or Declaration (Form PCT/DO/EO/917) was mailed to applicant indicating that an oath or declaration executed by the inventors in accordance with either 37 CFR 1.66 or 37 CFR 1.68 and the surcharge for filing the oath or declaration after the twenty month period was required.

On 30 August 1999, applicants filed a response to the Notification of Missing Requirements including a declaration executed by the inventors and accompanied by an explanation of the translation error in applicant/inventor Aiura's first name from the published

international application.

On 04 November 1999, a decision on applicant's request to correct the inventor's first name was dismissed on the grounds that applicant did not give an acceptable explanation of the difference in the spelling of the inventor's name. Applicant was required to provide an explanation as to why the inventor did not note the incorrect translation of his first name in the published international application.

On 22 April 2002, a petition to revive under 37 CFR 1.137 (b) was filed along with an explanation from inventor Tadashi Aiura regarding the translation error.

## DISCUSSION

### Petition Under 37 CFR 1.182

Applicant's explanation that "during the prosecution of the PCT in Japan, the documents are written in Japanese Miragana and Chinese characters" and that he did not notice the mis-translated spelling of his name until entering the national phase is accepted and noted for the record. The Request is **GRANTED**. No petition fee is required.

### Petition Under 37 CFR 1.137(b)

A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper response unless it has been previously submitted, (2) the fee required by law for revival of an unintentionally abandoned application (1.17(m)), and (3) a statement that the "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional".

The proper response is the explanation of the change in inventor's first name in the declaration. The required petition fee of $1,240 has also been paid.

Applicant's statement that "the entire delay in filing the explanation for the name error from the due date of completing the application of November 11, 1999 until the filing of this petition was unintentional" has been interpreted as meaning that "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3) at the time of filing this petition. If this is an incorrect interpretation in view of the rules, petitioner is required to promptly notify this office.

Applicant supplemented his petition to revive with a terminal disclaimer. The terminal disclaimer is not required in this application since it was filed after 08 June 1995.

Thus, the requirements of 37 CFR 1.137(b) have been satisfied. The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

## CONCLUSION

The petition to revive under 37 CFR 1.137(b) is **GRANTED**.

The application is being forwarded to the US Designated/Elected Office for further

The application is being forwarded to the US Designated/Elected Office for further processing as the national stage of PCT/JP98/04494, assigned U.S. serial number 09/341,339. The 35 U.S.C. 371(c) date is **30 August 1999.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

UNITED STATES
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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

JUN 10 2002

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BAYER CORP., LAW AND PATENTS DEPT.
800 DWIGHT WAY
P. O. BOX 1986
BERKELEY, CA 94701-1986

| | |
|---|---|
| In re Application of | : |
| Armen B. Shanafelt et al | : |
| Serial No.: 09/341,351 | : PETITION DECISION |
| Filed: May 13, 1999 | : |
| Attorney Docket No.: MSB-7273 | : |

This letter is in response to the petition under 37 CFR 1.137(b) which is being treated as a petition under 37 CFR 1.181, filed March 19, 2002, seeking withdrawal of abandonment based on non-receipt of an Office action.

A review of the file history shows that the Office mailed an Office action to applicants at the address "Jeffrey M Greenman, Bayer Corporation, 400 Morgan Lane, West Haven CT 06516" on March 1, 2001, setting a one month shortened statutory period for reply. A Notice of Abandonment was mailed to applicants on February 14, 2002, due to failure to reply to the Office action. Applicants state that the Office action was never received as evidenced by being mailed to an incorrect address. It is noted that this application was filed under 35 U.S.C. 371 and was filed with a signed declaration of all inventors giving as a correspondence address the address in West Haven, CT. On February 20, 2001, a new declaration was received, also signed by all inventors giving the above mailing address. The new address in the declaration was not noted, nor was it specifically pointed out by applicants so that Office records could be changed. Therefor, it is concluded that applicants did not receive the Office action. In view thereof, the Notice of Abandonment of this application is withdrawn as of the mailing date of this decision and the application restored to pending status.

Applicants' petition is **GRANTED**.

**The application will be forwarded for correction of applicants' mailing address on Office records and then forwarded to the examiner for mailing of a new Office action.**

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

Bruce M. Kisliuk
Director, Technology Center 1600

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EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

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|---|---|
| In re Application of | : |
| Terry Delovitch | : |
| Application Number: 09/341,407 | :DECISION ON PETITION |
| Patent: 6,841,152 | : |
| Filing Date: October 12, 1999 | : |
| Issue Date: January 11, 2005 | : |

This is a decision on the petition filed March 15, 2006 under 37 CFR 3.81 (b)[1] to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **Granted**.

This application is being forwarded to the Certificate of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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[1]See 69 Fed. Reg. 29865 (May 26, 2004).

UNITED STATES PATENT AND TRADEMARK OFFICE

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Washington, D.C. 20231
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Paper No. 17

ANTHONY P VENTURINO
1615 L STREET NW
SUITE 850
WASHINGTON DC 20036

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OFFICE OF PETITIONS

In re Application of
Petrus Cornelius Jozef Beentjes
Application No. 09/341,637
Filed: September 3, 1999
Attorney Docket No. APV30918
Title: METHOD AND APPARATUS FOR STRIP-COATING A METALLIC STRIP-SHAPED SUBSTRATE WITH A PLASTIC BAND AND STRIP THUS OBTAINED

DECISION ON PETITION

BEST AVAILABLE COPY

This is a decision on the petition filed on December 28, 2001, pursuant to 37 C.F.R. §1.137(b)[1], to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed May 18, 2001, which set a shortened statutory period for reply of three (3) months. On August 23, 2001, an after final amendment was received, along with an information disclosure statement and a one-month extension of time under the provisions of 37 CFR §1.136(a). This response was considered by the Examiner, and was not deemed to place the application in condition for allowance. An advisory action was mailed to the applicant on September 19, 2001, with an indication that the period for response expired four months from the mailing date of the final rejection. No further

1 A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:
(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

extensions of time under the provisions of 37 CFR §1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 19, 2001.

37 C.F.R. §1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 C.F.R. §1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. §1.137(b)(3) and petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

With the instant petition, petitioner has submitted the required reply in the form of the filing of a continued prosecution application (CPA), has paid the petition fee as well as the fee associated with the filing of a CPA, and has made a statement which is being construed as the proper statement of unintentional delay.

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of the CPA application, 09/341,637.

The application file is being forwarded to Technology Center for processing of the CPA filed with the instant petition.

Telephone inquiries specific to this decision should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

Paul Shanoski
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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WASHINGTON, DC 20004

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OFFICE OF PETITIONS

In re Application of :
Karl-Hermann Schlingensiepen, et al. :
Application No. 09/341,700 :
Filed: September 24, 1999 :
Atty Docket No. P63763US0 :

ON PETITION

This is a decision on the petition, filed November 4, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on August 18, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 1635 for further processing of the request for continued examination under 37 CFR 1.114 filed November 4, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: " Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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Paper No. 17

IVOR R. ELRIFI
MINTZ LEVIN COHN FERRIS GLOVSKY & POPEO
ONE FINANCIAL CENTER
BOSTON, MA 02111

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**JUL 1 2 2001**

**OFFICE OF PETITIONS**
**A/C PATENTS**

In re Application of
Marc Piechaczyk et al.
Application No. 09/341,894
Filed: December 15, 1999
Attorney Docket No. 19904-002

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 26, 2001, to revive the above-identified application.

The petition is **GRANTED**.

**The two-month period for filing an appeal brief in triplicate (accompanied by the fee required by 37 CFR 1.17(c)), runs from the date of this decision.**

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed December 14, 2000, which set a shortened statutory period for reply of three (3) months. Three months (3) extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 15, 2001.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 305-9282.

The application file is being forwarded to Technology Center 1600.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 24

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER
6110 CENTER HILL AVENUE - BOX 161
CINCINNATI, OH 45224

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OFFICE OF PETITIONS

In re Application of :
Jean-Francois Bodet et al :
Application No. 09/341,979 : ON PETITION
Filed: July 21, 1999 :
Attorney Docket No. CM1431 :

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on March 7, 2003, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed August 27, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on November 28, 3002.

Pursuant to petitioner's authorization, Deposit Account No. 16-2480 was charged a total of $2,050.00 -- $1,300.00 for the petition to revive an unintentionally abandoned application and $750.00 for the currently filed RCE.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Technology Center AU 1751 for processing of the request for continued examination (RCE) under 37 CFR 1.114 and the currently filed amendment.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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CINCINNATI OH 45224

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OFFICE OF PETITIONS

In re Application of :
Bodet et al. :
Application No.09/341,979 :
Filed: July 21, 1999 :
Attorney Dkt. No. CM1431 :
Title of Invention: DETERGENT :
COMPOSITIONS WITH IMPROVED :
PHYSICAL STABILITY AT LOW :
TEMPERATURE

ON PETITION

This is a decision on the petition filed January 28, 2005, under 37 CFR 1.137(b) to revive the above-identified application.

This application became abandoned for failure to timely submit the issue and publication fees, as required by the Notice of Allowance and Fee (s) Due which was mailed August 16, 2004. The Notice of Allowance and Fee (s) Due set a three (3) month statutory period for reply. Extensions of time were not available under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on November 17, 2004. A Notice of Abandonment was mailed January 3, 2005.

The requirements for a grantable petition under 37 CFR 1.137(b) have been met. This petition is hereby **Granted**.

This application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
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Paper No. 13

DAVID G. BECK
MCCUTCHEN DOYLE BROWN AND ENERSEN LLP
THREE EMBARCADERO CENTER, SUITE 1800
SAN FRANCISCO, CA 94111

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OFFICE OF PETITIONS

In re Application of :
Robert J. Fretz et al :
Application No. 09/341,994 :
Filed: October 28, 1999 :
Attorney Docket No. 22645-7013 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed May 15, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed June 19, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 20, 2001.

The above-identified application is being revived solely for purposes of continuity with a continued prosecution application (CPA) filed on May 15, 2002.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application file is being forwarded to Technology Center 2600 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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SEP 24 2007

JENKINS & GILCHRIST, A PROFESSIONAL CORPORATION
225 W. WASHINGTON STREET
SUITE 2600
CHICAGO, IL 60606-3418

*In re* Patent No. 6,331,308 VVAN VORIS et al
Issue Date: December 18, 2001
Appl No.: 09/342,529
Filed: June 29, 1999
For: Correction of Inventorship

**DECISION GRANTING PETITION**
*37 CFR 1.324*

This is a decision on the petition filed April 25, 2005, to correct inventorship under 37 CFR 1.324.

The petition is **GRANTED**.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

SEP 24 2007

Commissioner for Patents
United States Patent and Trademark Office
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**DATE:** September 19, 2007
**TO:** Certificates of Correction Branch
**FROM:** William R. Dixon, Jr.
Technology Center 1600
**SUBJECT:** REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 6,331,308 as specified on the attached Certificate.

William R. Dixon, Jr.
Technology Center 1600

SEP 24 2007

# UNITED STATES PATENT AND TRADEMARK OFFICE

## CERTIFICATE

Patent No. 6,331,308
Patented: December 18, 2001

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

Peter Van Voris
Dominic A Cataldo
Crystal J. Driver

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

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COMMISSIONER FOR PATENTS
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Paper No. 22

**JAMES R. DUZAN**
**TRASK BRITT & ROSSA**
**P O BOX 2550**
**SALT LAKE CITY, UT 84110**

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JAN 07 2003

OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| David J. Corisis | : | |
| Application No. 09/342,789 | : | ON PETITION |
| Filed: June 19, 1999 | : | |
| Atty Docket No. 3384.1US (97-564.1) | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed July 22, 2002, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8680.

The application file is being forwarded to Technology Center AU 2827.

Frances Hicks

Frances Hicks
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,267,450 | 2001-07-31 | 09/342,886 | 1999-06-29 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Gregory J. Nelson/ | Date (YYYY-MM-DD) | 2010-03-03 |
| Name | GREGORY J. NELSON | Registration Number | 22066 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6267450
Issue Date: July 31,2001
Application No. 09342886
Filed: June 29,1999
Attorney Docket No. 313-P-11

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed March 3,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 3,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6180871 | 2001-01-30 | 09343069 | 1999-06-29 | 019729-000100US |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /David N. Slone, Reg. # 28,572/ | Date (YYYY-MM-DD) | 2006-11-16 |
| Name | David N. Slone | Registration Number | 28572 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6180871
Issue Date: January 30,2001
Application No. 09343069
Filed: June 29,1999
Attorney Docket No. 19729-000100

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed November 16,2006 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of November 16,2006. This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

**UNITED STATES DEPARTMENT OF COMMERCE**
**Patent and Trademark Office**
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

6/25/09

Patent No. :6084259
Inventor(s) :Kwon et al.
Issued : 7/4/2000
Title : PHOTODIODE HAVING CHARGE TRANSFER FUNCTION AND IMAGE SENSOR USING THE SAME
Atty.doc./File No.

Request for Certificates of Correction

Consideration has been given to your request for the issuance of a Certificate of Correction, for the above – identified patent under the provisions of CFR 1.322.

Inspection of the application for the patent reveals item [75], is printed in accordance with the record please show a corrected filing receipt . Therefore being no fault on the Patent and Trademark Office, It has no authority to issue a certificate of correction under the provision of 1.322.

In view of the forgoing, your request in this matter, is hereby denied.

Future written correspondence concerning this matter should be filed and directed to Decisions & Certificates of Correction Branch.

Henry Randall
Decisions & Certificates
of Correction Branch
(703) 756-1571

Paul K. Tomita
Three Embarcadero Center, Suite 410
San Franciso, CA 94111

HR

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 10

GATEWAY, INC.
ATTN: SCOTT CHARLES RICHARDSON
610 GATEWAY DRIVE
MAIL DROP Y-04
N. SIOUX CITY, SD 57049

COPY MAILED

FEB 03 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Richard A. Peasley | : | |
| Application No. 09/343,143 | : | ON PETITION |
| Filed: June 29, 1999 | : | |
| Attorney Docket No. P1210US00 | : | |

This is a decision on the renewed petition under 37 CFR 1.137(b), filed January 28, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed March 12, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 13, 2002.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Technology Center AU 2174 for processing of the request for continued examination (RCE) under 37 CFR 1.114.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 11

RAYMOND J WERNER INTEL
BLAKELY SOKOLOFF TAYLOR AND ZAFMAN LLP
12400 WILSHIRE BOULEVARD 7TH FLOOR
LOS ANGELES, CA 90025

COPY MAILED

AUG - 9 2001

OFFICE OF PETITIONS

In re Application of
Cheng, et al.
Application No. 09/343,293
Filed: June 30, 1999
Attorney Docket No. 42390.P7068

DECISION ON PETITION

This is a decision on the petition filed on July 30, 2001, pursuant to 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application was abandoned for failure to timely file a proper reply to the final Office action mailed July 10, 2000. This Office action set a shortened statutory period for reply of three (3) months from the mailing date of the action. No extensions of time having been obtained and no reply having been received, the above-identified application became abandoned on October 11, 2000. A Notice of Abandonment was mailed on January 18, 2001.

With the instant petition, the petitioner filed a request for a continued prosecution application (CPA) of the above-identified application under 37 CFR 1.53(d), and met all other requirements for a grantable petition under 37 CFR 1.137(b).

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the application, the application is again abandoned in favor of the CPA, filed July 30, 2001.

The application file is being forwarded to Technology Center 2800 for processing of the CPA (and accompanying preliminary amendment).

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0309.

Nancy Johnson

Nancy Johnson
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

AT&T CORP.
ROOM 2A207
ONE AT&T WAY
BEDMINSTER NJ 07921

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MAR 10 2006

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of<br>Steven M. Bellovin<br>Application No. 09/343,464<br>Filed: June 30, 1999<br>Attorney Docket Number:<br>2685/113031<br>Title: METHOD AND APPARATUS FOR<br>A DISTRIBUTED FIREWALL | DECISION ON PETITION UNDER<br>37 C.F.R. §1.181(A) |

This is a decision on the petition filed February 28, 2006, pursuant to 37 C.F.R. §1.137(a)[1], to revive the above-identified application, which is properly treated as a petition under 37 C.F.R. §1.181(a) to withdraw the holding of abandonment.

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed September 29, 2005, which set a shortened statutory period for reply of three (3) months. No

1 A grantable petition pursuant to 37 CFR §1.137(a) must be accompanied by:
(1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
(2) the petition fee;
(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
(4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

extensions of time are permitted for transmitting issue fees[2]. Accordingly, the above-identified application became abandoned on December 30, 2005. A Notice of Abandonment was mailed on February 2, 2006.

With the present petition, Petitioner has asserted that the issue fee was timely submitted, and has included a copy of form PTOL-85b. Although a duplicate of the same has not been located in the electronic file, Office records indicate that a payment of $1,400 was received on December 13, 2005.

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that a timely response was timely submitted.

Accordingly, the petition under 37 C.F.R. §1.181(a) is **GRANTED**. The holding of abandonment is **WITHDRAWN**.

The Office of Patent Publication will be notified of this decision.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

2 See MPEP §710.02(e).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

RONALD P. KANANEN
RADER FISHMAN & GRAUER
1233 20TH STREET, N.W., SUITE 501
WASHINGTON, DC 20036

**COPY MAILED**

JUL 21 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Robert S. Alvin | : | |
| Application No. 09/343,550 | : | ON PETITION |
| Filed: June 30, 1999 | : | |
| Attorney Docket No. HIS-006 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed January 3, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 2, 2001, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on January 3, 2002.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 3661 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Steven A. Swemofsky
P.O. Box 390013
Mountain View, CA 94039-0013

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Benton S. Duffett Jr.
BURNS, DOANE, SWECKER & MATHIS LLP
P.O. Box 1404
Alexandria, VA 22314-1404

(For Patent Owner)

NOV 20 2000

REEXAM UNIT

Thomas P. Pavelko
STEVENS, DAVIS, MILLER & MOSHER
1615 L Street NW
Suite 850
Washington, DC 20036

(For Requester)

In re reissue application of
Pervan
Application No. 09/343,696
Filed: June 30, 1999
For: U.S. Patent No. 5,706,621

In re Pervan
Reexamination Proceeding
Control No. 90/005,744
Filed: June 13, 2000
For: U.S. Patent No. 5,706,621

**DECISION, SUA SPONTE, TO MERGE REEXAMINATION AND REISSUE PROCEEDINGS**

The above noted reissue application and reexamination proceeding are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

## REVIEW OF FACTS

1. U.S. Patent No. 5,706,621 issued to Pervan on January 13, 1998.

2. On June 30, 1999, a reissue application was filed and assigned application no. 09/343,696, which amended claims 3 and 6, and added claims 24-40, and a notice of the reissue was published in the *Official Gazette* on August 31, 1999.

3. A nonfinal Office action was mailed in the reissue application on April 13, 2000.

4. On June 13, 2000, a request for reexamination of the '621 patent was filed by a third party requester, and was assigned Control No. 90/005,744.

5. On September 7, 2000, reexamination was ordered.

6. No patent owner's statement was filed in response to the order.

## DISCUSSION REGARDING MERGER

Under 37 C.F.R. § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 C.F.R. § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted

separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue application shows that applicant has amended claims 3 and 6, and added new claims 24-40. A review of the reexamination file shows that reexamination was ordered on September 7, 2000, and is awaiting a first Office action. Original patent claims 1-23 have been filed in the reexamination proceeding. Accordingly, the claims are not identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination will be merged in accordance with the decision set forth below.

## DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

### I. Merger of Proceedings

The above-noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

### II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. This maintenance of

identical amendments in the two files is required as long as the proceedings remain merged. See 37 C.F.R. § 1.565(d).

2. A proposed housekeeping amendment **must be filed within ONE (1) month of the mailing date of this decision**, to thereby place the same amendments in both cases. The housekeeping amendment should not address the issue of patentability. See 37 C.F.R. § 1.540.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action.

2. In the event that a housekeeping amendment is not timely submitted, any claim that does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged proceeding. **However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to both the reissue application and the reexamination proceeding. Each action will contain identifying data *for both* the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, filed in duplicate, each bearing a signature, for entry in both files.

6. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissued patent, and the reissued patent will serve as the certificate under § 1.570. See MPEP 2285.

7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned. The Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

8. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 C.F.R. § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improper broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 C.F.R. § 1.552(c).

9. Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 C.F.R. § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continuation of prosecution of the reexamination proceeding.

## CONCLUSION

1. The above noted reissue application and reexamination proceeding ARE MERGED.

2. The reissue and reexaminations file are being forwarded to the examiner via the Director of Technology Center 3600. Upon receipt of same, the examiner **should not issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding until the expiration of ONE (1) month from the mailing of this decision,** to allow for submission of a proposed housekeeping amendment, to thereby place the same amendments in both cases, as required in Part II, above.

3. All further examination should be conducted in accordance with Part III of this decision.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)308-0255.

Lynn M. Kryza
Special Projects Examiner
Office of Patent Legal Administration

November 17, 2000

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 19

COPY MAILED

JAN 29 2002

OFFICE OF PETITIONS

DAVID M. QUINLAN, P.C.
40 NASSAU STREET
PRINCETON, NJ 08542

In re Application of
Spear et al.
Application No. 09/343,736
Filed: June 30, 1999
Attorney Docket No. 3600.100

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 4, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to file a proper reply within the meaning of 37 CFR 1.113 to the final Office Action of June 8, 2001, within the time period for reply. A three (3) month extension of time having been obtained pursuant to the provisions of 37 CFR 1.136(a), the date of abandonment of this application was December 9, 2001. A Notice of Abandonment was mailed on January 8, 2002.

Although petitioners filed a timely amendment on November 28, 2001, it did not *prima facie* place the application in condition for allowance. Therefore, the amendment was not entered and made of record.

**The Notice of Appeal filed January 4, 2002, has been entered and made of record. Accordingly, the two (2) month period for filing the appeal brief, in triplicate, accompanied by the requisite fee, runs from the date of this decision.**

The $1,280.00 petition fee, the $320.00 notice of appeal fee, and the $130.00 request to expedite fee are being charged to Deposit Account No. 50-0409, as authorized in the petition.

The application file is being forwarded to Technology Center 3700 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 19

COPY MAILED

JAN 29 2002

OFFICE OF PETITIONS

DAVID M. QUINLAN, P.C.
40 NASSAU STREET
PRINCETON, NJ 08542

In re Application of
Spear et al.
Application No. 09/343,736
Filed: June 30, 1999
Attorney Docket No. 3600.100

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 4, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to file a proper reply within the meaning of 37 CFR 1.113 to the final Office Action of June 8, 2001, within the time period for reply. A three (3) month extension of time having been obtained pursuant to the provisions of 37 CFR 1.136(a), the date of abandonment of this application was December 9, 2001. A Notice of Abandonment was mailed on January 8, 2002.

Although petitioners filed a timely amendment on November 28, 2001, it did not *prima facie* place the application in condition for allowance. Therefore, the amendment was not entered and made of record.

**The Notice of Appeal filed January 4, 2002, has been entered and made of record. Accordingly, the two (2) month period for filing the appeal brief, in triplicate, accompanied by the requisite fee, runs from the date of this decision.**

The $1,280.00 petition fee, the $320.00 notice of appeal fee, and the $130.00 request to expedite fee are being charged to Deposit Account No. 50-0409, as authorized in the petition.

The application file is being forwarded to Technology Center 3700 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 22

**AUDLEY A. CIAMPORCERO JR.**
**JOHNSON & JOHNSON**
**ONE JOHNSON & JOHNSON PLAZA**
**NEW BRUNSWICK, NJ 08933-7003**

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OCT 3 1 2003

OFFICE OF PETITIONS

In re Application of
Hull et al.
Application No. 09/343,759
Filed: June 30, 1999
Attorney Docket No. PPC-668

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 10, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 1.17(c)) within the time period provided in 37 CFR 1.192(a). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed March 3, 2003, and no extensions of time under the provisions of 37 CFR 1.136(b) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.192(b) & 1.197(c). As no claim was allowed, the-above-identified application became abandoned on May 4, 2003. See MPEP 1215.04. A Notice of Abandonment was mailed on September 26, 2003.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:
(1) the required reply,[1]
(2) the petition fee,
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

Where there is a question as to whether either the abandonment or the delay in filing a petition

[1] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

under 37 CFR 1.137 was unintentional, the Commissioner may require additional information.[2]

The instant petition lacks item (4). A terminal disclaimer (and fee) is also required for a utility or plant application filed on or after June 8, 1995, but before May 29, 2000, where the application became abandoned during appeal. The reason being that utility and plant patents issuing on applications filed on or after June 8, 1995, but before May 29, 2000, are eligible for the patent term extension under former 35 U.S.C. 154(b) (as a result of the Uruguay Round Agreement Act (URAA)). If such an application is abandoned during appeal, the patentee of a patent issuing from such an application is eligible for these situations will make certain that any patent term extension obtained for the period of abandonment while the application is under appeal, interference, or a secrecy order will be dedicated to the public.

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries should be directed to Paralegal Liana Chase at (703) 306-0482.

BethAnne Daygan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[2] See MPEP 711.03(c)(III)(C) and (D).

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Paper No. 25

**AUDLEY A. CIAMPORCERO JR.**
**JOHNSON & JOHNSON**
**ONE JOHNSON & JOHNSON PLAZA**
**NEW BRUNSWICK, NJ 08933-7003**

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**OFFICE OF PETITIONS**

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|---|---|---|
| In re Application of<br>Hull et al.<br>Application No. 09/343,759<br>Filed: June 30, 1999<br>Attorney Docket No. PPC-668 | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed November 10, 2003, to revive the above-identified application.

The petition is **granted.**

The above-identified application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 1.17(c)) within the time period provided in 37 CFR 1.192(a). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed March 3, 2003, and no extensions of time under the provisions of 37 CFR 1.136(b) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.192(b) & 1.197(c). As no claim was allowed, the-above-identified application became abandoned on May 4, 2003. See MPEP 1215.04. A Notice of Abandonment was mailed on September 26, 2003.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

The file is now being forwarded to Technology Center 3700 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Telephone inquiries should be directed to Paralegal Liana Chase at (703) 306-0482.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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500 W MADISON STREET
CHICAGO IL 60661

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| | | |
|---|---|---|
| In re Application of | : | |
| Kenneth Scott Kump | : | |
| Application No.: 09/344,190 | : | DECISION ON |
| Filing or 371(c) Date: 06/24/1999 | : | PETITION |
| Attorney Docket Number: 15-XZ-4971 | : | |

This is a decision in response to the Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181, filed July 27, 2006.

This Petition is hereby **dismissed**.

Any further petition must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Non-Compliant Amendment ("Notice"), mailed May 26, 2004. The Notice set a one (1) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No reply having been received, the application became abandoned on June 27, 2004. A Notice of Abandonment was mailed July 3, 2006.

Petition under 37 CFR 1.181

Applicant files the instant petition and asserts that a timely reply to the Office action was filed via facsimile on June 4, 2004. In support of this assertion, Applicant provides a copy of a Fax Cover Letter and "Amendments to the Claims". The Fax Cover Letter indicates that the transmission was sent to 703-746-5934. The "Amendments to the Claims" do not contain any indication therein as to when it was sent to this Office.

Applicant requests that the application be placed in condition for allowance with the associated PTA.

Applicable Law, Rules and MPEP

The MPEP 502(I)(A) mandates that

> [e]ffective December 1, 2003, all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, with a few exceptions below. The central facsimile number is (571) 273-8300. Replies to Office actions including after-final amendments that are transmitted by facsimile must be directed to the central facsimile number. Unofficial correspondence such as draft proposed amendments for interviews may continue to be transmitted by facsimile to the Technology Centers (TCs). Office personnel should not use their personal facsimile numbers for official application related correspondence. Office personnel that inadvertently receive official application related correspondence on a personal facsimile number must either route (do not forward) the correspondence to the official central facsimile number or they may, with applicant's (or applicant's representative) permission, make the facsimile amendment part of an examiner's amendment. (Emphasis supplied).

MPEP 502(I)(A)

Analysis and conclusion

Applicant has failed to demonstrate that a complete and proper reply to the Notice was properly filed in this Office. Applicant transmitted the reply to 703-746-5934. As provided in the MPEP, facsimile replies to Office actions must be sent to 571-273-8300. Accordingly, the petition is dismissed.

Alternative venue

Applicant is strongly urged to file a petition stating that the delay was unintentional. An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required fee, currently $750.00.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revive under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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| In re Application of | : | |
| Kenneth Scott Kump | : | |
| Application No.: 09/344,190 | : | DECISION ON |
| Filing or 371(c) Date: 06/24/1999 | : | PETITION |
| Attorney Docket Number: 15-XZ-4971 | : | |

This is a decision in response to the Petition for Revival of Application Abandoned Unintentionally Under 37 CFR 1.137(b), filed November 6, 2006.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Non-Compliant Amendment ("Notice"), mailed May 26, 2004. The Notice set a one (1) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No reply having been received, the application became abandoned on June 27, 2004. A Notice of Abandonment was mailed July 3, 2006.

Applicant files the instant petition and Amendment in response to the Notice. Accordingly, the petition is granted.

This application is being referred to Technology Center Art Unit 2624 for processing of the Amendment filed with the petition in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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James Graziano
Patton Boggs, LLP
P.O. Box 270930
Louisville, CO 80027

In re Application of
Charles C. WU
Application No.: 09/344,261
Filed: June 25, 1999
Atty Docket No.: WU4

DECISION ON PETITION

UNDER 37 CFR 1.181

This decision is in response to applicant's petition to revive under 37 CFR 1.137(b) filed 14 February 2006 in the United States Patent and Trademark Office (USPTO). For the reasons stated below, the petition is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment. The $1500.00 petition fee will be refunded to deposit account number 50-1602.

On March 11, 2002, applicant was mailed a Notice Of Allowance which set a statutory period for reply of three (3) months for payment of the issue fee.

On January 26, 2006, applicant was mailed a Notice of Abandonment indicating that the fee had not been paid.

On 14 February 2006, applicant filed the present petition to revive. As applicant has included exhibits indicating that a fee payment was indeed provided in June, 2002, the petition is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment.

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Applicant has provided a copy of a stamped postcard receipt stamped "OIPE JC60 Patent & Trademark Office JUN 17 2002." Applicant has also included a copy of the subject filing which shows a certificate of mailing of June 7, 2002, as well as, a copy of the firm deposit account indicating that t he fees in question were charged to the deposit account on June 17, 2002. Thus it is clear that applicant made a timely payment of the issue fee in response to the Notice of Allowance mailed March 11, 2002.

Accordingly, the issue fee payment is accepted as having been timely paid.

The application is being referred to the Office Of Publications.

Telephone inquiries concerning this decision should be directed to the undersigned.

Derek A. Putonen
Attorney Advisor
Tel: (571) 272-3294

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

James Graziano
Patton Boggs, LLP
1660 Lincoln Street
Suite 2050
Denver, Colorado 80264

COPY MAILED
JUN 19 2006
OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Charles C. WU | : | DECISION ON PETITION |
| Application No.: 09/344,261 | : | |
| Filed: June 25, 1999 | : | UNDER 37 CFR 1.181 |
| Atty Docket No.: WU4 | : | |

This decision is a substitute decision for one mailed 05 June 2006. The original decision was inadvertently mailed to an incorrect Patton Boggs post office box in Louisville, Colorado. The decision is in response to applicant's petition to revive under 37 CFR 1.137(b) filed 14 February 2006 in the United States Patent and Trademark Office (USPTO). For the reasons stated below, the petition is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment. The $1500.00 petition fee will be refunded to deposit account number 50-1602.

On March 11, 2002, applicant was mailed a Notice Of Allowance which set a statutory period for reply of three (3) months for payment of the issue fee.

On January 26, 2006, applicant was mailed a Notice of Abandonment indicating that the fee had not been paid.

On 14 February 2006, applicant filed the present petition to revive. As applicant has included exhibits indicating that a fee payment was indeed provided in June, 2002, the petition is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment.

The best evidence of what was actually received by the Office is a postcard receipt containing a specific itemization of all the items being submitted. See MPEP 503. Applicant has provided a copy of a stamped postcard receipt stamped "OIPE JC60 Patent & Trademark Office JUN 17 2002." Applicant has also included a copy of the subject filing which shows a certificate of mailing of June 7, 2002, as well as, a copy of the firm deposit account indicating that t he fees in question were charged to the deposit account on June 17, 2002. Thus it is clear that applicant made a timely payment of the issue fee in response to the Notice of Allowance mailed March 11, 2002.

Accordingly, the petition is **GRANTED** and the issue fee payment is accepted as having been timely paid.

The application is being referred to the Office Of Publications.

Telephone inquiries concerning this decision should be directed to the undersigned.

Derek A. Putonen
Attorney Advisor
Tel: (571) 272-3294

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 6237629
Issue Date: May 29,2001
Application No. 09344404
Filed: June 24,1999
Attorney Docket No.

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed June 17,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 17,2009 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6237629 | 2001-05-29 | 09344404 | 1999-06-24 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /kevin l. klug/ | Date (YYYY-MM-DD) | 2009-06-17 |
| Name | Kevin L. Klug | Registration Number | 38756 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 11

MARTIN CONNAUGHTON
ASHLAND INC.
5200 BLAZER PARKWAY
DUBLIN, OH 43017

COPY MAILED

OCT 27 2006

OFFICE OF PETITIONS

| | |
|---|---|
| In re Patent No. 6,305,143 | : |
| Issue Date: October 23, 2001 | :DECISION GRANTING PETITION |
| Application No. 09/344,462 | :UNDER 37 CFR 1.378(c) |
| Filed: June 25, 1999 | : |
| Attorney Docket No. 5495 | : |

This is a decision on the petition, filed August 1, 2006, under 37 CFR 1.378(c) to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is GRANTED.

The patent issued October 23, 2001. The grace period for paying the first maintenance fee expired at midnight on October 23, 2005. Therefore, since this petition was filed within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), this petition was timely filed under the provisions of 37 CFR 1.378(c).

Accordingly, the maintenance fee in this case is hereby accepted and the above-identified patent is hereby reinstated as of the mail date of this decision.

It is noted that the address on the petition differs from the address of record. Accordingly, if appropriate, petitioner should submit a "Fee Address" Indication Form (PTO/SB/47) if petitioner desires to receive future correspondence related to maintenance fees which may be mailed in the above-identified patent.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3218.

This file is being forwarded to Files Repository.

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 11

Burns Doane Swecker & Mathis
PO Box 1404
Alexandria, VA 22313-1404

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APR 2 9 2003

OFFICE OF PETITIONS

In re Application of
Arthur Douglas Allen
Application No. 09/344,688
Filed: June 25, 1999
Attorney Docket No. 032638-007

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 22, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the non-final office action mailed January 31, 2002, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on May 1, 2002.

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

The application file is being forwarded to Technology Center AU 2155.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 12

H. Dale Langley, Jr.
The Law Firm of H. Dale Langley, Jr.
610 West Lynn
Austin, TX 78703

**COPY MAILED**

DEC 1 9 2003

**OFFICE OF PETITIONS**

In re Application of :
Nicholas D. Evans :
Application No. 09/344,795 :
Filed: June 25, 1999 :
Attorney Docket No. NESO:009 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed December 5, 2003, to revive the above-identified application.

The petition is **Granted**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 10, 2002, which set a shortened statutory period for reply of three months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on October 11, 2002.

The application file is being forwarded to Technology Center AU 3621 for further processing.

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DIW Jun-05

H. DALE LANGLEY, JR.
THE LAW FIRM OF H. DALE LANGLEY, JR. PC
610 WEST LYNN
AUSTIN TX 78703

**COPY MAILED**

JUN 03 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Nicolas D. Evans | : | |
| Application No. 09/344,795 | : | ON PETITION |
| Filed: 25 June, 1999 | : | |
| Atty Dckt No. NESO:009 | : | |

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on 24 February, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on 3 August, 2004, for failure to file a proper reply to the Notice of Non-Compliant Amendment mailed on 2 July, 2004, which set a one (1) month shortened

---

[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

period for reply. On 6 August, 2004 (certificate of mailing 2 August, 2004), a response to the Notice was filed. However, on 9 November, 2004, an Office communication entitled Failure to Acceptably Respond to Notice of Non-Compliant Amendment was mailed, stating that the time period continued to run from the prior Notice of Non-Compliant Amendment. No extensions of the time for reply were obtained, and a Notice of Abandonment was mailed on 10 February, 2005.

Petitioners have filed a reply to the Notice of Non-Compliant Amendment with the present petition.

The application is being referred to Technology Center Art Unit 3621 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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PERKINS COIE LLP
PATENT-SEA
P.O. BOX 1247
SEATTLE WA 98111-1247

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JUN 1 4 2005

OFFICE OF PETITIONS

In re Application of
Bowman et al.
Application No. 09/344,802
Filed: June 25, 1999
For: IDENTIFYING ITEMS RELEVANT TO A CURRENT QUERY BASED ON ITEMS ACCESSED IN CONNECTION WITH SIMILAR QUERIES

: Decision on Petition for Patent Term Extension

The above-identified application has been forwarded to the undersigned for consideration on the "Petition Under 37 CFR 1.181 For Extension of Patent Term Due to Examination Delay Under Uruguay Round Agreements Act," which was received on April 19, 2005, for the above-identified application. See 35 U.S.C. § 154(b) and 37 C.F.R. § 1.701. The petition is being treated as a petition under 37 CFR 1.182 for questions not specifically provided for. Further requests or a request for reconsideration of this decision for patent term extension, requesting that the rules be waived should be submitted as a petition under 37 CFR 1.183, and include the required fee.

The petition is dismissed.

Petitioner notes that the above-identified application was filed on June 25, 1999, a Final Office Action was mailed on October 6, 2003, a Notice of Appeal was filed on February 5, 2004, an Appeal Brief was filed on July 6, 2004, and the application was allowed on January 19, 2005. Petitioner notes that the Determination of Patent Term Extension under 35 U.S.C. 154(b) dated January 19, 2005, included with the Notice of Allowance in the above-identified application states that the patent term extension is zero (0) days.

Petitioner argues that while the examiner issued the decision reversing the adverse determination of patentability and not the Board, the delay in issuance of the patent was still due to appellate review and thus the patent is eligible for term extension. Petitioner argues that under 37 CFR 1.701(c), "[t]he period of delay . . . is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant."

Petitioner argues that the application is entitled to 349 days of patent term extension from February 5, 2004, when the Notice of Appeal was filed to January 19, 2005 when the Examiner reversed the adverse determination of patentability.

35 U.S.C. § 154 provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for patent term adjustment for administrative delays in applications filed on or after May 29, 2000.

The above-identified application was filed on June 25, 1999, which is after June 8, 1995 and before May 29, 2000, and, as a result is an application that may be eligible for patent term extension under 35 U.S.C. § 154. The application was not issued due to an adverse determination of patentability by the Board of Patent Appeals and Interferences (BPAI), was not delayed due to an interference proceeding, nor was it subject to a secrecy order, as a result, this application is not eligible for the extension under 35 U.S.C. 154 and 37 CFR 1.701. The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

While Petitioner argues that since the application was allowed, he had a successful appeal because he filed a Notice of Appeal and an Appeal Brief and the Examiner decided to allow the application, a decision by the examiner to allow an application is not a decision by the Board of Appeals and Interferences (BPAI). Petitioner argues in his petition under 37 CFR 1.181 that he is entitled to patent term extension under 37 CFR 1.701, however, both 35 U.S.C. 154(b)(2) and 37 CFR 1.701(a)(3) <u>require a decision by the BPAI</u> reversing an adverse determination of patentability for the patent application to be eligible for patent term extension under 35 U.S.C. § 154. A decision by the BPAI is a written decision signed by a three member panel of administrative patent judges. See 35 U.S.C. 6, 37 CFR 41.50 and MPEP 1213. Since, the application was not issued due to an adverse determination of patentability by the BPAI, the application is not entitled to patent term extension under 35 U.S.C. 154 and 37 CFR 1.701 and the petition under 37 CFR 1.182 is dismissed.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). Accordingly, a $400 petition fee is required for a petition pursuant to 37 CFR 1.182 and 37 CFR 1.17(f). A petition fee of $200 has been paid, $200 will be charged to Petitioner's Deposit Account 50-0665.

Telephone inquiries with regard to this communication should be directed to Mark Polutta at (571) 272-7709.

Mark Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 18

**JAMES H MORRIS**
**WOLF GREENFIELD & SACKS**
**600 ATLANTIC AVENUE**
**BOSTON, MA 02210**

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AUG 1 9 2004
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Gajinder Singh Panesar | : | |
| Application No. 09/344,847 | : | ON PETITION |
| Filed: June 28, 1999 | : | |
| Attorney Docket No. S1022/8249 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed July 23, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 19, 2003, which set a shortened statutory period for reply of three (3) months. Extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on November 20, 2003.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 306-5685.

The application file is being forwarded to Technology Center AU 2123.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 6253396
Issue Date: July 3,2001
Application No. 09345035
Filed: June 30,1999
Attorney Docket No. 9671.6803

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed April 10,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 10,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,253,396 | 2001-07-03 | 09/345,035 | 1999-06-30 | 1183.8002 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

◉ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Sole Patentee | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature. | | | |
| Signature | /michael munro weston/ | Date (YYYY-MM-DD) | 2007-04-07 |
| Name | Michael Munro Weston | | |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

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AUDLEY A CIAMPORCERO JR
ONE JOHNSON AND JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

| | | |
|---|---|---|
| In re Application of | : | |
| JOHNSON, BRUCE C. | : | |
| Application No.: 09/345090 | : | DECISION ON |
| Filing or 371(c) Date: June 30, 1999 | : | PETITION |
| Attorney Docket Number: **PPC-691** | : | |

This is a decision in response to the "Petition to Withdraw Holding of Abandonment," filed July 21, 2003.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance, mailed May 20, 2003.

In view of the foregoing, the holding of abandonment for failure to timely pay the issue fee is hereby withdrawn and the application restored to pending status.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 756 - 1499.

Kendrick Sprun
Application Assistance Unit
Office of Data Management

UNITED STATES
PATENT AND
TRADEMARK OFFICE

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231
www.USPTO.gov

Mailed: MAR 11 2003

WAK
Paper Number 21

| | | |
|---|---|---|
| In re application of | : | |
| Wang et al. | : | |
| Serial No. 09/345,173 | : | DECISION ON |
| Filed: June 30, 1999 | : | PETITION |
| For: METHOD FOR ETCHING AND/OR | : | |
| PATTERNING A SILICON CONTAINING LAYER | : | |

This is a decision from the applicants' request filed on February 06, 2003. This request is being treated as a Request to Reinstate Appeal under 37 CFR 1.193(b)(2).

**DECISION**

Rule § 1.193 Examiner's answer and reply brief.

(b) (2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under § 1.111, if the Office action is not final, or a reply under § 1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§ 1.130, 1.131 or 1.132) or other evidence are permitted.

Applicants have filed a supplemental appeal brief with no new amendments, affidavits or other evidence.

The Request is **granted**.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Sonnenschein Nath & Rosenthal
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, IL 60606

UNITED STATES PATENT AND TRADEMARK OFFICE

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CHARLES J. BARBAS
CESARI AND MCKENNA, LLP
88 BLACK FALCON AVE.
BOSTON, MA 02210

**COPY MAILED**

FEB 17 2005

**OFFICE OF PETITIONS**

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|---|---|---|
| In re Application of | : | |
| Zhang et al. | : | |
| Application No. 09/345,193 | : | |
| Filed: June 30, 1999 | : | ON PETITION |
| Attorney Docket Number: | : | |
| 112025-0138 | : | |

This Decision is in response to the Petition to Correct Filing Date, filed April 28, 2004. The correspondence is properly treated as a petition under 37 CFR 1.53.

The petition is dismissed.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.53." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application, including 31 pages of specification and 17 claims, and 7 drawing sheets, was filed on June 30, 1999. Applicant files the instant petition and notes that the specification filed with the application on June 30, 1999, refers to and incorporates by reference a second application; however, the second application was not filed until July 30, 1999[1]. Applicant asserts that, because the second application describes the preferred embodiment of an aspect of

[1] The specification in the above-identified application refers and seeks to incorporate by reference to a "co-pending U.S. Patent Application Ser. No. [] entitled A Protocal to Coordinate Network End Points to Measure Network Latency…", when in fact no co-pending U.S. Patent Application entitled A Protocal to Coordinate Network End Points to Measure Network Latency, existed. *See, In re Glass*, 492 F.2d 1228, 181 U.S.P.Q. (BNA) 31 (C.C.P.A. 1974).

the present application, the second application contains material that is essential to the specification of the above-identified application. As such, Applicant argues, the above-identifed application was incomplete for purposes of obtaining a filing date.

Applicable Law

37 CFR 1.53, Application number, filing date, and completion of application, provides, in relevant part, that

> [t]he filing date of an application for patent filed under this section, except for a provisional application under paragraph (c) of this section or a continued prosecution application under paragraph (d) of this section, is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office. No new matter may be introduced into an application after its filing date.

37 CFR 1.53(b).

Further to this, the Manual for Patent Examining Procedure ("MPEP") provides that

> [u]nder 37 CFR 1.53(b), a filing date is assigned to a nonprovisional application as of the date a specification containing a description and claim and any necessary drawings are filed in the U.S. Patent and Trademark Office (USPTO). Failure to meet any of the requirements in 37 CFR 1.53(b) will result in the application being denied a filing date. *The filing date to be accorded such an application is the date on which all of the requirements of 37 CFR 1.53(b) are met.* (Emphasis supplied).

Conclusion

For purposes of receiving a filing date, the above-identified application was complete on the day that the specification

a description and claims (31 pages), and 7 drawing sheets, were filed in this Office.

The application is an Image File Wrapper ("IFW"), and as such, no forwarding of the file is necessary.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney/Advisor
Office of Petitions

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BOSTON, MA 02210

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Zhang et al. | : | |
| Application No. 09/345,193 | : | |
| Filed: June 30, 1999 | : | ON PETITION |
| Attorney Docket Number: | : | |
| 112025-0138 | : | |

This Decision is in response to the Request for Reconsideration of Petition to Correct Filing Date, filed August 2, 2005. The correspondence is properly treated as a petition under 37 CFR 1.53.

The petition is dismissed.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.53." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application, including 31 pages of specification and 17 claims, and 7 drawing sheets, was filed on June 30, 1999. Applicant filed a Petition to Correct Filing Date on April 28, 2004, and asserted that the specification filed with the application on June 30, 1999, refers to and incorporates by reference a second application; however, the second application was not filed until July 1, 1999[1]. Applicant

[1] The specification in the above-identified application refers and seeks to incorporate by reference to a "co-pending U.S. Patent Application Ser. No. [] entitled A Protocal to Coordinate Network End Points to Measure Network Latency…", when in fact no co-pending U.S. Patent Application entitled A Protocal to Coordinate Network End Points to Measure Network Latency, existed on June 30, 1999. *See, In re Glass*, 492 F.2d 1228, 181 U.S.P.Q. (BNA) 31 (C.C.P.A. 1974).

argued that, because the second application describes the preferred embodiment of an aspect of the present application, the second application contains material that is essential to the specification of the above-identified application. As such, Applicant argues, the above-identifed application was incomplete for purposes of obtaining a filing date.

In a Decision dismissing the petition mailed February 17, 2005, Applicant was advised that 37 CFR 1.53 provides that the filing date of an application "is the date on which a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to § 1.71 and at least one claim pursuant to § 1.75, and any drawing required by § 1.81(a) are filed in the Patent and Trademark Office." The MPEP reiterates 37 CFR 1.53(b) and provides that "[t]he filing date to be accorded such an application is the date on which all of the requirements of 37 CFR 1.53(b) are met.

Applicant was informed that, for purposes of receiving a filing date, the above-identified application was complete on the day that the specification a description and claims (31 pages), and 7 drawing sheets, were filed in this Office.

The instant petition

Applicant files the instant Request for Reconsideration and admits that the papers filed on June 30, 1999 entitled applicants to a filing date. Applicant argues that pages and figures were missing from the submitted materials. Because the pages and figures were missing from the application as filed, Applicant argues that he should have the opportunity to submit the omitted or missing pages and figures and receive as a filing date the date the omitted or missing pages and figures are submitted. Applicant seeks to analogize the instant situation to one where an application is filed without all of the pages of the specification. In such a situation, this Office mails a Notice of Omitted Items in accordance with MPEP 601.01(d), and an applicant is given the option of submitting the omitted or missing pages and/or figures and accepting the date of the submission as the filing date of the application.

Analysis and conclusion

Applicant's arguments are not well taken. It is initially noted that 601.01(d) is applicable only when the Office of Initial

Patent Examination ("OIPE") has reviewed application papers and determined the application has been filed without all of the page(s) of the specification [but does containing something that can be construed as a written description, at least one drawing figure, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim]. Here, applicant filed 25 consecutively numbered pages of specification, 5 consecutively numbered pages of claims, and 7 sheets of drawings containing Figures 1A, 1B, 2, 3A, 3B, 4 and 5, all of which were referenced in the specification. All of the pages of the specification were filed on June 30, 1999, and there was no need to mail a "Notice of Omitted Items" indicating that the application papers so deposited have been accorded a filing date, but are lacking some page(s) of the specification, because all of the pages of the specification were present on filing. As such, section 601.01(d) of the MPEP was not invoked. Applicant was not mailed a Notice of Omitted Items and Applicant was not given the option of submitting any omitted or missing pages and/or figures and accepting the date of such submission as the filing date of the application.

Similarly, the MPEP 601.01(g) provides that (OIPE) reviews application papers to determine whether all of the figures of the drawings that are mentioned in the specification are present in the application. If the application is filed without all of the drawing figure(s) referred to in the specification, and the application contains something that can be construed as a written description, at least one drawing, if necessary under 35 U.S.C. 113 (first sentence), and, in a nonprovisional application, at least one claim, OIPE will mail a "Notice of Omitted Item(s)" indicating that the application papers so deposited have been accorded a filing date, but are lacking some of the figures of drawings described in the specification.

Here, all of the figures of the drawings that were mentioned in the specification were present in the application.

The application was complete for purposes of obtaining a filing date; however, applicant sought to supplement the disclosure by reference to an application that was not in existence at the time the above-identified application was filed. In essence, applicant sought to supplement the disclosure by a later publication. There are numerous examples wherein an application was complete for purposes of receiving a filing date but later

the applicant attempted to supplement the disclosure of the application. In the Decision dismissing Applicant's original petition, this Office noted in a footnote *In re Glass*, 492 F.2d 1228, 181 U.S.P.Q. (BNA) 31 (C.C.P.A. 1974). There, as here, Appellant had filed his application and, as here, received a filing date. Appellant there attempted to use the disclosure of patents which issued after his filing date. Similarly here, Applicant's are attempting to use the disclosure of an application filed after their filing date. The court in *Glass* posited that "[i]f a disclosure is insufficient at the time it is filed, can it be made sufficient, while the application is still pending, by later publications which add to the knowledge of the art so that the disclosure, supplemented by such publications, would suffice to enable the practice of the invention?" *Glass* at 1232. The *Glass* court answered in the negative. The court held that "[t]he sufficiency must be judged as of the filing date." *Id.* See, also, *White Consol. Indus., Inc. v. Vega Servo-Control, Inc.*, 713 F.2d 788, 218 USPQ 961 (Fed. Cir. 1983); *In re Scarbrough*, 500 F.2d 560, 182 USPQ 298 (CCPA 1974).

Here Applicant seeks to conflate the completeness of an application for purposes of obtaining a filing date with the sufficiency of an application's disclosure. As can be seen in the cases *supra*, an application may be found complete for purposes of obtaining a filing date while at the same time have an incomplete disclosure. Such is the case here.

*After a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director*. Therefore, it is extremely important that petitioner supply **any** and **all** relevant information and documentation with his request for reconsideration. The Director's decision will be based solely on the administrative record in existence.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

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388 SOUTH MAIN STREET
SUITE 500
AKRON OH 44311

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OFFICE OF PETITIONS

In re Application of
Martin
Application No. 09/345,202
Filed: June 30, 1999
Attorney Docket No. 30236.30006
For: METHOD AND DEVICE FOR PREVENTING CHECK FRAUD

: Decision on Petition

The above-identified application has been forwarded to the undersigned for consideration on the "Petition for Patent Term Extension," which was received on December 11, 2006, for the above-identified application. See 35 U.S.C. § 154(b) and 37 C.F.R. § 1.701. Further requests or a request for reconsideration of this decision for patent term extension, must be filed under 37 CFR 1.182 or 37 CFR 1.183, and include the required fee.

The petition under 37 CFR 1.181 for patent term extension is dismissed.

Petitioner notes that the above-identified application was filed on June 30, 1999; allowed on November 27, 2006, but was delayed by an appeal to the Board of Interferences and Patent Appeals. Petitioner asserts that the patent to issue from the above-identified application should include at least 632 days of patent term extension. Petitioner notes that the Appeal Brief was filed in the application was filed on October 20, 2003 and that the application was remanded by the BPAI and that a non-final Office action was mailed on July 13, 2005. Petitioner asserts that delay by the Office is from October 20, 2003 until July 13, 2005, which is 632 days.

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000. 35 U.S.C. § 154(b)(as amended by the "American Inventors Protection Act of 1999," (AIPA) enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000. The patent statute only permits extension of patent term based on very specific criteria. The Office has no authority to grant any extension or adjustment of the term due to administrative delays except as authorized by 35 U.S.C. § 154.

The above-identified application was filed on June 30, 1999, which is after June 8, 1995 and before May 29, 2000, and, as a result is an application that may be eligible for patent term extension under 35 U.S.C. § 154.

In order to implement 35 U.S.C. 154(b) (in effect between June 8, 1995 and May 28, 2000), the Office promulgated 37 CFR 1.701(c)(3), which, consistent with the statute, requires a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal Court in an appeal under 35 U.S.C. 145 to be eligible for patent term extension. The application was not issued due to an adverse determination of patentability by the BPAI, was not delayed due to an interference proceeding, nor was it subject to a secrecy order, as a result, this application is not eligible for the extension under 35 U.S.C. 154 in effect on June 8, 1995 and 37 CFR 1.701. While a Notice of Appeal and an Appeal Brief were filed in the application, the application was not remanded to the Examiner as asserted by Petitioner. The Examiner reopened prosecution in response to the appeal brief as stated in the Office action mailed on July 13, 2005. The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154. Since, the application was not issued due to an adverse determination of patentability by the BPAI, the application is not entitled to patent term extension under 35 U.S.C. 154 and 37 CFR 1.701.

The delay in issuance of petitioner's application is regretted.

After mailing of this decision, the above-identified application will be returned to Office of Publications for further processing. The patent, if issued, will include an indication that the patent term is extended by zero **(0) days.**

Petitioner's deposit account has been charged a petition fee.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
www.uspto.g

Paper No. 6

Kudirka & Jobse, LLP
One State Street
Suite 1510
Boston, Massachusetts 02109

MAIL

APR 2 3 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

| | | |
|---|---|---|
| In re Application of: Glenn W. Hutton et al. | ) | |
| Application No. 09/345,222 | ) | |
| Filed: June 30, 1999 | ) | |
| For: METHOD AND APPARATUS FOR ESTABLISHING POINT-TO-POINT COMMUNICATIONS OVER A COMPUTER NETWORK | ) | **DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY** |

This is a decision on the Request To Withdraw from Representation filed February 15, 2002 and supplemented by the submission of April 19, 2002.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED**.

All future communications from the United States Patent and Trademark Office (Office) will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Office of any change in correspondence address to ensure receipt of all communications from the Office.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce
(703) 306-4160

cc: Jeffrey S. Ginsberg, Esq.
Kenyon & Kenyon
One Broadway
New York, New York 10004

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WASHINGTON, D.C. 20231
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Paper No. 19

Jong H. Lee
Kenyon & Kenyon
One Broadway
New York, NY 10004

MAILED
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Technology Center 2100

| | | |
|---|---|---|
| In re Application of: Hutton et al. | ) | |
| Application No. 09/345,222 | ) | DECISION ON PETITION TO |
| Attorney Docket No. N0003/7000D3 | ) | WITHDRAWAL HOLDING OF |
| Filed: June 30, 1999 | ) | ABANDONMENT UNDER 37 CFR § |
| For: POINT-TO-POINT INTERNET | ) | 1.181(a) |
| PROTOCOL | ) | |

This is a decision on the petition filed on May 23, 2003 to withdraw the holding of abandonment (Paper No. 17) mailed on May 5, 2003 based upon a failure to receive a Notice of Allowance. Applicants' request is being treated as a petition under 37 CFR § 1.181(a).

**Applicable Prosecution History**

| | |
|---|---|
| Dec 31, 2002 | Notice of Allowance and issue fee due mailed (Paper No. 16). |
| Mar 31, 2003 | Issue fee due date. |

**Issues**

The petition includes statements from Jong H. Lee that the Notice of Allowance was not received; and that a search of the file jacket and docket records indicated the Notice of Allowance was not received. The practitioner has attached a copy of the file jacket data sheet, a copy of a log showing incoming mails for the relevant period and docket sheets showing due date entries for March 30, 2003; all of which are evidence the Notice of Allowance was not received.

**Decision**

In the absence of any apparent irregularity associated with the mailing of an Office communication, the Office presumes the communication was properly mailed to the address of record. According to MPEP §711.03(c), the showing required to establish nonreceipt of an Office action includes the following:

a) a statement from the practitioner that the Office action was not received,
b) a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates the Office communication was not received,

c) a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed, and
d) a reference to the docket record in the practitioner's statement.

The statements in the petition are interpreted that the practitioner is personally aware that a search was made for the records at the *address of record*. That is, while papers have been filed by attorneys from the Washington DC office during the course of prosecution, that, in fact, the records and files checked for this petition were for the address of the New York office.

However, the submission is deficient because the practitioner has provided incomplete evidence. Specifically, the docket sheets only appear to cover the due date of March 30, 2003, but as noted above, the issue fee due date was March 31, 2003. Therefore, the presumption of nonreceipt remains. Submission of the docket records for March 31, 2003 would assist in establishing the practitioner's nonreceipt of the Notice of Allowance.

The petition is **DISMISSED**.

If petitioners desire further review of this decision, petitioners should file a Request for Reconsideration within two (2) months of the mailing date of this decision. Telephone inquiries should be directed to the undersigned at (703) 308-0269.

Josie A. Ballato
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

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**MAILED**

SEP 26 2003

**Technology Center 2100**

Paper No. 21

Jong H. Lee
Kenyon & Kenyon
One Broadway
New York, NY 10004

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|---|---|---|
| In re Application of: Hutton et al. | ) | |
| Application No. 09/345,222 | ) | DECISION ON PETITION TO |
| Attorney Docket No. N0003/7000D3 | ) | WITHDRAWAL HOLDING OF |
| Filed: June 30, 1999 | ) | ABANDONMENT UNDER 37 CFR § |
| For: POINT-TO-POINT INTERNET | ) | 1.181(a) |
| PROTOCOL | ) | |

This is a decision on the request for reconsideration filed August 4, 2003 to withdraw the holding of abandonment (Paper No. 17) mailed on May 5, 2003 based upon a failure to receive a Notice of Allowance. The original petition was dismissed on July 25, 2003.

The original petition included statements from Jong H. Lee that the Notice of Allowance was not received; and that a search of the file jacket and docket records indicated the Notice of Allowance was not received. The practitioner has attached a copy of the file jacket data sheet, a copy of a log showing incoming mails for the relevant period and docket sheets showing due date entries for March 30, 2003; all of which are evidence the Notice of Allowance was not received. The request for reconsideration contains "docket sheets showing all docketed due-date entries for March 31, 2003".

Petitioners' submission in the original petition and in the request for reconsideration meet the burden of proof set forth in MPEP § 711.03(c) and are sufficient to establish a showing of nonreceipt by applicants' representative of the original Notice of Allowance.

The petition is **GRANTED**. The Notice of Abandonment is withdrawn.

The application file will be forwarded to the Technology Center support staff. The Notice of Allowability will be remailed with the three-month non-extendable period for reply restarted to run from the date of the remailing.

Josie A. Ballato
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

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HUMAN GENOME SCIENCES INC
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ROCKVILLE MD 20850

COPY MAILED

JUL 2 1 2003

OFFICE OF PETITIONS

Applicant: Ruben et al.
Appl. No.: 09/345,373
Filing Date: July 1, 1999
Title: KERATINOCYTE GROWTH FACTOR-2
Attorney Docket No.: PF155C1
Pub. No.: US 2003/0077695 A1
Pub. Date: April 24, 2003

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), filed on June 20, 2003 for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication omits some of the continuity data and there is a typographical error in dependent claim 32. Applicant argues that the mistake is material because the missing priority data affects the use of the published application as prior art under 35 U.S.C. § 102(e), as a member of the public would be unable to determine the correct effective date of the publication as a reference and that the scope of claim 32 can not be determined from the publication.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.[1] The instant request does not identify a material mistake in the publication made by the Office:

The error in the continuity claim is an Office mistake, but it is not a material mistake as required by 37 CFR 1.221(b). The improper priority claim is not a material mistake because it does not affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. The error in dependent claim 32 is also an Office mistake as "Leu (152) Phe" is misspelled as –Leu (52) Phe–, but it is not a material mistake as required by 37 CFR 1.221(b). The error in the claim is not a material mistake, as it is a minor typographical error, the amino acid was correctly written in the preceding dependent claim, the claim has been canceled and additionally the amino acid was correctly printed in the child application (10/075,446) as US 2003/0129687 A1. The specification was accurately published, thus one can read and understand the content of the application. The error also does not affect the use of the patent application publication as a prior art reference, because the earliest priority date is correctly published. While some of the related continuity data is missing, anyone looking to determine the effective date of the publication as a reference would

[1] Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

have to order the provisional application files and would be reviewing PALM. To help avoid errors in the continuity data in the future, applicant's representative should request a corrected filing receipt using the facsimile number (703-746-9195) on the Filing Receipt.

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

Any request for republication under 37 CFR 1.221(b), should be submitted via the EFS system and questions or request for reconsideration of this decision, should be addressed as follows:

By mail to: Mail Stop PGPUB
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: 703-305-8568

The application is being forwarded to the Files Repository.

Inquiries relating to this matter may be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).

Mark O. Polutta

Mark Polutta
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: Corrected Filing Receipt

UNITED STATES DEPARTMENT OF COMMERCE
**Patent and Trademark Office**
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 2023

March 28, 2002

David G. Pursel
LSI Logic Corporation
Patent Law Department
1551 McCarthy Blvd., MS D-16
Milpitas, CA 95035

In re application of:
Sion Quinlan DECISION ON PETITION
Serial No.: 09/345,568
Filed: June 30, 1999

For: TESTING ANALOG TO DIGITAL CONVERTERS

This is a decision on the documents received by fax on December 19, 2000, to withdraw the holding of abandonment in the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. 1.113 in timely manner to the Notice to File Missing Parts of Application mailed August 3, 1999. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned October 5, 1999. A notice of abandonment was mailed on August 19, 2000.

On December 13, 1999, the office received a communication from the attorney of record. Enclosed was an acknowledgment that the attorney responded to the Notice to File Missing Part on December 13, 1999.

The evidence submitted is sufficient to establish that the petitioners responded to the Notice to File Missing Parts of Application on December 13, 1999.

The petition is hereby GRANTED.

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The application has been completed for release to Technology Center 2819.

The necessary extension fee of two months to complete the application will be charged to deposit account 12-2252.

Telephone inquiries concerning this matter may be directed to Doshie E. Day at (703) 308-3640.

Doshie Day

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination.

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 10

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

**COPY MAILED**

OCT 0 8 2004

**OFFICE OF PETITIONS**

In re Application of :
Brewster Kahle et al. :
Application No. 09/345,611 :
Filed: June 29, 1999 :
Attorney's Docket No. ALEXAI.006A :

ON PETITION

This is a decision on the petition filed September 3, 2004 under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED**.

The instant application became abandoned on September 29, 1999, for failure to timely reply to the Notice to File Missing Parts, mailed July 28, 1999, which set a two (2) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Accordingly, a Notice of Abandonment was mailed September 19, 2000.

The filing of the filing fees, excess claim fees, oath or declaration and surcharge for their late filing, as required by the Notice to File Missing Parts mailed July 28, 1999 is acknowledged.

All other requirements having been met , this application is being forwarded to the Office of Initial Patent Examination for further pre-examination processing.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| | | | | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | | Small Entity | | |
|---|---|---|---|---|---|
| | Fee | Code | | Fee | Code |
| ○ | 3 ½ year | (1551) | ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (1552) | ○ | 7 ½ year | (2552) |
| ○ | 11 ½ year | (1553) | ○ | 11 ½ year | (2553) |

SURCHARGE

The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: “Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest.”

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

- ◉ An attorney or agent registered to practice before the Patent and Trademark Office
- ○ A sole patentee
- ○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.
- ○ A joint patentee; all of whom are signing this e-petition
- ○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | | Date (YYYY-MM-DD) | |
| Name | | Registration Number | |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,505,179 | 2003-01-07 | 09/345,617 | 1999-06-30 | 075815.0102 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ● 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

- ● An attorney or agent registered to practice before the Patent and Trademark Office
- ○ A sole patentee
- ○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.
- ○ A joint patentee; all of whom are signing this e-petition
- ○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Robert C. Scheinfeld/ | Date (YYYY-MM-DD) | 2007-02-27 |
| Name | Robert C. Scheinfeld | Registration Number | 31300 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

MAILED

OCT 16 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

David H. Tannenbaum
FULBRIGHT & JAWORSKI L.L.P.
2200 Ross Avenue
Suite 2800
Dallas, TX 75201

In re application of
Salim G. Kara
Application No. 09/345,617 :
Filed: June 30, 1999 :
For: VERIFYING THE AUTHENTICITY OF PRINTED DOCUMENTS ON UNIVERSALLY AVAILABLE PAPER

DECISION ON REQUEST FOR WITHDRAWAL OF

This is a decision on the request filed on June 24, 2002, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. For approval of such a request the following conditions must be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;
B) There must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a);
C) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided;
D) The applicant or patent owner must have been notified of the withdrawal as provided for in 37 CFR 1.36.

09/345,617

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition A) above. This office does not recognize law firms; and D) above that the applicant has not been given notice of this withdrawal as stated in 37CFR 1.36.

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866
Facsimile No.: (703) 605-0586

Rjb:10/8/02

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BAKER BOTTS L.L.P.**
**30 ROCKEFELLER PLAZA**
**44TH FLOOR**
**NEW YORK NY 10112-4498**

**COPY MAILED**

MAY 03 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| Patent No. 6,505,179 | : | |
| Application No. 09/345,617 | : | |
| Filed: June 30, 1999 | : | ON PETITION |
| Issued: January 7, 2003 | : | |
| Attorney Docket No. 075815.0102 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed April 25, 2007, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The patent issued January 7, 2003. The last day of the grace period for paying the 3.5-year maintenance fee was January 7, 2007. Therefore, since this petition was filed within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), this petition was timely filed under the provisions of 37 CFR 1.378(c).

**The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.**

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3206.

The patent file is being forwarded to Files Repository.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**MERCHANT & GOULD P.C.**
**P.O. BOX 2903**
**MINNEAPOLIS, MN 55402-0903**

COPY MAILED

MAR 02 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| John S. Daniel et al | : | |
| Application No. 09/345,668 | : | ON PETITION |
| Filed: June 30, 1999 | : | |
| Attorney Docket No. 36968-179673 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed November 18, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed April 7, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 8, 2003.

The above-identified application is being revived for consideration of a submission under 37 CFR 1.114 (request for continued examination).

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being forwarded to Technology Center AU 2662 for processing of the request for continued examination under 37 CFR 1.114.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

DYKEMA GOSSETT PLLC
FRANKLIN SQUARE, THIRD FLOOR WEST
1300 I STREET, NW
WASHINGTON DC 20005

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NOV 0 8 2005

OFFICE OF PETITIONS

In re Patent No. 6,149,846 :
Issue Date: November 21, 2000 :
Application No. 09/345,725 : DECISION ON PETITION
Filed: July 1, 1999 :
Attorney Docket No. 71963-7 :
For: METHOD OF MIXING COMPONENTS IN A NON-INTERMESHING TWIN SCREW COMPOUNDER FOR INJECTION MOLDING

This is a decision on the petition, filed May 6, 2005, under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3 ½ year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The patent issued November 21, 2000. The grace period for paying the 3 ½ year maintenance fee expired at midnight on November 21, 2004. Therefore, since this petition was filed within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), this petition was timely filed under the provisions of 37 CFR 1.378(c).

Accordingly, the maintenance fee in this case is hereby accepted and the above-identified patent is hereby reinstated as of the mail date of this decision.

This file is being forwarded to Files Repository.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3230.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 19

DENISE M. KETTELBERGER
P. O. BOX 2903
MINNEAPOLIS MN 55402-0903

COPY MAILED
JUL 22 2002
OFFICE OF PETITIONS

In re Application of :
Uckun :
Application No. 09/345,815 :
Filed: 06/30/1999 :
Attorney Docket No. 957.001US1 :

ON PETITION

## FACTS

This is a decision on the September 6, 2001 petition which requests under 37 C.F.R. §1.182 that the office allow the entry of the sequence listing attached to the petition. The petition fee has been received. The office sincerely apologizes for the delay and any inconvenience caused by it.

## RULES

*§1.182 Questions not specifically provided for.*

All situations not specifically provided for in the regulations of this part will be decided in accordance with the merits of each situation by or under the authority of the Commissioner, subject to such other requirements as may be imposed, and such decision will be communicated to the interested parties in writing. Any petition seeking a decision under this section must be accompanied by the petition fee set forth in §1.17(h).

*§1.314 Issuance of patent.*

If applicant timely pays the issue fee, the Office will issue the patent in regular course unless the application is withdrawn from issue (§1.313) or the Office defers issuance of the patent. To request that the Office defer issuance of a patent, applicant must file a petition under this section including the fee set forth in § 1.17(h) and a showing of good and sufficient reasons why it is necessary to defer issuance of the patent.

---

*§1.312 Amendments after allowance.*

No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the application from issue.

*§ 1.313 Withdrawal from issue.*

(c) Once the issue fee has been paid, the application will not be withdrawn from issue upon petition by the applicant for any reason except:

(1) Unpatentability of one of more claims, which petition must be accompanied by an unequivocal statement that one or more claims are unpatentable, an amendment to such claim or claims, and an explanation as to how the amendment causes such claim or claims to be patentable;

(2) Consideration of a request for continued examination in compliance with § 1.114; or

(3) Express abandonment of the application. Such express abandonment may be in favor of a continuing application.

(d) A petition under this section will not be effective to withdraw the application from issue unless it is actually received and granted by the appropriate officials before the date of issue. Withdrawal of an application from issue after payment of the issue fee may not be effective to avoid publication of application information.

**ANALYSIS**

Applicant seeks to amend the record after payment of the issue fee. This is specifically prohibited by 37 C.F.R. §1.312. However, this situation *is* provided for under 37 C.F.R. §1.314. Accordingly, since 37 C.F.R. §1.182 applies only in situations that are not specifically provided for under the regulations, the petition under 37 C.F.R. §1.182 is ***dismissed***.

The proper method for achieving the desired ends is to file a petition under 37 C.F.R. §1.314 to defer issuance of the patent.

Accordingly, this petition will be treated as a petition to defer issuance under that rule and that request is ***granted***. Petitioner is given one month to file a request for continued examination. The sequence listing provided will serve as the required submission under 37 C.F.R. §1.114.

If the RCE is not received by the office within one month of the date of this mailing, the application will be forwarded to Publications division for processing into a patent.

Telephone inquiries relative to this decision should be directed to Petitions Attorney Scott M. Ledford at (703) 306-5593.

Scott M. Ledford
Senior Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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DIW 04-03

Paper No. 21

DENISE M. KETTELBERGER
P. O. BOX 2903
MINNEAPOLIS MN 55402-0903

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APR 1 0 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Fatih M. Uckun | : | CORRECTED DECISION |
| Application No. 09/345,815 | : | ON PETITION |
| Filed: 30 June, 1999 | : | |
| Attorney Docket No. 957.001US1 | : | |

This is a corrected decision in response to the petition under 37 CFR 1.182 filed on 6 September, 2001.

The petition is **dismissed**.

The above-identified application was filed on 30 June, 1999. On 19 January, 2001, a Notice of Allowance and Issue Fee was mailed, and the issue fee was filed on 23 April, 2001 (certificate of mailing date 19 April, 2001). On 6 September, 2001, petitioner filed the present petition requesting entry of a Sequence Listing, along with the Sequence Listing.

On 22 July, 2002, a decision was mailed treating the petition as a petition to defer issuance and requiring a Request for Continued Examination (RCE). On 9 August, 2002, petitioner filed an RCE and specified the previously-filed Sequence Listing as the required submission.

Petitioner is advised that since the request to enter the Sequence Listing was filed after payment of the issue fee, a petition to withdraw from issue under 37 CFR 1.313(c) rather than a petition to defer issuance is required. Therefore, the petition under 37 CFR 1.182 is improper.

Petitioner must file a petition to withdraw from issue under 37 CFR 1.313(c) in order to consider the RCE and Sequence Listing.

The decision mailed on 22 July, 2002, was issued in error and is **vacated**. Any indication that deferral of issue has been granted is vacated. Additionally, any indication that the Sequence Listing has been approved or entered is also vacated. The Examiner will determine the viability of the submissions upon remand.

The Office apologizes for the error in treatment of the petition and the delay in proper treatment of the petition and regrets any inconvenience to petitioner.

The petition will be retained in the Office of Petitions for **TWO (2) MONTHS** to await the filing of a petition to withdraw from issue. **This time period is not extendable.**[1] If no reply is received within TWO (2) MONTHS, the application will be forwarded to Publishing Division for issuance as a patent as required by law.

**As a grantable petition under 37 CFR 1.313(b) must be before an appropriate official in the Office of Petitions in sufficient time to grant the petition before the patent is issued, any petition filed under 37 CFR 1.313(b) to withdraw an application from issuance after payment of the issue fee should be clearly marked "Petition under 37 CFR 1.313(b)" and be promptly submitted by facsimile or hand-carried to the Office of Petitions. The Office cannot ensure that any petition under 37 CFR 1.313(c) will be acted upon prior to the date of patent grant.**[2]

Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

**OR** (after 1 May, 2003)[3]

---

[1] 37 CFR 1.181(f).

[2] See MPEP 1308.

[3] Effective 1 May, 2003, the U.S. Patent and Trademark Office is changing its address for some mail in preparation for its move to new office space in Alexandria, Virginia beginning at the end of 2003. See 68 Fed. Reg. 14332 (March 25, 2003).

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

By FAX: (703)308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.

DIWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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Paper No. 24

OFFICE OF PETITIONS

DENISE M. KETTELBERGER
P.O. BOX 2903
MINNEAPOLIS MN 55402-0903

In re Application of
Uckun
Application No. 09/345,815
Filed: June 30, 1999
Attorney Docket No. 957.001US1

ON PETITION

This is a decision on the petition, filed by facsimile transmission on June 2, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on April 23, 2001 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 1653 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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SEP 05 2001

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

Paper No. 9

KEVIN B LAURENCE
WORKMAN NYDEGGER & SEELEY
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

In re Application of: Lynn Y. Shimada
Application No. 09/345,820
Filed: June 30, 1999
For: METHOD AND SOFTWARE ARTICLE FOR SELECTING ELECTRONIC PAYMENT OF VENDORS IN AN AUTOMATED PAYMENT ENVIRONMENT

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition, filed August 14, 2001 under 37 C.F.R. §102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);

(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status...;

(C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Applicant's submission is deficient in that it does not comply with (B) and (E) above. With respect to (B), while a statement is found indicating that applicant believes all claims are directed to a single invention, no clear statement is found indicating that applicant would make an election without traverse if the claims are not obviously directed to a single invention. The petition does indicate that applicant "agrees to comply with the other requirements of §1.102(d), such as restriction practice and interviews without traverse" but this paragraph of the rule contains no restriction or interview requirements per se. With respect to (E), while applicant discusses the content of the references and argues that they do not disclose certain features, this discussion does not mention independent claim 9 and mentions a claim 15 that does not appear in the file. Finally, the discussion of the references is not clear with respect to how the features mentioned in the arguments correspond to the claim language as some features mentioned do not appear in the claims and it is not clear how each independent claim is covered by the arguments presented.

Accordingly, the Petition is **DENIED**. The application file is being forwarded to Central Files to await examination in its proper turn based on its effective filing date.

Any request for reconsideration must be filed within two months of the mailing date of this decision.

Robert A. Weinhardt
Special Program Examiner
Technology Center 2100
Computer Architecture, Software,
& Electronic Commerce
703-305-9780

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

JAN 2 9 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 11

KEVIN B LAURENCE
WORKMAN NYDEGGER & SEELEY
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY , UT 84111

In re Application of : Lynn Y. Shimada
Application No. 09/345,820
Filed: June 30, 1999
For: METHOD AND SOFTWARE ARTICLE FOR SELECTING ELECTRONIC PAYMENT OF VENDORS IN AN AUTOMATED PAYMENT ENVIRONMENT

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the renewed petition filed October 16, 2001 in response to the decision mailed September 5, 2001 regarding the petition, filed August 14, 2001 under 37 C.F.R. §102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);

(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status...;

(C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Applicant's submissions filed October 16, 2001 and August 14, 2001 together meet all the criteria set forth above and the petition is **GRANTED**.

The application file is being forwarded to the Examiner for accelerated examination in accordance with M.P.E.P. §708.02. If the application is subsequently allowed, it will be given priority for printing. See M.P.E.P. §1309.

Robert A. Weinhardt
Special Program Examiner
Technology Center 2100
Computer Architecture, Software,
& Electronic Commerce
703-305-9780

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 09/05/06

**TO SPE OF** : ART UNIT 1646

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 09/346069 Patent No.: **7005505**

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**Angela Green**
**Certificates of Correction Branch**
**703.308.9380 ext.** 123

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☒ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** Request filed 8/24/06 is approved.

**SPE** 1646 **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

PAUL J ESATTO JR
SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY NY 11530

**MAILED**

MAY 24 2010

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,467,078 | : | |
| Issue Date: October 15, 2002 | : | |
| Application No. 09/346,233 | : | DECISION ON PETITION |
| Filed: July 1, 1999 | : | |
| Attorney Docket No. 12784 | : | |

This is a decision on the petition under 37 CFR 1.183 for issuance of a Certificate of Correction, filed March 24, 2010.

The petition is **DISMISSED** as moot.

The Office mailed the requested Certificate of Correction on May 18, 2010. In view thereof, no consideration of the petition is necessary.

Receipt of the $130 processing fee set forth in 37 CFR 1.17(i) and the $100 fee for the Certificate of Correction set forth in 37 CFR 1.20(a) is acknowledged.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

**Newsome, Lamonte**

**From:** Ye, Lin
**Sent:** Wednesday, April 23, 2008 6:58 PM
**To:** Newsome, Lamonte
**Subject:** 306 SPE's Reponse (8) (6).doc

Certificate of Correcton for 09/346,256 has been approved

**Paper No.: X**

**DATE** : **January 12,2008**

**TO SPE OF** : ART UNIT **2622**

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **09/346,256** Patent No.: **6977676 B1**

A response is requested with respect to a request for a certificate of correction.

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within **7** days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

**DO NOT SENT TO ATTORNEY**

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within **7** days, to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location**
**7580**

**You can fax the Directors/SPE response to 571-270-9990**

***LAMONTE NEWSOME***

**Certificates of Correction Branch**

**703-308-9390 ext. 112**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

| | |
|---|---|
| X **Approved** | **All** changes apply. |
| ☐ **Approved in Part** | Specify below which changes **do not** apply. |
| ☐ **Denied** | State the reasons for denial below. |

**Comments:** _____

_____

_____

_____

_____

_____

/Lin Ye/

**SPE**
**Art Unit 2622**

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
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WASHINGTON, D.C. 20231
www.uspto.go

Paper No. 26

Jay M. Cantor
TEXAS INSTRUMENTS INCORPORATED
P. O. BOX 655474, M/S 3999
DALLAS, TX 75265

AUG 20 2003

| | | |
|---|---|---|
| In re Application of: | : | |
| HOUSTON, THEODORE W. | : | DECISION TO WITHDRAW |
| Application No. 09/346,436 | : | HOLDING |
| Filed: July 01, 1999 | : | OF ABANDONMENT |
| Attorney Docket No.: TI-21004 | : | |

This is a decision on the request filed March 04, 2003, to withdraw the holding of abandonment for the above identified application under 37 CFR 1.181 for which no fee is required.

The petition is **granted.**

A Reply Brief in response to the Examiner's Answer of August 22, 2001, was timely filed on October 18, 2001. In response to the Reply Brief filed October 18, 2001, the examiner reopened prosecution and mailed a final rejection on January 07, 2002. On April 05, 2002, a supplemental Appeal Brief was filed. In response to the Supplemental Appeal Brief, a "NOTIFICATION OF NON-COMPLIANCE WITH THE REQUIREMENTS OF 37 CFR 1.192(c)" (hereinafter NOTIFICATION) was mailed on May 20, 2002. On September 27, 2002, the office re-mailed and reset the period for response for the NOTIFICATION of May 20, 2002, because the petitioner had not received the NOTIFICATION. On October 07, 2002, a response to the NOTIFICATION was filed. On October 23, 2002, a Substitute Supplemental Appeal Brief was filed. On January 29, 2003, the appeal was dismissed and the application was held abandoned because there were no allowed claims.

Petitioner asserts that the application was erroneously abandoned because a proper Notice of appeal was filed as to claims 1 to 4, 7 to 9 and 18 to 24. Further, the petitioner attests that claims 1 to 4, 7 to 8, 18 to 21, 23 and 24 were dropped with respect to the appeal and as such, the petitioner has chosen not to contest the rejection of these claims.

A review of the application file reveals that the NOTIFICATION indicated that the "indication of claims pending in the application is uncertain because it is unclear if, in fact, claims 1, 3, 7, 8, 18-21, 23, and 24 are canceled. Further, the Supplemental Appeal Brief in response to this Office Action must either address claims 2 and 4 or be accompanied by an amendment canceling

claims 2 and 4." The petitioner responded with a Substitute Supplemental Appeal Brief that reinstated the Reply Brief of October 18, 2001 and reiterates that "all claims have been canceled by not having been appealed with the exception of claims 9 and 22, which remain on appeal and claims 25 and 26 which have been stated to be allowable if independently presented, this appeal only involves claims 9 and 22." Upon receipt of the apparent unsatisfactory response to the NOTIFICATION, the application was held abandoned. The Notice of Abandonment indicates that the Appeal Brief is defective because "it is unclear if, in fact, claims 1-4, 7, 8, 18-21, 23 and 24 were canceled since no proper amendment canceling the claims was made."

MPEP 1215.03 states the following:

> **1215.03 Partial Withdrawal**
>
> A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application or reexamination proceeding and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from an application by direction of the examiner at the conclusion of the appeal proceedings, if necessary (e.g., the examiner is reversed as to the rejection of the remaining claims on appeal), without further action by the applicant.

In view of the above, it is clear that when claims are withdrawn from consideration, they are, in effect, canceled from the application and the appeal continues as to the remaining claims. Accordingly, the examiner's assertion that the Appeal Brief is defective because it is unclear if some of the claims were canceled, since no proper amendment canceling the claims was made, is inaccurate. It is clear from the Reply Brief filed October 18, 2001 and the subsequent Substitute Supplemental Appeal Brief filed October 23, 2002, that the petitioner has, with the exception of claims 9, 22, 25 and 26, withdrawn all the remainders of the claims[1] from consideration. And as such, only rejected dependent claims 9 and 22 are the subject of the appeal for the above identified application. As a result, the examiners assertion with regards to the cancelation of the claims in the NOTIFICATION were inappropriate since withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application proceedings.

For the above stated-reason, the petition is **granted**.

The Notice of Defective Appeal Brief and the Notice of Abandonment are hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

The application file is being forwarded to the examiner for appropriate action.

---

[1]The petitioner addresses claims 2 and 4 in his response to the NOTIFICATION filed October 07, 2002. Accordingly, the status of all the claims has been addressed by the petitioner.

Inquiries regarding this decision should be directed to Lissi Mojica Marquis at (703) 308-2260.

Lissi Mojica Marquis, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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**TEXAS INSTRUMENTS INCORPORATED**
**P O BOX 655474, M/S 3999**
**DALLAS TX 75265**

COPY MAILED

AUG 0 2 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Houston, Theodore W. | : | |
| Application No. 09/346,436 | : | ON PETITION |
| Filed: July 1, 1999 | : | |
| Attorney Docket No. TI-21004 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed July 11, 2005, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance mailed November 23, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on February 24, 2005. A Notice of Abandonment was mailed on June 16, 2005.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

This matter is being referred to the Publishing Division for processing into a patent.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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GREENLEE WINNER AND SULLIVAN P C
5370 MANHATTAN CIRCLE
SUITE 201
BOULDER, CO 80303

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SEP 07 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Ronald J. Hill, et al. | : | |
| Application No. 09/346,470 | : | ON PETITION |
| Filed: July 1, 1999 | : | |
| Attorney Docket No. 53-99 | : | |

This is a decision on the petition, filed September 2, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on January 5, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

The application is being referred to Technology Center AU 1646 for further processing of the request for continued examination under 37 CFR 1.114 filed September 2, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 17

ANDREW J. RITTER
11778 STONEHENGE LANE
LOS ANGELES CA 90077

COPY MAILED

OCT 03 2005

OFFICE OF PETITIONS

In re Application of
ANDREW J. RITTER
Application No. 09/346,479
Filed: July 1, 1999
Attorney Docket No. 4806-2
Title: METHOD FOR INCREASING LACTOSE TOLERANCE IN MAMMALS EXHIBITING LACTOSE INTOLERANCE

DECISION GRANTING PETITION UNDER 37 C.F.R. §1.137(b)

This is a decision on the petition filed July 22, 2005, pursuant to 37 C.F.R. §1.137(b)[1], to revive the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R §1.113 in a timely manner to the final Office action mailed November 29, 2001, which set a shortened statutory period for reply of three (3) months. No responses were received, and no extensions of time were requested. Accordingly, the above-identified application became abandoned on March 2, 2002. A Notice of Abandonment was mailed on June 19, 2002.

With the present petition, petitioner has filed the petition fee, an amendment, a Request for Continued Examination (RCE) under 37 C.F.R. §1.114 as well as the associated fee and the proper statement of unintentional delay. The RCE has been accepted as the required reply under 37 C.F.R. §1.137(b)(1). The amendment submitted with the present petition shall serve as the required submission.

1 A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:
(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

As such, the petition is **GRANTED**.

After the mailing of this decision, the application will be forwarded to Technology Center 1600 for further processing.

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at http://www.uspto.gov/web/forms/sb0122.pdf.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay2. In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that the delay in paying the maintenance fee under 37 CFR 1.137(b) was intentional, petitioner must notify the Office.

**Paul Shanoski**
**Senior Attorney**
**Office of Petitions**
**United States Patent and Trademark Office**

cc: Eric Witt
650 Page Mill Road
Palo Alto, CA 94304

2 See 37 CFR 10.18(b); cf. Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).

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Paper No. 7

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MAY 2 2 2003

OFFICE OF PETITIONS

LAMORTE & ASSOCIATES P C
985 READING AVENUE
YARDLEY, PA 19067-1626

In re Application :
Rachlin, et al. : ON PETITION
Application No. 09/346,520 :
Filed: July 2, 1999 :
Attorney Docket No.: RACHLIN-1 :

This is a decision on the petition under 37 C.F.R. § 1.137(a), filed February 19, 2003 to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R.§ 1.137(a)." This is not a final agency decision.

This application became abandoned January 27, 2002 for failure to timely submit a proper reply to the final Office action mailed October 26, 2001. The Notice set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 C.F.R. § 1.136(a) were timely requested. Notice of Abandonment was mailed January 13, 2003.

A grantable petition under 37 C.F.R. § 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

As to item (1), petitioner has failed to submit a proper response to the outstanding Office communication. As petitioner alleges non-receipt of the final Office action, a courtesy copy is attached. Any renewed petition should be accompanied by a proper reply to the final Office action (i.e., amendment which *prima facie* places the application in condition for allowance, continuation application, or Request for Continued Examination).

As to item (3), petitioner has failed to present a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a) was unavoidable.

The Office may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 C.F.R. 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533 at 538, 213 U.S.P.Q. (BNA) 977 at 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 U.S.P.Q. 2d 1130 (N.D. Ind. 1987).

Petitioner alleges non-receipt of the Notice.

In the absence of any irregularity in the mailing of the final Office action, there is a strong presumption that the final Office action was properly mailed to the correspondence address of record. This presumption may be overcome by a showing that the final Office action was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the inventor stating that the Office communication was not received by the inventor and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in the inventor's statement. See, MPEP 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

The instant petition is not accompanied by corroborative evidence to support the allegation that the final Office action was not received. Any renewed petition must be accompanied by evidence to sufficiently establish the final Office action was not received at the correspondence address of record at the time of mailing of the final Office action.

**ALTERNATE VENUE**

Petitioner may wish to consider filing a petition stating that the entire delay was unintentional. Petitioner's attention is directed to 37 C.F.R. § 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 C.F.R. § 1.137(b) must be accompanied by the required petition fee, statement of unintentional delay, reply, and, if applicable, a terminal disclaimer (and fee).

The filing of a petition under 37 C.F.R. § 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 C.F.R. § 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 C.F.R. § 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

| | |
|---|---|
| By mail: | **Mail Stop Petition**<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By facsimile: | (703) 308-6916 |
| By hand: | Office of Petitions<br>2201 South Clark Place<br>Crystal Plaza 4, Suite 3C23<br>Arlington, VA 22202 |
| By delivery service:<br>(FedEx, UPS, DHL, etc.) | U.S. Patent and Trademark Office<br>2011 South Clark Place<br>Customer Window, **Mail Stop Petition** |

Crystal Plaza Two, Lobby, Room 01B03
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0210.

Alesia M. Brown
Petitions Attorney
Office of Petitions

Enclosure: Copy of Final Office Action

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
AMB

COPY MAILED Paper No. 11

AUG 1 5 2003

OFFICE OF PETITIONS

LAMORTE & ASSOCIATES P C
985 READING AVENUE
YARDLEY, PA 19067-1626

In re Application
Rachlin, et al.
Application No. 09/346,520
Filed: July 2, 1999
Attorney Docket No.: RACHLIN-1

: ON PETITION

This is a decision on the renewed petition under 37 C.F.R. § 1.137(a), filed July 28, 2003 to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned January 27, 2002 for failure to timely submit a proper reply to the final Office action mailed October 26, 2001. The Notice set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 C.F.R. § 1.136(a) were timely requested. Notice of Abandonment was mailed January 13, 2003. A petition under 37 CFR 1.137(a) was submitted February 19, 2003 and dismissed May 22, 2003.

A grantable petition under 37 C.F.R. § 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant renewed petition has been examined and found in compliance with the requirements of 37 CFR 1.137(a). Accordingly, the failure to timely respond to the Office action is deemed to have been unavoidably delayed.

This application is being forwarded to Technology Center 2600 for processing of the Request for Continued Examination submitted herewith.

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6432039
Issue Date: August 13,2002
Application No. 09346643
Filed: July 1,1999
Attorney Docket No. A-1501

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 11,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 11,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6432039 | 2002-08-13 | 09346643 | 1999-07-01 | A-1501 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | | Small Entity | | |
|---|---|---|---|---|---|
| | Fee | Code | | Fee | Code |
| ○ | 3 ½ year | (1551) | ◉ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (1552) | ○ | 7 ½ year | (2552) |
| ○ | 11 ½ year | (1553) | ○ | 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /DES/ | Date (YYYY-MM-DD) | 2008-01-11 |
| Name | Donald E. Stout | Registration Number | 34493 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 11

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

COPY MAILED

SEP 13 2004

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| George B. Rockstein et al | : |
| Application No. 09/346,859 | : DECISION GRANTING PETITION |
| Filed: July 2, 1999 | : UNDER 37 CFR 1.137(b) |
| Attorney Docket No. 056103-5072-07 | : |

This is a decision on the petition under 37 CFR 1.137(b), filed July 23, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 15, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on January 16, 2002. A Notice of Abandonment was mailed on October 22, 2002.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply to the outstanding Office action of October 15, 2001; (2) the petition fee; and (3) an adequate statement of unintentional delay have been received. Accordingly, the reply to the nonfinal Office action of October 15, 2001 is accepted as having been unintentionally delayed.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and

circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8680.

The application file is being forwarded to Technology Center AU 2876 for appropriate action as the nature of the case may require.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**MORGAN LEWIS & BOCKIUS LLP**
**1111 PENNSYLVANIA AVENUE NW**
**WASHINGTON DC 20004**

**COPY MAILED**

MAR 29 2005

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Carl H. Knowles et al :
Application No. 09/346,859 :
Filed: July 2, 1999 :
Attorney Docket No. 056103.5072-07 :

This is a decision on the petition, filed March 24, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on January 10, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2876 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

Copied from 11005981 on 10/11/2005

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6176904
Issue Date: January 23,2001
Application No. 09346896
Filed: July 2,1999
Attorney Docket No. BMG9901

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 9,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 9,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6176904 | 2001-01-23 | 09346896 | 1999-07-02 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

◉ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Sole Patentee | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature. | | | |
| Signature | /BRIJ M. GUPTA/ | Date (YYYY-MM-DD) | 2007-01-09 |
| Name | BRIJ M GUPTA | | |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,239,113 | 2001-05-29 | 09/346,923 | 1999-07-02 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ◉ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Aamer S. Ahmed/ | Date (YYYY-MM-DD) | 2009-07-15 |
| Name | Aamer S. Ahmed | Registration Number | 58958 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6239113
Issue Date: May 29,2001
Application No. 09346923
Filed: July 2,1999
Attorney Docket No. 03543-0250-U

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed July 15,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 15,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**AKIN GUMP STRAUSS HAUER & FELD L.L.P.**
**ONE COMMERCE SQUARE**
**2005 MARKET STREET, SUITE 2200**
**PHILADELPHIA PA 19103**

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NOV 23 2007

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jurgen Eck et al | : | |
| Application No. 09/347,064 | : | DECISION ON PETITION |
| Filed: July 2, 1999 | : | |
| Attorney Docket No. 684999-1 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 11, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 14, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 15, 2006. A Notice of Abandonment was mailed on October 25, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a continuing application under 37 CFR 1.53(b); (2) the petition fee of $750; and (3) a proper statement of unintentional delay. Accordingly, the failure to timely reply to the non-final Office action of March 14, 2006 is accepted as being unintentionally delayed.

The petition is not accompanied by a statement of express abandonment in favor of the filing of a continuing application. In order to facilitate action, the petition to revive should include reference to the filing of a continuing application and a letter of express abandonment conditional upon the granting of the petition and of a filing date to the continuing application. Nevertheless, in view of the statement that the reply is the filing of a continuing application, this will be construed as a request to expressly abandon this application in favor of the

granting of a filing date to the continuing application. If this is an improper, petitioner must promptly inform the office.

Accordingly, this application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the application, the application is again abandoned in favor of continuing application No. 11/803,114, filed May 11, 2007.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

Frances Hicks
Petitions Examiner
Office of Petitions

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6308887
Issue Date: October 30,2001
Application No. 09347069
Filed: July 2,1999
Attorney Docket No. 141815-5

:

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

:

This is a decision on the electronic petition, filed October 25,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 25,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,308,887 | 2001-10-30 | 09/347,069 | 1999-07-02 | 141815-5 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

◉ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

| A Joint Patentee and I certify that I am authorized to sign this submission on behalf of all the other patentees | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature. | | | |
| Signature | /BRUCE KORMAN/ | Date (YYYY-MM-DD) | 2007-10-25 |
| Name | BRUCE KORMAN | | |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 17

BARTON E. SHOWALTER, ESQ.
BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS TX 75201-2980

**MAILED**

NOV 0 6 2003

**Technology Center 2100**

In re Application of: MARK ALBERT, ET AL.
Application No.: 09/347,111
Filed: July 02, 1999
For: **LOAD BALANCING USING DISTRIBUTED FORWARDING AGENTS WITH APPLICATION BASED FEEDBACK FOR DIFFERENT VIRTUAL MACHINES**

**DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

This is in reply to Petitioner's petition to Withdraw the Holding of Abandonment filed in the United States Patent and Trademark Office on August 04, 2003. No fee is required.

The petition is **DISMISSED**.

A review of the file record reveals that the application was held abandoned for failure to respond to the Office Letter mailed October 18, 2002, within the Shortened Statutory Period of three months set therein.

The file record also indicates that the Office Letter was mailed to Petitioner at the address of record on October 18, 2002. There is a strong presumption that mail properly addressed and delivered to the United States Postal Service is in fact delivered to the addressee. This presumption may be overcome by a showing that the Office Letter was not, in fact, received. MPEP 711.03(c)II states that:

> The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

Petitioner has failed to comply with MPEP 711.03(c)II in that:

(1) Petitioner's submission does not include **a statement from the practitioner** stating that the Office communication was **not received by the practitioner** and **attesting** to the fact that **a search of the file jacket and docket records** indicates that the Office communication was not received.

(2) Petitioner's submission does not include a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. Here, Petitioner's submission only encloses a list of 10 Office Actions and a list of User Actions regarding the current application. It is required that Petitioner submit a copy of the **docket report showing all replies docketed** for a date **three months** from the mail date of the nonreceived Office action as documentary proof of nonreceipt of the Office action (See MPEP 711.03(c)II).

It is noted that Petitioner's address on the Office Letter mailed October 18, 2002 is different from that on the Notice of Abandonment mailed June 18, 2003. Therefore, the copy of the docket report should be from the location where the Office Letter mailed October 18, 2002 would have been entered had it been received and docketed.

For the above stated reasons, the Petition is **DISMISSED**. Any request for reconsideration must be filed within TWO MONTHS of the mailing date of this decision. Petitioner may wish to consider filing a petition to revive under 37 CFR 1.137(a) or 37 CFR 1.137(b).

Bot LeDynh
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 305-0651

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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JAN 29 2004

Technology Center 2100

Paper No. 19

BARTON E. SHOWALTER, ESQ.
BAKER BOTTS L.L.P.
2001 ROSS AVENUE
SUITE 600
DALLAS TX 75201-2980

| | |
|---|---|
| In re Application of: MARK ALBERT, ET AL.<br>Application No.: 09/347,111<br>Filed: July 02, 1999<br>For: **LOAD BALANCING USING DISTRIBUTED FORWARDING AGENTS WITH APPLICATION BASED FEEDBACK FOR DIFFERENT VIRTUAL MACHINES** | **DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT** |

This is in reply to Petitioner's petition to Withdraw the Holding of Abandonment filed in the United States Patent and Trademark Office on August 04, 2003, supplemented by the Request for Reconsideration of Petition filed December 11, 2003. No fee is required.

The Petition is **GRANTED**.

A review of the file record reveals that the application was held abandoned for failure to respond to the Office Letter mailed October 18, 2002, within the Shortened Statutory Period of three months set therein. Petitioner's submission dated August 04, 2003 failed to comply with MPEP 711.03(c)II in that it does not include (1) a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received, and (2) a copy of the docket record, where the nonreceived Office communication would have been entered had it been received and docketed, attached to and referenced in practitioner's statement.

Petitioner's Request for Reconsideration of Petition filed December 11, 2003 cures the deficiencies in the original Petition noted in the decision mailed November 06, 2003.

Since Petitioner never received the Office Letter mailed October 18, 2002, the holding of abandonment dated June 18, 2003 is hereby withdrawn. The application will be forwarded to the Supervisory Legal Instruments Examiner with the instructions to remail and redate the Office Letter dated October 18, 2002.

Bot LeDynh, J.D., Ph.D.
Special Programs Examiner

Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 305-0651

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DIW Feb-07

JOHN R VAN AMSTERDAM
C/O WOLF GREENFIELD & SACKS P C
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON MA 02210-2211

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 7,005,423 | : | |
| Issued: 28 February, 2006 | : | |
| Application No. 09/347,311 | : | ON PETITION |
| Filed: 2 July, 1999 | : | |
| Atty Docket No. B0192/7010 | : | |

This is in response to the deficiency fee payment filed pursuant to 37 CFR 1.28(c) on 15 November, 2006.

37 CFR 1.28(c) states, "The deficiency is based on the amount of the fee, for other than a small entity, in effect at the time the deficiency is paid in full."

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Small entity status will no longer apply.

Telephone inquiries should be directed to the undersigned at (571) 272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 22

Jayadeep R. Deshmukh
Ranbaxy Laboratories Limited
600 College Road East, Suite 2100
Princeton, NJ 08540

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SEP 1 7 2002

OFFICE OF PETITIONS

In re Application of
Talwar et al.
Application No. 09/347,315
Filed: July 2, 1999
Attorney Docket No. RLL-1.1US

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 5, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed August 29, 2000, which set a shortened statutory period for reply of three (3) months. A Request for a three-month extension of time was submitted on February 26, 2001. Accordingly, the application became abandoned on February 27, 2001.

The Continued Prosecution Application (CPA) and the Request for a four-month extension of time submitted on August 9, 2001 was filed subsequent to statutory response period for reply to the Final Office action mailed August 29, 2000. Therefore, the $1390 fee for the extension of time and the $710 fee for the CPA will be credited to petitioner's deposit account.

The file is being forwarded to Technology Center AU 1615 for processing the Request for Continued Examination under 37 CFR 1.114 filed on September 9, 2002.

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ARTHROCARE CORPORATION
680 VAQUEROS AVENUE
SUNNYVALE, CA 94085-3523

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of<br>Philip E. Eggers, et. al.<br>Application No. 09/347,390<br>Filed: July 6, 1999<br>Attorney Docket No. C-06-5 | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision on the petition under 37 CFR 1.137(b), filed on June 18, 2007, to revive the above-identified application.

The above application became abandoned for failure to file a proper reply to the final Office action mailed October 16, 2006. A Notice of Abandonment was mailed on June 14, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) under 37 CFR 1.114, with the $790 filing fee; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application is being revived for consideration of the RCE.

The application file is being referred to Technology Center Art Unit 3739, for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SUGHRUE MION ZINN MACPEAK & SEAS
2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20037-3202

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MAR 1 0 2006

**OFFICE OF PETITIONS**

In re Patent No. 6,975,979 :

Issue Date: December 13, 2005 :

Application No. 09/347,409 : ON PETITION

Filed: July 6, 199 :

Attorney Docket No. **Q55026**

This is a decision on the petition filed January 24, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **granted**.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3222. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

The file is being forwarded to the Certificate of Correction Branch for issuance of the requested Certificate of Correction.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

[1] See *Official Gazette* of June 22, 2004.

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OFFICE OF PETITIONS

KCO LAW P.L.L.C.
/DBA KEADY, OLDS & MAIER, PLLC
128 NORTH PITT STREET, 2ND FLOOR
ALEXANDRIA, VA 22314

In re Application of
Rodney L. Clark, et al.
Application No. 09/347,427
Filed: July 6, 1999
Attorney Docket No. M3477.0000/P

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-identified application, filed December 21, 2004.

The petition is GRANTED.

The application became abandoned for failure to pay the issue fee on or before December 20, 2004. Receipt is acknowledged of the requisite issue fee on December 21, 2004.

The application is being forwarded to Publishing Division.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at Publishing Division should be directed to (703) 305-8283.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE CA 95110

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APR 1 3 2007

**OFFICE OF PETITIONS**

In re Application of :
Mohaban et al. :
Application No. 09/347,438 : DECISION ON PETITION
Filed: 07/02/1999 :
Attorney Docket No. 50325-074 :

This is a decision on the petition under 37 CFR 1.314, filed March 20, 2007, to defer issuance of the patent.

The petition is GRANTED.

Issuance will be deferred for a period of one month from the date of this decision. At the end of this period, the application will be referred to Office of Patent Publication for processing into a patent.

If an additional deferral period is required, another petition and fee should be promptly submitted. The petition must include a showing of extraordinary circumstances. See MPEP 1306.01.

This matter is being referred to Technology Center AU 2157 for the Examiner's review of the Rule 312 Amendment filed March 13, 2007.

Telephone inquiries should be directed to undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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**P.O. BOX 1169**
**LOS ALTOS, CA 94023-1169**

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Philippe Harscoet | : | |
| Application No. 09/347,473 | : | ON PETITION |
| Filed: July 2, 1999 | : | |
| Attorney Docket No. 17201.707 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed March 3, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance mailed November 22, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on February 23, 2005.

The Revocation of Power of Attorney... filed on March 3, 2005 is entered and made of record.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Publishing Division.

Wan Laymon

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Notice Regarding Change of Power of Attorney
Notice of Acceptance of Power of Attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 12

**CHRISTOPHER R. CHRISTENSON**
**WESTMAN CHAMPLIN & KELLY PA**
**900 SECOND AVENUE SOUTH**
**INTERNATIONAL CENTRE SUITE 1600**
**MINNEAPOLIS, MN 55402-3319**

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MAR 0 6 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
John K. Kielb :
Application No. 09/347,683 :
Filed: July 2, 1999 :
Attorney Docket No. R11.12-0662 :

ON PETITION

This is a decision on the petition under 37 CFR 1.313(b)(5), filed February 22, 2001, which is being treated as a petition under 37 CFR 1.313(c)(3) to withdraw the above-identified application from issue after payment of the issue fee. See 1233 *Official Gazette* 54 (April 11, 2000).

The petition is **GRANTED**.

The above-identified application is hereby withdrawn from issue in favor of a continued prosecution application (CPA) under 37 CFR 1.53(d).

***Petitioner is advised that the issue fee paid on January 29, 2001 in the parent application is not refundable nor can it be applied towards any new Notice of Allowance which may issue on the CPA filed February 22, 2001.***

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

The application is being forwarded to Technology Center AU 3662 for processing of the CPA.

Frances Hicks
Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
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Paper No. 8

RICHARD D. EGAN
O'KEEFE EGAN & PETERMAN
1101 CAPITAL OF TEXAS HIGHWAY SOUTH
BUILDING C, SUITE 200
AUSTIN, TX 78746

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OCT 1 1 2002

OFFICE OF PETITIONS

In re Application of :
George Tyson Tuttle et al :
Application No. 09/347,689 :
Filed: July 2, 1999 :
Attorney Docket No. SILA:045 :

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center 2600.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
Washington, D.C. 20231
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JAN 17 2001

OFFICE OF PETITIONS
A/C PATENTS

Robert L. Knechtel
1105 Moraine Drive
Woodstock, IL 60098

In re Application of
William Yarbrough et al.
Application No. 09/347,714
Filed: July 3, 1999
Attorney Docket No. None

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed December 21, 2000, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b)[1] must be accompanied by: (1) the required reply,[2] unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lack(s) item(s) (2).

As to item (2), petitioner has submitted a check in the amount of $55 for payment of the petition fee.

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[1] As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

[2] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

Effective October 1, 2000 the small entity fee for filing a petition to revive under rule 1.137(b) is $620. Accordingly, a balance is $565 is due before revival of this application can be effected.

Additionally, an extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $435 extension of time fee submitted with the petition on December 21, 2000 was subsequent to the maximum extendable period for reply, this fee is unnecessary. If petitioner wishes to have the $435 extension fee applied toward payment of the petition fee, petitioner must submit a balance of $130 to complete the $620 petition fee and indicate such when filing the renewed petition.

**In order to expedite a decision on the renewed petition, petitioner may wish to consider submitting the response to the attention of the undersigned and to the mailing address indicated below.**

Further correspondence with respect to this matter should be addressed as follows:

By mail: Office of Petitions
Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No. 13

Robert L. Knechtel
1105 Moraine Drive
Woodstock, IL 60098

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AUG 1 2001

OFFICE OF PETITIONS
A/C PATENTS

| | | |
|---|---|---|
| In re Application of | : | |
| William Yarbrough et al. | : | |
| Application No. 09/347,714 | : | ON PETITION |
| Filed: July 3, 1999 | : | |
| Attorney Docket No. N/A | : | |

This is a decision on the renewed petition under 37 CFR 1.137(b), filed March 22, 2001, to revive the above-identified application.

The petition is **GRANTED**.

**The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed June 16, 2000, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 17, 2000.**

The application is being forwarded to Technology Center AU 1614, for further processing.

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 6225379
Issue Date: May 1,2001
Application No. 09347794
Filed: July 6,1999
Attorney Docket No. 1829

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed August 4,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of August 4,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6225379 | 2001-05-01 | 09347794 | 1999-07-06 | N-1829 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ◉ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Jane E. Gennaro/ | Date (YYYY-MM-DD) | 2009-08-04 |
| Name | Jane E. Gennaro | Registration Number | 34884 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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J. Randall Beckers
STAAS & HALSEY LLP
Suite 500
700 Eleventh Street, N.W.
Washington, DC 20001

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OCT 1 9 2005

OFFICE OF PETITIONS

In re Application of
Akira NAKAGAWA, et al.
Application No. 09/348,165
Filed: 07 July 1999
Attorney Docket No. 826.1553/JDH

DECISION
ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed 12 July 2005, to revive the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner in reply to the Final Office Action mailed 18 November 2004, which set a shortened statutory period for reply of three (3) months. A three-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b). The amendment submitted on 17 May 2005 did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed 17 June 2005. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed, the above-identified application became abandoned on 19 May 2005.

The petition is GRANTED.

**The two-month period for filing the Appeal Brief under 37 CFR 41.37(a)(1), accompanied by the fee set forth in 37 CFR 41.20(b)(2), runs from the date of this decision.**

Applicants' statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" meets the requirement under 37 CFR 1.137(b)(3).

The change of address submitted concurrently with the petition has not been entered since it embodied in the instant petition. Petitioner is adviced that the change of address must be included in a separate paper since different matters are handled by different branches of the Office. See 37 CFR 1.4(c).

Telephone inquiries concerning this decision should be directed to Nguyen Ngoc-Ho at (571) 272-3290.

This matter is being referred to Tech Center 2713.

Wan Laymon

Wan Laymon
Petitions Examiner
Office of Petitions

NNH/WL:hn

c/c to:
J. Randall Beckers
STAAS & HALSEY LLP
Suite 700
1201 New York Avenue, N.W.
Washington, DC 20005

OIPE IAP3
DEC 01 2005
PATENT & TRADEMARK OFFICE

AF
IFW

Docket No.: 826.1553

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Akira NAKAGAWA, et al.

Serial No. 09/348,165 Group Art Unit: 2613

Confirmation No. 4844

Filed: July 7, 1999 Examiner: Allen C. WONG

For: MOTION VECTOR ENCODING DEVICE AND DECODING DEVICE

**RESUBMISSION OF APPEAL BRIEF PER DECISION ON PETITION**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Decision on Petition mailed October 19, 2005.

The attached Appeal Brief, which was previously filed on October 12, 2005, before the receipt of the Decision on Petition is hereby being resubmitted to satisfy the requirements specified in the Decision.

OIPE IAP3
DEC 0 1 2005
PATENT & TRADEMARK OFFICE

S&H Form: (2/01)

Docket No.: 826.1553

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the Application of:

Akira NAKAGAWA, et al.

Serial No. 09/348,165 Group Art Unit: 2613

Confirmation No. 4844

Filed: July 7, 1999 Examiner: Allen C. WONG

For: MOTION VECTOR ENCODING DEVICE AND DECODING DEVICE

**APPELLANTS' BRIEF ON APPEAL UNDER 37 C.F.R. § 41.37**

**Mail Stop - Appeal Brief - Patents**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

The following comprises the Appellants' Brief on Appeal from the final rejection, dated November 18, 2004, of claims 11-23. This Appeal Brief is accompanied by the required appeal fee set forth in 37 C.F.R. § 41.20(b)(2), as well as a petition for a one-month extension of time to October 12, 2005. Appellants' Notice of Appeal was filed on July 12, 2005. Therefore, the present Appeal Brief is timely filed.

## I. REAL PARTY IN INTEREST

The above-captioned application is assigned in its entirety to Fujitsu Limited, having a corporate situs of Japan.

## II. RELATED APPEALS AND INTERFERENCES

Appellants state that, upon information and belief, Appellants are not aware of any co-pending appeal or interference, which will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

## III. STATUS OF CLAIMS

Claims 5 and 11-23 are pending in the application. Claim 5 is allowed. Claims 1-4 and 6-10 have been cancelled. Claims 11-23 stand rejected. The rejection of claims 11-23 is being appealed.

## IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection.

## V. SUMMARY OF CLAIMED SUBJECT MATTER

### A. Independent Claim 11

Independent claim 11 is directed to a motion vector decoding device 70 for decoding an encoding result, an embodiment of which is shown in Fig. 15. The encoding result may be obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, as described at page 15, lines 20-23 of the specification and shown in Fig. 7.

The motion vector decoding device 70, an embodiment of which is shown in Fig. 15 and described at page 36, lines 5-25, and page 37, lines 1-15 of the specification, may include predicting means for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block. An embodiment of means for predicting a motion vector is shown as element 37 in Fig. 7 and described at page 16, lines 13-25, and page 17, line 1 of the specification.

The motion vector decoding device may further include determining means for determining accuracy of a prediction made by said predicting means based on degrees of non-

uniformity of the plurality of motion vectors. An embodiment of means for determining accuracy of a prediction is shown as determining unit 51 in Fig. 8 and described at page 18, lines 24 and 25, and page 19, lines 1-14, and also shown as determining unit 61 in Figs. 12 and 15 and described at page 28, lines 10-18, page 36, lines 7-12, and page 37, lines 16-25 of the specification.

Finally, the motion vector decoding device may include decoding means for decoding the motion vector of the target block by using a result of the prediction made by said predicting means with a decoding method determined based on a result of a determination made by said determining means. An embodiment of means for decoding the motion vector is shown as decoding units 71a, 71b, 73a, and 73b in Fig. 15 and described at page 36, lines 12-20, and page 38, lines 1-10 of the specification.

B. Independent Claim 12

Independent claim 12 is directed to a motion vector decoding device 70 for decoding an output of a motion vector encoding device which predicts a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block within the frame, determines accuracy of a prediction based on degrees of non-uniformity of a plurality of motion vectors which have already been encoded in an area adjacent to the target block, and encodes the motion vector of the target block by using a result of the prediction with an encoding method determined based on a result of a determination of the accuracy of the prediction, in order to encode motion vectors of respective blocks obtained by partitioning each frame of moving image data, an embodiment of which is shown in Fig. 15. The encoding result may be obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, as described at page 15, lines 20-23 of the specification and shown in Fig. 7.

The motion vector decoding device 70, an embodiment of which is shown in Fig. 15 and described at page 36, lines 5-25, and page 37, lines 1-15 of the specification, may include predicting means for predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block used to make the determination within the motion vector encoding device. An embodiment of means for predicting a motion vector is shown as element 37 in Fig. 7 and described at page 16, lines 13-25, and page 17, line 1 of the specification.

The motion vector decoding device may further include determining means for determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold. An embodiment of means for determining accuracy of a prediction is shown as determining unit 51 in Fig. 8 and described at page 18, lines 24 and 25, and page 19, lines 1-14, and also shown as determining unit 61 in Figs. 12 and 15 and described at page 28, lines 10-18, page 36, lines 7-12, and page 37, lines 16-25 of the specification.

Finally, the motion vector decoding device may include decoding means for decoding the motion vector of the target block by using a result of the prediction made by said predicting means with a decoding method determined based on a result of a determination made by said determining means. An embodiment of the means for decoding the motion vector is shown as decoding units 71a, 71b, 73a, and 73b in Fig. 15 and described at page 36, lines 12-20, and page 38, lines 1-10 of the specification.

C. Independent Claim 13

Independent claim 13 is directed to a method of motion vector decoding for decoding a result of encoding obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, an embodiment of which is shown in Fig. 15.

The method of motion vector decoding, an embodiment of which is shown in Fig. 15 and described at page 36, lines 5-25, and page 37, lines 1-15 of the specification, may include predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block. An embodiment of predicting a motion vector is shown as element 37 in Fig. 7 and described at page 16, lines 13-25, and page 17, line 1 of the specification.

The motion vector decoding device may further include determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors. An embodiment of determining the accuracy of a prediction is shown as determining unit 51 in Fig. 8 and described at page 18, lines 24 and 25, and page 19, lines 1-14, and also shown as determining unit 61 in Figs. 12 and 15 and described at page 28, lines 10-18, page 36, lines 7-12, and page 37, lines 16-25 of the specification.

Finally, the motion vector decoding device may include decoding the motion vector of the target block by using a result of the prediction with a decoding method determined based on a result of a determination of the accuracy of the prediction. An embodiment decoding the motion

vector is shown as decoding units 71a, 71b, 73a, and 73b in Fig. 15 and described at page 36, lines 12-20, and page 38, lines 1-10 of the specification.

D. Independent Claim 20

Independent claim 20 is directed to motion vector decoding device 70 for motion vector decoding device for decoding an output of a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block, determines accuracy of a prediction based on a plurality of motion vectors which have already been encoded in an area adjacent to the target block, and encodes the motion vector of the target block by using a result of the prediction with an encoding method determined based on a result of a determination of the accuracy of the prediction, in order to encode motion vectors of respective blocks obtained by partitioning each frame of moving image data, an embodiment of which is shown in Fig. 15. The encoding result may be obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, as described at page 15, lines 20-23 of the specification, and shown in Fig. 7.

The motion vector decoding device 70, an embodiment of which is shown in Fig. 15 and described at page 36, lines 5-25, and page 37, lines 1-15 of the specification, may include predicting means for predicting the motion vector of the target block based on the plurality of motion vectors used to make the determination within the motion vector encoding device. An embodiment of means for predicting a motion vector is shown as element 37 in Fig. 7 and described at page 16, lines 13-25, and page 17, line 1 of the specification.

The motion vector decoding device may further include determining means for determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors. An embodiment of means for determining accuracy of a prediction is shown as determining unit 51 in Fig. 8 and described at page 18, lines 24 and 25, and page 19, lines 1-14, and also shown as determining unit 61 in Figs. 12 and 15 and described at page 28, lines 10-18, page 36, lines 7-12, and page 37, lines 16-25 of the specification.

Finally, the motion vector decoding device may include decoding means for decoding the motion vector of the target block by using a result of the prediction made by said predicting means with a decoding method determined based on a result of a determination made by said determining means. An embodiment of the means for decoding the motion vector is shown as

decoding units 71a, 71b, 73a, and 73b in Fig. 15 and described at page 36, lines 12-20, and page 38, lines 1-10 of the specification.

E. Independent Claim 21

Independent claim 21 is directed to a motion vector decoding device 70 for decoding an encoding result, which is obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, an embodiment of which is shown in Fig. 15. The encoding result may be obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, as described at page 15, lines 20-23 of the specification, and shown in Fig. 7.

The motion vector decoding device 70, an embodiment of which is shown in Fig. 15 and described at page 36, lines 5-25, and page 37, lines 1-15 of the specification, may include predicting means for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block. An embodiment of means for predicting a motion vector is shown as element 37 in Fig. 7 and described at page 16, lines 13-25, and page 17, line 1 of the specification.

The motion vector decoding device may further include determining means for determining accuracy of a prediction made by said predicting means based on the plurality of motion vectors. An embodiment of means for determining accuracy of a prediction is shown as determining unit 51 in Fig. 8 and described at page 18, lines 24 and 25, and page 19, lines 1-14, and also shown as determining unit 61 in Figs. 12 and 15 and described at page 28, lines 10-18, page 36, lines 7-12, and page 37, lines 16-25 of the specification.

Finally, the motion vector decoding device may include decoding means for decoding the motion vector of the target block by using a result of the prediction made by said predicting means with a decoding method determined based on a result of a determination made by said determining means. An embodiment of means for decoding the motion vector is shown as decoding units 71a, 71b, 73a, and 73b in Fig. 15 and described at page 36, lines 12-20, and page 38, lines 1-10 of the specification.

F. Independent Claim 22

Independent claim 22 is directed to a motion vector decoding method for decoding a result of encoding obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, an embodiment of which is shown in Fig. 15. The

encoding result may be obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, as described at page 15, lines 20-23 of the specification, and shown in Fig. 7.

The method of motion vector decoding 70, an embodiment of which is shown in Fig. 15 and described at page 36, lines 5-25, and page 37, lines 1-15 of the specification, may include predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block within the frame. An embodiment of predicting a motion vector is shown as element 37 in Fig. 7 and described at page 16, lines 13-25, and page 17, line 1 of the specification.

The motion vector decoding device may further include determining accuracy of a prediction based on the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold. An embodiment of determining the accuracy of a prediction is shown as determining unit 51 in Fig. 8 and described at page 18, lines 24 and 25, and page 19, lines 1-14, and also shown as determining unit 61 in Figs. 12 and 15 and described at page 28, lines 10-18, page 36, lines 7-12, and page 37, lines 16-25 of the specification.

Finally, the motion vector decoding device may include decoding the motion vector of the target block by using a result of the prediction with a decoding method determined based on a result of a determination of the accuracy of the prediction. An embodiment of the means for decoding the motion vector is shown as decoding units 71a, 71b, 73a, and 73b in Fig. 15 and described at page 36, lines 12-20, and page 38, lines 1-10.

## VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The following grounds of rejection are to be reviewed in this Appeal:

The rejection of claims 11-23 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 5,198,901 to Lynch (hereinafter "Lynch") in view of U.S. Pat. No. 5,428,396 to Yagasaki et al. (hereinafter "Yagasaki ").

## VII. ARGUMENTS

### A. Independent Claim 11

**First**, independent claim 11, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all

of the features of independent claim 11. Neither Lynch nor Yagasaki, for example, disclose "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 11.

The Examiner asserts at page 2, lines 12-16 of the final Office Action:

"Lynch discloses the predicting meant for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block, as disclosed in fig.17 and col. 10, ln. 23, to col. 11, ln. 4, where the "PREDICTION" or the prediction of the motion vector is predicatively done."

This is submitted to be incorrect. Lynch, rather, extrapolates motion vectors for a particular B Block from that B block only, as described at column 10, lines 42, 43, and 44,

> "a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

The passage in Lynch cited in the final Office Action, to the contrary, mentions nothing about "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 11.

Fig. 17, for its part, shows a decoder for the AO method, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 11. Lynch, in fact, describes deriving motion vectors for B frames from motion vectors for *an* anchor frame that is referenced to *a* previous anchor frame, in the description pertaining to Fig. 17 at column 11, lines 13-16,

> "motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame."

Thus, Lynch derives a motion vector for a B frame from a single anchor frame that is referenced to a previous anchor frame. This is to be contrasted with independent claim 11, which recites "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner asserts further at page 2, lines 16-19 of the final Office Action:

"that fig. 14 shows that the target block motion vector was predicted for accurately predicting the image data, especially in the MPEG interframe encoding/decoding environment when obtaining the motion vector between a current frame and a reference frame."

This is submitted to be incorrect. Lynch describes Fig. 14, rather, at column 10, lines 31-46 as showing interpolation of B frames *from* a predicted frame such as $P_3$, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 11. In particular, as described in Lynch at column 10, lines 31-46,

> "FIG. 14 is a block diagram for an encoder incorporating this invention. Those components corresponding to components in FIG. 11 are designated in the same way. Forward motion vectors for $P_3$, such as $mv_{30}$, are stored in a memory 89 for a period (delay) of one or two frames as required by frames $B_1$ and $B_2$ respectively (see FIG. 3). The stored motion vectors are supplied by the Fmv Memory 89 to an Area Overlap Motion Vector Calculator 90 where forward and backward motion vectors AO FMv and AO BMv are calculated for B frame motion blocks in a manner described by reference to FIGS. 4 through 10. As previously explained, a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

Thus, in Lynch, whatever prediction went into $P_3$ happened before Fig. 14, and involved no "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 11.

Finally, the Examiner asserts at page 2, lines 19-21 of the final Office Action that,

"Also, Lynch's fig. 5 discloses that a frame with the shaded area of interest has, for instance, four blocks that are obtained, utilized for predicting a motion vector."

This is submitted to be incorrect. Fig. 5, rather, depicts using the degree of overlap of a projected motion vector to estimate the accuracy of the projection. In particular, as described at column 4, lines 60-68, continuing at column 5, lines 14 of Lynch,

> "By way of example, suppose we wish to find the area of overlap of the projection of the motion block in the upper left corner of the $P_3$ frame of FIG. 4 with the motion block at j=1, i=2 of the $B_1$ frame. As shown in FIG. 5, L1=16 pixels and L2=8 pixels. By observation, the width of the overlap is 12 pixels and its height is 6, so that the desired area is 12 X 6=72 pixels. If the defined relationship is that the reference point is the top left corner of a block, then u=12 and v=18 and x=16 and y=16 so that the area of overlap in accordance with the formula is:
> AO = [16-|16-12|][8-|16-18|] = [16-4][8-2] = 12 X 6 = 72
> As illustrated by the flow charts of FIGS. 6 through 10 for calculating the areas of overlap AO, the areas of overlap in each of the blocks of a B frame are derived for each motion block in a P frame and the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap."

Thus, in Lynch, the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap. Therefore, the magnitude of the overlap is assessed *after* the projection. Any prediction to be performed in Fig. 5 has already occurred, and now the accuracy of a projection of is being assessed. None of the four blocks will be used to predict anything, let alone motion. This is to be contrasted with independent claim 11, which recites, "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner, in fact, acknowledges at page 2, line 23, continuing at page 3, line1 of the final Office Action that Lynch,

"does not disclose the prediction of a motion vector values of blocks adjacent to the target block of the same frame."

The Examiner seeks to compensate for this deficiency of Lynch by combining Lynch with Yagasaki. Yagasaki, however, neither teaches, discloses, nor suggests "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block" either, and thus cannot compensate for the deficiencies of Lynch with respect to independent claim 11.

The Examiner asserts at page 3, lines 1-3 of the final Office Action that,

"Yagasaki teaches the motion vectors of adjacent blocks to the target block in the same frame are implemented for obtaining a predicted motion vector, as disclosed at col. 18, ln. 1-13."

This is submitted to be incorrect. Yagasaki is talking about differential encoding for transmitting motion vectors at column 18, lines 1-13, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 11. Whatever predictions are to be done in Yagasaki have already been done. All Yagasaki is doing now is encoding the results. In particular, as described at column 18, lines 6-12 of Yagasaki,

> "An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0."

Thus, the motion vector values have already been produced. The adjacent blocks to which Yagasaki refers are adjacent blocks of data to be transmitted, not "a plurality of blocks adjacent to the target block," as recited in independent claim 11. Yagasaki, rather, is preserving

bandwidth by transmitting only the changes to the motion vectors relative to those around them, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 11.

In particular, the only prediction discussed in Yagasaki relates to interframe predictive coding with motion compensation, such as at column 1, lines 31-42, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 11,

> "Inter-frame predictive coding using correlation between frames is one known technique for highly efficient coding of a moving picture signal. In particular, inter-frame predictive coding with motion compensation is known, as in the MPEG document referred to above.
>
> "Motion compensated predictive coding uses correlation over time within the picture signal. A difference signal is formed for a present frame with respect to a past frame, after compensating for motion in the picture between the two frames."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 11, independent claim 11 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 11 be withdrawn.

**Second**, independent claim 11, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner.

The test for obviousness under 35 U.S.C. § 103 (a) is set forth by the United States Supreme Court in Graham v. John Deere, Co., 383 U.S. 1, 17-18 (1966). As mandated therein, in an obviousness determination under 35 U.S.C. § 103, the scope and content of the prior art are to be determined, the differences between the prior art and the claims at issue are to be ascertained and the level of ordinary skill in the pertinent art resolved. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 (Fed. Cir. 1984). A suggestion, teaching or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R.

Bard, Inc. v. MP3 Sys., Inc., 157 F.3d 1340, 1352 (Fed. Cir. 1998). "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." In re Rouffet, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). Furthermore, the suggestion must be clear and particular; broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120 (Fed. Cir. 2000).

Here, the Examiner has pointed to no evidence, either in the references or the general knowledge of the prior art, of a suggestion or motivation to combine the references in the proposed manner. The broad conclusory statement by the Examiner at page 7, lines 4-8 of the final Office Action that,

"it would have been obvious to one of ordinary skill to combine the teachings of Lynch and Yagasaki as a whole for accurately predicting motion vectors so as to efficiently produce clear, precise images for viewing and saving costs,"

in particular, is not "evidence" of a suggestion or motivation to combine the references as required for a finding of obviousness.

Lynch, rather, is complete in itself. There would thus have been no reason for persons of ordinary skill in the art at the time the invention was made to look to Yagasaki to make up for any deficiency of Lynch. Simply put, there would have been no need to look to Yagasaki to produce clear, precise images for viewing and saving costs any more efficiently than Lynch already had.

Furthermore, Lynch teaches away from the combination proposed by the Examiner at column 2, lines 39-54, when he describes differential pulse code modulation systems, for example, as requiring the transmission of a significant amount of residue in most cases,

> "In article 4, which is incorporated herein by reference, a differential pulse code modulation system is described that is like the IS system described above except for the fact that the motion vectors for the B frames are derived from motion vectors such as $mv_{30}$ or $mv_{63}$ of FIG. 2 that indicate the relative position of a block in an anchor frame that matches a block in the next anchor frame. The motion vector selected for a motion block in a B frame is the motion vector for a block in the later anchor frame that is in the same spatial position. If linear motion is assumed, a motion vector $mv_{20}$ (i, j) would equal $2/3mv_{30}$ (i, j) and $mv_{23}$ (i, j) would equal $-1/3mv_{30}$ (i, j). While this method has the advantage of not transmitting motion vectors for the B frames, the motion vectors that are used require the transmission of a significant amount of residue in most cases. "

Transmitting residues, on the other hand, is exactly what Yagasaki is doing, as described in the Abstract,

> "In connection with compression-coding of video signals on the basis of inter-frame correlation, a single reference table is used for variable length encoding of inter-frame motion vectors established on the basis of various motion vector value ranges and degrees of accuracy. A reference table is provided for variable length encoding motion vectors based on a particular value range and degree of accuracy. In order to use the same table for motion vectors based on a larger value range than that for which the table was designed, the value of a motion vector to be encoded is divided to form a quotient and a remainder. An addition bit code is formed on the basis of the remainder and is appended to a variable length code which corresponds in the reference table to the quotient so that a variable length code value is formed for the motion vector based on the larger range."

Thus, Yagasaki is going to transmit the residues, he just seeks to code the residues efficiently, using variable length codes in which longer code words represent lower accuracy, i.e. larger residues. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would have been deterred, rather than encouraged, from the modification proposed in the final Office Action, since Lynch teaches away from encoding residues at all. Consequently, the Examiner has failed to set forth a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Appellants, therefore, respectfully request that the rejection of independent claim 11 be withdrawn.

**Third**, independent claim 11, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 11. Neither Lynch nor Yagasaki, for example, disclose "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 11.

The Examiner asserts at page 3, lines 18-23, continuing at page 4, lines 1 and 2,

"As previously stated, col. 11, ln. 18-22 and fig.17, note "MODE" is determined and motion vector calculator 111 determines the prediction accuracy based on non-uniformity of the plural motion vectors."

This is submitted to be incorrect. As shown in Fig. 17, only one lead, and hence one input, enters AO Mv Calculator 111. Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 11.

Furthermore, the Area Overlap (AO) method depicted in Fig. 17 is described in Lynch at column 11, lines 5-22 as deriving motion vectors for B frames from motion vectors for an anchor frame that is referenced to a previous anchor frame, in the singular. Each motion vector is

derived from a single anchor frame, not "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 11. The motion vectors themselves are input singly to AO Mv Calculator 111, as is apparent from the single input lead. In particular, as described in Lynch at column 11, lines 5-22,

> "A decoder for the AO method is shown in FIG. 17 in which components corresponding to those of FIG. 13 are designated in the same way. In view of the fact that motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame, blocks 110 and 111 are used by the decoder for this purpose. These are identical to blocks 89 and 90 in FIG. 14. The mode information instructs the displacement blocks 104 and 105 as well as switch 107 as to the prediction mode to be used for B frame motion blocks. Otherwise, the operation of this decoder is identical to that of the decoder for the IS method."

Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 11.

Yagasaki, for its part, describes no motion vectors at all, let alone "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 11. Yagasaki, rather, is discussing encoding motion vectors at column 18, lines 1-13, not "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 11, contrary to the assertion in the final Office Action at page 3, lines 1-3. In particular, as described in Yagasaki at column 18, lines 1-13,

> "Finally, there will be described an embodiment of the present invention in which motion vector values are encoded with differential PCM (DPCM), so that the data transmitted with respect to motion vector values represents only the differences between motion vector values for adjacent blocks. An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0. The difference values are then variable length encoded in a motion vector VLC."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of

independent claim 11, independent claim 11 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 11 be withdrawn.

B. Independent Claim 12

**First**, independent claim 12, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 12. Neither Lynch nor Yagasaki, for example, disclose "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block," as recited in independent claim 12.

The Examiner asserts at page 2, lines 12-16 of the final Office Action:

"Lynch discloses the predicting meant for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block, as disclosed in fig.17 and col. 10, ln. 23, to col. 11, ln. 4, where the "PREDICTION" or the prediction of the motion vector is predicatively done."

This is submitted to be incorrect. Lynch, rather, extrapolates motion vectors for a particular B Block from that B block only, as described at column 10, lines 42, 43, and 44,

> "a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

The passage in Lynch cited in the final Office Action, to the contrary, mentions nothing about "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block," as recited in independent claim 12.

Fig. 17, for its part, shows a decoder for the AO method, not "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block," as recited in independent claim 12. Lynch, in fact, describes deriving motion vectors for B frames from motion vectors for *an* anchor frame that is referenced to *a* previous anchor frame, in the description pertaining to Fig. 17 at column 11, lines 13-16,

> "motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame."

Thus, Lynch derives a motion vector for a B frame from a single anchor frame that is referenced to a previous anchor frame. This is to be contrasted with independent claim 12, which recites "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block."

The Examiner asserts further at page 2, lines 16-19 of the final Office Action:

"that fig. 14 shows that the target block motion vector was predicted for accurately predicting the image data, especially in the MPEG interframe encoding/decoding environment when obtaining the motion vector between a current frame and a reference frame."

This is submitted to be incorrect. Lynch describes Fig. 14, rather, at column 10, lines 31-46 as showing interpolation of B frames *from* a predicted frame such as $P_3$, not "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block," as recited in independent claim 12. In particular, as described in Lynch at column 10, lines 31-46,

> "FIG. 14 is a block diagram for an encoder incorporating this invention. Those components corresponding to components in FIG. 11 are designated in the same way. Forward motion vectors for $P_3$, such as $mv_{30}$, are stored in a memory 89 for a period (delay) of one or two frames as required by frames $B_1$ and $B_2$ respectively (see FIG. 3). The stored motion vectors are supplied by the Fmv Memory 89 to an Area Overlap Motion Vector Calculator 90 where forward and backward motion vectors AO FMv and AO BMv are calculated for B frame motion blocks in a manner described by reference to FIGS. 4 through 10. As previously explained, a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

Thus, in Lynch, whatever prediction went into $P_3$ happened before Fig. 14, and involved no "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block," as recited in independent claim 12.

Finally, the Examiner asserts at page 2, lines 19-21 of the final Office Action that,

"Also, Lynch's fig. 5 discloses that a frame with the shaded area of interest has, for instance, four blocks that are obtained, utilized for predicting a motion vector."

This is submitted to be incorrect. Fig. 5, rather, depicts using the degree of overlap of a projected motion vector to estimate the accuracy of the projection. In particular, as described at column 4, lines 60-68, continuing at column 5, lines 14 of Lynch,

> "By way of example, suppose we wish to find the area of overlap of the projection of the motion block in the upper left corner of the $P_3$ frame of FIG. 4 with the motion block at j=1, i=2 of the $B_1$ frame. As shown in FIG. 5, L1=16 pixels and L2=8 pixels. By observation, the width of the overlap is 12 pixels and its height is 6, so that the desired area is 12 X 6=72 pixels. If the defined relationship is that the reference point is the top left corner of a block, then u=12 and v=18 and x=16 and y=16 so that the area of overlap in accordance with the formula is:
> AO = [16-|16-12|][8-|16-18|] = [16-4][8-2] = 12 X 6 = 72
> As illustrated by the flow charts of FIGS. 6 through 10 for calculating the areas of overlap AO, the areas of overlap in each of the blocks of a B frame are derived for each motion block in a P frame and the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap."

Thus, in Lynch, the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap. Therefore, the magnitude of the overlap is assessed *after* the projection. Any prediction to be performed in Fig. 5 has already occurred, and now the accuracy of a projection of is being assessed. None of the four blocks will be used to predict anything, let alone motion. This is to be contrasted with independent claim 12, which recites, "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block."

The Examiner, in fact, acknowledges at page 2, line 23, continuing at page 3, line1 of the final Office Action that Lynch,

"does not disclose the prediction of a motion vector values of blocks adjacent to the target block of the same frame."

The Examiner seeks to compensate for this deficiency of Lynch by combining Lynch with Yagasaki. Yagasaki, however, neither teaches, discloses, nor suggests "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block" either, and thus cannot compensate for the deficiencies of Lynch with respect to independent claim 12.

The Examiner asserts at page 3, lines 1-3 of the final Office Action that,

"Yagasaki teaches the motion vectors of adjacent blocks to the target block in the same frame are implemented for obtaining a predicted motion vector, as disclosed at col. 18, ln. 1-13."

This is submitted to be incorrect. Yagasaki is talking about differential encoding for transmitting motion vectors at column 18, lines 1-13, not "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block," as recited in independent claim 12. Whatever predictions are to be done in Yagasaki have already been done. All Yagasaki is doing now is encoding the results. In particular, as described at column 18, lines 6-12 of Yagasaki,

> "An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0."

Thus, the motion vector values have already been produced. The adjacent blocks to which Yagasaki refers are adjacent blocks of data to be transmitted, not "a plurality of blocks adjacent to the target block," as recited in independent claim 12. Yagasaki, rather, is preserving bandwidth by transmitting only the changes to the motion vectors relative to those around them, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 12.

In particular, the only prediction discussed in Yagasaki relates to interframe predictive coding with motion compensation, such as at column 1, lines 31-42, not "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block," as recited in independent claim 12,

> "Inter-frame predictive coding using correlation between frames is one known technique for highly efficient coding of a moving picture signal. In particular, inter-frame predictive coding with motion compensation is known, as in the MPEG document referred to above.
>
> "Motion compensated predictive coding uses correlation over time within the picture signal. A difference signal is formed for a present frame with respect to a past frame, after compensating for motion in the picture between the two frames."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination,

disclose all of the features of independent claim 12, independent claim 12 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 12 be withdrawn.

**Second**, independent claim 12, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Here, the Examiner has pointed to no evidence, either in the references or the general knowledge of the prior art, of a suggestion or motivation to combine the references in the proposed manner. The broad conclusory statement by the Examiner at page 7, lines 4-8 of the final Office Action that,

"it would have been obvious to one of ordinary skill to combine the teachings of Lynch and Yagasaki as a whole for accurately predicting motion vectors so as to efficiently produce clear, precise images for viewing and saving costs,"

in particular, is not "evidence" of a suggestion or motivation to combine the references as required for a finding of obviousness.

Lynch, rather, is complete in itself. There would thus have been no reason for persons of ordinary skill in the art at the time the invention was made to look to Yagasaki to make up for any deficiency of Lynch. Simply put, there would have been no need to look to Yagasaki to produce clear, precise images for viewing and saving costs any more efficiently than Lynch already had.

Furthermore, Lynch teaches away from the combination proposed by the Examiner at column 2, lines 39-54, when he describes differential pulse code modulation systems, for example, as requiring the transmission of a significant amount of residue in most cases,

> "In article 4, which is incorporated herein by reference, a differential pulse code modulation system is described that is like the IS system described above except for the fact that the motion vectors for the B frames are derived from motion vectors such as $mv_{30}$ or $mv_{63}$ of FIG. 2 that indicate the relative position of a block in an anchor frame that matches a block in the next anchor frame. The motion vector selected for a motion block in a B frame is the motion vector for a block in the later anchor frame that is in the same spatial position. If linear motion is assumed, a motion vector $mv_{20}$ (i, j) would equal $2/3mv_{30}$ (i, j) and $mv_{23}$ (i, j) would equal $-1/3mv_{30}$ (i, j). While this method has the advantage of not transmitting motion vectors for the B frames, the motion vectors that are used require the transmission of a significant amount of residue in most cases. "

Transmitting residues, on the other hand, is exactly what Yagasaki is doing, as described in the Abstract,

> "In connection with compression-coding of video signals on the basis of inter-frame correlation, a single reference table is used for variable length encoding of inter-frame motion vectors established on the basis of various motion vector value ranges and degrees of accuracy. A reference table is provided for variable length encoding motion vectors based on a particular value range and degree of accuracy. In order to use the same table for motion vectors based on a larger value range than that for which the table was designed, the value of a motion vector to be encoded is divided to form a quotient and a remainder. An addition bit code is formed on the basis of the remainder and is appended to a variable length code which corresponds in the reference table to the quotient so that a variable length code value is formed for the motion vector based on the larger range."

Thus, Yagasaki is going to transmit the residues, he just seeks to code the residues efficiently, using variable length codes in which longer code words represent lower accuracy, i.e. larger residues. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would have been deterred, rather than encouraged, from the modification proposed in the final Office Action, since Lynch teaches away from encoding residues at all. Consequently, the Examiner has failed to set forth a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Appellants, therefore, respectfully request that the rejection of independent claim 12 be withdrawn.

**Third**, independent claim 12, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 12. Neither Lynch nor Yagasaki, for example, disclose "determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 12.

The Examiner asserts at page 3, lines 18-23, continuing at page 4, lines 1 and 2,

"As previously stated, col. 11, ln. 18-22 and fig.17, note "MODE" is determined and motion vector calculator 111 determines the prediction accuracy based on non-uniformity of the plural motion vectors."

This is submitted to be incorrect. As shown in Fig. 17, only one lead, and hence one input, enters AO Mv Calculator 111. Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 12.

Furthermore, the Area Overlap (AO) method depicted in Fig. 17 is described in Lynch at column 11, lines 5-22 as deriving motion vectors for B frames from motion vectors for an anchor

frame that is referenced to a previous anchor frame, in the singular. Each motion vector is derived from a single anchor frame, not "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 12. The motion vectors themselves are input singly to AO Mv Calculator 111, as is apparent from the single input lead. In particular, as described in Lynch at column 11, lines 5-22,

> "A decoder for the AO method is shown in FIG. 17 in which components corresponding to those of FIG. 13 are designated in the same way. In view of the fact that motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame, blocks 110 and 111 are used by the decoder for this purpose. These are identical to blocks 89 and 90 in FIG. 14. The mode information instructs the displacement blocks 104 and 105 as well as switch 107 as to the prediction mode to be used for B frame motion blocks. Otherwise, the operation of this decoder is identical to that of the decoder for the IS method."

Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 12.

Yagasaki, for its part, describes no motion vectors at all, let alone "determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 12. Yagasaki, rather, is discussing encoding motion vectors at column 18, lines 1-13, not "determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 12, contrary to the assertion in the final Office Action at page 3, lines 1-3. In particular, as described in Yagasaki at column 18, lines 1-13,

> "Finally, there will be described an embodiment of the present invention in which motion vector values are encoded with differential PCM (DPCM), so that the data transmitted with respect to motion vector values represents only the differences between motion vector values for adjacent blocks. An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0. The difference values are then variable length encoded in a motion vector VLC."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly,

because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 12, independent claim 12 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 12 be withdrawn.

C. Independent Claim 13

**First**, independent claim 13, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 13. Neither Lynch nor Yagasaki, for example, disclose "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 13.

The Examiner asserts at page 2, lines 12-16 of the final Office Action:

"Lynch discloses the predicting meant for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block, as disclosed in fig.17 and col. 10, ln. 23, to col. 11, ln. 4, where the "PREDICTION" or the prediction of the motion vector is predicatively done."

This is submitted to be incorrect. Lynch, rather, extrapolates motion vectors for a particular B Block from that B block only, as described at column 10, lines 42, 43, and 44,

> "a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

The passage in Lynch cited in the final Office Action, to the contrary, mentions nothing about "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 13.

Fig. 17, for its part, shows a decoder for the AO method, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 13. Lynch, in fact, describes deriving motion vectors for B frames from motion vectors for *an* anchor frame that is referenced to *a* previous anchor frame, in the description pertaining to Fig. 17 at column 11, lines 13-16,

> "motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame."

Thus, Lynch derives a motion vector for a B frame from a single anchor frame that is referenced to a previous anchor frame. This is to be contrasted with independent claim 13, which recites "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner asserts further at page 2, lines 16-19 of the final Office Action:

"that fig. 14 shows that the target block motion vector was predicted for accurately predicting the image data, especially in the MPEG interframe encoding/decoding environment when obtaining the motion vector between a current frame and a reference frame."

This is submitted to be incorrect. Lynch describes Fig. 14, rather, at column 10, lines 31-46 as showing interpolation of B frames *from* a predicted frame such as $P_3$, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 13. In particular, as described in Lynch at column 10, lines 31-46,

> "FIG. 14 is a block diagram for an encoder incorporating this invention. Those components corresponding to components in FIG. 11 are designated in the same way. Forward motion vectors for $P_3$, such as $mv_{30}$, are stored in a memory 89 for a period (delay) of one or two frames as required by frames $B_1$ and $B_2$ respectively (see FIG. 3). The stored motion vectors are supplied by the Fmv Memory 89 to an Area Overlap Motion Vector Calculator 90 where forward and backward motion vectors AO FMv and AO BMv are calculated for B frame motion blocks in a manner described by reference to FIGS. 4 through 10. As previously explained, a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

Thus, in Lynch, whatever prediction went into $P_3$ happened before Fig. 14, and involved no "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 13.

Finally, the Examiner asserts at page 2, lines 19-21 of the final Office Action that,

"Also, Lynch's fig. 5 discloses that a frame with the shaded area of interest has, for instance, four blocks that are obtained, utilized for predicting a motion vector."

This is submitted to be incorrect. Fig. 5, rather, depicts using the degree of overlap of a projected motion vector to estimate the accuracy of the projection. In particular, as described at column 4, lines 60-68, continuing at column 5, lines 14 of Lynch,

> "By way of example, suppose we wish to find the area of overlap of the projection of the motion block in the upper left corner of the $P_3$ frame of FIG. 4 with the

> motion block at j=1, i=2 of the $B_1$ frame. As shown in FIG. 5, L1=16 pixels and L2=8 pixels. By observation, the width of the overlap is 12 pixels and its height is 6, so that the desired area is 12 X 6=72 pixels. If the defined relationship is that the reference point is the top left corner of a block, then u=12 and v=18 and x=16 and y=16 so that the area of overlap in accordance with the formula is:
> AO = [16-|16-12|][8-|16-18|] = [16-4][8-2] = 12 X 6 = 72
> As illustrated by the flow charts of FIGS. 6 through 10 for calculating the areas of overlap AO, the areas of overlap in each of the blocks of a B frame are derived for each motion block in a P frame and the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap."

Thus, in Lynch, the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap. Therefore, the magnitude of the overlap is assessed *after* the projection. Any prediction to be performed in Fig. 5 has already occurred, and now the accuracy of a projection of is being assessed. None of the four blocks will be used to predict anything, let alone motion. This is to be contrasted with independent claim 13, which recites, "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner, in fact, acknowledges at page 2, line 23, continuing at page 3, line1 of the final Office Action that Lynch,

"does not disclose the prediction of a motion vector values of blocks adjacent to the target block of the same frame."

The Examiner seeks to compensate for this deficiency of Lynch by combining Lynch with Yagasaki. Yagasaki, however, neither teaches, discloses, nor suggests "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block" either, and thus cannot compensate for the deficiencies of Lynch with respect to independent claim 13.

The Examiner asserts at page 3, lines 1-3 of the final Office Action that,

"Yagasaki teaches the motion vectors of adjacent blocks to the target block in the same frame are implemented for obtaining a predicted motion vector, as disclosed at col. 18, ln. 1-13."

This is submitted to be incorrect. Yagasaki is talking about differential encoding for transmitting motion vectors at column 18, lines 1-13, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 13. Whatever predictions are to be done in Yagasaki have already been

done. All Yagasaki is doing now is encoding the results. In particular, as described at column 18, lines 6-12 of Yagasaki,

> "An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0."

Thus, the motion vector values have already been produced. The adjacent blocks to which Yagasaki refers are adjacent blocks of data to be transmitted, not "a plurality of blocks adjacent to the target block," as recited in independent claim 13. Yagasaki, rather, is preserving bandwidth by transmitting only the changes to the motion vectors relative to those around them, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 13.

In particular, the only prediction discussed in Yagasaki relates to interframe predictive coding with motion compensation, such as at column 1, lines 31-42, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 13,

> "Inter-frame predictive coding using correlation between frames is one known technique for highly efficient coding of a moving picture signal. In particular, inter-frame predictive coding with motion compensation is known, as in the MPEG document referred to above.
>
> "Motion compensated predictive coding uses correlation over time within the picture signal. A difference signal is formed for a present frame with respect to a past frame, after compensating for motion in the picture between the two frames."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 13, independent claim 13 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 13 be withdrawn.

**Second**, independent claim 13, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Here, the Examiner has pointed to no evidence, either in the references or the

general knowledge of the prior art, of a suggestion or motivation to combine the references in the proposed manner. The broad conclusory statement by the Examiner at page 7, lines 4-8 of the final Office Action that,

"it would have been obvious to one of ordinary skill to combine the teachings of Lynch and Yagasaki as a whole for accurately predicting motion vectors so as to efficiently produce clear, precise images for viewing and saving costs,"

in particular, is not "evidence" of a suggestion or motivation to combine the references as required for a finding of obviousness.

Lynch, rather, is complete in itself. There would thus have been no reason for persons of ordinary skill in the art at the time the invention was made to look to Yagasaki to make up for any deficiency of Lynch. Simply put, there would have been no need to look to Yagasaki to produce clear, precise images for viewing and saving costs any more efficiently than Lynch already had.

Furthermore, Lynch teaches away from the combination proposed by the Examiner at column 2, lines 39-54, when he describes differential pulse code modulation systems, for example, as requiring the transmission of a significant amount of residue in most cases,

> "In article 4, which is incorporated herein by reference, a differential pulse code modulation system is described that is like the IS system described above except for the fact that the motion vectors for the B frames are derived from motion vectors such as $mv_{30}$ or $mv_{63}$ of FIG. 2 that indicate the relative position of a block in an anchor frame that matches a block in the next anchor frame. The motion vector selected for a motion block in a B frame is the motion vector for a block in the later anchor frame that is in the same spatial position. If linear motion is assumed, a motion vector $mv_{20}$ (i, j) would equal $2/3mv_{30}$ (i, j) and $mv_{23}$ (i, j) would equal $-1/3mv_{30}$ (i, j). While this method has the advantage of not transmitting motion vectors for the B frames, the motion vectors that are used require the transmission of a significant amount of residue in most cases. "

Transmitting residues, on the other hand, is exactly what Yagasaki is doing, as described in the Abstract,

> "In connection with compression-coding of video signals on the basis of inter-frame correlation, a single reference table is used for variable length encoding of inter-frame motion vectors established on the basis of various motion vector value ranges and degrees of accuracy. A reference table is provided for variable length encoding motion vectors based on a particular value range and degree of accuracy. In order to use the same table for motion vectors based on a larger value range than that for which the table was designed, the value of a motion vector to be encoded is divided to form a quotient and a remainder. An addition bit code is formed on the basis of the remainder and is appended to a variable length code which corresponds in the reference table to the quotient so that a

variable length code value is formed for the motion vector based on the larger range."

Thus, Yagasaki is going to transmit the residues, he just seeks to code the residues efficiently, using variable length codes in which longer code words represent lower accuracy, i.e. larger residues. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would have been deterred, rather than encouraged, from the modification proposed in the final Office Action, since Lynch teaches away from encoding residues at all. Consequently, the Examiner has failed to set forth a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Appellants, therefore, respectfully request that the rejection of independent claim 13 be withdrawn.

**Third**, independent claim 13, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 13. Neither Lynch nor Yagasaki, for example, disclose "determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 13.

The Examiner asserts at page 3, lines 18-23, continuing at page 4, lines 1 and 2,

"As previously stated, col. 11, ln. 18-22 and fig.17, note "MODE" is determined and motion vector calculator 111 determines the prediction accuracy based on non-uniformity of the plural motion vectors."

This is submitted to be incorrect. As shown in Fig. 17, only one lead, and hence one input, enters AO Mv Calculator 111. Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 13.

Furthermore, the Area Overlap (AO) method depicted in Fig. 17 is described in Lynch at column 11, lines 5-22 as deriving motion vectors for B frames from motion vectors for an anchor frame that is referenced to a previous anchor frame, in the singular. Each motion vector is derived from a single anchor frame, not "determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 13. The motion vectors themselves are input singly to AO Mv Calculator 111, as is apparent from the single input lead. In particular, as described in Lynch at column 11, lines 5-22,

"A decoder for the AO method is shown in FIG. 17 in which components corresponding to those of FIG. 13 are designated in the same way. In view of the fact that motion vectors for B frames can also be derived in accordance with this

> invention from motion vectors for an anchor frame that is referenced to a previous anchor frame, blocks 110 and 111 are used by the decoder for this purpose. These are identical to blocks 89 and 90 in FIG. 14. The mode information instructs the displacement blocks 104 and 105 as well as switch 107 as to the prediction mode to be used for B frame motion blocks. Otherwise, the operation of this decoder is identical to that of the decoder for the IS method."

Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 13.

Yagasaki, for its part, describes no motion vectors at all, let alone "determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 13. Yagasaki, rather, is discussing encoding motion vectors at column 18, lines 1-13, not "determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 13, contrary to the assertion in the final Office Action at page 3, lines 1-3. In particular, as described in Yagasaki at column 18, lines 1-13,

> "Finally, there will be described an embodiment of the present invention in which motion vector values are encoded with differential PCM (DPCM), so that the data transmitted with respect to motion vector values represents only the differences between motion vector values for adjacent blocks. An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0. The difference values are then variable length encoded in a motion vector VLC."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 13, independent claim 13 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 13 be withdrawn.

D. Independent Claim 20

**First**, independent claim 20 is patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 20. Neither Lynch nor Yagasaki, for example, disclose "a motion vector encoding device which

predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 20.

The Examiner asserts at page 2, lines 12-16 of the final Office Action:

"Lynch discloses the predicting meant for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block, as disclosed in fig.17 and col. 10, ln. 23, to col. 11, ln. 4, where the "PREDICTION" or the prediction of the motion vector is predicatively done."

This is submitted to be incorrect. Lynch, rather, extrapolates motion vectors for a particular B Block from that B block only, as described at column 10, lines 42, 43, and 44,

> "a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

The passage in Lynch cited in the final Office Action, to the contrary, mentions nothing about "a motion vector encoding device, which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 20.

Fig. 17, for its part, shows a decoder for the AO method, not "a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 20. Lynch, in fact, describes deriving motion vectors for B frames from motion vectors for *an* anchor frame that is referenced to *a* previous anchor frame, in the description pertaining to Fig. 17 at column 11, lines 13-16,

> "motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame."

Thus, Lynch derives a motion vector for a B frame from a single anchor frame that is referenced to a previous anchor frame. This is to be contrasted with independent claim 20, which recites "a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner asserts further at page 2, lines 16-19 of the final Office Action:

"that fig. 14 shows that the target block motion vector was predicted for accurately predicting the image data, especially in the MPEG interframe encoding/decoding environment when obtaining the motion vector between a current frame and a reference frame."

This is submitted to be incorrect. Lynch describes Fig. 14, rather, at column 10, lines 31-46 as showing interpolation of B frames *from* a predicted frame such as $P_3$, not "a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 20. In particular, as described in Lynch at column 10, lines 31-46,

> "FIG. 14 is a block diagram for an encoder incorporating this invention. Those components corresponding to components in FIG. 11 are designated in the same way. Forward motion vectors for $P_3$, such as $mv_{30}$, are stored in a memory 89 for a period (delay) of one or two frames as required by frames $B_1$ and $B_2$ respectively (see FIG. 3). The stored motion vectors are supplied by the Fmv Memory 89 to an Area Overlap Motion Vector Calculator 90 where forward and backward motion vectors AO FMv and AO BMv are calculated for B frame motion blocks in a manner described by reference to FIGS. 4 through 10. As previously explained, a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

Thus, in Lynch, whatever prediction went into $P_3$ happened before Fig. 14, and involved no "a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 20.

Finally, the Examiner asserts at page 2, lines 19-21 of the final Office Action that,

"Also, Lynch's fig. 5 discloses that a frame with the shaded area of interest has, for instance, four blocks that are obtained, utilized for predicting a motion vector."

This is submitted to be incorrect. Fig. 5, rather, depicts using the degree of overlap of a projected motion vector to estimate the accuracy of the projection. In particular, as described at column 4, lines 60-68, continuing at column 5, lines 14 of Lynch,

> "By way of example, suppose we wish to find the area of overlap of the projection of the motion block in the upper left corner of the $P_3$ frame of FIG. 4 with the motion block at j=1, i=2 of the $B_1$ frame. As shown in FIG. 5, L1=16 pixels and L2=8 pixels. By observation, the width of the overlap is 12 pixels and its height is 6, so that the desired area is 12 X 6=72 pixels. If the defined relationship is that the reference point is the top left corner of a block, then u=12 and v=18 and x=16 and y=16 so that the area of overlap in accordance with the formula is:
> AO = [16-|16-12|][8-|16-18|] = [16-4][8-2] = 12 X 6 = 72
> As illustrated by the flow charts of FIGS. 6 through 10 for calculating the areas of overlap AO, the areas of overlap in each of the blocks of a B frame are derived for each motion block in a P frame and the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap."

Thus, in Lynch, the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap. Therefore, the magnitude of the overlap is assessed *after* the projection. Any prediction to be performed in Fig. 5 has already occurred, and now the accuracy of a projection of is being assessed. None of the four blocks will be used to predict anything, let alone motion. This is to be contrasted with independent claim 20, which recites, "a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner, in fact, acknowledges at page 2, line 23, continuing at page 3, line1 of the final Office Action that Lynch,

"does not disclose the prediction of a motion vector values of blocks adjacent to the target block of the same frame."

The Examiner seeks to compensate for this deficiency of Lynch by combining Lynch with Yagasaki. Yagasaki, however, neither teaches, discloses, nor suggests "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block" either, and thus cannot compensate for the deficiencies of Lynch with respect to independent claim 20.

The Examiner asserts at page 3, lines 1-3 of the final Office Action that,

"Yagasaki teaches the motion vectors of adjacent blocks to the target block in the same frame are implemented for obtaining a predicted motion vector, as disclosed at col. 18, ln. 1-13."

This is submitted to be incorrect. Yagasaki is talking about differential encoding for transmitting motion vectors at column 18, lines 1-13, not "a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 20. Whatever predictions are to be done in Yagasaki have already been done. All Yagasaki is doing now is encoding the results. In particular, as described at column 18, lines 6-12 of Yagasaki,

> "An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0."

Thus, the motion vector values have already been produced. The adjacent blocks to which Yagasaki refers are adjacent blocks of data to be transmitted, not "a plurality of blocks adjacent to the target block," as recited in independent claim 20. Yagasaki, rather, is preserving

bandwidth by transmitting only the changes to the motion vectors relative to those around them, not "a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 20.

In particular, the only prediction discussed in Yagasaki relates to interframe predictive coding with motion compensation, such as at column 1, lines 31-42, not "a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 20,

> "Inter-frame predictive coding using correlation between frames is one known technique for highly efficient coding of a moving picture signal. In particular, inter-frame predictive coding with motion compensation is known, as in the MPEG document referred to above.
>
> "Motion compensated predictive coding uses correlation over time within the picture signal. A difference signal is formed for a present frame with respect to a past frame, after compensating for motion in the picture between the two frames."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 20, independent claim 20 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 20 be withdrawn.

**Second**, independent claim 20 is patentable over Lynch in view of Yagasaki because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Here, the Examiner has pointed to no evidence, either in the references or the general knowledge of the prior art, of a suggestion or motivation to combine the references in the proposed manner. The broad conclusory statement by the Examiner at page 7, lines 4-8 of the final Office Action that,

"it would have been obvious to one of ordinary skill to combine the teachings of Lynch and Yagasaki as a whole for accurately predicting motion vectors so as to efficiently produce clear, precise images for viewing and saving costs,"

in particular, is not "evidence" of a suggestion or motivation to combine the references as required for a finding of obviousness.

Lynch, rather, is complete in itself. There would thus have been no reason for persons of ordinary skill in the art at the time the invention was made to look to Yagasaki to make up for any deficiency of Lynch. Simply put, there would have been no need to look to Yagasaki to produce clear, precise images for viewing and saving costs any more efficiently than Lynch already had.

Furthermore, Lynch teaches away from the combination proposed by the Examiner at column 2, lines 39-54, when he describes differential pulse code modulation systems, for example, as requiring the transmission of a significant amount of residue in most cases,

> "In article 4, which is incorporated herein by reference, a differential pulse code modulation system is described that is like the IS system described above except for the fact that the motion vectors for the B frames are derived from motion vectors such as $mv_{30}$ or $mv_{63}$ of FIG. 2 that indicate the relative position of a block in an anchor frame that matches a block in the next anchor frame. The motion vector selected for a motion block in a B frame is the motion vector for a block in the later anchor frame that is in the same spatial position. If linear motion is assumed, a motion vector $mv_{20}$ (i, j) would equal $2/3mv_{30}$ (i, j) and $mv_{23}$ (i, j) would equal $-1/3mv_{30}$ (i, j). While this method has the advantage of not transmitting motion vectors for the B frames, the motion vectors that are used require the transmission of a significant amount of residue in most cases. "

Transmitting residues, on the other hand, is exactly what Yagasaki is doing, as described in the Abstract,

> "In connection with compression-coding of video signals on the basis of inter-frame correlation, a single reference table is used for variable length encoding of inter-frame motion vectors established on the basis of various motion vector value ranges and degrees of accuracy. A reference table is provided for variable length encoding motion vectors based on a particular value range and degree of accuracy. In order to use the same table for motion vectors based on a larger value range than that for which the table was designed, the value of a motion vector to be encoded is divided to form a quotient and a remainder. An addition bit code is formed on the basis of the remainder and is appended to a variable length code which corresponds in the reference table to the quotient so that a variable length code value is formed for the motion vector based on the larger range."

Thus, Yagasaki is going to transmit the residues, he just seeks to code the residues efficiently, using variable length codes in which longer code words represent lower accuracy, i.e. larger residues. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would have been deterred, rather than encouraged, from the modification proposed in the final Office Action, since Lynch teaches away from encoding residues at all.

Consequently, the Examiner has failed to set forth a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Appellants, therefore, respectfully request that the rejection of independent claim 20 be withdrawn.

**Third**, independent claim 20, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 20. Neither Lynch nor Yagasaki, for example, disclose "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 20.

The Examiner asserts at page 3, lines 18-23, continuing at page 4, lines 1 and 2,

"As previously stated, col. 11, ln. 18-22 and fig.17, note "MODE" is determined and motion vector calculator 111 determines the prediction accuracy based on non-uniformity of the plural motion vectors."

This is submitted to be incorrect. As shown in Fig. 17, only one lead, and hence one input, enters AO Mv Calculator 111. Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 20.

Furthermore, the Area Overlap (AO) method depicted in Fig. 17 is described in Lynch at column 11, lines 5-22 as deriving motion vectors for B frames from motion vectors for an anchor frame that is referenced to a previous anchor frame, in the singular. Each motion vector is derived from a single anchor frame, not "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 20. The motion vectors themselves are input singly to AO Mv Calculator 111, as is apparent from the single input lead. In particular, as described in Lynch at column 11, lines 5-22,

> "A decoder for the AO method is shown in FIG. 17 in which components corresponding to those of FIG. 13 are designated in the same way. In view of the fact that motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame, blocks 110 and 111 are used by the decoder for this purpose. These are identical to blocks 89 and 90 in FIG. 14. The mode information instructs the displacement blocks 104 and 105 as well as switch 107 as to the prediction mode to be used for B frame motion blocks. Otherwise, the operation of this decoder is identical to that of the decoder for the IS method."

Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 20.

Yagasaki, for its part, describes no motion vectors at all, let alone "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 20. Yagasaki, rather, is discussing encoding motion vectors at column 18, lines 1-13, not "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 20, contrary to the assertion in the final Office Action at page 3, lines 1-3. In particular, as described in Yagasaki at column 18, lines 1-13,

> "Finally, there will be described an embodiment of the present invention in which motion vector values are encoded with differential PCM (DPCM), so that the data transmitted with respect to motion vector values represents only the differences between motion vector values for adjacent blocks. An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0. The difference values are then variable length encoded in a motion vector VLC."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 20, independent claim 20 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 20 be withdrawn.

E. Independent claim 21

**First**, independent claim 21 is patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 21. Neither Lynch nor Yagasaki, for example, disclose "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 21.

The Examiner asserts at page 2, lines 12-16 of the final Office Action:

"Lynch discloses the predicting meant for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block, as disclosed in fig.17 and col. 10, ln. 23, to col. 11, ln. 4, where the "PREDICTION" or the prediction of the motion vector is predicatively done."

This is submitted to be incorrect. Lynch, rather, extrapolates motion vectors for a particular B Block from that B block only, as described at column 10, lines 42, 43, and 44,

> "a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

The passage in Lynch cited in the final Office Action, to the contrary, mentions nothing about "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 21.

Fig. 17, for its part, shows a decoder for the AO method, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 21. Lynch, in fact, describes deriving motion vectors for B frames from motion vectors for *an* anchor frame that is referenced to *a* previous anchor frame, in the description pertaining to Fig. 17 at column 11, lines 13-16,

> "motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame."

Thus, Lynch derives a motion vector for a B frame from a single anchor frame that is referenced to a previous anchor frame. This is to be contrasted with independent claim 21, which recites "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner asserts further at page 2, lines 16-19 of the final Office Action:

"that fig. 14 shows that the target block motion vector was predicted for accurately predicting the image data, especially in the MPEG interframe encoding/decoding environment when obtaining the motion vector between a current frame and a reference frame."

This is submitted to be incorrect. Lynch describes Fig. 14, rather, at column 10, lines 31-46 as showing interpolation of B frames *from* a predicted frame such as $P_3$, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the

target block," as recited in independent claim 21. In particular, as described in Lynch at column 10, lines 31-46,

> "FIG. 14 is a block diagram for an encoder incorporating this invention. Those components corresponding to components in FIG. 11 are designated in the same way. Forward motion vectors for $P_3$, such as $mv_{30}$, are stored in a memory 89 for a period (delay) of one or two frames as required by frames $B_1$ and $B_2$ respectively (see FIG. 3). The stored motion vectors are supplied by the Fmv Memory 89 to an Area Overlap Motion Vector Calculator 90 where forward and backward motion vectors AO FMv and AO BMv are calculated for B frame motion blocks in a manner described by reference to FIGS. 4 through 10. As previously explained, a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

Thus, in Lynch, whatever prediction went into $P_3$ happened before Fig. 14, and involved no "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 21.

Finally, the Examiner asserts at page 2, lines 19-21 of the final Office Action that,

"Also, Lynch's fig. 5 discloses that a frame with the shaded area of interest has, for instance, four blocks that are obtained, utilized for predicting a motion vector."

This is submitted to be incorrect. Fig. 5, rather, depicts using the degree of overlap of a projected motion vector to estimate the accuracy of the projection. In particular, as described at column 4, lines 60-68, continuing at column 5, lines 14 of Lynch,

> "By way of example, suppose we wish to find the area of overlap of the projection of the motion block in the upper left corner of the $P_3$ frame of FIG. 4 with the motion block at j=1, i=2 of the $B_1$ frame. As shown in FIG. 5, L1=16 pixels and L2=8 pixels. By observation, the width of the overlap is 12 pixels and its height is 6, so that the desired area is 12 X 6=72 pixels. If the defined relationship is that the reference point is the top left corner of a block, then u=12 and v=18 and x=16 and y=16 so that the area of overlap in accordance with the formula is:
> AO = [16-|16-12|][8-|16-18|] = [16-4][8-2] = 12 X 6 = 72
> As illustrated by the flow charts of FIGS. 6 through 10 for calculating the areas of overlap AO, the areas of overlap in each of the blocks of a B frame are derived for each motion block in a P frame and the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap."

Thus, in Lynch, the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap. Therefore, the magnitude of the overlap is assessed *after* the projection. Any prediction to be performed in Fig. 5 has already occurred, and now the accuracy of a projection of is being assessed. None of the four blocks

will be used to predict anything, let alone motion. This is to be contrasted with independent claim 21, which recites, "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner, in fact, acknowledges at page 2, line 23, continuing at page 3, line1 of the final Office Action that Lynch,

"does not disclose the prediction of a motion vector values of blocks adjacent to the target block of the same frame."

The Examiner seeks to compensate for this deficiency of Lynch by combining Lynch with Yagasaki. Yagasaki, however, neither teaches, discloses, nor suggests "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block" either, and thus cannot compensate for the deficiencies of Lynch with respect to independent claim 21.

The Examiner asserts at page 3, lines 1-3 of the final Office Action that,

"Yagasaki teaches the motion vectors of adjacent blocks to the target block in the same frame are implemented for obtaining a predicted motion vector, as disclosed at col. 18, ln. 1-13."

This is submitted to be incorrect. Yagasaki is talking about differential encoding for transmitting motion vectors at column 18, lines 1-13, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 21. Whatever predictions are to be done in Yagasaki have already been done. All Yagasaki is doing now is encoding the results. In particular, as described at column 18, lines 6-12 of Yagasaki,

> "An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0."

Thus, the motion vector values have already been produced. The adjacent blocks to which Yagasaki refers are adjacent blocks of data to be transmitted, not "a plurality of blocks adjacent to the target block," as recited in independent claim 21. Yagasaki, rather, is preserving bandwidth by transmitting only the changes to the motion vectors relative to those around them, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 21.

In particular, the only prediction discussed in Yagasaki relates to interframe predictive coding with motion compensation, such as at column 1, lines 31-42, not "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 21,

> "Inter-frame predictive coding using correlation between frames is one known technique for highly efficient coding of a moving picture signal. In particular, inter-frame predictive coding with motion compensation is known, as in the MPEG document referred to above.
>
> "Motion compensated predictive coding uses correlation over time within the picture signal. A difference signal is formed for a present frame with respect to a past frame, after compensating for motion in the picture between the two frames."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 21, independent claim 21 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 21 be withdrawn.

**Second**, independent claim 21 is patentable over Lynch in view of Yagasaki because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Here, the Examiner has pointed to no evidence, either in the references or the general knowledge of the prior art, of a suggestion or motivation to combine the references in the proposed manner. The broad conclusory statement by the Examiner at page 7, lines 4-8 of the final Office Action that,

> "it would have been obvious to one of ordinary skill to combine the teachings of Lynch and Yagasaki as a whole for accurately predicting motion vectors so as to efficiently produce clear, precise images for viewing and saving costs,"

in particular, is not "evidence" of a suggestion or motivation to combine the references as required for a finding of obviousness.

Lynch, rather, is complete in itself. There would thus have been no reason for persons of ordinary skill in the art at the time the invention was made to look to Yagasaki to make up for any deficiency of Lynch. Simply put, there would have been no need to look to Yagasaki to produce clear, precise images for viewing and saving costs any more efficiently than Lynch already had.

Furthermore, Lynch teaches away from the combination proposed by the Examiner at column 2, lines 39-54, when he describes differential pulse code modulation systems, for example, as requiring the transmission of a significant amount of residue in most cases,

> "In article 4, which is incorporated herein by reference, a differential pulse code modulation system is described that is like the IS system described above except for the fact that the motion vectors for the B frames are derived from motion vectors such as $mv_{30}$ or $mv_{63}$ of FIG. 2 that indicate the relative position of a block in an anchor frame that matches a block in the next anchor frame. The motion vector selected for a motion block in a B frame is the motion vector for a block in the later anchor frame that is in the same spatial position. If linear motion is assumed, a motion vector $mv_{20}$ (i, j) would equal $2/3mv_{30}$ (i, j) and $mv_{23}$ (i, j) would equal $-1/3mv_{30}$ (i, j). While this method has the advantage of not transmitting motion vectors for the B frames, the motion vectors that are used require the transmission of a significant amount of residue in most cases. "

Transmitting residues, on the other hand, is exactly what Yagasaki is doing, as described in the Abstract,

> "In connection with compression-coding of video signals on the basis of inter-frame correlation, a single reference table is used for variable length encoding of inter-frame motion vectors established on the basis of various motion vector value ranges and degrees of accuracy. A reference table is provided for variable length encoding motion vectors based on a particular value range and degree of accuracy. In order to use the same table for motion vectors based on a larger value range than that for which the table was designed, the value of a motion vector to be encoded is divided to form a quotient and a remainder. An addition bit code is formed on the basis of the remainder and is appended to a variable length code which corresponds in the reference table to the quotient so that a variable length code value is formed for the motion vector based on the larger range."

Thus, Yagasaki is going to transmit the residues, he just seeks to code the residues efficiently, using variable length codes in which longer code words represent lower accuracy, i.e. larger residues. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would have been deterred, rather than encouraged, from the modification proposed in the final Office Action, since Lynch teaches away from encoding residues at all. Consequently, the Examiner has failed to set forth a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Appellants, therefore, respectfully request that the rejection of independent claim 21 be withdrawn.

**Third**, independent claim 21, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 21. Neither Lynch nor Yagasaki, for example, disclose

"determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 21.

The Examiner asserts at page 3, lines 18-23, continuing at page 4, lines 1 and 2,

"As previously stated, col. 11, ln. 18-22 and fig.17, note "MODE" is determined and motion vector calculator 111 determines the prediction accuracy based on non-uniformity of the plural motion vectors."

This is submitted to be incorrect. As shown in Fig. 17, only one lead, and hence one input, enters AO Mv Calculator 111. Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 21.

Furthermore, the Area Overlap (AO) method depicted in Fig. 17 is described in Lynch at column 11, lines 5-22 as deriving motion vectors for B frames from motion vectors for an anchor frame that is referenced to a previous anchor frame, in the singular. Each motion vector is derived from a single anchor frame, not "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 21. The motion vectors themselves are input singly to AO Mv Calculator 111, as is apparent from the single input lead. In particular, as described in Lynch at column 11, lines 5-22,

> "A decoder for the AO method is shown in FIG. 17 in which components corresponding to those of FIG. 13 are designated in the same way. In view of the fact that motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame, blocks 110 and 111 are used by the decoder for this purpose. These are identical to blocks 89 and 90 in FIG. 14. The mode information instructs the displacement blocks 104 and 105 as well as switch 107 as to the prediction mode to be used for B frame motion blocks. Otherwise, the operation of this decoder is identical to that of the decoder for the IS method."

Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 21.

Yagasaki, for its part, describes no motion vectors at all, let alone "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 21. Yagasaki, rather, is discussing encoding motion vectors at column 18, lines 1-13, not "determining accuracy of a prediction

made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 21, contrary to the assertion in the final Office Action at page 3, lines 1-3. In particular, as described in Yagasaki at column 18, lines 1-13,

> "Finally, there will be described an embodiment of the present invention in which motion vector values are encoded with differential PCM (DPCM), so that the data transmitted with respect to motion vector values represents only the differences between motion vector values for adjacent blocks. An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0. The difference values are then variable length encoded in a motion vector VLC."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 21, independent claim 21 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 21 be withdrawn.

F. Independent Claim 22

**First**, independent claim 22, and the claim dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 22. Neither Lynch nor Yagasaki, for example, disclose "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 22.

The Examiner asserts at page 2, lines 12-16 of the final Office Action:

"Lynch discloses the predicting meant for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block, as disclosed in fig.17 and col. 10, ln. 23, to col. 11, ln. 4, where the "PREDICTION" or the prediction of the motion vector is predicatively done."

This is submitted to be incorrect. Lynch, rather, extrapolates motion vectors for a particular B Block from that B block only, as described at column 10, lines 42, 43, and 44,

> "a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

The passage in Lynch cited in the final Office Action, to the contrary, mentions nothing about "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 22.

Fig. 17, for its part, shows a decoder for the AO method, not "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 22. Lynch, in fact, describes deriving motion vectors for B frames from motion vectors for *an* anchor frame that is referenced to *a* previous anchor frame, in the description pertaining to Fig. 17 at column 11, lines 13-16,

> "motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame."

Thus, Lynch derives a motion vector for a B frame from a single anchor frame that is referenced to a previous anchor frame. This is to be contrasted with independent claim 22, which recites "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner asserts further at page 2, lines 16-19 of the final Office Action:

"that fig. 14 shows that the target block motion vector was predicted for accurately predicting the image data, especially in the MPEG interframe encoding/decoding environment when obtaining the motion vector between a current frame and a reference frame."

This is submitted to be incorrect. Lynch describes Fig. 14, rather, at column 10, lines 31-46 as showing interpolation of B frames *from* a predicted frame such as $P_3$, not "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 22. In particular, as described in Lynch at column 10, lines 31-46,

> "FIG. 14 is a block diagram for an encoder incorporating this invention. Those components corresponding to components in FIG. 11 are designated in the same way. Forward motion vectors for $P_3$, such as $mv_{30}$, are stored in a memory 89 for a period (delay) of one or two frames as required by frames $B_1$ and $B_2$ respectively (see FIG. 3). The stored motion vectors are supplied by the Fmv Memory 89 to an Area Overlap Motion Vector Calculator 90 where forward and backward motion vectors AO FMv and AO BMv are calculated for B frame motion blocks in a manner described by reference to FIGS. 4 through 10. As previously explained, a backward motion vector for a $B_1$ block=-2/3 of motion vector $mv_{30}$, and the

> forward motion vector is 1/3 $mv_{30}$. These motion vectors are supplied to the motion compensator 68 via a lead M'."

Thus, in Lynch, whatever prediction went into $P_3$ happened before Fig. 14, and involved no "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 22.

Finally, the Examiner asserts at page 2, lines 19-21 of the final Office Action that,

"Also, Lynch's fig. 5 discloses that a frame with the shaded area of interest has, for instance, four blocks that are obtained, utilized for predicting a motion vector."

This is submitted to be incorrect. Fig. 5, rather, depicts using the degree of overlap of a projected motion vector to estimate the accuracy of the projection. In particular, as described at column 4, lines 60-68, continuing at column 5, lines 14 of Lynch,

> "By way of example, suppose we wish to find the area of overlap of the projection of the motion block in the upper left corner of the $P_3$ frame of FIG. 4 with the motion block at j=1, i=2 of the $B_1$ frame. As shown in FIG. 5, L1=16 pixels and L2=8 pixels. By observation, the width of the overlap is 12 pixels and its height is 6, so that the desired area is 12 X 6=72 pixels. If the defined relationship is that the reference point is the top left corner of a block, then u=12 and v=18 and x=16 and y=16 so that the area of overlap in accordance with the formula is:
> AO = [16-|16-12|][8-|16-18|] = [16-4][8-2] = 12 X 6 = 72
> As illustrated by the flow charts of FIGS. 6 through 10 for calculating the areas of overlap AO, the areas of overlap in each of the blocks of a B frame are derived for each motion block in a P frame and the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap."

Thus, in Lynch, the vector for the block in the B frame is derived from the vector of the motion block in the P frame whose projection has the most overlap. Therefore, the magnitude of the overlap is assessed *after* the projection. Any prediction to be performed in Fig. 5 has already occurred, and now the accuracy of a projection of is being assessed. None of the four blocks will be used to predict anything, let alone motion. This is to be contrasted with independent claim 22, which recites, "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block."

The Examiner, in fact, acknowledges at page 2, line 23, continuing at page 3, line1 of the final Office Action that Lynch,

"does not disclose the prediction of a motion vector values of blocks adjacent to the target block of the same frame."

The Examiner seeks to compensate for this deficiency of Lynch by combining Lynch with Yagasaki. Yagasaki, however, neither teaches, discloses, nor suggests "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block " either, and thus cannot compensate for the deficiencies of Lynch with respect to independent claim 22.

The Examiner asserts at page 3, lines 1-3 of the final Office Action that,

"Yagasaki teaches the motion vectors of adjacent blocks to the target block in the same frame are implemented for obtaining a predicted motion vector, as disclosed at col. 18, ln. 1-13."

This is submitted to be incorrect. Yagasaki is talking about differential encoding for transmitting motion vectors at column 18, lines 1-13, not "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 22. Whatever predictions are to be done in Yagasaki have already been done. All Yagasaki is doing now is encoding the results. In particular, as described at column 18, lines 6-12 of Yagasaki,

> "An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0."

Thus, the motion vector values have already been produced. The adjacent blocks to which Yagasaki refers are adjacent blocks of data to be transmitted, not "a plurality of blocks adjacent to the target block," as recited in independent claim 22. Yagasaki, rather, is preserving bandwidth by transmitting only the changes to the motion vectors relative to those around them, not "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 22.

In particular, the only prediction discussed in Yagasaki relates to interframe predictive coding with motion compensation, such as at column 1, lines 31-42, not "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block," as recited in independent claim 22,

> "Inter-frame predictive coding using correlation between frames is one known technique for highly efficient coding of a moving picture signal. In particular, inter-frame predictive coding with motion compensation is known, as in the MPEG document referred to above.

> "Motion compensated predictive coding uses correlation over time within the picture signal. A difference signal is formed for a present frame with respect to a past frame, after compensating for motion in the picture between the two frames."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 22, independent claim 22 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 22 be withdrawn.

**Second**, independent claim 22, and the claim dependent thereon, are patentable over Lynch in view of Yagasaki because the Examiner has not made out a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Here, the Examiner has pointed to no evidence, either in the references or the general knowledge of the prior art, of a suggestion or motivation to combine the references in the proposed manner. The broad conclusory statement by the Examiner at page 7, lines 4-8 of the final Office Action that,

"it would have been obvious to one of ordinary skill to combine the teachings of Lynch and Yagasaki as a whole for accurately predicting motion vectors so as to efficiently produce clear, precise images for viewing and saving costs,"

in particular, is not "evidence" of a suggestion or motivation to combine the references as required for a finding of obviousness.

Lynch, rather, is complete in itself. There would thus have been no reason for persons of ordinary skill in the art at the time the invention was made to look to Yagasaki to make up for any deficiency of Lynch. Simply put, there would have been no need to look to Yagasaki to produce clear, precise images for viewing and saving costs any more efficiently than Lynch already had.

Furthermore, Lynch teaches away from the combination proposed by the Examiner at column 2, lines 39-54, when he describes differential pulse code modulation systems, for example, as requiring the transmission of a significant amount of residue in most cases,

> "In article 4, which is incorporated herein by reference, a differential pulse code modulation system is described that is like the IS system described above except for the fact that the motion vectors for the B frames are derived from motion vectors such as $mv_{30}$ or $mv_{63}$ of FIG. 2 that indicate the relative position of a block in an anchor frame that matches a block in the next anchor frame. The motion

> vector selected for a motion block in a B frame is the motion vector for a block in the later anchor frame that is in the same spatial position. If linear motion is assumed, a motion vector $mv_{20}$ (i, j) would equal $2/3mv_{30}$ (i, j) and $mv_{23}$ (i, j) would equal $-1/3mv_{30}$ (i, j). While this method has the advantage of not transmitting motion vectors for the B frames, the motion vectors that are used require the transmission of a significant amount of residue in most cases. "

Transmitting residues, on the other hand, is exactly what Yagasaki is doing, as described in the Abstract,

> "In connection with compression-coding of video signals on the basis of inter-frame correlation, a single reference table is used for variable length encoding of inter-frame motion vectors established on the basis of various motion vector value ranges and degrees of accuracy. A reference table is provided for variable length encoding motion vectors based on a particular value range and degree of accuracy. In order to use the same table for motion vectors based on a larger value range than that for which the table was designed, the value of a motion vector to be encoded is divided to form a quotient and a remainder. An addition bit code is formed on the basis of the remainder and is appended to a variable length code which corresponds in the reference table to the quotient so that a variable length code value is formed for the motion vector based on the larger range."

Thus, Yagasaki is going to transmit the residues, he just seeks to code the residues efficiently, using variable length codes in which longer code words represent lower accuracy, i.e. larger residues. It is submitted, therefore, that persons of ordinary skill in the art at the time the invention was made would have been deterred, rather than encouraged, from the modification proposed in the final Office Action, since Lynch teaches away from encoding residues at all. Consequently, the Examiner has failed to set forth a prima facie case of obviousness with respect to the combination of Lynch in view of Yagasaki proposed by the Examiner. Appellants, therefore, respectfully request that the rejection of independent claim 22 be withdrawn.

**Third**, independent claim 22, and the claims dependent thereon, are patentable over Lynch in view of Yagasaki because neither Lynch and Yagasaki, or their combination, disclose all of the features of independent claim 22. Neither Lynch nor Yagasaki, for example, disclose "determining accuracy of a prediction based on the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold," as recited in independent claim 22.

The Examiner asserts at page 3, lines 18-23, continuing at page 4, lines 1 and 2,

"As previously stated, col. 11, ln. 18-22 and fig.17, note "MODE" is determined and motion vector calculator 111 determines the prediction accuracy based on non-uniformity of the plural motion vectors."

This is submitted to be incorrect. As shown in Fig. 17, only one lead, and hence one input, enters AO Mv Calculator 111. Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors," as recited in independent claim 22.

Furthermore, the Area Overlap (AO) method depicted in Fig. 17 is described in Lynch at column 11, lines 5-22 as deriving motion vectors for B frames from motion vectors for an anchor frame that is referenced to a previous anchor frame, in the singular. Each motion vector is derived from a single anchor frame, not "determining accuracy of a prediction based on the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold," as recited in independent claim 22. The motion vectors themselves are input singly to AO Mv Calculator 111, as is apparent from the single input lead. In particular, as described in Lynch at column 11, lines 5-22,

> "A decoder for the AO method is shown in FIG. 17 in which components corresponding to those of FIG. 13 are designated in the same way. In view of the fact that motion vectors for B frames can also be derived in accordance with this invention from motion vectors for an anchor frame that is referenced to a previous anchor frame, blocks 110 and 111 are used by the decoder for this purpose. These are identical to blocks 89 and 90 in FIG. 14. The mode information instructs the displacement blocks 104 and 105 as well as switch 107 as to the prediction mode to be used for B frame motion blocks. Otherwise, the operation of this decoder is identical to that of the decoder for the IS method."

Thus, AO Mv Calculator 111 uses but one motion vector at a time, rather than "determining accuracy of a prediction based on the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold," as recited in independent claim 22.

Yagasaki, for its part, describes no motion vectors at all, let alone "determining accuracy of a prediction based on the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold," as recited in independent claim 22. Yagasaki, rather, is discussing encoding motion vectors at column 18, lines 1-13, not "determining accuracy of a prediction based on the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold," as recited in

independent claim 22, contrary to the assertion in the final Office Action at page 3, lines 1-3. In particular, as described in Yagasaki at column 18, lines 1-13,

> "Finally, there will be described an embodiment of the present invention in which motion vector values are encoded with differential PCM (DPCM), so that the data transmitted with respect to motion vector values represents only the differences between motion vector values for adjacent blocks. An encoder according to this embodiment takes advantage of the strong spatial correlation of the motion vector values and forms difference values representing differences between motion vectors in adjacent blocks so that the resulting difference values are concentrated around 0. The difference values are then variable length encoded in a motion vector VLC."

Since neither Lynch nor Yagasaki teach, disclose, or suggest "determining accuracy of a prediction based on the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold," their combination cannot either. Thus, even if Lynch and Yagasaki were combined as proposed by the Examiner, the claimed invention would not result. Accordingly, because neither Lynch nor Yagasaki, nor their combination, disclose all of the features of independent claim 22, independent claim 22 is patentable over Lynch in view of Yagasaki. Appellants, therefore, respectfully request that the rejection of independent claim 22 be withdrawn.

For the forgoing reasons, Appellants respectfully request that the Board reverse the outstanding rejections of the claims of this application.

## CONTINGENT AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT AND CONTINGENT PETITION FOR EXTENSION OF TIME

Unless a check for the present Brief on Appeal is submitted herewith for the fee required under 37 C.F.R. § 41.20(b)(2), please charge said fee to Deposit Account No. 19-3935.

Appellants hereby petition for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 19-3935.

If any further fees, other than and except for the issue fee, are necessary with respect to this paper, the U.S.P.T.O. is requested to obtain the same from deposit account number 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 30 NOV 05

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## VIII. CLAIMS APPENDIX

11. (previously presented) A motion vector decoding device for decoding an encoding result which is obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, comprising:

predicting means for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block;

determining means for determining accuracy of a prediction made by said predicting means based on degrees of non-uniformity of the plurality of motion vectors; and

decoding means for decoding the motion vector of the target block by using a result of the prediction made by said predicting means with a decoding method determined based on a result of a determination made by said determining means.

12. (previously presented) A motion vector decoding device for decoding an output of a motion vector encoding device which predicts a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block within the frame, determines accuracy of a prediction based on degrees of non-uniformity of a plurality of motion vectors which have already been encoded in an area adjacent to the target block, and encodes the motion vector of the target block by using a result of the prediction with an encoding method determined based on a result of a determination of the accuracy of the prediction, in order to encode motion vectors of respective blocks obtained by partitioning each frame of moving image data, comprising:

predicting means for predicting the motion vector of the target block within the frame based on the plurality of motion vectors of the at least two of the plurality of blocks adjacent to the target block used to make the determination within the motion vector encoding device;

determining means for determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold; and

decoding means for decoding the motion vector of the target block by using a result of the prediction made by said predicting means with a decoding method determined based on a result of a determination made by said determining means.

13. (previously presented) A motion vector decoding method for decoding a result of encoding obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, comprising the steps of:

predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block;

determining accuracy of a prediction based on degrees of non-uniformity of the plurality of motion vectors; and

decoding the motion vector of the target block by using a result of the prediction with a decoding method determined based on a result of a determination of the accuracy of the prediction.

14. (previously presented) The motion vector decoding device according to claim 11, wherein said determining means determines the accuracy of the prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors which have already been decoded in an area adjacent to the target block.

15. (previously presented) The motion vector decoding device according to claim 12, wherein said determining means determines the accuracy of the prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors which have already been decoded in an area adjacent to the target block.

16. (previously presented) The motion vector decoding device according to claim 13, wherein said determining means determines the accuracy of the prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors which have already been decoded in an area adjacent to the target block.

17. (previously presented) The motion vector decoding device according to claim 11, wherein said encoding means comprises:

a plurality of individual decoding means for decoding the motion vector of the target block with unique decoding methods; and

selecting means for selecting one of said plurality of individual decoding means based on the result of the determination made by said determining means, and for outputting a result of decoding performed by the selected individual decoding means.

18. (previously presented) The motion vector decoding device according to claim 12, wherein said encoding means comprises:

a plurality of individual decoding means for decoding the motion vector of the target block with unique decoding methods; and

selecting means for selecting one of said plurality of individual decoding means based on the result of the determination made by said determining means, and for outputting a result of decoding performed by the selected individual decoding means.

19. (previously presented) The motion vector decoding device according to claim 13, wherein said encoding means comprises:

a plurality of individual decoding means for decoding the motion vector of the target block with unique decoding methods; and

selecting means for selecting one of said plurality of individual decoding means based on the result of the determination made by said determining means, and for outputting a result of decoding performed by the selected individual decoding means.

20. (previously presented) A motion vector decoding device for decoding an output of a motion vector encoding device which predicts a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block, determines accuracy of a prediction based on a plurality of motion vectors which have already been encoded in an area adjacent to the target block, and encodes the motion vector of the target block by using a result of the prediction with an encoding method determined based on a result of a determination of the accuracy of the prediction, in order to encode motion vectors of respective blocks obtained by partitioning each frame of moving image data, comprising:

predicting means for predicting the motion vector of the target block based on the plurality of motion vectors used to make the determination within the motion vector encoding device;

determining means for determining accuracy of a prediction made by said predicting means based on the degrees of non-uniformity of the plurality of motion vectors; and

decoding means for decoding the motion vector of the target block by using a result of the prediction made by said predicting means with a decoding method determined based on a result of a determination made by said determining means.

21. (previously presented) A motion vector decoding device for decoding an encoding result which is obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, comprising:

predicting means for predicting a motion vector of a target block based on motion vectors of a plurality of blocks adjacent to the target block;

determining means for determining accuracy of a prediction made by said predicting means based on the plurality of motion vectors; and

decoding means for decoding the motion vector of the target block by using a result of the prediction made by said predicting means with a decoding method determined based on a result of a determination made by said determining means.

22. (previously presented) A motion vector decoding method for decoding a result of encoding obtained by encoding motion vectors of respective blocks obtained by partitioning each frame of moving image data, comprising:

predicting a motion vector of a target block within a frame based on motion vectors of a plurality of blocks adjacent to the target block within the frame;

determining accuracy of a prediction based on the plurality of motion vectors by determining whether differences between any of the vectors is greater than a threshold; and

decoding the motion vector of the target block by using a result of the prediction with a decoding method determined based on a result of a determination of the accuracy of the prediction.

23. (previously presented) A method as recited in claim 22, wherein the motion vectors comprise first, second and third motion vectors said determining comprises:

determining a first absolute value of difference between the first and second motion vectors, determining a second absolute value of difference between the second and third motion vectors, and determining a third absolute value of difference between the first and third motion vectors;

comparing the first absolute value to the threshold, comparing the second absolute value to the threshold and comparing the third absolute value to the threshold; and

indicating that the prediction is not accurate when any of the first, second and third absolute values are greater than the threshold.

## IX. EVIDENCE APPENDIX

Not applicable.

## X. RELATED PROCEEDINGS APPENDIX

Not applicable.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6321211
Issue Date: November 20,2001
Application No. 09348198
Filed: July 6,1999
Attorney Docket No. 1237/17 (Previously 07734

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed May 21,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of May 21,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,321,211 | 2001-11-20 | 09/348,198 | 1999-07-06 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | | Small Entity | | |
|---|---|---|---|---|---|
| | Fee | Code | | Fee | Code |
| ○ | 3 ½ year | (1551) | ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (1552) | ◉ | 7 ½ year | (2552) |
| ○ | 11 ½ year | (1553) | ○ | 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /C. Scott Talbot/ | Date (YYYY-MM-DD) | 2010-05-21 |
| Name | C. Scott Talbot | Registration Number | 34262 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6453569 | 2004-09-24 | 09348211 | 1999-07-08 | A32581 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

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☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ◉ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /David Schalk/ | Date (YYYY-MM-DD) | 2007-09-04 |
| Name | David Schalk | Registration Number | 60527 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Approved for use through 04/30/2009. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6453569 | 2002-09-24 | 09348211 | 1999-07-08 | 071382.0169 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ◉ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /David W. Schalk/ | Date (YYYY-MM-DD) | 2007-10-31 |
| Name | David W. Schalk | Registration Number | 60527 |

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

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# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6453569
Issue Date: September 24,2002
Application No. 09348211
Filed: July 8,1999
Attorney Docket No. A32581

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed October 31,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 31,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
DIW 04-02

Paper No. 11

MORLAND C. FISHER, ESQ.
2030 MAIN STREET
SUITE 1050
IRVINE, CA 92614

| | | |
|---|---|---|
| In re Application of<br>Pieroni et al.<br>Application No. 09/348,320<br>Filed: July 7, 1999<br>Attorney Docket No.CHMP-102 | :<br>:<br>:<br>:<br>: | ON PETITION |

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile on March 22, 2002, to revive the above-identified application.[1]

The petition is **GRANTED**.

A final Office Action was mailed on August 14, 2001, setting forth a 3-month shortened statutory reply period. A proposed amendment, timely filed on February 4, 2002[2] ("2/4/02 proposed amendment"), did not place the application in condition for allowance and was not entered.[3] The application thus became abandoned on November 15, 2001.[4] The petition precedes the mailing of a notice of abandonment.

The instant petition encloses an RCE and the requisite "submission" as reply to the August 14, 2001 final Office Action;[5] an authorization to charge the $370 RCE filing fee (small entity) and

---

1 The instant petition had been filed concurrently with a petition under 37 CFR 1.137(a), which was withdrawn on 4/29/02 in accordance with counsel's instruction via facsimile.

2 Certificate of Mailing date 10/25/01.

3 As pointed out in the 2/15/02 Advisory Action letter, the period for reply to the 8/14/01 final Office Action expires 3 months from the mailing date of that letter, i.e., 11/14/01, unless an extension of time under 37 CFR 1.136(a) is obtained.

4 Abandonment may result where applicant's reply is timely but is not fully responsive to the Office action; see MPEP section 711.02(a) (Aug. 2001); also 37 CFR 1.135 & MPEP 711.04(a) (Aug. 2001): "[T]he date of abandonment is after midnight of the date on which the set shortened statutory period, including any [obtained] extensions under 37 CFR 1.136, expired."

5 The "required reply" under 37 CFR 1.137(b)(1) for reviving an application abandoned due to failure to timely and properly respond to a final Office action, as is in the instant case, must be the filing of: (1) a continuing application under 37 CFR 1.53(b); (2) a request for continued examination (RCE) by filing a submission under 37 CFR 1.114 (for utility or plant applications filed on or after 6/8/95); (3) a notice

the $640 petition fee (small entity) to Deposit Account No. 08-1310; and a statement that the entire delay in filing the required reply from its due date until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The petition is thus granted.

The Office also acknowledges receipt on February 19, 2002 of an assignment document for recordation.[6]

The application is being forwarded to Technology Center 2800 for review of the "submission" accompanying the RCE filed with the petition.[7]

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

of appeal; or, (4) a proper amendment, i.e., an amendment that *prima facie* places the application in condition for allowance. Since no claims stand allowed under the 8/14/01 final Office Action, an amendment canceling all rejected claims would not be a proper form of reply for the instant application. See MPEP 711.03(c)(III)(A)(2)(b) (Aug. 2001).

Applicants are utilizing the 2/4/02 proposed amendment as the "submission" required under 37 CFR 1.114; see MPEP section 706.07(h)(II) (Aug. 2001) (A previously filed amendment after final, whether or not entered, may satisfy this "submission" requirement).

[6] Only 1 assignment was recorded in the PTO on that date, which requires a $40 fee. A $80 payment is shown. The overpayment of $40 has been credited to Deposit Account No. 08-1310 as also authorized in the instant petition.

[7] See *supra* note 5, last paragraph.

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 23

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JUN 19 2003

OFFICE OF PETITIONS

WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD CT 06905

In re Application of
Jay S. Walker et al.
Application No. 09/348,566
Filed: July 7, 1999
Attorney Docket No. WD2-98-120

ON PETITION
PETITION

This is a decision on the petition under 37 CFR 1.78(a)(3), filed April 23, 2003 (certificate of mail date), to accept an unintentionally delayed claim under 35 USC § 120 for the benefit of a prior filed application.

The petition is **DISMISSED AS MOOT**.

The instant application was filed on July 7, 1999. A petition for a acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. See 65 FR 57024 (Sept. 20, 2000). Therefore, the petition is dismissed as involving a moot issue.

In view of the above, the no fees are due and none have been charged for the petition under 37 CFR 1.78(a)(3).

Any inquiries concerning this decision on petition may be directed to Senior Petitions Attorney Patricia Faison-Ball in the Office of Petitions at (703) 305-4497.

The application is being forwarded to Technology Center 3600 for consideration of the RCE, amendment and request for three month extension of time, filed April 23 (certificate of mail date) in response to the final office action mailed October 23, 2002.

Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

STEVENS, DAVIS, MILLER & MOSHER, LLP
ATTEN: NOREEN O. WELCH ESQUIRE
1615 L STREET NW
SUITE 850
WASHINGTON, DC 20036

MAILED

SEP 19 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

| | | |
|---|---|---|
| In re Application of | : | |
| William R. Van Etten et al. | : | |
| Serial No. 09/348,693 | : | DECISION ON PETITION |
| Filed July 7, 1999 | : | TO WITHDRAW THE FINALITY |
| For: INFORMATION TRANSLATION | : | OF AN OFFICER ACTION |
| COMMUNICATION PROTOCOL | : | UNDER 37 CFR 1.181 |

This is a decision on the Petition under 37 CFR 1.181 filed August 29, 2002 to withdraw the finality of an Office action.

The petition is GRANTED to the extent indicated below.

A review of the file history reveals that on July 29, 2002 the Office issued a Final rejection. In the Final rejection, the examiner rejected claims 1-3, 8-10, 11-16 and 17-26 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,740,425 to Povilus (hereinafter '425) in view of the U.S. patent 5,570,291 to Dudle et al (hereinafter '291).

The file history shows that a first Office action was mailed out on February 14, 2002. In that action, the examiner rejected claim 9 under 35 U.S.C. 112; rejected claims 1-3, 8-10 and 17-26 under 35 U.S.C. 102(b) as being clearly anticipated by the '425 reference; and rejected claims 4-6 under 35 U.S.C. 103(a) as being unpatentable over the '425 in view of the '291 reference, and further in view of U.S. patent 6,338,050 to Conklin et al. Applicant has not amended the claims in response to the art rejections of the first Office action rejection mailed February 12, 2002.

Thus, the final rejection of claims 1-3, 8-10, 11-16 and 17-26 under 35 U.S.C. 103(a) as being unpatentable over the '425 reference in view of the '291 reference constitutes a new ground of rejection that has not been necessitated by amendment. Accordingly, it is agreed that the finality of the July 23, 2001 Office action was premature.

The application is being forwarded to the Supervisory Legal Instrument Examiner to withdraw the finality of the July 29, 2002 Office action (but not the Office action itself). Please note that the period for response continues to run THREE MONTHS from the date of the July 29, 2002 Office action.

Inquiries related to this decision may be directed to Supervisory Patent Examiner Wynn Coggins at (703) 308-1344.

John J. Love, Director
Patent Technology Center 3600
(703) 308-1020
FAX (703) 306-4597

WC/SM: 09/16/02
SM

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6240809
Issue Date: June 5,2001
Application No. 09348945
Filed: July 7,1999
Attorney Docket No.

:

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

:

This is a decision on the electronic petition, filed June 4,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 4,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

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# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6240809 | 2001-06-05 | 09/348,945 | 1999-07-07 | Sasarak-1 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
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SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

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○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Walter J. Tencza Jr./ | Date (YYYY-MM-DD) | 2007-06-04 |
| Name | Walter J. Tencza Jr. | Registration Number | 35708 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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AMB 05-02

Paper No. 8

C/O BRISTOL MYERS SQUIBB COMPANY
100 HEADQUARTERS PARK DRIVE
SKILLMAN, NJ 08558

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MAY 21 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of<br>Gent, et al.<br>Application No. 09/348,954<br>Filed: July 7, 1999<br>Attorney Docket No. C-309<br>For: IMPROVEMENTS RELATING TO<br>POUCHES FOR COLLECTING MATTER<br>EXCRETED BY THE BODY | : | PETITION |

This is a decision on the petition renewed under 37 CFR 1.137(b), filed April 11, 2002, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned July 3, 2001 for failure to timely file a proper response to the non-final Office action mailed April 2, 2001. The non-final Office action set a three (3) month non-statutory period for reply. No extensions of time in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed November 9, 2001.

There is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation and change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to petitioner, however, all future correspondence will be directed to the address of record unless the Office is notified otherwise in writing.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. The statement, nevertheless, is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. *See,* 37 CFR 10.18(b). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

This application is being forwarded to Technology Center 3700 for review of the amendment submitted herewith.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

CC: ARTHUR E. JACKSON
DECHERT
1717 ARCH STREET
PHILADELPHIA, PA 19103

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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SEP 28 2006
OFFICE OF PETITIONS

Zhongdu Liu
2-3-3 JiaXing Tower, C-2 NanFang Garden
Shi Qiao Pu District
ChongQing 40004-1 CN CHINA

| | | |
|---|---|---|
| In re Patent No. | : | |
| 6,603,221 | : | |
| Application No. 09/348,980 | : | DECISION GRANTING PETITION |
| Filing Date: July 7, 1999 | : | |
| Issue Date: August 5, 2003 | : | |
| Attorney Docket No. M-6043-US | : | |

This is a decision on the petition under 37 CFR 1.182, filed January 20, 2004, requesting issuance of duplicate Letters of Patent for the above-identified patent.

The petition is **granted.**

The file record discloses that the above-cited application matured into U.S. Patent No. 6,603,221 on August 5, 2003.

In view of the facts set forth in the petition, it is concluded that the patent was never received at the correspondence address of record. The Publishing Division is directed to issue duplicate Letters of Patent.

Any questions concerning this decision may be directed to the undersigned at (571)272-3222. Any questions concerning issuance of the duplicate Letter of Patent should be directed to Krystal Paige at (703) 308-9250, extension 139.

A copy of this decision is being forwarded to the Publishing Division for issuance of a duplicate Letter of Patent.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc: Krystal Paige, P/OPPD/ST 8C32, (Fax 571-273-9756)

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 16

MANATT PHELPS & PHILLIPS
11355 WEST OLYMPIC BLVD
LOS ANGELES, CA 90064

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MAY 01 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hiroshi Murakami et al | : | |
| Application No. 09/349,423 | : | ON PETITION |
| Filed: July 7, 1999 | : | |
| Attorney Docket No. 22845-039 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed February 6, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 28, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 29, 2001.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Technology Center AU 2166.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

#25

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FEB 04 2004

Office of the Director
Group 3600

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

In re application of
Hiroshi Murakami, et al.
Application No. 09/349,423
Filed: July 7, 1999
For: SHARED VEHICLE SYSTEM AND METHOD INVOLVING RESERVING VEHICLES WITH HIGHEST STATES OF CHARGE

**DECISION ON REQUEST FOR WITHDRAWAL OF ATTORNEY**

This is a decision on the request filed on November 17, 2003, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED.**

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney in the above-identified application is not approved under Item A) above because the attorney making the request, and several of the attorneys listed as withdrawing in the request, do not now have, and apparently never have had, power of attorney in this application.

There is no record of power of attorney ever being given to the attorney making the request. The original declaration does not include a power of attorney for the requesting attorney, Ziye J. Zhou, nor does it include a power of attorney to Robert D. Becker, Bruce J. McCubbrey and Jinntung Su, and no separate paper conferring power of attorney to these attorneys was filed. A paper filed March 23, 2001 from one of the assignees of record gave power of attorney to Peter M. Duchesneau and to Edward W. Jordan whose address is/was:

MANATT, PHELPS & PHILLIPS, LLP
11355 West Olympic Blvd.
Los Angeles, CA 90064

A letter to that affect was mailed from the Office on April 13, 2001.

The names and address of the attorneys listed in the request for withdrawal do not match with those previously given power of attorney, as indicated above, thereby creating confusion as to who is withdrawing.

A new power of attorney from Honda Giken Kogyo Kabushiki Kaisha filed January 7, 2004 has given power of attorney to:

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

A letter to that affect was mailed from the Office on January 9, 2004.

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866

KJD/cps: 1/27/04

cc:

MANATT, PHELPS & PHILLIPS
1001 Page Mill Road, Building 2
Palo Alto, CA 94304

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12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hiroshi Murakami, et al. | : | |
| Application No. 09/349,423 | : | ON PETITION |
| Filed: July 7, 1999 | : | |
| Attorney Docket No. 31050.7US01 | : | |

This is a decision in response to a communication filed July 1, 2004, requesting, in effect, a decision on the December 22, 2003 petition to revive the above-identified application under 37 CFR 1.137(b).

A review of the record discloses that the application became abandoned for failure to respond to a final Office action mailed April 14, 2003. It is noted that a request for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) was filed on October 14, 2003, including an appropriate 3-month extension of time. However, the request for a CPA was automatically treated as an request for continued examination (RCE) of this application under 37 CFR 1.114, since a CPA of this application was not permitted under 37 CFR 1.53(d)(1). The constructive RCE was subsequently held improper by a notice mailed November 10, 2003. Applicant was also advised that the time period set in the final Office action continued to run. On March 24, 2004, a Notice of Abandonment was mailed.

The present communication argues that a petition to revive, RCE and reply were filed on December 22, 2003, followed by a petition to withdraw the Notice of Abandonment on April 1, 2004. While the above noted communications are present in the Image File Wrapper (IFW), the communications were not forwarded to the appropriate deciding official for a decision thereon. The Office apologizes for the delay in responding. A decision on the petition filed December 22, 2003 follows.

The petition is GRANTED.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Although the statement contained in the petition varies from the language required by 37 CFR 1.137(b)(3), the statement will be construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

The application is revived for consideration of a submission under 37 CFR 1.114 (request for continued examination).

It is noted that filing fees were paid for the constructive RCE on October 14, 2003 and the RCE filed on December 22, 2003. Applicant is only required to pay one filing fee to process the RCE filed in response to the final Office action mailed April 14, 2003. Accordingly, applicant may request a refund of the overpayment in writing to Mail Stop 16, Director of the US Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

The application is being forwarded to Technology Center AU 3626, for further processing of the request for continued examination under 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-9220. Inquiries relating to the processing of the RCE should be directed to the Technology Center.

Sherry D. Brinkley

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 14

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

**COPY MAILED**

JAN 28 2008

**OFFICE OF PETITIONS**

In re Application of :
Noribumi Koitabashi et al. :
Application No. 09/349,473 :
Filed: July 9, 1999 :
Attorney Docket No.: 1272.7910-DI :
Title: INK-JET APPARATUS EMPLOYING INK-JET HEAD HAVING A PLURALITY OF INK EJECTION HEATERS CORRESPONDING TO EACH INK EJECTION OPENING :

DECISION ON RENEWED PETITION UNDER 37 C.F.R. § 1.181(A)

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.181(a), filed on November 16, 2007.

The above-identified application became abandoned for failure to submit the issue fee and drawings in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed September 8, 2000, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting formal drawings or issue fees[1]. Accordingly, the above-identified application became abandoned on December 9, 2000. A Notice of Abandonment was mailed on March 20, 2001.

The original petition was filed on September 20, 2006, and dismissed via the mailing of a decision on August 16, 2007. It is noted that along with this renewed petition, Petitioner has

1 See MPEP § 710.02(e).

submitted a one-month extension of time so as to make timely this response.

The proper correspondence address has been made of record.

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the mailing was not received.

Accordingly, the petition under 37 C.F.R. § 1.181(a) is **GRANTED**. The holding of abandonment is **WITHDRAWN**.

The Office of Patent Publication will be notified of this decision. The Office of Patent Publication will re-mail the Notice of Allowance and Issue Fee Due of September 8, 2000, and will set a new period for response.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[2]. All other inquiries concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.

Paul Shanoski
Senior Attorney
Office of Petitions

2 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

PMG150C APC Correspondence Address 49473

## Correspondence Address

**Customer Number**: 05514

**Change Reason**: Applicant Request

**Directly Supplied**

**Name ***: FITZPATRICK CELLA HARPER & SCINTO

**Street ***: 30 ROCKEFELLER PLAZA

**City ***: NEW YORK

**State/Province**: NY

**Postal**: 10112

**Country ***: US

Save | Refresh | Clear

**Other Contact Information:**

**Phone No. / Ext.**: 212-218-2100

**Fax No.**: 212-218-2200

**E-Mail**:

Print | Cancel

**Last Modification** PSHANOSKI 01/27/2008

No changes to the Correspondence Address were supplied. pshanoski 01/27/2008

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AUG 16 2007

OFFICE OF PETITIONS

FITZPATRICK CELLA HARPER & SCINTO
277 PARK AVENUE
NEW YORK NY 10172

| | |
|---|---|
| In re Application of<br>Noribumi Koitabashi et al.<br>Application No. 09/349,473<br>Filed: July 9, 1999<br>Attorney Docket No.: 1272.7910-DI<br>Title: INK-JET APPARATUS EMPLOYING INK-JET HEAD HAVING A PLURALITY OF INK EJECTION HEATERS CORRESPONDING TO EACH INK EJECTION OPENING | DECISION ON PETITION UNDER 37 C.F.R. §§ 1.181(A) |

This is a decision on the "Petition to Withdraw Holding of Abandonment," filed on June 27, 2003, and resubmitted on September 20, 2006, which is properly treated as a petition pursuant to 37 C.F.R. § 1.181(a).

The Office regrets the period of delay in issuing this decision.

## BACKGROUND

The above-identified application became abandoned for failure to submit the issue fee and drawings in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed September 8, 2000, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting formal drawings or issue fees[1]. Accordingly, the above-

1 See MPEP §710.02(e).

identified application became abandoned on December 9, 2000. A Notice of Abandonment was mailed on March 20, 2001.

## RELEVANT PORTIONS OF THE C.F.R. AND M.P.E.P.

37 C.F.R. § 1.63(d)(4) sets forth, *in toto*:

> Where the power of attorney or correspondence address was changed during the prosecution of the prior application, the change in power of attorney or correspondence address must be identified in the continuation or divisional application. Otherwise, the Office may not recognize in the continuation or divisional application the change of power of attorney or correspondence address during the prosecution of the prior application.

See also MPEP § 201.06(c)(VII)

37 C.F.R. § 1.33(a) sets forth, *in pertinent part*:

> Correspondence address and daytime telephone number. When filing an application, a correspondence address must be set forth in either an application data sheet (§ 1.76), or elsewhere, in a clearly identifiable manner, in any paper submitted with an application filing.

MPEP 711.03(c) states, *in pertinent part*:

> PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION
>
> In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action,

> a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).
>
> The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).
>
> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).
>
> Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

The showing in the present petition is not sufficient to withdraw the holding of abandonment.

## ANALYSIS

First, Petitioner has set forth that the present application is a divisional of 08/579,241, which was filed on December 28, 1995. Application number 08/579,241 was filed with a declaration which lists the correspondence address as "Fitzpatrick Cella Harper & Scinto, 277 Park Avenue, New York, NY, 10172."

Petitioner submitted a "Request for Customer Number Data Change," updating the address associated with this Customer Number to the 30 Rockefeller Plaza address, along with a spreadsheet with a plurality of application numbers, including application number 08/579,241 - it is noted that the request contains a date of May 29, 1998. It is not clear when this document was submitted to the Office (it does not appear to contain a certificate of mailing), however Petitioner has included a "Notice of Customer Number Record Change," which appears to have been mailed by the Office on June 22, 1998.

On July 9, 1999, the present application was filed, along with a copy of the declaration that is associated with the parent application - which lists the correspondence address as "Fitzpatrick Cella Harper & Scinto, 277 Park Avenue, New York, NY, 10172."

It is noted in passing that the inclusion of the parental declaration when filing a divisional application is permitted by 37 C.F.R. § 1.63(d)(1). However, as noted above, 37 C.F.R. § 1.63(d)(4) indicates that when the correspondence address was changed during the prosecution of the parent application, the change in address must be identified in the divisional application.

It does not appear that Petitioner identified the change of address in the divisional application. Consequently, during prosecution, all papers were mailed to the former address and it appears that Petitioner received the first Office action.

Petitioner failed to comply with Rule § 1.63(d)(4), and consequently, Office mailings were properly sent to the former address. It follows that Petitioner's request for the Office to withdraw the holding of abandonment must be **DISMISSED**.

Secondly, Petitioner has stated that the Office communication was not received, however, it does not appear that he has not set forth that he searched either the file jacket or the place where he normally would keep such communications and could not find it, and it does not appear that he has submitted a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed.

As such, Petitioner has not established non-receipt of the communication.

## CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be

submitted by mail[2], hand-delivery[3], or facsimile[4]. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web[5].

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§1.137(a) and/or (b). Petitioner may download information about these petitions here: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If Petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For Petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at http://www.uspto.gov/web/forms/sb0122.pdf.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[6]. All other inquiries

---

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
4 (571) 273-8300- please note this is a central facsimile number.
5 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
6 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

cc: FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112-3801

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 2/25/09

TO SPE OF : ART UNIT 2853

SUBJECT : Request for Certificate of Correction for Appl. No.: 09349473 Patent No.: 7425056 B1

Please respond to this request for a certificate of correction within 7 days.

**FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**
**You can fax the Directors/SPE response to 571-270-9990**

*LAMONTE NEWSOME*
**Certificates of Correction Branch**
**703-308-9390 ext. 112**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** OK for entry

STEPHEN MEIER
SUPERVISORY PATENT EXAMINER

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 15

Gregory Scott Smith
3900 Newpark Mall Road, Suite 317
Newark, CA 94560

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AUG 0 2 2002

OFFICE OF PETITIONS

In re Application of
Russell W. McDonald et al.
Application No. 09/349,517
Filed: July 8, 1999
Attorney Docket No. R250-001

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 14, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliance mailed January 16, 2002, which set a reply period of ONE MONTH or THIRTY DAYS whichever is longer, within which to reply. Extensions of time under the provisions of 37 CFR 1.136(a) were permitted.

The application file is being forwarded to Technology Center AU 2164 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 308-6911.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6624918 | 2003-09-23 | 09349570 | 1999-07-08 | French 1-1-1 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ◉ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Joseph Pugh/ | Date (YYYY-MM-DD) | 2007-12-01 |
| Name | Joseph Pugh | Registration Number | 52137 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6624918
Issue Date: September 23,2003
Application No. 09349570
Filed: July 8,1999
Attorney Docket No. FRENCH-1-1-1

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed December 3,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of December 3,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 8

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

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SEP 28 2007

OFFICE OF PETITIONS

In re Application of

Minoru Nakagawara.

Application No. 09/349,573

Filed: July 8, 1999

Attorney Docket No. P-646-1

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 31, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed September 19, 2000, which set a shortened statutory period for reply of three (3) months. No response was received within the allowed period, and the application became abandoned on December 20, 2000. A Notice of Abandonment was mailed on April 10, 2001.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply form the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office.

The amendment filed August 31, 2007, is noted. The Power of Attorney is also noted and made of record.

The application is being forwarded to Technology Center 3700, GAU 3736 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 3

DAVIS & JOHNSON, L.L.P.
P.O. Box 90698
Austin , TX 78709-0698

FEB 1 2001

| | | |
|---|---|---|
| In re Application of<br>Raymond G. Gauthier et al.<br>Application No. 09/349,575<br>Filed: July 8, 1999<br>For: METHOD AND APPARATUS FOR CONTROLLING BRUSHLESS DC MOTORS IN IMPLANTABLE MEDICAL DEVICES | )<br>)<br>)<br>)<br>)<br>)<br>)<br>) | DECISION ON REQUEST TO WITHDRAW FROM RECORD |

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed January 02, 2001.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by William D. Davis on behalf of all attorneys of record associated with customer number 22503. Currently, there is no outstanding Office action that requires a response from applicant.

The request is APPROVED.

Applicant is reminded that there is no attorney of record at this time. The correspondence address of record has been changed and the new correspondence address appears below.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant.

Hien H. Phan, Special Program Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: KRITON MEDICAL, INC.
Attn: Rob Fine
6790 Florin-Perkins, Suite 100
Sacramento, CA 95828

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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LEYDIG VOIT & MAYER, LTD.
TWO PRUDENTIAL PLAZA, SUITE 4900
180 NORTH STETSON AVENUE
CHICAGO, IL 60601-6780

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AUG 16 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,010,497 | : | |
| Issue Date: March 7, 2006 | : | |
| Application No. 09/349,650 | : | NOTICE |
| Filed: July 8, 1999 | : | |
| Attorney Docket No. DYN-P-99-001 | | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

**MAILED**

AUG 13 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Corporate Patent Counsel
Phillips Electronics North America Corporation
580 White Plains Road
Tarrytown, NY 10591

| | | |
|---|---|---|
| In re Application of | : | |
| Kristen Diane Ondeck | : | DECISION ON PETITION |
| Application No. 09/349,676 | : | TO WITHDRAW THE |
| Filed: July 8, 1999 | : | HOLDING OF ABANDONMENT |
| For: AFTER-SALES CUSTOMIZATION SPECIFIED BY RETAILER ACTS AS INCENTIVE | | |

This is in response to applicant's petition to withdraw the holding of abandonment filed with the United States Patent and Trademark Office (USPTO), on July 29, 2002. There is no fee for this petition.

The petition is **GRANTED**.

A review of the file record indicates that the application was held abandoned for failing to file a timely response to an Office communication dated January 17, 2002. Although no formal notice of abandonment has yet been mailed, the six-month response period has expired, and the application is in fact abandoned.

Applicant's petition includes a copy of a response and includes USPTO facsimile return receipt bearing a transmittal date of March 8, 2002. This is sufficient evidence of a timely response.

Since a timely response to the Office action was filed, the holding of abandonment is withdrawn and the application is restored to pending status. The application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response filed with the petition, and then to the Primary Examiner for prompt action on the merits of the application.

Steven N. Meyers, Special Program Examiner
Patent Technology Center 3600
Telephone No.: (703) 308-3868
Facsimile No.: (703) 605-0586

SM: 8/12/02

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**KNOBBE MARTENS OLSON & BEAR LLP**
**2040 MAIN STREET**
**FOURTEENTH FLOOR**
**IRVINE CA 92614**

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JUL 13 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| McKeeth, James | : | |
| Application No. 09/349,735 | : | DECISION ON PETITION |
| Filed: July 8, 1999 | : | |
| Attorney Docket No. MTIPAT.180A | : | |

This is a decision on the petition, filed December 12, 2005, which is being treated as a petition under 37 CFR 1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to reply to the non-final Office action mailed May 18, 2005, which set a three (3) month shortened statutory period for reply.

Petitioner asserts that the Office action dated May 18, 2005, was not received.

A review of the written record indicates no irregularity in the mailing of the Office action, and, in the absence of any irregularity, there is a strong presumption that the Office action was properly mailed to the practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. In this regard, the showing required to establish the failure to receive the Office action must consist of the following:

1. a statement from practitioner stating that the Office action was not received by the practitioner;

2. a statement from the practitioner attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and

3. a copy of the docket record where the non-received Office action would have been entered had it been received must be attached to and referenced in the practitioner's statement.

*See* MPEP § 711.03(c) under subheading "Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action," and "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993).

The petition satisfies the above-stated requirements. Accordingly, the application was not abandoned in fact.

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

This application is being referred to the Technology Center technical support staff of Art Unit 2179 for re-mailing the Office action of May 18, 2005. The period for reply will run from the mailing date of the Office action.

Liana Chase
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Mailed: OCT - 9 2003

wak
Paper Number 23

In re application of
Shacklett et al.
Serial No. 09/349,737
Filed: July 8, 1999
For: FABRIC PADS WITH A PRINTED DESIGN AND A METHOD OF MAKING FABRIC PADS WITH A PRINTED DESIGN

DECISION ON PETITION

This is a response to the PETITION TO RESCIND THE NOTICE OF APPEAL filed by the Applicant on April 4, 2003, and stay the fee submitted by Applicant in support thereof in the event a subsequent Notice of Appeal is filed. The Notice of Appeal filed on March 12, 2003 was filed in response to a second non-final Office Action dated September 12, 2002. Applicant further submitted an amendment on March 12, 2003 that was not entered by the Examiner. Subsequently another amendment was filed on May 20, 2003 that was not entered. The Examiner sent out an Advisory Action on July 23, 2003.

**DECISION**

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee).

The Advisory Action of July 23, 2003 and the Amendment of May 20, 2003 will be vacated. The Notice of Appeal will be rescinded and the Amendment filed March 12, 2003 will be entered and the application forwarded to the Examiner for consideration. Under 37 CFR 1.191(a), an applicant for a patent dissatisfied with the primary examiner's decision in the second or final rejection of his or her claims may appeal to the Board for review of the examiner's rejection by filing a notice of appeal and the required fee set forth in 37 CFR 1.17(b) within the time period provided under 37 CFR 1.134 and 1.136. A notice of appeal may be filed after any of the claims has been twice rejected, regardless of whether the claim(s) has/have been finally rejected.

The fee filed for the Notice of Appeal will not be refunded since the filing of a Notice of Appeal after two actions in the application was proper.

The Petition is **GRANTED**.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

THOMAS J. MCWILLIAMS
REED SMITH LLP
1650 MARKET STREET
PHILADELPHIA, PA 19103

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 17

KNOBBE MARTENS OLSON & BEAR LLP
620 NEWPORT CENTER DRIVE, SIXTEENTH FLOOR
NEWPORT BEACH CA 92660

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JUN 2 8 2002
OFFICE OF PETITIONS
ON PETITION

In re Application of :
Frederick L. Jordan :
Application No. 09/350,043 :
Filed: July 8, 1999 :
Attorney Docket No. ORYXE.001A :

This is a decision on the petition, filed June 26, 2002, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on June 10, 2002 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

The application is being forwarded to Technology Center AU 1616 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice must be made in writing and should be accompanied by the new Issue Fee Transmittal Form PTOL-85(b), along with a copy of this decision. Additionally, if the issue fee has increased from the previously paid issue fee, the balance due must be submitted. **Failure to *timely* request *in writing* that the previously paid issue fee be applied towards the new Notice and payment of any balance due will result in the abandonment of the application.**

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 10

Akin Gump Strauss Hauer & Feld
PO Box 688
Dallas, TX 75313-0688

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DEC 2 6 2002

OFFICE OF PETITIONS

In re Application of
Payne et al.
Application No. 09/350,467
Filed: July 9, 1999
Attorney Docket No. B65537

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed December 12, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed April 24, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 25, 2002.

Telephone inquiries regarding this decision should be directed to Latrice Bond at (703) 308-6911.

The application file is being forwarded to Technology Center AU 2154 for further processing.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 13, 2007

TO SPE OF : ART UNIT 2800(2154)

SUBJECT : Request for Certificate of Correction for Appl. No.09/350467patent no.7035914

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.


**Magdalene Talley**

**Certificates of Correction Branch**

**703-308-9390 ext. 116**


**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

- [x] **Approved** — **All** changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

**Comments:**

APPROVED

/nATHAN j. fLYNN/ SPE 2154

**SPE** **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 12

JOSEPH B KEJHA
1022 FREDERICK ROAD
MEADOWBROOK PA 19046

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JAN 1 5 2002

OFFICE OF PETITIONS

In re Application of
Joseph B. Kejha
Application No. 09/350,713
Filed: July 9, 1999
Attorney Docket No. JBK-7

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed December 19, 2001, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed November 30, 2000, which set a shortened statutory period for reply of three (3) months. Petitioner filed a reply on May 30, 2001, and attempted to obtain an extension of time within the third month. Petitioner did not, however, remit a sufficient amount to cover the fee for the extension of time for reply within the third month. Because the maximum statutory period for reply expired on May 30, 2001, petitioner could not file an additional reply. The application became abandoned on March 2, 2001. A Notice of Abandonment was mailed on July 19, 2001.

Petitioner will be refunded the amount of $435.00 and $25.00 remitted for extension of time within the third month that was not made available to petitioner.

The application is being forwarded to Technology Center 3600 review of the response filed on December 19, 2001.

Telephone inquiries concerning this decision should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.

Kenya A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6582365 | 2003-06-24 | 09/350,736 | 1999-07-09 | ARC-14280-1 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ◉ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /rmpadilla/ | Date (YYYY-MM-DD) | 2007-08-21 |
| Name | Robert M. Padilla | Registration Number | 38987 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6582365
Issue Date: June 24,2003
Application No. 09350736
Filed: July 9,1999
Attorney Docket No. ARC-14280-1L

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed August 21,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of August 21,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LSI LOGIC CORPORATION
1621 BARBER LANE
MS: D-106
MILPITAS CA 95035

**COPY MAILED**

MAR 2 0 2006

**OFFICE OF PETITIONS**

In re Application of :
Dekoning et al. :
Application No. 09/350,742 :
Filed: July 9, 1999 :
Title: Methods and Apparatus for Issuing :
Updates to Multiple Management Entities

ON PETITION

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed March 6, 2006.

The petition to withdraw the holding of abandonment is **Dismissed**.

Any request for reconsideration should be filed within **TWO MONTHS** of the mailing date of this decision in order to be considered timely. 37 CFR 1.181(f). This time period may not be extended pursuant to 37 CFR 1.136.

This above-identified application became abandoned for failure to file a response to an Office Communication mailed on July 16, 2004. A Notice of Abandonment was mailed on January 24, 2006.

Petitioner contends the Office Communication mailed on July 16, 2004 was not received. The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

Although petitioner has presented the above showing, a review of the record shows that Kevin West is not an attorney of record for the above-identified application. Further the correspondence address affiliated with attorney West is that of Omaha Nebraska, contrary to the correspondence address of record. Any request for reconsideration should state whether the docket records and searches conducted were for the

Copied from 10350742 on 07/17/2006

correspondence address of record (Milipitas, California).

Further correspondence with respect to this matter should be addressed as follows:

| | |
|---|---|
| By mail: | Mail Stop Petition<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By facsimile: | (571) 273-8300 |
| By delivery service:<br>(FedEx, UPS, DHL, etc.) | U.S. Patent and Trademark Office<br>Customer Service Window,<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

Copied from 10350742 on 07/17/2006

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LSI LOGIC CORPORATION
1621 BARBER LANE
MS: D-106
MILPITAS CA 95035

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JUL 17 2006
OFFICE OF PETITIONS

In re Application of :
Dekoning et al. :
Application No. 09/350,742 :
Filed: July 9, 1999 :
Title: Methods and Apparatus for Issuing Updates to Multiple Management Entities :

ON PETITION

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed May 18, 2006.

The petition to withdraw the holding of abandonment is **GRANTED**.

This above-identified application became abandoned for failure to file a response to an Office Communication mailed on July 16, 2004. A Notice of Abandonment was mailed on January 24, 2006.

Petitioner asserts that the Office Communication mailed on July 16, 2004 was never received. Petitioner states a search of the file jacket and docket records confirms the Office Communication was not received. In support of petitioner's contention, a copy of the docket records has been provided.

This application is being forwarded to Art Unit 2143 for re-mailing of Notification of Non-Compliant Appeal Brief to the current correspondence address of record. Appellant will be given 1 month or 30 days from the mailing of the notification of non-compliance, whichever is longer to file an amended brief.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**LSI CORPORATION**
**1621 BARBER LANE**
**MS: D-105**
**MILPITAS CA 95035**

MAILED

FEB 19 2009

OFFICE OF PETITIONS

In re Application of
Rodney A. Dekoning et al
Application No. 09/350,742
Filed: July 9, 1999
Attorney Docket No. 98-054

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 16, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an Supplemental Appeal Brief; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply of January 16, 2009, is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 2443 for appropriate action by the Examiner in the normal course of business on the reply received January 16, 2009.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 6

WALKER DIGITAL CORPORATION
ONE HIGH RIDGE PARK
STAMFORD, CT 06905-1325

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APR 0 6 2000

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

In re Application of
Jay S. Walker et al.
Application No. 09/350,875
Filed: July 9, 1999
Attorney Docket No. 98-113

: NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc.. No. 97-1128, -1280, -1453, 1998 U.S. App. LEXIS 21409, at *30 (Fed. Cir. Sept. 1, 1998). Therefore, your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being returned to Technology Center 2700.

Wan Laymon
Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Karen Creasy
Karen Creasy
Petitions Examiner

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 10

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JUN 15 2000

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

WALKER DIGITAL CORPORATION
ONE HIGH RIDGE PARK
STAMFORD, CT 06905

| | |
|---|---|
| In re Application of | : |
| Jay S. Walker et al. | : |
| Application No. 09/350,875 | : NOTICE |
| Filed: July 9, 1999 | : |
| Attorney Docket No. 98-113 | : |

This is a supplemental notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc.. No. 97-1128, -1280, -1453, 1998 U.S. App. LEXIS 21409, at *30 (Fed. Cir. Sept. 1, 1998). Therefore, your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being returned to its Technology Center 2700.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

**MAILED**

FEB 18 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

WALKER DIGITAL LLC
FIVE HIGH RIDGE PARK
STAMFORD, CT 06905

In re Application of
Jay S. Walker, et al.
Application No. 09/350,875
Filed: July 9, 1999
For: MULTI-TIER PRICING OF INDIVIDUAL PRODUCTS BASED ON VOLUME DISCOUNTS

**DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT**

This is a decision on the applicant's petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office (USPTO), on January 5, 2004.

The petition is **GRANTED**.

A review of the file record reveals that a Final rejection was mailed to the applicants on December 3, 2002. A Notice of Appeal accompanied by a request for a three month extension of time under 37 CFR 1.136(a) was received in the United States Patent and Trademark Office (USPTO) on June 5, 2003. An Advisory action was subsequently mailed to the applicants on June 12, 2003 acknowledging receipt of the Notice of Appeal and notifying applicant of the time period for filing an Appeal Brief. The application was held abandoned for failure to timely file the Appeal Brief and a notice to that effect was mailed December 15, 2003.

Applicants submit the application should not have been held abandoned because the time period for filing an Appeal Brief may be extended up to seven months from the date the Notice of Appeal is received in the USPTO (June 5, 2003). Applicants state at the bottom of page 4 of the petition that an Appeal Brief was filed January 5, 2004, however no Appeal Brief was found accompanying the petition.

The time periods set forth in sections 37 CFR 1.191 and 37 CFR 1.192 for filing an Appeal Brief are subject to the provisions of 37 CFR 1.136.

35 U.S.C. 133 sets the maximum statutory period for reply to an Office action at six months. However once a Notice of Appeal is filed, the time periods set for filing an Appeal Brief, or to correct a defect therein, are no longer statutory periods subject to the six month maximum set in 35 U.S.C. 133. These periods may in turn be extendable by up to five months under 37 CFR 1.136(a).

The Notice of Appeal properly filed on June 5, 2003 in itself extends the time period for filing the Appeal Brief (i.e. the time period for reply) to August 5, 2003. Under 37 CFR 1.136(a) this non-statutory time period for reply may be extended by up to five months to January 5, 2004.

The petition is therefore **GRANTED.**

The application will be forwarded to the Supervisory Legal Instruments Examiner to withdraw the abandonment and restore the application to pending status, before being returned to the examiner for consideration of any timely filed Appeal Brief.

Steven Meyers, Special Program Examiner
Patent Technology Center 3600
(703) 308-3868

SNM/cps: 2/12/04

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6305880 | 2001-10-23 | 09350948 | 1999-07-09 | 50-10298 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | | Small Entity | | |
|---|---|---|---|---|---|
| | Fee | Code | | Fee | Code |
| ○ | 3 ½ year | (1551) | ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (1552) | ◉ | 7 ½ year | (2552) |
| ○ | 11 ½ year | (1553) | ○ | 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /C. John Brannon/ | Date (YYYY-MM-DD) | 2010-07-23 |
| Name | C. John Brannon | Registration Number | 44557 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6305880
Issue Date: October 23,2001
Application No. 09350948
Filed: July 9,1999
Attorney Docket No. 16279-14

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed July 23,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 23,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 7

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OCT 31 2000

OFFICE OF PETITIONS
A/C PATENTS

ON PETITION

Elizabeth E. Nugent
Choate Hall & Stewart
53 State Street
Boston, MA 02109-0890

In re Application of
Bawendi, et al.
Application No. 09/350,956
Filed: July 9, 1999
Attorney Docket No.: 0492611-0350

This is a decision on the petition under 37 CFR 1.137(b), filed October 16, 2000, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned October 6, 1999 for failure to timely submit an oath or declaration and a surcharge for its late filing as required by the Notification of Missing Requirements under 35 USC 371 mailed August 5, 1999, which set a two (2)-month period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on August 11, 2000.

Receipt is hereby acknowledged of the Declaration and Surcharge submitted by Petitioner October 16, 2000.

With respect to the request for corrected filing receipt filed October 12, 1999, the petition is granted and no fees are due nor will any fees be charged to Deposit Account No. 03-1721.

This application will be forwarded to the Office of Initial Patent Examination for further processing and for issuance of a corrected filing receipt.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.

Patricia Faison-Ball

Patricia Faison-Ball
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 12

Elizabeth E. Nugent, Ph.D.
Choate, Hall & Stewart
53 State Street
Boston MA 02109

COPY MAILED

JUL 1 5 2002

OFFICE OF PETITIONS

In re Application of
Miller et al.
Application No. 09/350,956
Filed: July 9, 1999
Attorney Docket No. 0492611-0350

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 12, 2002, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on 29 September, 2001, for failure to timely file a response to the Restriction Requirement mailed on 28 August, 2001, which set forth a one (1) month shortened statutory period for reply. No extensions of time pursuant to 37 CFR 1.136(a) were obtained. A Notice of Abandonment was mailed on 22 April, 2002.

The statement of unintentional delay presented in the petition does not comply with the current rule. Effective December 1, 1997, 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

The application file is being forwarded to Technology Center 2800 for further processing.

Telephone inquiries concerning this decision should be directed to Petitions Attorney Douglas Wood at (703) 308-6918.

D Wood

Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MORGAN, LEWIS & BOCKIUS, LLP
2 PALO ALTO SQUARE
3000 EL CAMINO REAL
PALO ALTO, CA 94306

**COPY MAILED**

DEC 07 2004

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Marc Porat, et al. :
Application No. 09/350,983 :
Filed: July 9, 1999 :
Attorney Docket No. 040180-0002 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 3600, Art Unit 3624.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6901361 | 2005-05-31 | 09/351,208 | 1999-07-09 | 19098 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /js/ | Date (YYYY-MM-DD) | 2010-05-12 |
| Name | Jesus Sanchelima, Esq. | Registration Number | 28755 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6901361
Issue Date: May 31,2005
Application No. 09351208
Filed: July 9,1999
Attorney Docket No. 19098

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed May 12,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of May 12,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6296261 | 2001-10-02 | 09351448 | 1999-07-12 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

◉ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Sole Patentee | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature. | | | |
| Signature | /Rolando L. deGoma/Rolando L. deGoma/ | Date (YYYY-MM-DD) | 2007-09-03 |
| Name | Rolando L. deGoma | | |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

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3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6296261
Issue Date: October 2,2001
Application No. 09351448
Filed: July 12,1999
Attorney Docket No. RD-2

:

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

:

This is a decision on the electronic petition, filed September 3,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 3,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6623982
Issue Date: September 23,2003
Application No. 09351515
Filed: July 12,1999
Attorney Docket No. IMMU.FFAF

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed September 3,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 3,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,623,982 | 2003-09-23 | 09/351,515 | 1999-07-12 | VDXUSNP |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☒ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ◉ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Joseph F. Aceto/ | Date (YYYY-MM-DD) | 2009-09-03 |
| Name | Joseph F. Aceto | Registration Number | 50701 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 21

**PEARNE & GORDON LLP**
**1801 EAST 9TH STREET**
**SUITE 1200**
**CLEVELAND, OH 44114-3108**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Fumihiro Muramatsu et al | : | |
| Application No. 09/351,521 | : | DECISION ON PETITION |
| Filed: July 12, 1999 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 31879 | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 8, 2004, requesting withdrawal of the above-identified application from issue.

The petition is dismissed as moot for the reasons stated below.

A review of the file record discloses that a Notice of Allowability was mailed on May 21, 2003. However, no Notice of Allowance and Issue Fee(s) Due was mailed at that time. Thereafter, on February 5, 2004, the Office mailed a second Notice of Allowability and a new Notice of Allowance and Fee(s) Due. The Notice required submission of the issue fee to be paid on or before May 5, 2004 to avoid the abandonment of the application.

An issue fee payment in the amount of $1,300 was received in the USPTO on August 26, 2003. However, since no Notice of Allowance and Issue Fee(s) Due was mailed prior to the payment thereof, this fee is considered to have been prematurely paid. There is no indication in the record, and petitioner herein has confirmed, that no reply to the February 5, 2004 Notice of Allowance and Issue Fee(s) Due has been submitted.

37 CFR 1.313(c)(2) provides for withdrawal of an application from issue after payment of the issue fee. In the instant case, as noted above, the issue fee in reply to the Notice of Allowance of February 5, 2004 has not been received. Therefore, the filing of a petition to withdraw this application from issue is unnecessary at this time. The mere filing of a Request for Continued Examination (RCE) under 37 CFR 1.114 and submission will effectively

withdraw an application from issue prior to payment of the issue fee. In view thereof, the petition to withdraw from issue is dismissed as involving a moot issue. Note MPEP 706.07(h)(IX).

No fee has been assessed for the instant petition to withdraw from issue. However, as authorized, the $770 fee due for the RCE will be charged to petitioner's deposit account.

Inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This file will be forwarded to Technology Center AU 2684 for appropriate processing of the RCE filed March 8, 2004 and consideration of the IDS submitted concurrently therewith.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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GREGORY A. WELTE, ESQ.
806 NORTH COUNTY ROAD, 700 WEST
FRANKFORT IN 46041

**COPY MAILED**

SEP 0 9 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of<br>BRASSIL<br>Application No. 09/351,597<br>Filed: July 12, 1999<br>Attorney Docket No. BRASSIL-3 | :<br>:<br>:<br>:<br>: | DECISION<br>ON PETITION |

This is a decision on the petition under 37 CFR 1.137(b), filed March 22, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final office action mailed January 29, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on April 30, 2002.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an Amendment; (2) the petition fee of $1500; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the non-final action of January 29, 2002 is accepted as having been unintentionally delayed.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

The Associate Power of Attorney of February 23, 2005 and March 22, 2005 were filed on or after June 25, 2004, the effective date of a rule change eliminating Associate Power of Attorney practice (37 CFR 1.34(b) was eliminated). See Revision of Power of Attorney and Assignment Practice, 69 Fed. Reg. 29865 (May 26, 2004); 1283 Off. Gaz. 148 (Jun. 22, 2004). Although the papers have been placed in the file, the names of the patent practitioner(s) listed on these Associate Powers of Attorney have not been made of record.

Telephone inquiries concerning this decision should be directed to Denise Pothier at (571) 272-4787.

The application matter is being forwarded to Technology Center Art Unit 2155.

Frances Hicks
Petitions Examiner
Office of Petitions

OIPE JC19
AUG 0 1 2000
PATENT & TRADEMARK OFFICE

**Pra titi n r's Docket No.** 16153-7775 **PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

New application of:
Inventors:
Title of Invention:

**OR**

In re application of: Wold et al.
Serial No.: 09 / 351,778 Group No.: 1611
Filed: July 12, 1999 Examiner: Unknown
For: Replication-Competent Anti-Cancer Vectors

**Assistant Commissioner for Patents**
**Washington, D.C. 20231**

## PETITION TO ACCEPT PHOTOGRAPH(S) AS DRAWING(S)
## (37 C.F.R. § 1.84(b))

1. Petition is hereby made to accept photograph(s) in this case.

*NOTE: ". . .Photographs must either be developed on double weight photographic paper or be permanently mounted on bristol board. The photographs must be of sufficient quality so that all details in the drawing are reproducible in the printed patent." 37 C.F.R. 1.84(b)(ii).*

---

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10**
***(When using Express Mail, the Express Mail label number is mandatory; Express Mail certification is optional.)***

I hereby certify that, on the date shown below, this correspondence is being:

**MAILING**

☒ deposited with the United States Postal Service in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231

**37 C.F.R. § 1.8(a)**
☒ with sufficient postage as first class mail.

**37 C.F.R. § 1.10***
☐ as "Express Mail Post Office to Addressee"
Mailing Label No. _____(mandatory)

**TRANSMISSION**

☐ transmitted by facsimile to the Patent and Trademark Office.

Date: July 26, 2000

Signature

Elie H. Gendloff
*(type or print name of person certifying)*

***WARNING:** Each paper or fee filed by Express Mail **must** have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. § 1.10(b).*
*"Since the filing of correspondence under § 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable care, requests for waiver of this requirement will **not** be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.*



08/03/2000 VYANG1 00000003 09351778
01 FC:122 130.00 OP

2. Three (3) sets of photographs

☒ are submitted herewith.

☐ have already been submitted in this application on _____.
Date

*NOTE: The petition must include three sets of photographs. 37 C.F.R. § 1.84(b).*

3. The reason(s) why photograph(s) is/are necessary in this case is/are as follows:

The nature of the information that is intended to be conveyed by the Figures is such that it can not be easily observed without the resolution afforded by photographs.

4. The petition fee (37 C.F.R. § 1.17(i)) is paid as follows:

☐ Please charge the petition fee of $130.00 to Account _____.
A duplicate of this petition is attached.

☒ A check in the sum of $130.00 is attached.

Please charge Account 18-1829 for any fee deficiency, or credit said Account for any overpayment.

SIGNATURE OF PRACTITIONER

Reg. No.: 44,704

Elie H. Gendloff
*(type or print name of practitioner)*

Tel. No.: (314 ) 727-5188

7733 Forsyth Blvd., 14th Floor
P.O. Address

Customer No.:

St. Louis, MO 63105

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

APPLIED MATERIALS, INC.
P. O. BOX 450A
SANTA CLARA CA 95052

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JAN 25 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,808,647 | : | |
| Issue Date: October 26, 2004 | : | |
| Application No. 09/352,008 | : | ON PETITION |
| Filed: July 12, 1999 | : | |
| Attorney Docket No. | : | |
| AMAT/3417/ET | : | |

This is a decision on the PETITION TO CORRECT THE ASSIGNEE UNDER 37 CFR 1.183 filed October 2, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

Petitioner states that the assignee was inadvertently omitted from form PTOL-85B, and requests that a Certificate of Correction be issued identifying the assignee as, "Applied Materials, Inc." Petitioner submits a "Certificate of Correction" for this purpose.

Both petitioner's evidence and Office records show that the assignment of the above-identified application to Applied Materials, Inc., was submitted for recording in the Office on July 12, 1999 before issuance of the patent (Reel/Frame 010102/0218) on October 26, 2004. This was also prior to payment of the Issue Fee on September 7, 2004.

Receipt of the required $130 processing fee set forth in § 1.17(i) and the required $100 certificate of correction fee set forth in § 1.20(a)) is acknowledged.

---

[1] *See* MPEP 1309, subsection II, Official Gazette at 1283 OG 148 (June 22, 2004) or Final Register at 69 FR 29865 (May 26, 2004).

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3219. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

The Certificates of Correction Branch has been notified of this decision granting the petition under 37 CFR 3.81(b) and directing issuance of the requested Certificate of Correction.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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WASHINGTON, D.C. 20231
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Paper No. 9

DEC 2 0 2000

**OFFICE OF PETITIONS**
**A/C PATENTS**

JAMES W POTTHAST
POTTHAST & ASSOCIATES
2712 N. ASHLAND AVENUE
CHICAGO , IL 60614

In re Application of
Jeffrey L. Hill
Application No. 09/352,192
Filed: July 12, 1999
Attorney's Docket No. DYN-6D-2

ON PETITION

This is a decision on the petition, filed October 26, 2000 under 37 C.F.R. § 1.137(a) to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. 37 CFR 1.137(d). Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)."

This application became abandoned for failure to timely submit a proper response to the final Office action mailed on January 28, 2000. The application became abandoned on April 29, 2000. A Notice of Abandonment was mailed on August 25, 2000.

The provisions of 37 CFR 1.137(a) provide that where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(a). A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

> (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
>
> (2) the petition fee as set forth in 37 CFR 1.17(l);
>
> (3) a showing to the satisfaction of the Commissioner that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and
>
> (4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy requirement (3) above.

**Failure to Present and Adequate Showing of Unavoidable delay**

The Commissioner may revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 USC 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in

determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term"unavoidable" is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Heinrich, 1913 Dec. Comm'r pat. 139, 141 (Comm'r Pat. 1913). In addition, decision on revival are made on a case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977,982 (D.C. Cir. 1982). Finally, the burden of showing the cause of the delay is on the person seeking to revive the application, Smith v. Mossinghoff, Id., and a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

The test of unavoidable delay is the "reasonably prudent person" test set forth in In re Mattullath, 38 App.D.C. 497, 514-15 (D.C. Cir. 1912): " the test of whether the delay is unavoidable is applicable to ordinary human affairs, and requires no more or greater care or diligence that is generally used and observed by prudent and careful men in relation to their most important business".

There are three periods to be considered in treating a petition to revive under 37 CFR 1.137(a): (1) the delay in reply that originally resulted in the abandonment; (2) the delay in filing an initial petition pursuant to 37 CFR 1.137 to revive the application; and (3) the delay in filing a grantable petition pursuant to 37 CFR 1.137 to revive the application.

With respect to the first period, an application is abandoned "unavoidably" only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The showing on the record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Petitioner asserts that the cause of delay in filing a timely reply to the non-final Office action mailed January 28, 2000, was due to the untimely receipt of an inexplicably late delivery of a bundle of mail held by the USPS. However, petitioners statements alone are insufficient as a basis for an adequate showing of unavoidable delay.

An adequate showing of late receipt of a PTO communication should include (1) evidence showing the date of receipt of the PTO action at the correspondence address (e.g., a copy of the PTO action having the date of receipt of the PTO action at the correspondence address stamped thereon, a copy of the envelope (which contained the PTO action) having the date of receipt of the PTO action at the correspondence address stamped thereon, etc.), and a statement establishing how the evidence presented establishes the date of receipt of the PTO action. Other forms of probative evidence **may** include statements from Postal Service personnel, copies of docket record and incoming mail logs or other evidence of nonreceipt of Official communications in accordance with MPEP § 711.03(c), with statements explaining how the evidence presented supports the statements made.

If revival of the above-identified application is pursued, petitioner may also wish to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application. A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: (**1**) the required reply (unless previously filed), which may met by the filing of a continuing application In a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; (**2**) the petition fee required by 37 CFR 1.17(m); (**3**) a statement that the entire delay In filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (**4**) a terminal disclaimer (and fee as set forth In 37 CFR 1.20(d)). A blank petition for revival under 37 CFR 1.137(b) is provided for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA. 22202

Telephone inquiries should be directed to Petitions Attorney, Jennifer M. Hayes, at (703) 306-5608.

Jennifer M. Hayes
Attorney Advisor
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: blank form for Petition to Revive an Unintentionally Abandoned Application under 37 CFR 1.137(b)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 14

LAW OFFICES OF POTTHAST & ASSOCIATES
2712 N. ASHLAND AVENUE
CHICAGO IL 60614-1106

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**DEC 1 5 2003**

**OFFICE OF PETITIONS**

In re Application of :
Hill et al. :
Application No. 09/352,192 :
Filed: July 12, 1999 :
Attorney Docket No. DYN-6D1-1 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 21, 2003, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to reply timely to the final Office action mailed January 28, 2000, which set a three-month shortened statutory period to respond. No extensions of time were obtained pursuant to 37 CFR 1.136(a). Accordingly, this application became abandoned on April 29, 2000.

With the present petition, applicant submitted a request for a CPA under 37 CFR § 1.53(d) and an amendment as a response to the final Office Action. However, effective July 14, 2003, the Office has eliminated CPA practice as to utility and plant applications. *See Elimination of Continued Prosecution Application Practice as to Utility and Plant Patent Applications, 68 FR 32376 (May 30, 2003), 1271 Off. Gaz. Pat. Office 143 (June 24, 2003) (final rule)*. Accordingly, the CPA request is improper because it was filed on July 21, 2003, after the elimination of CPA practice.

In the event that an applicant files a request for a CPA that does not meet the requirements of 37 CFR § 1.53(d) because the application is not a design application, and the application was filed on or after June 8, 1995, **the request for a CPA will be treated as an RCE under 37 CFR § 1.114**.

The file is being forwarded to Technology Center 2800 for processing of the RCE filed July 21, 2003.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

To: Tech. Center 2800

From: Office of Petitions

Treated CPA filed 7/21/03 as an RCE because CPA practice was eliminated effective 7/14/03.

CTD 12/12/04

See paper 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 40

**ERIC ROBINSON**
**PMB 955**
**21010 SOUTHBANK ST.**
**POTOMAC FALLS VA 20165**

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OFFICE OF PETITIONS

ON PETITION

In re Application of
Shunpei Yamazaki et al
Application No. 09/352,194
Filed: July 13, 1999
Attorney Docket No. 0756-1998

This is a decision on the petition, filed January 5, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on September 22, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2823 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 50

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OFFICE OF PETITIONS

**ERIC ROBINSON**
**PMB 955**
**21010 SOUTHBANK ST.**
**POTOMAC FALLS VA 20165**

In re Application of :
Shunpei Yamazaki et al :
Application No. 09/352,194 :
Filed: July 13, 1999 :
Attorney Docket No. 0756-1998 :

ON PETITION

This is a decision on the petition, filed July 14, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on July 6, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2823 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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JUL 16 2004

OFFICE OF PETITIONS

ERIC ROBINSON
PMB 955
21010 SOUTHBANK ST.
POTOMAC FALLS VA 20165

In re Application of
Shunpei Yamazaki et al
Application No. 09/352,194
Filed: July 13, 1999
Attorney Docket No. 0756-1998

ON PETITION

This is a decision on the petition, filed July 14, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on July 6, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2823 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 4

GRAHAM & JAMES LLP
600 HANSEN WAY
PALO ALTO , CA 94304-1043

Mailed

APR 11 2000

Director's Office
Group 2700

In re Application of: )
Hueymin Sheu )
Application No.: 09/352,280 )
Filed: July 13, 1999 )
For: VOICE OVER INTERNET PROTOCOL )
PROXY GATEWAY )

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed March 14, 2000.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is GRANTED.

All future communications from the Office will continue to be directed to the correspondence address of record at the address above.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2700
Communications & Information Processing
(703) 305-4710

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 4

GRAHAM & JAMES LLP
600 HANSEN WAY
PALO ALTO , CA 94304-1043

Mailed

APR 2 4 2000

Director's Office
Group 2700

In re Application of: )
Hueymin Sheu )
Application No.: 09/352,280 )
Filed: July 13, 1999 )
For: VOICE OVER INTERNET )
PROTOCOL PROXY GATEWAY )

CORRECTED DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OF RECORD

This is a decision on the Request To Withdraw from Representation filed March 14, 2000.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is GRANTED.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2700
Communications & Information Processing
(703) 305-4710

cc: Alan B. Kalin, Esq.
McCutchen, Doyle, Brown & Enersen
3150 Porter Drive
Palo Alto, CA 94304-1212

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UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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DARREN E. DONNELLY
McCUTCHEN DOYLE BROWN & EMERSEN, LLP
THREE EMBARCADERO CENTER
SAN FRANCISCO CA 94111

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AUG 0 9 2005

**OFFICE OF PETITIONS**

In re Application of
Hueymin Sheu
Application No.: 09/352,280
Attorney Docket No.: 35673.00078

: DECISION ON PETITION
:
: UNDER 37 CFR 1.137(b)
:

This is a decision on the petition under 37 CFR 1.137(b), filed April 20, 2005 to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed December 03, 2003, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned at midnight on March 03, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a Request for Continued Examination (RCE) and submission as required by 37 CFR 1.114; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final office action of December 3, 2003 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Rafael Bacares at (571) 272-3276 or in his absence, the undersigned at (571) 272-3217.

Frances Hicks for
Brian Hearn
Petitions Examiner
Office of Petitions

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**OLIFF & BERRIDGE**
**P.O. BOX 19928**
**ALEXANDRIA VA 22320**

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DEC 3 0 2005

**OFFICE OF PETITIONS**

In re Application of :
Hiromi Mori :
Application No. 09/352,335 :
Filed: July 13, 1999 :
Attorney Docket No. 103815 :

ON PETITION

This is a decision on the petition, filed December 29, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on August 22, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2624 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

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MAY 16 2006
OFFICE OF PETITIONS

In re Application of :
Hiromi Mori :
Application No. 09/352,335 : ON PETITION
Filed: July 13, 1999 :
Attorney Docket No.: 103815 :

This is a decision on the petition, filed May 15, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on April 20, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.*** [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2625 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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**AMGEN INC.**
**MAIL STOP 27-4-A**
**ONE AMGEN CENTER DRIVE**
**THOUSAND OAKS, CA 91320-1799**

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JAN 19 2005

**OFFICE OF PETITIONS**

In re Application of
Virginia C. Broudy et al
Application No. 09/352,466
Filed: July 13, 1999
Attorney Docket No. A-195CDD

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 17, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 1.17(c)) within the time period provided in 37 CFR 1.192(a). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed November 21, 2003, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.192(b) & 1.197(c). As no claim was allowed, the-above-identified application became abandoned on January 22, 2004. See MPEP 1215.04.

The above-identified application is being revived solely for purposes of continuity with a submission under 37 CFR 1.114 (request for continued examination).

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center 1642 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Amendment.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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**MAIL STOP 28-2-C**
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**THOUSAND OAKS, CA 91320-1799**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Virginia C. Broudy et al | : | |
| Application No. 09/352,466 | : | ON PETITION |
| Filed: July 13, 1999 | : | |
| Attorney Docket No. A-195CDD | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed December 29, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed February 28, 2005 which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on May 29, 2005.

The instant petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentionally delay have been received. Accordingly, the reply to the non-final Office action of February 28, 2005 is accepted as having been unintentionally delayed.

This matter will be referred to Technology Center AU 1643.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (571) 272-3220.

Wan Laymon
Wan Laymon
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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**AMGEN INC.**
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**ONE AMGEN CENTER DRIVE**
**THOUSAND OAKS CA 91320-1799**

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APR 30 2008

OFFICE OF PETITIONS

In re Application of
Virginia C. BROUDY et al.
Application No. 09/352,466
Filed: July 13, 1999
Attorney Docket No. **A-195CDD**

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 31, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed December 19, 2006, and no extension of time under the provisions of 37 CFR 1.136(a) was obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on February 20, 2007. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $1540; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at (571) 272-2783.

This application is being referred to Technology Center AU 1643 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

David Bucci
Petitions Examiner
Office of Petitions

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SEP 21 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Beyer Weaver & Thomas LLP
P.O. Box 778
Berkeley, CA 94704-0778

In re Application of
Paul J. Matsuda et al.
Application No. 09/352,468
Filed: July 14, 1999
For: CONDUCTING COMMERCE BETWEEN INDIVIDUALS

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in reply to the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office, on September 10, 2004.

The petition is **GRANTED** in view of the following evidence of timely filing :

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____ which identifies the application by serial number and the type of Response that was filed on that date.

☒ Certificate of Mailing/Transmission signed on January 27, 2004 and supported by a statement under 37 C.F.R. 1.8(b)(3).

☐ Hand Delivery Receipt of the specific documents submitted dated _____.

☐ Certificate of Transmission of CPA under 37 C.F.R. 1.6 filed on _____.

☐ Express Mail Receipt under 37 C.F.R. 1.10 dated _____.

This application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response filed with the petition, then to the examiner for prompt action on the response.

SNM/vdb: 9/16/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

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SLATTLER JOHANSEN & ADELI
P O BOX 51860
PALO ALTO, CA 94303

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MAY 06 2005

OFFICE OF PETITIONS

In re Application of :
Kevin E. Brehmer, et al. :
Application No. 09/352,494 :
Filed: July 13, 1999 :
Attorney Docket No. 03588.P002 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 4, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed February 19, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 20, 2004.

In view of the submission of the petition fee in the large entity amount of $1,330, status as a small entity has been removed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 2600, Art Unit 2615 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6

MAILED

JAN 3 1 2003

Technology Center 2600

SKJERVEN MORRILL LLP
25 METRO DRIVE
SUITE 700
SAN JOSE CA 95110

In re Application of :
David N. Suggs et al :
Application No. 09/352,659 :
Filed: July 6, 1999 :
For: **WAVETABLE AUDIO SYNTHESIZER WITH LEFT OFFSET, RIGHT OFFSET AND EFFECTS VOLUME CONTROL** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on December 13, 2002.

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys and agents of record in this application, including all attorneys and agents associated with Customer Nos. 24251 and 27869 are removed from record.

All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4701

cc: Mark Zagorin, Esq.
Zagorin, O'Brien & Graham, LLP
401 West 15th Street, Suite 870
Austin, TX 78701

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS
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Washington, D.C. 20231

Paper No. 6

Mailed
FEB 4 2000
Director's Office
Group 2700

CHUK DAVID CHAN
12779 FAIR BRIAR LANE
FAIRFAX , VA 22033

In re Application of
Chuk David Chan
Application No.: 09/352,661
Filed: July 7, 1999
For: METHOD AND APPARATUS FOR RECORDING INCIDENTS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the renewed Petition to Make Special, filed January 10, 2000.

The petition now meets all requirements.

For the above stated reasons, the petition is **GRANTED.**.

The application file will be forwarded to the examiner for expedited prosecution.

If the examiner can make this application special without prejudice to any possible interfering applications, and he or she should make a rigid search for such, he or she is authorized to do so for the next action. Should the application be rejected, the application will not be considered special for the subsequent action unless the applicant promptly makes a bona fide effort to place the application in condition for allowance, even if it is necessary to have an interview with the examiner to accomplish this purpose.

If the examiner finds any interfering application for the same subject matter, he or she should consider such application simultaneously with this application and should state in the official letter of such application that he or she is taking it out of its turn because of possible interference.

Should an appeal be taken in this application or should this application becomes involved in an interference, consideration of the appeal and the interference will be expedited by all Patent and Trademark Office officials concerned, contingent likewise upon diligent prosecution by the applicant.

Kenneth A. Wieder

Kenneth Wieder
Special Program Examiner
Technology Center 2700
Communications & Information Processing
(703) 305-4710

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 29

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MAR 1 1 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

BIRCH, STEWART, KOLASCH & BIRCH, LLP
P.O. BOX 747
FALLS CHURCH VA 22040-0747

| | | |
|---|---|---|
| In re Application of | : | |
| Chuk David Chan | : | |
| Application No. 09/352,661 | : | DECISION ON REQUEST TO |
| Filed: July 7, 1999 | : | WITHDRAW AS ATTORNEY |
| For: **METHOD AND APPARATUS FOR RECORDING INCIDENTS** | : | |

This is a decision on the request to withdraw as attorney/agent of record filed on February 25, 2003.

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw, and
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf, and
(3) be *approved* at least thirty (30) days prior to the maximum extendable period for response to any outstanding Office Action, and
(4) indicate the address to which future correspondence should be mailed.

Petitioner has met all of the above. Accordingly, the request is **GRANTED**.

All attorneys and agents of record in this application, including all attorneys and agents associated with Customer No. 02292 are removed from record.

All future communications from the Office will be directed to the address listed below until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4701

cc: C. David Chan
11 Westview Avenue
North Salem, NY 10560

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 18

Scott A. Horstemeyer
Thomas Kayden Horstemeyer & Risley
100 Galleria Parkway, NW
Suite 1500
Atlanta, GA 30339-5948

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MAR 29 2004
OFFICE OF PETITIONS

In re Application of :
Louis F. Villarosa Jr. :
Application No. 09/353,120 : ON PETITION
Filed: July 14, 1999 :
Attorney Docket No. 061607-1100 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 1, 2004, to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner in reply to the final Office action mailed April 23, 2003, which set a period for reply of three months. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on July 24, 2003.

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

The application file is being forwarded to Technology Center AU 2631 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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RAE-VENTER LAW GROUP PC
PO BOX 1898
MONTEREY CA 93942-1898

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JUN 09 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Malinow, et al. | : | |
| Application No. 09/353,126 | : | DECISION ON PETITION |
| Filed: July 14, 1999 | : | |
| Attorney Docket No. CSHL.005.01US | : | |

This is a decision on the "PETITION FOR FILING DATE UNDER 37 CFR 1.53(b)", filed March 25, 2005, to accord the above-identified application a filing date of July 14, 1999.

The petition is **DISMISSED AS MOOT**.

The application was deposited on July 14, 1999 with four sheets of drawings and method claims.[1] Accordingly, the application was accorded a filing date of July 14, 1999. On February 16, 2005, the Office mailed a "Notice of Drawing Inconsistency With Specification", stating that Figures 5A and 5B are listed in the specification, but not contained in the drawings. The Notice set a non-extendable period for reply of one month or thirty days, whichever was longer. Applicant filed the instant petition on March 25, 2005 (made timely by including a Certificate of Mailing dated March 18, 2005 - 30 days from February 16, 2005). Accompanying the petition was an amendment cancelling reference to all drawing figures.

---

[1] As stated in MPEP § 601.01(f), it is the practice of the PTO to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence).

The application is being forwarded to the Office of Patent Publication for processing of the amendment cancelling reference to the drawing figures.

Telephone inquiries specific to this decision may be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 15

Thomas J. D'Amico Esq.
Dickstein Shapiro Morin & Oshinsky L.L.P.
2101 l Street, NW
WASHINGTON D.C. 20037-1526

MAIL

JUL 1 1 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of: )
James J. Macor )
Application No.: 09/353,316 )
Filed: July 14, 2000 )
For: COMPUTER ND MOBILE COMMUNICATION SYSTEM

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw As Attorney filed March 14, 2002

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

Accordingly, the request is **GRANTED**.

The following Attorney is withdrawn from Record: **Thomas J. D'Amico, Esq**.
All the listed attorneys except Thomas J. D'Amico in the attachment A of the Declaration and Power of Attorney are still of record. As indicated above, the request does not indicate clearly that the attorney of record is signing on behalf of all other Attorneys.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorneys. Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office of any change in correspondence address to ensure receipt of all communications from the Office.

The application file is being returned to the Technology Center's central files to await a response to the non-final Office action of March 29, 2002.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: Paul Gardon
Avaya Inc.
101 Crawfords Corner Road
Holmdel, NJ 07733-3030

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Paper No. 22

BIRCH, STEWART, KOLASCH & BIRCH, LLP
P.O. BOX 747
FALLS CHURCH VA 22032-0747

**MAIL**

JUN 0 2 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
James J. Macor
Application No. 09/353,316
Filed: July 14, 1999
For: **COMPUTER AND MOBILE COMMUNICATION SYSTEM**

:DECISION ON PETITION

This is a decision on the petition filed January 14, 2004, based on M.P.E.P. 711.03(c)(II), and pursuant to 37 C.F.R. § 1.181(a), to withdraw the holding of abandonment. This decision is also responsive to the supplemental information filed via facsimile on March 18, 2004.

This application became abandoned for failure to timely file a proper reply to the Final Office action mailed November 13, 2002. A copy of the Final rejection was re-mailed to a new correspondence address on April 29, 2003 but did not reset the period for response. A Notice of Abandonment was mailed on November 18, 2003.

Petitioner alleges that the Final Office action (copy re-mailed on April 30, 2003) was not received.

Based on M.P.E.P. § 711.03(c) *[See also Notice entitled Withdrawing the Holding of Abandonment When Office Actions Are Not received, 1156 O.G. 53 (November 16, 1993)]*, in absence of any irregularity in the mailing of an Office Action, there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office communication must include:

(a) a statement from the practitioner stating that the Office communication was not received by the practitioner;

(b) a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and,

(c) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

A review of the instant application reveals that there was no irregularity in the mailing of the Final Office action mailed November 13, 2002 (paper no. 17) since it was mailed to the address of record at that time (Paul Gardon, AVAYA INC., 101 Crawfords Corner Road, Holmdel, NJ). It is further noted that in the instant application, a Change of Address was filed on December 13, 2003 (paper No. 18), exactly one month after the November 13, 2002 mailing date of the Final rejection.

37 C.F.R. § 1.33 states:

(a) The applicant, the assignee(s) of the entire interest (see §§ 3.71 and 3.73 ) or an attorney or agent of record (see §1.34(b)) may specify a correspondence address to which communications about the application are to be directed. All notices, official letters, and other communications in the application will be directed to the correspondence address or, if no such correspondence address is specified, to an attorney or agent of record (see § 1.34(b)), or, if no attorney or agent is of record, to the applicant, so long as a post office address has been furnished in the application. Double correspondence with an applicant and his attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent be made of record and a correspondence address has not been specified, correspondence will be held with the one last made of record.

In a facsimile filed March 18, 2004, petitioner Scott Lowe submits that a copy of the Final rejection originally mailed November 13, 2002 was re-mailed to the new correspondence address (BIRCH, STEWART, KOLASCH & BIRCH, PO Box 747, Falls Church, VA) on April 29, 2003. Furthermore, the petition filed January 14, 2004 submits copies of docket records from BIRCH, STEWART showing that the Office action mailed April 29, 2003 was not received.

A review of the file finds that the original Final rejection mailed November 13, 2002 was re-mailed to the new attorney at the new correspondence address as a courtesy on April 29, 2003. Absent any indication that the original Final rejection was vacated or that the time period for reply was reset to run from the date of the new mailing, **the time period for response continued to run from the date of the original November 13, 2002 mail date.** A further review of the file finds no evidence that the Final rejection mailed November 13, 2002 was vacated or reset to run from the date of the re-mailing on April 29, 2003.

It is noted that the Notice of Abandonment should have properly indicated that the application is abandoned for failure to reply to the Final rejection mailed November 13, 2002. The Office regrets the inconvenience to petitioner.

Accordingly, copies of docket records from BIRCH, STEWART, KOLASCH & BIRCH in regard to non-receipt of the April 29, 2003 Final Office action are insufficient inasmuch as petitioner fails to submit: 1) any evidence that a Change of Correspondence Address and/or Change in Power of Attorney was properly filed ***prior*** to the November 13, 2002 mailing of the Final rejection which resulted in an irregularity in the mailing of the Office action; or 2) copies of the necessary statements of non-receipt supported by copies of docket records from the attorney of record at that time (Mr. Paul Gardon) to evidence his non-receipt of the November 13, 2002 Final rejection.

Accordingly, the petition is **DENIED.**

Petitioner may submit a request for reconsideration with **TWO MONTHS** of the date of this decision. Any request for reconsideration must address the deficiencies outlined above. Alternatively, petitioner may want to consider filing a petition to revive an unintentionally abandoned application under 37 CFR 1.137(b). Any question regarding the filing of a petition to revive should be directed to the Office of Petitions at 703- 305- 9285.

The file is being returned to the Files Repository.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 24

FEB 2 2 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

BIRCH, STEWART, KOLASCH & BIRCH, LLP
P.O. BOX 747
FALLS CHURCH VA 22032-0747

In re Application of
James J. Macor
Application No. 09/353,316
Filed: July 14, 1999
For: **COMPUTER AND MOBILE COMMUNICATION SYSTEM**

DECISION ON PETITION

This is a decision on the request for reconsideration filed September 2, 2004, based on M.P.E.P. 711.03(c)(II), and pursuant to 37 C.F.R. § 1.181(a), to withdraw the holding of abandonment.

This application became abandoned for failure to timely file a proper reply to the Final Office action mailed November 13, 2002. A review of the file finds that the original Final rejection mailed November 13, 2002 was re-mailed to the new attorney at the new correspondence address as a courtesy on April 29, 2003. The courtesy copy of the outstanding Office action did not reset the period for response. A Notice of Abandonment was mailed on November 18, 2003.

Petitioner alleges that the Final Office action mailed November 13, 2002 was not received. In support thereof, a copy of the docket records for the address of record at the time the Final Office communication was mailed, has been provided and referenced in the accompanied request.

Based on M.P.E.P. § 711.03(c) *[See also Notice entitled Withdrawing the Holding of Abandonment When Office Actions Are Not received, 1156 O.G. 53 (November 16, 1993)]*, in absence of any irregularity in the mailing of an Office Action, there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office communication must include:

(a) a statement from the practitioner stating that the Office communication was not received by the practitioner;

(b) a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and,

(c) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

Petitioner's statement that "A search of the file jacket and docket records at Avaya revealed that no communication was received from the USPTO, dated November 13, 2002 regarding the above-identified application." is taken as though the practitioner personally searched the file

jacket and docket records as required and thus the petition has met the requirements of M.P.E.P. § 711.03(c), section II.

In view of the above, there is showing of non-receipt of the Office action at the correspondence address of record at that time. Accordingly, the application was not abandoned in fact.

The petition is **GRANTED.**

Accordingly, the Notice of Abandonment is vacated and the holding of abandonment is withdrawn.

Given the amount of time that has expired since the Final Office action was originally mailed, i.e., November 13, 2002, the application file is being forwarded to the examiner to update the search and action as appropriate. From there, the application file will be forwarded to TC 2600 technical support staff to mail the new Office action prepared by the examiner. The shortened statutory period for reply will be set to run from the mailing date of the new action.

Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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CHRISTIAN ULLSPERGER
TOWNSEND & TOWNSEND & CREW LLP
TWO EMBARCARDERO CENTER, EIGHTH FLOOR
SAN FRANCISCO, CA 94111--3834

**COPY MAILED**

OCT 2 4 2007

**OFFICE OF PETITIONS**

In re Application of :
Tattanahalli L. Nagabhushan, et al. :
Application No. 09/353,423 : ON PETITION
Filed: July 15, 1999 :
Attorney Docket No. 016930-001120US :

This is a decision on the petition, filed April 23, 2007, to revive the above-identified application under 37 CFR 1.137(b).

The petition is GRANTED.

**The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.**

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of November 3, 2005. A Notice of Abandonment was mailed on May 24, 2006. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2).

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Notice of Appeal and appeal fee of $500; (2) the petition fee of 1,500; and (3) an adequate statement of unintentional delay.

This application is being referred to Technology Center AU 1632 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. Inquiries relating to the prosecution of the application should be referred to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

MAILED

MAR 3 1 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ANDRES RIVERA
and KEITH R. D'ALESSIO

Appeal No. 2002-1799
Application No. 09/353,592

HEARD: March 13, 2003

Before KIMLIN, KRATZ and POTEATE, Administrative Patent Judges.
KRATZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-30, which are all of the claims pending in this application.

BACKGROUND

Appellants' invention relates to an applicator for dispensing polymerizable or cross-linkable material, a method of making same and a method of using such an applicator for applying such material to a substrate. The applicator device includes an

outer container including an inner container there within. The inner container holds a polymerizable or cross-linkable material. A rate modifier, such as an initiator, accelerator or inhibitor for the polymerizable or cross-linkable material, is normally maintained separate from, or in non-contacting relationship with, the polymerizable or cross-linkable material in such an applicator. See, e.g. the paragraph bridging pages 9 and 10 of appellants' specification.

Appellants state that the "rejected claims stand or fall together" (brief, page 3, item No. V.). Consequently, we select claim 1 as the representative claim in deciding this appeal. See 37 CFR § 1.192(c)(7)(2000). Representative claim 1 is reproduced below.

> 1. An applicator for dispensing a polymerizable or cross-linkable material, comprising:
> an outer container;
> an inner container disposed within said outer container, said inner container containing a polymerizable or cross-linkable material; and
> a rate modifier for said polymerizable or cross-linkable material disposed on an outer surface of said inner container.

The sole prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

| | | |
|---|---|---|
| Leung | 5,928,611 (Filed June 07, 1995) | Jul. 27, 1999 |

Claims 1-30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Leung.

We refer to the briefs and to the answer for a complete exposition of the opposing viewpoints expressed by appellants and the examiner concerning the issues before us on this appeal.

OPINION

Having carefully considered each of appellants' arguments for patentability as set forth in the briefs, appellants have not persuaded us of reversible error on the part of the examiner. Accordingly, we will affirm the examiner's rejection as set forth in the answer. We add the following for emphasis.

The applicator of representative claim 1 requires that a rate modifier is disposed on an outer surface of the inner container while a polymerizable or cross-linkable material is located inside the inner container.

Appellants' acknowledge at page 5 of their brief that the applicator of figure 3 of Leung includes an outer container (200), and an inner container (400), which inner container holds an amount of monomer (300) therein. Moreover, appellants' acknowledge that "Leung also discloses that the polymerization or cross-linking accelerator or initiator can be located in the applicator at a position other than being loaded in or on the

applicator tip ... for example, in the device of FIG. 3, the initiator may be coated on the internal surface of body 200" (brief, page 5).

Based on Leung's teachings, the examiner has determined that it would have been obvious for one of ordinary skill in the art to coat the outer surface of the inner container (400) of Leung's Figure 3 embodiment with the rate modifier rather than the inner surface of the outer container (200) and as a result arrive at the subject matter of appellants' representative claim 1. As suggested by the examiner, one of ordinary skill in the art would have recognized from Leung's teachings that either of those locations would result in the modifier being available at essentially the same relative location of the applicator and in a location satisfying Leung's non-contact requirement. That alternative location of the rate modifier would have immediately commended itself to one of ordinary skill in the art as an alternative workable, non-contacting location for the modifier rather than the inner surface of the outer container location specifically exemplified in Leung. Consequently, one of ordinary skill in the art would have been led to provide the applicator of Leung with rate modifier disposed at the claimed inner container outer surface location.

The examiner's position is bolstered by a review of the examples at column 12 of Leung, which are referred to by the examiner at page 8 of the answer. In this regard, the squeezing property of the flexible outer container coupled with the nearness thereof to the inner container outer surface so as to result in contact of those two surfaces for exerting a crushing force on the inner container as referred to in the examples results in the rate modifier being arranged next to or in contact with the outer surface of the inner container. In other words, the rate modifier would be "disposed on an outer surface of said inner container" as required by representative claim 1 even when coating the inner surface of the outer container therewith as expressly taught by Leung. Accordingly, one of ordinary skill in the art would have recognized that whether the rate modifier is initially coated on the inner surface of the outer container or the outer surface of the inner container, the resulting applicator would serve substantially the same function.

Therefore, even if we could agree with appellants that Leung does not explicitly describe coating the outer surface of the inner container by the use of the alternative language "lined or coated" at column 10, lines 47-51 of the patent, we cannot agree with appellants that Leung would not have reasonably led one of

ordinary skill in the art to "dispose" the rate modifier on the outer surface of the inner container based on the overall teachings of Leung.

In light of the above, appellants' arguments to the effect that one of ordinary skill in the art would not have been motivated to dispose the rate modifier (accelerator or initiator) on the outer surface of the inner container (400, FIG. 3) of Leung as one alternative is not found persuasive. Rather, we agree with the examiner that one of ordinary skill in the art would have been led to employ an inner container outside surface location for the rate modifier as an alternative to the outer container inside surface location mentioned by Leung (column 10, lines 43-53). In that regard, one of ordinary skill in the art would have readily recognized that there are only a limited number of possible places, including the outside surface of the inside container, for putting the rate modifier in the applicator container in a non-contacting relationship with the polymerizable material therein.

Consequently, it is our determination that the examiner has reasonably established that one of ordinary skill in the art would have envisioned the selection of the outside surface of the inside container as one of those limited alternatives which were

available as options for keeping the rate modifier separate from the polymerizable material in the Figure 3 applicator of Leung as required by Leung and with a reasonable expectation of success in so doing.

As a final point, we note that Leung is not limited to the preferred or exemplified embodiments disclosed therein as appellants would appear to argue. Rather, Leung may be relied upon for all that patent would have reasonably conveyed to one having ordinary skill in the art. See In re Beattie, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1043 (Fed. Cir. 1992); In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991); Merck & Co., Inc. v. Biocraft Laboratories, Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1847 (Fed. Cir. 1989). Accordingly, for the reasons set forth above and in the answer, we shall sustain the examiner's rejection.

CONCLUSION

The decision of the examiner to reject claims 1-30 under 35 U.S.C. § 103 as being unpatentable over Leung is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

| | |
|---|---|
| EDWARD C. KIMLIN<br>Administrative Patent Judge | ) |
| PETER F. KRATZ<br>Administrative Patent Judge | ) BOARD OF PATENT APPEALS AND INTERFERENCES |
| LINDA R. POTEATE<br>Administrative Patent Judge | ) |

PFK/sld

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 6407375
Issue Date: June 18,2002
Application No. 09353674
Filed: July 15,1999
Attorney Docket No. LSP-25

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed May 18,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of May 18,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,407,375 | 2002-06-18 | 09/353,674 | 1999-07-15 | 69012-33 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /W. Scott Harders/ | Date (YYYY-MM-DD) | 2007-05-17 |
| Name | W. Scott Harders | Registration Number | 42629 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6629942 | 2003-10-07 | 09/353,858 | 1999-07-15 | 74196/96136 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Marc E. Hankin/ | Date (YYYY-MM-DD) | 2008-02-06 |
| Name | Marc E. Hankin | Registration Number | 38908 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6629942
Issue Date: October 7,2003
Application No. 09353858
Filed: July 15,1999
Attorney Docket No. 74196/ 96136

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 6,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 6,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 6

MAIL

OCT 05 2001

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Akin Gump Strauss Hauer & Feld, LLP
1900 Frost Bank Plaza
816 Congress Avenue
Austin, Texas 78701

| | | |
|---|---|---|
| In re Application of: John Crescenti et al. | ) | |
| Application No. 09/354,063 | ) | **DECISION ON REQUEST FOR** |
| Filed: July 15, 1999 | ) | **WITHDRAWAL AS ATTORNEY** |
| For: MODULAR BACKUP AND | ) | |
| RETRIEVAL SYSTEM | ) | |

This is a decision on the Request To Withdraw from Representation filed September 24, 2001.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is deficient in the following aspects: (1) each attorney for whom withdrawal is requested must be individually listed - a referral to a power of attorney must identify it unambiguously (for example, referring to the date of filing); (2) there is no statement that Gary W. Hamilton is signing on behalf of the other attorneys of record and is ***authorized*** to sign on behalf of the other attorneys. Furthermore, there is no indication that the client has been apprised of this request for withdrawal. Therefore, the request is **DENIED**.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant. Applicant is reminded of the obligation to promptly notify the Office of any change in correspondence address to ensure receipt of all communications from the Office.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce
(703) 306-4160

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JJGJr: 06-06

Paper No: __

UNIVERSITY OF MARYLAND, BALTIMORE
TEC-COM/ORD
515 W. LOMBARD STREET
BALTIMORE MD 21201

COPY MAILED

JUN 0 5 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Lakowicz, et al. | : | |
| Application No. 09/354,106 | : | NOTICE |
| Filed: 15 July, 1999 | : | |
| Attorney Docket No. 2065-143A | : | |
| Patent No. 6,197,543 | : | |
| Issue Date: 6 March, 2001 | : | |

This is a notice regarding the notification to the Office that the patent holder no longer claims small entity status filed on 10 February, 2006–**in this case the Office does not acknowledge a request for acceptance of a fee deficiency submission (properly considered under 37 C.F.R. §1.28) because no such request was made at the filing noted above**.

**NOTE:** **There is no indication that Petitioner herein was ever empowered to prosecute the instant application. If Petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary**

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 C.F.R. §1.28(c)

is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 C.F.R. §1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this notice is intended to imply that an investigation was done.

This file is released to image file wrapper (IFW) storage.

Inquiries regarding this application should be directed to the Technology Center. The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

cc:
GEORGE R. REPPER
ROTHWELL FIGG ERNST & MANBECK PC
SUITE 800
1425 K STREET NW
WASHINGTON, DC 20005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JJGJr: 06-06

Paper No: __

UNIVERSITY OF MARYLAND, BALTIMORE
TEC-COM/ORD
515 W. LOMBARD STREET
BALTIMORE MD 21201

COPY MAILED
JUN 26 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Lakowicz, et al. | : | |
| Application No. 09/354,106 | : | NOTICE |
| Filed: 15 July, 1999 | : | |
| Attorney Docket No. 2065-143A | : | |
| Patent No. 6,197,534 | : | |
| Issue Date: 6 March, 2001 | : | |

This is a **corrected notice–mailed because the original Notice carried an incorrect patent number**[1]--regarding the notification to the Office that the patent holder no longer claims small entity status filed on 10 February, 2006–**in this case the Office does not acknowledge a request for acceptance of a fee deficiency submission (properly considered under 37 C.F.R. §1.28) because no such request was made at the filing noted above**.

**NOTE:** **The address of record is other than that of the petition. If Petitioner desires to receive future correspondence regarding this application, the documentation must be submitted. A courtesy copy of this decision will be mailed to Petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary**

[1] The Notice of 5 June, 2006, erroneously identified the natter as Patent No. 6,197,543, rather than Patent No. 6,197,534.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 C.F.R. §1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 C.F.R. §1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore, nothing in this notice is intended to imply that an investigation was done.

This file is released to image file wrapper (IFW) storage.

Inquiries regarding this application should be directed to the Technology Center. The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

cc:
GEORGE R. REPPER
ROTHWELL FIGG ERNST & MANBECK PC
SUITE 800
1425 K STREET NW
WASHINGTON, DC 20005

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 6

PAUL ESATTO JR
SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY NY 11530

COPY MAILED

SEP 6 2001

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Morita | : | DECISION |
| Application No. 09/354,190 | : | GRANTING PETITION |
| Filed: July 15, 1999 | : | AND NOTICE OF |
| Attorney Docket No. 12827 | : | MISSING PARTS |

This is a decision on the petition filed April 11, 2001, under 37 CFR 1.182 which is being treated as a request, to disregard the English language papers presented on filing, and accord the above-identified application a filing date of July 15, 1999, based upon the contents (specification, drawing, claims) of Japanese priority document 201789/1998 which was present in this file on that date.

The petition is **GRANTED**.

This application as filed lacks an oath or declaration executing the Japanese priority document deposited July 15, 1999. Rather, the declaration present on filing executes only the English language papers that concededly were incorrectly filed. Applicant is given TWO MONTHS from this mailing to supply the required oath or declaration and pay the surcharge for late completion of an application, to avoid abandonment. Extensions of time under 37 CFR 1.136(a) are available. 2 mos

The petition asserts that the English language papers (specification and claims) present on filing were inadvertently submitted and do not correspond to the aforementioned Japanese priority document. The petition includes a verified translation of the priority document, correctly notes that an application may be accepted even if originally filed in a language other than English, pursuant to 37 CFR 1.52(d) and, in essence, requests that the papers be considered a reply to the outstanding Office action. It is noted that as the Office action is a restriction requirement based on the English language claims, the substantive examination on the merits has not yet begun.

Inspection of the verified translation reveals that, by virtue of the Japanese priority document, which was present in the USPTO on July 15, 1999 a specification, at least one [6] claim[s], any necessary drawings described in the Japanese specification (four

sheets, drawing figures 1 through 7), were all present in the USPTO on that date, notwithstanding that these required components were in a foreign language in the priority document. As such, on petition, all the components required by 35 U.S.C. 111(a) and 37 CFR 1.53(b) for according the above-identified papers a filing date of July 15, 1999, are considered to have been met by the Japanese priority document. To facilitate subsequent processing, the undersigned has made a photocopy of the priority document, which will be used for according this application a filing date as a non-English language application by the Office of Initial Patent Examination (OIPE)

While the verified translation may be employed in further prosecution, applicant may wish to subsequently file a reformatted version of the verified translation so as to be more in accordance with U.S. practice. See 37 CFR 1.71. Similarly, applicant should *promptly* present a preliminary amendment adding any necessary additional claims consonant with the correct specification.

The English language papers present on filing are considered withdrawn and will not be further used during the prosecution of this application.

The new oath or declaration (and any other preliminary papers) should be sent to OIPE, captioned for BOX MISSING PARTS at the USPTO address noted in the letter-head.

The $130 fee required by 37 CFR 1.17(k) due to filing a non-English language specification has been charged to deposit account No. 19-1013.

The application file is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of July 15, 1999, using the already prepared photocopy of the priority document (in Japanese), and an indication that the application papers contained 6 claims and 4 sheets of drawings having drawing figures 1 though 7, on filing.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-1820.

Brian Hearn

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 14

Barry E. Bretschneider
Morrison & Foerster
2000 Pennsylvania Avenue, N.W.
Washington, DC 20006-1888

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APR 30 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hiromi Watanabe et al. | : | |
| Application No. 09/354,464 | : | ON PETITION |
| Filed: July 15, 1999 | : | |
| Attorney Docket No. 530172000100 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed March 4, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lack(s) item(s) (1).

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of May 6, 2002. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, or the filing of a continuing application. See MPEP 711.03(c)(III)(A)(2). Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee) or the filing of a continuing application. Alternatively, the reply requirement may be met by the filing of a

submission under 37 CFR 1.129(a) if the above-identified application is eligible for such transitional practice.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
PO Box 1450
Arlington, VA 22313-1450

By facsimile: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: "Courtesy Copy of Advisory Action"

Cc: Morrison & Foerster
1650 Tysons Blvd., Suite 300
McLean, VA 22102

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Arlington, VA 22313-1450
www.uspto.gov

Paper No. 17

Barry E. Bretschneider
Morrison & Foerster
1650 Tysons Boulevard, Suite 300
McLean, VA 22102

COPY MAILED

JUN 0 4 2003

OFFICE OF PETITIONS

In re Application of :
Hiromi Watanabe et al. :
Application No. 09/354,464 : ON PETITION
Filed: July 15, 1999 :
Attorney Docket No. 530172000100 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed May 30, 2003, to revive the above-identified application.

The petition is **GRANTED**.

This application is being forwarded to the primary examiner in Technology Center AU 1772 for processing the Continued Prosecution Application (CPA) filed with the instant petition.

Telephone inquiries regarding this decision may be directed to the undersigned at (703) 308-6911.

Latrice Bond

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

OIPE
MAY 30 2003
PATENT & TRADEMARK OFFICE

PATENT
Docket No. 530172000100

**CERTIFICATE OF HAND DELIVERY**

I hereby certify that this correspondence is being hand filed with the United States Patent and Trademark Office in Washington, D.C. on May 30, 2003.

For

Debbie Labriny

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Hiromi WATANABE et al.

Serial No.: 09/354,464

Filing Date: July 15, 1999

For: STOCK MATERIAL FOR CONTAINER BODY OF INSULATING PAPER CONTAINER, INSULATING PAPER CONTAINER AND PROCESS FOR MAKING THEM

Examiner: Sow-Fun Hon

Art Unit: 1772

RECEIVED
JUN 09 2003
TC 1700

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JUN 04 2003
OFFICE OF PETITIONS

**<u>SUPPLEMENTAL</u> PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 CFR 1.137(b)**

Commissioner for Patents
Washington, D.C. 20231

Sir:

This supplements and incorporates by reference, in its entirety, applicants' PETITION TO REVIVE UNINTENTIONALLY ABANDONED APPLICATION UNDER 37 CFR 1.137(B), filed on March 4, 2003.

Included herewith is a request for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) and a copy of applicants' unentered response and amendment, originally filed via facsimile with Examiner Hon on August 22, 2002. Since this application was filed prior to May 29, 2000, a CPA is appropriate, rather than an RCE.

By agreement reached between applicants' undersigned representative, Ms. Latrice Bond, and Examiner Hon on May 29, 2003, the filing of the attached CPA will result in the granting of applicants' petition of March 4, 2003, revival of this application, and entry of applicants' response and amendment of August 22, 2002. Examiner Hon will then enter and take further action on this application.

Although it is believed that no fee is due for entry and consideration of this supplemental petition, in the event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. **530172000100**.

Respectfully submitted,

Dated: May 30, 2003

By: _____

Wayne C. Jaeschke, Jr.
Reg. No. 38,503

Morrison & Foerster LLP
1650 Tysons Boulevard, Suite 300
McLean, Virginia 22102
Telephone: 703-760-7756
Facsimile: 703-760-7777

PTO/SB/29(10-00)
Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

OIPE JC141
MAY 30 2003
PATENT & TRADEMARK OFFICE

# CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL

***Submit an original, and a duplicate for fee processing.***

*(Only for Continuation or Divisional applications under 37 CFR 1.53(d))*

[X] *CHECK BOX, if applicable:* DUPLICATE

*Address to:*

**Box CPA**
**Commissioner for Patents**
**2011 South Clark Place**
**Room 1B03, Crystal Plaza 2**
**Arlington, Virginia, 22202**

| | |
|---|---|
| *Attorney Docket No. of Prior Application* | 530172000100 |
| *First Named Inventor* | Hiromi WATANABE |
| *Examiner Name* | Sow Fun HON |
| *Group Art Unit* | 1772 |
| *Express Mail Label No.* | |

This is a request for a [X] continuation or [ ] divisional application under 37 CFR 1.53(d) (continued prosecution application (CPA)) of prior application number 09/354,464 filed on July 15, 1999, entitled

US PATENT APPLICATION SN 09/354,464

RECEIVED
JUN 09 2003
TC 1700

***NOTES***

***FILING QUALIFICATIONS:*** *The prior application identified above must be a nonprovisional application that is either: (1) complete as defined by 37 CFR 1.51 (b), or (2) the national stage of an international application in compliance with 35 U.S.C 371. Effective May 29, 2000, a CPA may only be filed in a utility or a plant application if the prior nonprovisional application was filed before May 29, 2000. A CPA may be filed in a design application regardless of the filing date of the prior application. See "Request for Continued Examination Practice changes to and Provisional Application Practice," Final Rule, 65 Fed. Reg. 50092 (Aug. 16, 2000); Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office (Apr. 11, 2000).*

***C-I-P NOT PERMITTED:*** *A continuation-in-part application cannot be filed as a CPA under 37 CFR 1.53 (d), but must be filed under 37 CFR 1.53(b).*

***EXPRESS ABANDONMENT OF PRIOR APPLICATION:*** *The filing of this CPA is a request to expressly abandon the prior application as of the filing date of the request for a CPA. 37 CFR 1.53(b) must be used to file a continuation, divisional, or continuation-in-part of an application that is not to be abandoned.*

***ACCESS TO PRIOR APPLICATION:*** *The filing of this CPA will be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. 122 to the extent that any member of the public who is entitled under the provisions of 37 CFR 1.14 to access to, copies of, or information concerning, the prior application may be given similar access to, copies of, or similar information concerning, the other application or applications in the file jacket.*

***35 U.S.C. 120 STATEMENT:*** *In a CPA, no reference to the prior application is needed in the first sentence of the specification and none should be submitted. If a sentence referencing the prior application is submitted, it will not be entered. A request for a CPA is the specific reference required by 35 U.S.C. 120 and to every application assigned the application number identified in such request, 37 CFR 1.78(a).*

1. [X] Enter the unentered amendment previously filed on August 22, 2002 under 37 CFR 1.116 in the prior nonprovisional application.
2. [ ] A preliminary amendment is enclosed.
3. [ ] This application is filed by fewer than all the inventors named in the prior application, 37 CFR 1.53(d)(4).
   a. [ ] DELETE the following inventor(s) named in the prior nonprovisional application: 09354464
   b. [ ] The inventor(s) to be deleted are set forth on a separate sheet attached hereto
4. [ ] A new power of attorney or authorization of agent (PTO/SB/81) is enclosed.
5. Information Disclosure Statement (IDS) is enclosed:
   a. [ ] PTO-1449
   b. [ ] Copies of IDS Citations

06/03/2003 SLUONG1 00000113 031952 09354464
01 FC:1006 750.00 CH
02 FC:1202 1044.00 CH

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JUN 04 2003
OFFICE OF PETITIONS

PTO/SB/29(10-00)
Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| CLAIM | (1) FOR | (2) NUMBER FILED | (3) NUMBER EXTRA | (4) RATE | (5) CALCULATIONS |
|---|---|---|---|---|---|
| | TOTAL CLAIMS (37 CFR 1.16(c) or (j)) | 78 - 20* = | 58 | x $ 18 = | $ 1044.00 |
| | INDEPENDENT CLAIMS (37 CFR 1.16(b) or (i)) | 3 - 3** = | 0 | x $ = | |
| | MULTIPLE DEPENDENT CLAIMS (if applicable) 37 CFR 1.16(d)) | | | + $ = | |
| | | | | BASIC FEE (37 CFR 1.16) | 750.00 |
| | | | | Total of above Calculations = | 1794.00 |
| | Reduction by 50% for filing by small entity (Note 37 CFR 1.27). | | | | |
| | * *Reissue claims in excess of 20 and over original patent.* ** *Reissue independent claims over original patent.* | | | TOTAL = | $ 1794.00 |

6. [ ] Small entity status: Applicant claims small entity status. See 37 CFR 1.27.
7. The Commissioner is hereby authorized to credit overpayments or charge the following fees to Deposit Account No. 03-1952 :
   a. [x] Fees required under 37 CFR 1.16.
   b. [x] Fees required under 37 CFR 1.17.
   c. [ ] Fees required under 37 CFR 1.18.
8. [ ] A check in the amount of $ _____ is enclosed.
9. [ ] Payment by credit card. Form PTO-2038 is attached.
10. [ ] Applicant requests suspension of action under 37 CFR 1.103(b) for a period of months (not to exceed 3 months) and the fee under 37 CFR 1.17(i) is enclosed.
11. [ ] New Attorney Docket Number, if desired _____
    *[Prior application Attorney Docket Number will carryover to this CPA unless a new Attorney Docket Number has been provided herein.]*
12. a. [ ] Receipt For Facsimile Transmitted CPA (PTO/SB/29A)
    b. [x] Return Receipt Postcard (Should be specifically itemized, See MPEP 503)
13. [ ] Other: August 22, 2002

RECEIVED
JUN 0 9 2003
TC 1700

**NOTE:** *The prior application's correspondence address will carry over to this CPA UNLESS a new correspondence address is provided below.*

**14. NEW CORRESPONDENCE ADDRESS**

[ ] *Customer Number or Bar Code Label* or [ ] *New correspondence address below*

| | | | | | |
|---|---|---|---|---|---|
| Name | 25227 PATENT TRADEMARK OFFICE | | | | |
| Address | | | | | |
| City | | State | | Zip Code | |
| Country | | Telephone | | Fax | |

**15. SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

| | |
|---|---|
| *Name (Print/Type)* | Wayne C. Jaeschke, Jr. |
| *Signature* | |
| *Registration No. (Attorney/Agent)* | 38,508 |
| *Date* | May 30, 2003 |

RECEIVED
JUN 0 4 2003
OFFICE OF PETITIONS

I hereby certify that this correspondence is being hand delivered to: Commissioner for Patents, 2011 South Clark Place, Room 1B03, Crystal Plaza 2, Arlington, Virginia, 22202, on the date shown below.

Dated: 5/30/03 Signature: _____ (Jeff McCuller)

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

FULBRIGHT AND JAWORSKI LLP
555 S. FLOWER STREET, 41ST FLOOR
LOS ANGELES, CA 90071

COPY MAILED

JUL 15 2005

OFFICE OF PETITIONS

In re Application of :
Ching-Hwa Kiang :
Application No. 09/354,531 :
Filed: July 15, 1999 :
Attorney Docket No. 1279-286/991 :

ON PETITION

This is a decision in response to the petition, filed May 24, 2005, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The application became abandoned for a failure to reply in a timely manner to the non-final Office action mailed November 15, 2004. This decision precedes the mailing of a Notice of Abandonment.

The petition is found to comply with the requirements of 37 CFR 1.137(b). Accordingly, the petition is **GRANTED**.

It is noted that the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

The application is being referred to Technology Center AU 1651 for consideration of the amendment filed May 24, 2005.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. Inquiries relating to further prosecution should be directed to the Technology Center.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Fulbright & Jaworski L.L.P.
865 south Figueroa
Los Angeles, CA 90017-2571

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

William A. Drucker
Unit 208
610 N. West Street
Alexandria VA 22314

COPY MAILED

MAR 27 2007

OFFICE OF PETITIONS

In re Application of :
Anne Marie Vacher et al. :
Application No. 09/354,570 :
Filed: July 16, 1999 :
Attorney Docket No.: IRISB-0016 :
Title: COSMETIC COMPOSITION :
WHICH INCLUDES AT LEAST ONE :
POLYSACCHARIDE DERIVED FROM :
BACTERIA OF HYDROTHERMAL ORIGIN :

DECISION ON PETITION
UNDER 37 C.F.R. §1.181(A)

This is a decision on the petition under 37 C.F.R. §1.181(a) to withdraw the holding of abandonment, filed on June 23, 2004. The Office regrets the period of delay in issuing the present decision.

The change of address that was submitted on March 16, 2007 has been entered and made of record.

## BACKGROUND

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R §1.113 in a timely manner to the final Office action mailed May 7, 2003, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 C.F.R §1.136(a) were obtained, and no responses were received. Accordingly, the above-identified application became abandoned on August 8, 2003. A notice of abandonment was mailed on March 25, 2004.

With the present petition, Petitioner has alleged that the Office action of May 7, 2003 was not received. A discussion follows.

## RELEVANT PORTION OF THE C.F.R. AND MPEP

37 C.F.R. §1.181(f) sets forth, *in toto*:

> The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

MPEP §601.03 sets forth, *in pertinent part*:

> Where an attorney or agent of record (or applicant, if he or she is prosecuting the application pro se) changes his or her correspondence address, he or she is responsible for promptly notifying the U.S. Patent and Trademark Office (emphasis added) of the new correspondence address (including ZIP Code). The notification should also include his or her telephone number. A change of correspondence address may not be signed by an attorney or agent not of record (see MPEP § 405).

MPEP §711.03(c)(I)(A) sets forth, in toto:

> In Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of Delgar, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of Delgar is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee ( 35 U.S.C. 151) or for failure to prosecute ( 35 U.S.C. 133).
>
> To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

> The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).
> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See Lorenz v. Finkl, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); Krahn v. Commissioner, 15 USPQ2d 1823, 1824 (E.D. Va 1990); In re Application of Fischer, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

## ANALYSIS

37 C.F.R. §1.181(f) indicates that any petition submitted under this portion of the C.F.R. that is not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely. The notice of abandonment was mailed on March 25, 2004, and the present petition was not filed until June 23, 2004. The present petition was submitted over two months after the mailing of the notice of abandonment, and as such, the present petition will be dismissed as untimely.

It is noted in passing that even if this petition were to be accepted as timely filed, it could not be granted.

Petitioner has asserted that the Office communication was not received. He has indicated the reason the mailing was not received was due to the fact that the Office action was "mailed to an old address[1]."

Pursuant to MPEP §711.03(c)(I)(A), re-printed above, an applicant who wishes to establish that an Office mailing was not received must assert the same, must attest to the fact that a search of the file jacket and docket records indicates that the Office communication was not received, and must provide a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed. Petitioner has failed to provide the required attestation pertaining to a search of the file jacket and docket records, and has failed to provide a copy of the docket record.

It is noted in passing that the electronic file has been reviewed, and it does not appear that the relevant mailing was returned by the U.S. Postal Service as undeliverable.

---

1 Petition, page 2.

Moreover, it appears that if the mailing was not received, the non-receipt was due to Petitioner's failure to keep his address current with the Office.

Pursuant to 37 C.F.R. §1.33(a), the Office will direct all notices relating to an application to the correspondence address. The declaration directs all mail to be sent to "William Anthony Drucker, 12th Floor, 1111 Nineteenth Street, N.W., Washington, D.C., 20036." The electronic file indicates that a change of address was included on filing, requesting that the address of record be changed to "William Anthony Drucker, Esq., c/o Jay M. Cantor, Esq., 1299 Pennsylvania Avenue, N.W., Washington, D.C., 20004-2400."

Consequently, the Office mailed all subsequent communications, including the final Office action of May 7, 2003, to the Pennsylvania Avenue address, as instructed by Applicant.

With the present petition, Petitioner submitted a change of address, changing the address to ""William Anthony Drucker, Suite 800, 1901 L Street, N.W., Washington, D.C., 20036-3506." On March 16, 2007, a change of address was filed, changing the address to the present address of record.

The electronic file does not appear to indicate that a Change of Address was filed with the Office, subsequent to the change of address which was presented on filing and prior to the abandonment of the present application. As such, the communication appears to have been mailed to the correct address. It appears that the communication in question was not received however, because Petitioner had previously moved from Pennsylvania Avenue to L Street, and failed to notify the Office of this move.

Petitioner has set forth that the Office mailed the relevant communication to "an old address." Consequently, it appears that Petitioner's office moved subsequent to the filing of the present application and prior to the mailing of the final Office action. However, it does not appear that Petitioner met his responsibility of notifying the Office when his office moved sometime prior to May 7, 2003. Due to his failure to meet this responsibility, the communication was not received, and the application went abandoned as a direct result of his inaction.

## CONCLUSION

For the reasons discussed above, the petition under 37 C.F.R. §1.181 must be **DISMISSED**.

Any renewed petition under 37 C.F.R. §1.181 must be submitted within **TWO MONTHS** from the mail date of this decision.

Extensions of time under 37 C.F.R. §1.136(a) are permitted. The renewed petition should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. §§1.137(a) and/or (b). No assurance can be made that any remedy will be forthcoming.

Any response should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[2], hand-delivery[3], or facsimile[4].

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225[5]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

**Paul Shanoski**
**Senior Attorney**
**Office of Petitions**
**United States Patent and Trademark Office**

---

2 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
3 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
4 (571) 273-8300- please note this is a central facsimile number.
5 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

COPY MAILED
SEP 17 2007
OFFICE OF PETITIONS

In re Application of :
Anne Marie Vacher et al. :
Application No. 09/354,570 :
Filed: July 16, 1999 :
Attorney Docket No.: IRISB-0016 :
Title: COSMETIC COMPOSITION :
WHICH INCLUDES AT LEAST ONE :
POLYSACCHARIDE DERIVED FROM :
BACTERIA OF HYDROTHERMAL ORIGIN :

DECISION ON PETITION
UNDER 37 C.F.R. § 1.137(B)

This is a decision on the petition filed April 10, 2007, pursuant to 37 C.F.R. § 1.137(b)[1], to revive the above-identified application.

A petition under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment was filed on June 23, 2004, and was dismissed via the mailing of a decision on March 27, 2007.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R § 1.113 in a timely manner

1 A grantable petition pursuant to 37 C.F.R §1.137(b) must be accompanied by:
(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

to the final Office action mailed May 7, 2003, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 C.F.R § 1.136(a) were obtained, and no responses were received. Accordingly, the above-identified application became abandoned on August 8, 2003. A notice of abandonment was mailed on March 25, 2004.

With the present petition, Petitioner has submitted the petition fee, a notice of appeal along with the associated fee, and the proper statement of unintentional delay. No terminal disclaimer is required.

As such, the petition under 37 C.F.R. § 1.137(b) is **GRANTED**.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of this decision, so that the notice of appeal that was received with the present petition can be processed.

The Notice of Appeal filed on April 10, 2007, has been entered and made of record. Accordingly, **the two-month period for filing the Appeal Brief, accompanied by the fee required by law, runs from the mailing date of this decision.**

Telephone inquiries **regarding this decision** should be directed to the undersigned at (571) 272-3225[2]. All other inquiries concerning the status of the application should be directed to the Technology Center.

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

---

2 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

MAILED

NOV 06 2009

OFFICE OF PETITIONS

In re Application of :
Vacher, et al. :
Application No. 09/354,570 :
Filed: July 16, 1999 :
Attorney Docket No. VACHER1 :
For: COSMETIC COMPOSITION WHICH INCLUDES AT LEAST ONE POLYSACCHARIDE DERIVED FROM BACTERIA OF HYDROTHERMAL ORIGIN

ON PETITION

This is a decision on the petition entitled, "REQUEST TO VACATE HOLDING OF ABANDONMENT AND TO RE-ISSUE OFFICIAL ACTION OF DECEMBER 9, 2008," filed July 28, 2009. The petition will be treated as a feeless petition under 37 CFR 1.181.

The petition under 37 CFR 1.181 is **GRANTED**.

This application was held abandoned for failure to respond in a proper manner to the non-final Office action, mailed June 11, 2008, which set forth an extendable three (3) month period for reply. Applicant filed an amendment on September 11, 2008. On December 9, 2008 the Office mailed a communication discussing the September 11, 2008 amendment. However, the communication failed to set a date for further response or inform applicants that the September 11, 2008 amendment was non-responsive. A Notice of Abandonment was mailed on July 10, 2009.

Petitioners assert that the application is not abandoned because the examiner did not follow the procedure set forth in MPEP 821.03 at the time of mailing the communication of December 9, 2008, the examiner did not explicitly advise applicants that the amendment of September 11, 2008 was non-responsive, no statement was made as to what time period was running against applicants, the communication was received on the last day of the six-month statutory period for response, and because the December 9, 2008 did not include reference to a pending claim.

Petitioners' arguments have been considered and have been found to be persuasive. A review of the December 9, 2008 communication reveals that no statement was made as to whether or not the amendment of September 11, 2008 had been entered or that it was non-responsive. It appears

that the examiner did not follow MPEP 821.03, which requires the applicant be notified that an amendment canceling all claims drawn to the elected invention and presenting only claims drawn to a nonelected invention will not be entered. Such an amendment is nonresponsive and a one-month/30 day period to correct the submission should be set. **No period for response was set by the December 9, 2008 communication.**

In addition, a complete action on all claims to the elected invention should have been given. The December 9, 2008 communication only addressed claims 1, 5, 7-9, 11-25. There is no mention of claim 26.

As the December 9, 2008 communication appears be incomplete per MPEP 821.03, it would be inequitable to hold the present application abandoned.

The petition under 37 CFR 1.181 is **granted**, the holding of abandonment is withdrawn, and the July 10, 2009 Notice of Abandonment is **vacated**.

After the instant decision is mailed, the application will be referred to Technology Center 1617 for the mailing of a complete Office action in response to the September 11, 2008 amendment. The examiner will determine the length of the time period for response, which will be set to run from the mailing of the Office action.

Telephone inquiries pertaining to this matter may be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

**UNITED STATES DEPARTMENT OF COMMERCE**
**Patent and Trademark Office**
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

1/14/08

Patent No. :7051360
Inventor(s) : Ellis et al.
Issued : 5/23/2006
Title : INTERACTIVE TELEVISION PROGRAM GUIDE WITH SELECTABLE LANGUAGES
Atty.doc./File No.

Request for Certificates of Correction

Consideration has been given to your request for the issuance of a Certificate of Correction, for the above – identified patent under the provisions of CFR 1.322.

Inspection of the application for the patent reveals that claim 56 & 86 is printed in accordance with the record please show supporting evidence to make these changes. Therefore being no fault on the Patent and Trademark Office, It has no authority to issue a certificate of correction under the provision of 1.322.

In view of the forgoing, your request in this matter, is hereby denied.

Future written correspondence concerning this matter should be filed and directed to Decisions & Certificates of Correction Branch.

Henry Randall
Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 Ext. 108

FISH & NEAVE IP GROUP, ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON, MASSACHUSETTS 02110

HR/CBN

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 11

MAIL

FEB 19 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Mark D. Kirkland
FISH & RICHARDSON P.C. (Silicon Valley)
2200 Sand Hill Road, Suite 100
Menlo Park, CA 94025

In re Application of: )
Der-Hwa Gan et al. )
Application No.: 09/354,640 )
Filed: July 15, 1999 )
For: METHOD AND APPARATUS FOR FAST REROUTE IN A CONNECTION-ORIENTED NETWORK

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw As Attorney of Record filed January 16, 2002.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

Power of Attorney to petitioner, was revoked by the applicant before the instant request was filed.

For the above stated reasons, the request is **DISMISSED AS MOOT**.

A courtesy copy of this decision is being mailed to petitioner at the address on the petition, however, all future communications from the Office will be directed to the below-listed correspondence address unless the Office receives proper notification otherwise.

Krista Zele
Special Program Examiner
Technology Center 2600
Communication

cc: Allen M. Lo
Director of Intellectual Property, Patent Counsel
Juniper Networks, Inc.
1194 North Mathilda Avenue
Sunnyvale, CA 94089

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 12

CHERNOFF VILHAUER MCCLUNG & STENZEL LLP
1600 ODS TOWER
601 SW SECOND AVENUE
PORTLAND OR 97204

**MAILED**

JUN 09 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

| | | |
|---|---|---|
| In re Application of: | : | DECISION |
| WESTERMAN, LARRY A. | : | ON PETITION |
| Application No. 09/354,938 | : | |
| Filed: July 15, 1999 | : | |
| For: METHOD OF ELIMINATING FLICKER ON AN INTERLACED MONITOR | : | |

This is a decision on the petition filed April 15, 2003 under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment. No fee is required.

This application was abandoned for failure to timely file a proper response to the non-final Office action mailed August 15, 2002. A Notice of Abandonment was mailed on March 24, 2003.

Petitioner asserts that a proper response to the non-final Office action was timely filed. To support this position, Petitioner has included with the petition a copy of a date stamped mailroom receipt, indicating PTO receipt of the response on February 11, 2003. The postcard itemizes the Amendment Transmittal Form, Fee Transmittal, Amendment response, Petition for Three Month Extension of Time, and a Check for $2,058. A second postcard also stamped February 11, 2003 itemized three new drawing pages. Petitioner submitted a copy of these itemized documents with the petition.

The original response was not matched with the file at the time the Notice of Abandonment was mailed. The original response has recently been located. The delay in locating the response is regretted.

In view of the above, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The petition is **GRANTED**.

The application will be forwarded to Technology Center's technical support staff to properly enter the amendment and the other papers as necessary. From there, the file will be forwarded to the examiner for further consideration in due course.

Allen MacDonald

Allen R. MacDonald, Director
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MARYANN TERRAMANI
625 SERRILL DRIVE
HATBORO, PA 19040-1422

MAILED

JAN 23 2009

OFFICE OF PETITIONS

In re Patent No. 6,241,388 :
Issue Date: June 5, 2001 :
Application No. 09/354,953 : ON PETITION
Filed: July 16, 1999 :
Patentee(s) Maryann Terramani :

## CORRECTED DECISION

This is a decision on the petition under 37 CFR 1.378(c), filed May 1, 2006 (certificate of mailing April 25, 2006), to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

The above-identified patent issued on June 5, 2001. Therefore, the grace period in 35 U.S.C. § 41(b) for paying the 3½ maintenance fee expired on June 5, 2005.

35 U.S.C. § 41(c)(1) authorizes the Commissioner to accept a delayed maintenance fee payment within twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) if the delay is shown to have been unintentional, and authorizes the Commissioner to accept a delayed maintenance fee payment at any time if the delay is shown to have been unavoidable. Thus, 35 U.S.C. § 41(c)(1) does not authorize the Commissioner to accept a delayed maintenance fee payment later than twenty-four (24) months after the expiration of the six-month grace period specified in 35 U.S.C. § 41(b) unless the delay is shown to have been unavoidable.

Petitioner submitted $2090 (maintenance fee and Surcharge) and $750 (petition fee) on May 1, 2006. The decision mailed September 29, 2006 states "The $750 petition fee submitted with petition on May 1, 2006 is unnecessary when filing a petition under 37 CFR 1.378(c). Therefore, petitioner may request a refund of this fee by writing to the Office of Finance, Refund Section." Office records show the $2090 (maintenance fee and Surcharge) was refunded on May 1, 2006. Since the Commissioner can not accept delayed maintenance fee payment after twenty-four (24) months of the date of expiration, the petitioner must filed a petition under 37 CFR 1.377 or a petition under 37 CFR 1.378(b).

**The decision mailed September 29, 2006 is hereby vacated as of the mail date of this decision.**

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300
ATTN: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**FROMMER LAWRENCE & HAUG**
**745 FIFTH AVENUE – 10TH FL.**
**NEW YORK NY 10151**

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NOV 18 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Fritz Schwertfeger et al | : | |
| Application No. 09/355,046 | : | DECISION ON PETITION |
| Filed: September 23, 1999 | : | |
| Attorney Docket No. 517901-2002 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 4, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a response; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice mailed October 25, 2007, is accepted as having been unintentionally delayed.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. See 37 CFR 10.18(b) and Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997). In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that it is not correct that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, petitioner must notify the Office.

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. While a courtesy copy of this decision is being mailed to the person signing the

petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This application is being referred to Technology Center AU 1794 for appropriate action by the Examiner in the normal course of business on the reply received September 4, 2008.

Karen Creasy
Petitions Examiner
Office of Petitions

cc:

**ROBERT M. AMICI**
**CABOT CORPORATION**
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**BILLERICA, MA 01821**

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MAR 0 9 2000

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| In re Application of<br>JOHNSON, Charles D. *et al*<br>Application No.: 09/355,075<br>PCT No.: PCT/US98/01504<br>Int. Filing Date: 23 January 1998<br>Priority Date: 24 January 1997<br>Attorney Docket No.: 51185-220116<br>For: SYSTEM FOR TWO DIMENSIONAL AND THREE DIMENSIONAL IMAGING OF TUBULAR STRUCTURES IN THE HUMAN BODY | DECISION ON<br>PETITION UNDER<br>37 CFR 1.48(a) |

This is a decision on applicants' "Response to Notification of Missing Requirements and a Defective Oath or Declaration" filed in the United States Patent and Trademark Office on 01 November 1999. Counsel argues that the declaration submitted 22 July 1999 without the signature of an inventor be accepted because the inventor, Amy K. Hara was erroneously listed on the international publication as an inventor. This has been treated as a request under 37 CFR 1.48(a) to remove an inventor in an application.

## BACKGROUND

On 23 January 1998, applicants filed international application No. PCT/US98/01504 claiming priority to a United States patent filed 24 January 1997.

On 24 August 1998, a Demand was filed with the International Preliminary Examination Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date. Accordingly, the deadline for submission of a copy of the international application and payment of the basic national fee was extended to expire thirty months from the priority date, *i.e.*, 23 July 1999.

On 22 July 1999, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, a declaration executed by two of the three listed inventors on the international publication; a verified statement claiming small entity status; a check of $528.00 to cover the basic national fee and; authorization to charge any additional fees as required to Deposit Account No. 06-0029.

On 28 September 1999, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) and Notification of Defective Oath or Declaration (Form PCT/DO/EO/917) to applicants indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) must be provided. A one-month time period to respond was set, although extensions of time were available under 37 CFR 1.136(a).

On 01 November 1999, applicants submitted the instant response.

## DISCUSSION

### Petition to Correct Inventorship

A petition under 37 CFR 1.48(a) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part; (2) an oath or declaration by the actual inventor or inventors as required by § 1.63 or as permitted by §§ 1.42, 1.43 or 1.47; (3) the fee set forth in § 1.17(i); and (4) written consent of the assignee, if an assignment has been executed by any of the original named inventors. *See also* section 201.03, Manual of Patent Examining Procedure, pg. 200-5. Items (2), and (3) are satisfied.

Concerning item (2), applicants have provided a declaration signed by the remaining inventors, Charles D. Johnson and Judd E. Reed. The declaration lists the specification to which it is directed and identifies the inventor and country of citizenship as required by 37 CFR 1.497. The declaration is sufficient to satisfy item (2).

With regards to item (3), the petition fee of $130.00 as required by 37 CFR 1.17(i) has been charged to Deposit Account No. 06-0029 as authorized. Item (3) is satisfied.

However, applicants have not satisfied the requirements of item (1). There is no statement from Amy K. Hara attesting that the error in inventorship occurred without deceptive intention on her part with the instant response. Counsel's statement that "[o]n the basis of an investigation conducted at the time the above-identified application was prepared for filing, it was determined that Amy K. Hara was not an inventor of the subject matter characterized by the claims in the application," Pet. ¶ 2, or any other declarations made are <u>not</u> sufficient to address the issues raised in the Notification of Missing Requirements and Defective Oath or Declaration mailed 28 September 1999.

Moreover, the assignee has not granted written consent to remove Amy K. Hara as inventor. Item (4) is not satisfied.

Accordingly, applicants have failed to meet the requirements of 37 CFR 1.48(a).

## CONCLUSION

For the reasons above, the petition is **DISMISSED** without prejudice.

Applicants must provide either an acceptable oath or declaration in compliance with 37 CFR 1.497(a) and (b), or file a renewed petition under 37 CFR 1.48(a) to delete Amy K. Hara as an inventor within **TWO (2) MONTHS** from the mail date of this decision. No extension of time may be granted under 37 CFR 1.136, but the period of response set in the Notification of Missing Requirements may be extended up to a maximum of five months. Failure to properly respond will result in the abandonment of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

James Thomson
Petitions Attorney
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JUN 20 2000

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|---|---|
| In re Application of<br>JOHNSON, Charles D. *et al*<br>Application No.: 09/355,075<br>PCT No.: PCT/US98/01504<br>Int. Filing Date: 23 January 1998<br>Priority Date: 24 January 1997<br>Attorney Docket No.: 51185-220116<br>For: SYSTEM FOR TWO DIMENSIONAL AND THREE DIMENSIONAL IMAGING OF TUBULAR STRUCTURES IN THE HUMAN BODY | DECISION ON<br>PETITION UNDER<br>37 CFR 1.48(a) |

This is a decision on applicants' "Petition to Correct Inventorship Under 37 CFR 1.48(a)" filed in the United States Patent and Trademark Office on 15 May 2000. The petition fee has already been paid.

## BACKGROUND

On 09 March 2000, a decision dismissing applicants' petition was mailed. Applicants failed to meet the requirements of 37 CFR 1.48(a).

On 15 May 2000, applicants filed the instant petition which was accompanied by, *inter alia*, a declaration of the deleted inventor ("Hara Decl."); a copy of the declaration filed 22 July 1999; and written consent of the assignee to the correction of inventors.

## DISCUSSION

In the decision mailed 09 March 2000, it was determined from the "Response to Notification of Missing Requirements and a Defective Oath and Declaration" filed 01 November 1999 ("Pet."), that a petition under 37 CFR 1.48(a) was required to remove Amy K. Hara as an inventor in the above-captioned application. Specifically, counsel's statement

that "[o]n the basis of an investigation conducted at the time the above-identified application was prepared for filing, it was determined that Amy K. Hara was not an inventor of the subject matter characterized by the claims in the application," Pet. ¶ 2, was used in the determination that a petition under 37 CFR 1.48(a) was required. Accordingly, the response was treated as a petition under 37 CFR 1.48(a). As such, applicants failed to satisfy items (1) and (4).

In the instant petition, applicants included a declaration by the inventor to be deleted, Amy K. Hara and a written consent of the assignee to satisfy the remaining requirements of 37 CFR 1.48(a). However, in the declaration Ms. Hara elaborated on the circumstances surrounding the decision by counsel concluding that Ms. Hara was not an inventor of the subject matter in the application.

Ms. Hara states that "I . . . invented a system for two dimensional and three dimensional imaging of tubular structures in the human body (Invention Embodiment 1)." Hara Decl. ¶ 1. Later, she declares that "a Patent Cooperation Treaty (PCT) international application was filed with claims directed to both Invention Embodiment 1 and Invention Embodiment 2," and that "[s]ince I was an inventor of Invention Embodiment 1, I was identified as an inventor in the PCT application." Id. at ¶ 3. Ms. Hara says that the national stage application was amended to include only Invention Embodiment 2 with the submission of a Preliminary Amendment on 22 July 1999 and that "[s]ince I was not an inventor of Invention Embodiment 2, I did not sign the declaration that accompanied the filing of the national stage application." Id at ¶ 4.

Consequently, it is clear that only upon entry of the Preliminary Amendment does Ms. Hara cease to become an inventor in the above-captioned application. In this case, Ms. Hara was properly identified as an inventor in the international application. Accordingly, Ms. Hara must be included as an inventor on the declaration and the petition under 37 CFR 1.48(a) must be dismissed as there was no error in the inventive entity. A declaration signed by all of the inventors named in the international application must be submitted.

After meeting the requirements of 35 U.S.C. 371, a petition pursuant to 37 CFR 1.48(b) to remove Ms. Hara as an inventor would be appropriate. 37 CFR 1.48(b) states, in part:

> If the correct inventors are named in a nonprovisional application, other than a reissue application, and the prosecution of the application results in the amendment or cancellation of claims so that fewer than all of the currently named inventors are the actual inventors of the invention being claimed in the application, an amendment must be filed deleting the name or names of the person or persons who are not inventors of the invention being claimed . . .

It is noted that a nonprovisional application is defined as "a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which enter the

national stage from an international application **after** compliance with 35 U.S.C. 371." 37 CFR 1.9(a)(3). (Emphasis added).

## CONCLUSION

For the reasons above, the petition is **DISMISSED** without prejudice.

Applicants must provide either an acceptable oath or declaration in compliance with 37 CFR 1.497(a) and (b) within **ONE (1) MONTH** from the mail date of this decision. Extensions of time may be granted under 37 CFR 1.136. Failure to properly respond will result in the abandonment of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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| In re Application of<br>JOHNSON, Charles D. *et al*<br>Application No.: 09/355,075<br>PCT No.: PCT/US98/01504<br>Int. Filing Date: 23 January 1998<br>Priority Date: 24 January 1997<br>Attorney Docket No.: 51185-220116<br>For: SYSTEM FOR TWO DIMENSIONAL AND THREE DIMENSIONAL IMAGING OF TUBULAR STRUCTURES IN THE HUMAN BODY | COMMUNICATION |

This communication is in response to the papers submitted with applicants' "Response to Decision on Petition Under 37 CFR 1.48(a)" filed in the United States Patent and Trademark Office on 11 August 2000.

## BACKGROUND

On 09 March 2000, a decision dismissing applicants' petition under 37 CFR 1.48(a) was mailed because it was determined that there was no error in the inventive entity. Applicants were requested to provide a declaration signed by all of the inventors listed on the international application. Further, it was recommended that applicants submit a petition under 37 CFR 1.48(b) to remove Amy K. Hara as a co-inventor after meeting the requirements of 35 U.S.C. 371.

On 11 August 2000, applicants filed a "Response to Decision on Petition Under 37 CFR 1.48(a)" which was accompanied by, *inter alia*, a declaration of all inventors listed on the international application; a petition under 37 CFR 1.48(b) with the $130.00 petition fee; a request for a one-month extension with the appropriate $55.00 fee; and an "Amendment to Correct Inventorship under 37 CFR 1.48(b)."

## DISCUSSION

In the instant response, applicants included a declaration signed by all of the inventors listed on the PCT international application in compliance with 37 CFR 1.497(a) & (b). The surcharge fee of $130.00 pursuant to 37 CFR 1.492(e) has been charged to counsel's Deposit Account No. 06-0029 as authorized. A one-month extension fee has been paid.

Applicants have completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 23 January 1998, under 35 U.S.C. 363, and a 35 U.S.C. 102(e) and 371(c) date of **11 August 2000**.

The petition under 37 CFR 1.48(b) will be considered by the examiner when considering the above-captioned application for examination.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing in accordance with this decision.

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PCT Legal Examiner
PCT Legal Office

James Thomson
PCT Attorney
PCT Legal Office

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UNITED STATES PATENT AND TRADEMARK OFFICE

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16 JUN 2003

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| In re Application of | : | |
| HECHT | : | |
| U.S. Application No.: 09/355,117 | : | DECISION ON PETITION |
| PCT No.: PCT/EP98/00295 | : | |
| Int. Filing Date: 20 January 1998 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 20 January 1997 | : | |
| Attorney Docket No.: ANWAL.004APC | : | |
| For: AN OPTICAL WAVE-GUIDE CABLE NETWORK | : | |

This decision is in response to applicant's "Petition to Revive Abandoned Application" filed in the United States Patent and Trademark Office (USPTO) originally on 15 October 1999 and again on 28 April 2003. Applicant has paid the $605.00 small entity petition fee.

## BACKGROUND

On 20 January 1998, applicant filed international application PCT/EP98/00295, which claimed priority of an earlier application filed 20 January 1997. A Demand for international preliminary examination, in which the United States was elected was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 July 1999.

On 20 July 1999, applicant filed a transmittal letter for entering the U.S. national stage under 35 U.S.C. 371 accompanied by: partial payment of the U.S. basic national fee; a copy of the published international application; a translation of the international application into English; an Information Disclosure Statement and an executed combined declaration and power of attorney of the inventor.

On 13 August 1999, applicant was mailed a "Notification of Abandonment" (Form PCT/DO/EO/909) informing applicant that the present application was abandoned as to the United States for failure to pay the full, U.S. Basic National fee by thirty months from the earliest claimed priority date.

On 15 October 1999, applicant filed a petition to revive the present application accompanied by a check in the amount of $372.00 as payment of the remainder of the Basic U.S. National fee and a check in the amount of $605.00 as payment of the petition to revive fee.

On 28 April 2003, applicant filed the present petition to revive pursuant to 37 CFR 1.137(b) accompanied by a copy of stamped postcard receipt showing a USPTO datestamp of 15 October 1999.

## DISCUSSION

A review of the application file finds the original petition contained therein.

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

With regard to Item (1), the proper response was payment of the full U.S. Basic National fee. A review of the fee record for the present application shows that applicant provided this payment with the petition on 15 October 1999.

As to Item (2), applicant has included the small entity fee of $605.00 along with the present petition.

With regard to Item (3), applicant's statement that, "The failure of paying the full national fee was unintentional" is being interpreted to mean that the entire delay in paying the full national fee from the due date for the payment until the filing of a grantable petition pursuant to this paragraph was unintentional. If this is an incorrect reading of applicant's statement applicant should contact the Office of PCT Legal Administration immediately. Applicant's statement and the prompt filing of the petition satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate. Further, a review of the application file reveals that all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied. However, it is noted that the filed combined declaration and power of attorney lists the filing date for the priority application as "January 20, 1998." The filing date is in fact 20 January 1997. This mistake does not render the declaration non-compliant for the purposes of 35 U.S.C. 371, however, applicant should file a declaration with the correct priority information as soon as possible in order to assure that the USPTO record-keeping and databases are correct.

## CONCLUSION

For the reasons stated above, applicant's petition to revive under 37 CFR 1.137(b) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision. The 35 U.S.C. 371(c) date is **15 October 1999**.

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MAR 19 2004

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Paper Number 22

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| In re application of | : | |
| Ronald Gibson Gration et al. | : | DECISION ON |
| Serial No. 09/355,169 | : | PETITION |
| Filed: August 30, 1999 | : | |
| For: PRINTED MATERIAL PRODUCING REFLECTIVE | : | |
| INTAGLIO EFFECT | : | |

This is a response to the PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW HOLDING OF ABANDONMENT, received September 11, 2003. The petition requests that the abandonment for failure to timely pay the required issue fee within the statutory period of three months from the mailing date of the Notice of Allowance be withdrawn. The requester asserts that the Notice of Allowance mailed February 20, 2003 was not received at the applicant's correspondence address.

**DECISION**

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee), and is evaluated under the procedures regarding an acceptable showing of non-receipt of an office action, TMOG 1156 O.G. 53, November 16, 1993, (see also MPEP 711.03(c) - NEW PROCEDURE TMOG 1170 O.G. 114). A review of the petitioner's evidence indicates that the request has merit. The evidence presented is sufficient to establish that the applicants or applicant's representative did not receive the Notice of Allowance, mailed February 20, 2003. The evidence provided includes a statement by the petitioner that the Notice of Allowance, mailed February 20, 2003 was not received, a statement that a search of the file and docket records was made, and a statement that the search revealed the Notice of Allowance was not received. Also provided is a copy of the attorney's application docket records where the Notice of Allowance would have been posted had it been timely received.

Therefore, the abandonment is hereby withdrawn, and the application is returned to pending status. The application shall be forwarded to the examiner for prompt remailing of the Notice of Allowance originally mailed February 20, 2003 and restarting of the statutory period of response from the remail date thereof. It is noted that a search of the USPTO financial records indicates that fees in the amount of $1600.00 submitted with the instant petition have been credited to the instant application.

The Petition is **GRANTED**.

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0 9 MAR 2000

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| | |
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| In re Application of<br>GIORGI (deceased) et al<br>Application No.: 09/355,210<br>PCT No.: PCT/EP98/00599<br>Int. Filing Date: 04 February 1998<br>Priority Date: 07 February 1997<br>Attorney Docket No.: 515-4167<br>For: MONOCYCLIC COMPOUNDS WITH FOUR BIFUNCTIONAL RESIDUES... | DECISION |

This is a decision on applicants' "LETTER TRANSMITTING DECLARATIONS" filed in the Patent and Trademark Office (PTO) on 08 November 1999, which requests that the application be accepted under 37 CFR 1.42 as filed on behalf of a deceased joint inventor, Raffaello Giorgi.

## BACKGROUND

On 04 February 1998, applicants filed international application No. PCT/EP98/00599 which claimed a priority date of 07 February 1997, and which designated the United States.

On 04 September 1998, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of 19 months from the priority date, and as a result the deadline for submission of a copy of the international application (unless previously communicated by the International Bureau) and payment of the basic national fee was extended to expire 30 months from the priority date, i.e. 07 August 1999.

On 23 July 1999, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia,: the basic national fee and a copy of the international application.

On 19 August 1999, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 08 November 1999, applicants filed the present response which was accompanied by, inter alia, a declaration of the inventors executed by the surviving inventors and two heirs of the deceased inventor.

## DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

Section 409.01 of the Manual of Patent Examining Procedure (M.P.E.P.) states, in part:

> "One who has reason to believe that he or she will be appointed legal representative of a deceased inventor may apply for a patent a legal representative in accordance with 37 CFR 1.42. Proof of the applicant's authority as legal representative may be filed after the filing date of the application....
>
> Application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and if accompanied by a certificate from the court that they are all the heirs and that the estate was under the sum required by state law for the appointment of an administrator.

A review of the declaration of the inventors reveals that cannot be accepted for the purposes of 37 CFR 1.42. Specifically, the declaration fails to positively list Mr. Giorgi as an inventor but rather lists (and is executed by) his heirs, Rosaria Pirari and Alberta Giorgi as inventors. Further, it is unclear in what capacity (i.e., as legal representatives or heirs) Ms. Pirari and Ms. Giorgi are executing the declaration in that it states that they are

"executing and signing the declaration to which this is attached as...legal representative (or heirs)" of Mr. Giorgi. Further, if they have not been legally named as the legal representatives of the estate, then the declaration must list and be executed by all of the heirs, and a review of the supporting documents which accompanied the declaration reveals that there are two additional heirs not named on the declaration. In the case of minor children, as appears to be the present situation, such a declaration should list them as heirs and be signed on their behalf by their legal guardian. Finally, the declaration is unacceptable in that it appears to have been altered after execution. Specifically, it appears that at some point after the signature blocks of the declaration were filled out by hand and signed, someone went back and struck out the various indications of citizenship and typed in "ITALY" as well as similarly inserting "ITALY" in the indicated residences. Such an alteration is improper (see MPEP 605.04(a)). Therefore, in that a proper declaration has not been submitted, applicants request for acceptance of the application under 37 CFR 1.42 may not be properly granted at this time.

## CONCLUSION

For the reasons discussed above, the request for status under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42". No additional petition fee is required.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Affairs Division of the PCT Legal Office.

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28 SEP 2000

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|---|---|---|
| In re Application of | : | |
| GIORGI (deceased) et al | : | |
| Application No.: 09/355,210 | : | |
| PCT No.: PCT/EP98/00599 | : | |
| Int. Filing Date: 04 February 1998 | : | DECISION |
| Priority Date: 07 February 1997 | : | |
| Attorney Docket No.: 515-4167 | : | |
| For: MONOCYCLIC COMPOUNDS WITH | : | |
| FOUR BIFUNCTIONAL RESIDUES... | : | |

This is a decision on applicants' "REQUEST FOR RECONSIDERATION" filed in the Patent and Trademark Office (PTO) on 12 July 2000, which again requests that the application be accepted under 37 CFR 1.42 as filed on behalf of a deceased joint inventor, Raffaello Giorgi. The request was accompanied by, *inter alia,* a declaration executed by the remaining inventors and the heirs of the deceased inventor and a "DECLARATION REPLACING THE ATTESTED AFFIDAVIT" (and translation thereof) by the widow of Mr. Giorgi, Rosaria Pirari, setting forth that the heirs signing the declaration of the inventors are all of Mr. Giorgi's heirs. The request is **GRANTED** as discussed below.

On 09 March 2000, this Office mailed a decision indicating that the application could not be accepted under 37 CFR 1.42 on the grounds that the persons who had executed the declaration on behalf of the deceased inventor did not appear to be the legal represenatative and/or all of the heirs of the deceased inventor.

A review of application file, and specifically the declaration and the accompanying statement of Ms. Pirari, reveals that the signatures of Rosaria Pirari (both on her own behalf and as the legal guardian of minor heirs Chiara and Gabriele Giorgi) and Alberta Giorgi on

the declaration filed 12 July 2000, are being offered as that of all the heirs of the deceased joint inventor. Therefore, the application papers have been found to be in compliance with 37 CFR 1.42.

In that the declaration of the inventors is acceptable under 37 CFR 1.42, the application satisfies the requirements for entry into the national stage in the U.S. under 35 U.S.C. 371. The papers filed under 37 CFR 1.42 are **ACCEPTED**.

The application has an international filing date of **04 February 1998**, under 35 U.S.C. 363, and a 35 U.S.C. 102(e) and 371(c) date of **12 July 2000**.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Richard R. Cole
Legal Examiner
PCT Legal Office

(703)305-6639
RRC:rrc

# NOTICE RE: CERTIFICATES OF CORRECTION

**DATE** : 03-15-02 **Paper No.:** 14

**TO** : Supervisor, Art Unit 3700

**SUBJECT : Certificate of Correction Request in Patent No.:** 6,336,912

A response to the following question is requested with respect to the accompanying request for a certificate of correction.

**With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.**

***PLEASE COMPLETE THIS FORM AND RETURN WITH FILE, WITHIN 7 DAYS, TO CERTIFICATES OF CORRECTION BRANCH - PK 3-915/922 PALM LOCATION 7580 - TEL. N0. 305-8309***

***THANK YOU FOR YOUR ASSISTANCE!***

**Note your decision, regarding the changes requested in the Request for Certificate of Correction, by placing a check mark (+) in the box that reflects your decision, which corresponds to the question checked above.**

☐ **YES** ☒ **NO** ☒ **Comments below**

☒ **Comments:** The change would alter the scope of the claims and the evidence does not clearly show office reciept of the 2ND Amendment after allowance.

[signature] 3763

**Supervisor** **Art Unit**

22 SEP 2000

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Daniel Bliss
Bliss McGlynn
2075 West Big Beaver Road
Suite 600
Troy, MI 48084

| | |
|---|---|
| In re Application of<br>Jeffrey J. Lace et al.<br>Application No.: 09/355436<br>PCT No.: PCT/US98/02043<br>Int. Filing Date: 04 February 1998<br>Priority Date: 07 February 1997<br>Attorney's Docket No.: 1201.00022<br>For: Anti-Theft Vehicle System | DECISION ON<br>PETITION UNDER<br>37 CFR 1.181 |

This is in response to the "Petition Under 37 C.F.R. 1.181 to Withdraw the Holding of Abandonment" filed on 01 September 2000.

## BACKGROUND

This international application was filed on 04 February 1998, and claimed a priority date of 07 February 1997. A Demand electing the United States was filed on 24 August 1998, which was prior to the elapse of 19 months from the international filing date. Accordingly, the thirty-month time period to pay the basic national fee in the United States expired as of midnight on 07 August 1999.

On 28 July 1999, applicants filed a Transmittal Letter accompanied by, *inter alia*, the basic national fee.

On 24 September 1999, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an executed oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(e). The Notification set an extendable period for response which ended on 24 October 1999.

On 25 April 2000, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicants, indicating that this international application had become abandoned with respect to the United States for failure to timely comply with the requirements of the Notification of Missing Requirements.

Applicant filed the instant petition on 01 September 2000.

## DISCUSSION

The petition indicates that the required reply to the Notification of Missing Requirements (including an executed declaration and the surcharge under 37 CFR 1.492(e)) were mailed via first-class mail to the USPTO on Monday, 25 October 1999. The petition is accompanied by, *inter alia*, copies of the executed declaration, a "Response" and a postcard receipt date stamped as received by the Office on "29 OCT 1999." The postcard receipt itemizes a "Response, Copy of Notification of Missing Requirements Under 35 U.S.C. 371, Declaration and Power of Attorney and check in the amount of $130.00." The copy of the "Response" includes a signed Certificate of Mailing under 37 CFR 1.8.

Based on the postcard evidence of record, it would be appropriate to accept the Response, Notification of Missing Requirements and Declaration and Power of Attorney accompanying the petition as copies of the papers originally filed, and to consider the itemized $130.00 surcharge to have been received on the same date. In view of the certificate of mailing appearing on the correspondence, it would be appropriate to consider the papers and surcharge to have been filed on 25 October 1999. Since the period for reply to the Notification of Missing Parts ended on Sunday, 24 October 1999, the papers and surcharge were timely filed, pursuant to 35 U.S.C. 21 and 37 CFR 1.7. Therefore, the Notification of Abandonment mailed on 25 April 2000 was in error and is hereby **withdrawn**.

## DECISION

The petition under 37 CFR 1.181 is **GRANTED**.

**Counsel's Deposit Account No. 02-2712 is being credited in the amount of $1080.00 as a refund of an unnecessary partial payment of a petition fee under 37 CFR 1.137(b). (fee code 141).**

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for continued processing, including the preparation and mailing of a Notification of Acceptance (Form PCT/DO/EO/903). The 35 USC 102(e) and 35 USC 371 date of this application is **25 October 1999**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

# NOTICE RE: CERTIFICATES OF CORRECTION

DATE : September 27, 2002 2632 Paper No.: 15

TO : Supervisor, Art Unit 2832

SUBJECT : Certificate of Correction Request in Patent No.: 6362,728

A response to the following question is requested with respect to the accompanying request for a certificate of correction.

**With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.**

*Ernest C. White, LIE*
(703) 305- 8339

***PLEASE COMPLETE THIS FORM AND RETURN WITH FILE, WITHIN 7 DAYS, TO CERTIFICATES OF CORRECTION BRANCH - PK 3-915/922 PALM LOCATION 7580 - TEL. N0. 305-8309***

***THANK YOU FOR YOUR ASSISTANCE!***

**Note your decision by placing a check mark in the appropriate box below, indicating whether all changes requested in the Request for Certificate of Correction should be applied. Please specify which changes should not be applied and indicate the reason(s) for denial, in the "Comments" section below.**

☑ **YES** ☐ **NO**

☐ **Comments:** _____

Supervisor

AU 2632
Art Unit

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ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 22

**PILLSBURY WINTHROP**
**1600 TYSONS BOULEVARD**
**McLEAN, VA 22102**

COPY MAILED
AUG 05 2003
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,497,877 | : | |
| Issue Date: December 24, 2002 | : | |
| Application No. 09/355,522 | : | ON PETITION |
| Filed: October 22, 1999 | : | |
| Attorney Docket No. PM254815 | : | |

This is a decision on the petition under 37 CFR 1.182, filed July 24, 2003, requesting issuance of a duplicate Letters Patent for the above-identified application.

The petition is **granted**.

The Publishing Division is directed to issue duplicate Letters Patent.

Any questions concerning this matter may be directed to Wan Laymon at (703) 306-5685. Any questions concerning issuance of the duplicate Letters Patent should be directed to either Krystal Paige at (703) 305-8237 or Susan Free at (703) 305-0136.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent. The patent file is being forwarded to the Files Repository.

Wan Laymon
Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Krystal Paige, Crystal Park 3-910 (FAX 305-4372)
Susan Free, Crystal Park 3-910 (FAX 305-4372)

05 MAY 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

James Ray and Associates
2640 Pitcairn Road
Monroeville, PA 15146

In re Application of :
BENGMARK, Stig :
U.S. Application No.: 09/355,665 :
PCT No.: PCT/SE98/00145 :
Int. Filing Date: 02 February 1998 :
Priority Date: 04 February 1997 :
Attorney Docket No.: SG-99224 :
For: CATHETER FOR PROVIDING A FLUID :
CONNECTION WITH THE SMALL :
INTESTINE :

**DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b) AND REQUEST FOR REFUND**

This decision is in response to applicant's petition under 37 CFR 1.137(b) and request for a refund under 37 CFR 1.28 filed on 17 September 1999.

## BACKGROUND

On 02 August 1999, applicant filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 along with a check of $876.00 for the basic national fee.

On 30 August 1999, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) for failing to provide the full U.S. Basic National Fee by thirty months from the earliest claimed priority date.

On 17 September 1999, applicant filed a petition to revive under 37 CFR 1.137(b) which was accompanied by, *inter alia*, a small entity statement; an executed declaration; and a request for refund.

On 12 March 2002, a "Status Inquiry" was filed.

On 28 April 2004, applicant resubmitted the papers originally filed 17 September 1999 along with a copy of a date-stamped postcard receipt for those papers.

On 05 May 2004, applicant submitted via facsimile authorization to pay the surcharge fee of $65.00 pursuant to 37 CFR 1.492(e) from the refund request.

## DISCUSSION

The papers filed 17 September 1999 were located in the above-captioned

application along with fees of $130.00 to complete the basic filing fee and $605.00 for the petition fee. However, these papers were not acted upon by the Office.

Accordingly, the documents submitted on 28 April 2004 attempting to show that applicants filed papers on 17 September 1999 are not required and moot. The papers filed 17 September 1999 will be answered below.

**Petition to Revive Under 37 CFR 1.137(b)**

A petition to revive an application on the grounds of unintentional delay pursuant to 37 CFR 1.137(b) must be accompanied by: (1) a proper reply; (2) the requisite petition fee; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any required terminal disclaimer.

Here, applicant submitted a payment of $130.00 for the remainder of the basic national fee of $970.00 and total claim fee of $36.00 minus the previous payment of $876.00. This is an appropriate response. The petition fee of $605.00 was submitted. Applicant's statement, "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). A terminal disclaimer is not required.

Thus, all the requirements of 37 CFR 1.137(b) have been satisfied.

**Request for Refund Under 37 CFR 1.28**

Applicant submitted a verified statement claiming small entity status and request for refund of one-half of the basic national fee paid of $503.00 on 17 September 1999.

37 CFR 1.28 states, in part:

> A refund pursuant to § 1.26 of this part, based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if a verified statement under § 1.27 and a request for a refund of the excess amount are filed within two months of the date of the timely payment of the full fee. The two-month time period is not extendable under § 1.136.

A review of the application file reveals that a verified small entity statement and request for refund have been filed within two months from the payment of the filing fees.

Thus, applicant qualifies for the refund pursuant to 37 CFR 1.28.

## DECISION

For the reasons noted above, applicant's petition under 37 CFR 1.137(b) to revive the above-captioned application is hereby **GRANTED**.

Applicant's request for refund of one-half the basic national fee is also **GRANTED**.

Applicant submitted a declaration in compliance with 37 CFR 1.497(a) and (b) on 17 September 1999. Applicant also authorized that the surcharge fee of $65.00 required by 37 CFR 1.492(e) be taken from money owed on the $503.00 refund request. A check of $438.00 will be mailed by the Finance Office to applicant.

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 02 February 1998, under 35 U.S.C. 363 and a 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) date of 17 September 1999.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-6457

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 13

Bradley D. Lytle
OBLON, SPIVAK, MCCLELAND,
MAIER & NEUSTADT, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202

JUL 17 2002

| | | |
|---|---|---|
| In re Application of | : | |
| FROMM et al. | : | DECISION |
| Application No. 09/355,726 | : | ON PETITION |
| Filed: November 1, 1999 | : | |
| Attorney Docket No. 9847-0031-6X PCT | : | |

This is a decision on the petition, filed March 20, 2002 requesting that the prosecution in the above-identified patent application be suspended for a period of six months under 37 C.F.R. § 1.103(a), and an additional six months, pursuant to MPEP § 1002.02(c)9, for a total of twelve months, beginning with the filing of the subject Petition.

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
> (1) A showing of good and sufficient cause for suspension of action; and
> (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office

In the Request, to establish cause, Petitioner asserts the claims and issues of the instant application are relevant to the claims and issues in at least U.S. Application No. 08/973,019 which Petitioner has appealed. Further, because the appeal of '019 will materially affect the prosecution of the instant application, the instant application should be suspended pending the decision on appeal of '019.

A review of the record indicates the instant application has claims and issues that are relevant to

appealed case '019 . The claims in the instant application and appealed case '019 are both directed toward the particular structure of the high voltage cable. Consequently, since the outcome of appealed case '019 will materially affect prosecution of the instant application, good and sufficient reasons have been demonstrated to warrant suspension of action.

Accordingly, the petition to suspend prosecution is GRANTED for a period of up to twelve (12) months starting from the filing of petition, March 20, 2002.

Inquiries regarding this decision should be directed to Richard Seidel at (703) 306-3431.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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Paper No. 17

Bradley D. Lytle
OBLON, SPIVAK, MCCLELAND,
MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, Virginia 22314

JUN - 4 2003

| | | |
|---|---|---|
| In re Application of | : | |
| FROMM et al. | : | DECISION |
| Application No. 09/355,726 | : | ON PETITION |
| Filed: November 01, 1999 | : | |
| Attorney Docket No. 9847-0031-6X PCT | : | |

This is a decision on the petition, filed March 20, 2003, requesting that the prosecution in the above-identified patent application be suspended for an additional six months beyond the 12 months that prosecution has been suspended under 37 C.F.R. § 1.103(a).

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
> (1) A showing of good and sufficient cause for suspension of action; and
> (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office

In the Request, to establish cause, Petitioner asserts the claims and issues of the instant application are relevant to the claims and issues in at least U.S. Application No. 08/973,019 which Petitioner has appealed. Further, because the appeal of '019 will materially affect the prosecution of the instant application, the instant application should be suspended pending the decision on appeal of '019.

A review of the record indicates the instant application has claims and issues that are relevant to appealed case '019 . The claims in the instant application and appealed case '019 are both directed toward the particular structure of the high voltage cable. Consequently, since the

outcome of appealed case '019 will materially affect prosecution of the instant application, good and sufficient reasons have been demonstrated to warrant suspension of action.

Accordingly, the petition to suspend prosecution is GRANTED for a period of up to six (6) months starting from the filing of petition, March 20, 2003.

Inquiries regarding this decision should be directed to Richard Seidel at (703) 306-3431.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.

ATTORNEYS AT LAW

#12
3/27/02

Docket No.: 9847-0031-6X PCT

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/355,726
Applicants: UDO FROMM ET AL
Filing Date: NOVEMBER 1, 1999
For: TRANSFORMER WITH VOLTAGE REGULATING MEANS
Group Art Unit: 2832
Examiner: MAI, A.

SIR:

Attached hereto for filing are the following papers:

**PETITION FOR SUSPENSION OF ACTION UNDER 37 C.F.R. § 1.103(a) AND REQUEST FOR A SECOND SUSPENSION OF ACTION UNDER 37 C.F.R. § 1.103(a), PURSUANT TO MPEP § 1002.02(c)9**

Our check in the amount of **$130.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

RECEIVED
MAR 22 2002
TECHNOLOGY CENTER 2800

Bradley D. Lytle
Attorney of Record
Registration No. 40,073
Thomas J. Fisher
Registration No. 44,681

22850

(703) 413-3000 (phone)
(703) 413-2220 (fax)

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

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OFFICE OF PETITIONS

ON PETITION

| | | |
|---|---|---|
| In re Application of | : | |
| Udo Fromm, et al. | : | |
| Application No. 09/355,726 | : | |
| Filed: November 1, 1999 | : | |
| Attorney Docket No. 705/71943-2/ | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed November 12, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely reply to a final Office action mailed January 12, 2004. A Notice of Abandonment was mailed September 9, 2004.

Extensions of time under 37 CFR 1.136 are available only if asked for "prior to or with the response." In no case, however, may an applicant respond later than the maximum time period set by statute. Accordingly, if the question of abandonment arises when the provisions of 37 CFR 1.136 can no longer be used, then the application is abandoned when the unextended time for response has expired. Therefore, no extension of time fees are due on a petition for revival. In view thereof, the $980 extension of time fee submitted with the petition is unnecessary and will be refunded to petitioner's deposit account.

The application is revived for consideration of a submission under 37 CFR 1.114 (request for continued examination).

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204.

The application file is being forwarded to Technology Center AU 2832, for further processing of the request for continued examination under 37 CFR 1.114 filed November 12, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

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RESPONSE TO DECISION
2-1-00

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APR 28 2000
PATENT & TRADEMARK OFFICE

Paper No. 11

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DEC 01 1999

SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

Oblon Spivak McClelland Maier & Neustadt
1755 Jefferson Davis Highway
Fourth Floor
Arlington VA 22202

In re Application of
Mats Leijon, et al
Application No. 09/147,325
Filed: February 17, 1999
Attorney Docket No. 9847-0001-6X

: RESPONSE TO PETITION UNDER
: 37 CFR 1.182 SEEKING SPECIAL
: TREATMENT RELATING TO AN
: ELECTRONIC SEARCH TOOL, AND
: DECISION ON PETITION UNDER
: 37 CFR 1.183 SEEKING WAIVER
: OF REQUIREMENTS UNDER 37 CFR
: 1.98

This is a response to a September 29, 1999 Petition Under 37 CFR 1.182, requesting relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98 in view of the need to file multiple applications relating to different aspects of a particular invention. The petition will be treated as two separate petitions: a first petition under 37 CFR 1.182, relating to submission of an electronic search tool and the need to protect proprietary information therein, and a second petition under 37 CFR 1.183, requesting relief from the § 1.98 provision which requires filing paper copies of references being cited in each of many related applications.

A Decision on the petition under 37 CFR 1.182 re the electronic search tool will be issued in due course.

The petition under 37 CFR 1.183 re the submission of 3 paper copies of IDS citations in a holding application is Granted to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Electronic Search Tool
- Part III. Petition Under 37 CFR 1.183 - Paper Copies

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DEC 03 1999
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT P.C.

- Part IV. Summary
- Part V. Further Correspondence

## Part 1. Background

The instant national stage application filed under 35 U.S.C. 371 currently contains claims 77-153 with three independent claims. The instant application is one of about 200 U.S. applications (either filed or to be filed) with each U.S. application having as many as 40 corresponding foreign applications (either filed or to be filed), the applications relating to different aspects of the invention. An Information Disclosure Citation List has been submitted that lists 259 U.S. patents, 369 foreign patent documents, and 43 other references for a total of 671 citations. Additionally, a list of related cases has been supplied containing 31 U.S. applications and 52 PCT applications. Paper copies have not been supplied in the related applications of any of the citations or the identified related cases.

37 CFR 1.56(b)(1) requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98. 37 CFR 1.56(a).

Petitioner asks "[w]hether the information cited in the manner proposed in [petition] Section 3.1.1 ... is a disclosure that is sufficient to meet the requirements of 37 CFR § 1.56." To the extent that this question refers to the content of the disclosure and the particulars of the subject applications, the Office will not answer the question. It is Office practice not to attempt to define how an individual "ensures" compliance with the rule in a particular application. See, e.g., MPEP 2004. Because determinations on this issue require an evaluation of the intent of the party involved, the Office declines to investigate the question. See MPEP 2010. To the extent that Petitioner's question concerns the form in which the disclosure is provided, rule 56 permits a disclosure in a combination of paper and electronic formats.

Petitioner, in addition to meeting the duty set forth in 37 CFR 1.56 to disclose material information, also wishes to disclose to the Office information that may not meet the definition of

materiality as set forth in the rule[1]. Information identified by U.S. or foreign examiners in any of the related U.S. and foreign applications would be cited in each of the related U.S. applications.[2] In addition, Petitioner seeks to submit other information in each of the related U.S. applications, such as all the co-pending U.S. applications that relate to the invention (useful for determining possible double patenting rejections), and foreign search reports. Petition, page 4.

Rather than be required to submit, via a paper copy, each piece of information in each application each time the information is obtained, Petitioner seeks to have:

(1)(a) one application (the instant application) identified as a "holding" application which would contain a complete set of paper copies of references; the paper copies to be submitted in only the "holding" application;

(b) the other related pending U.S. applications, hereafter referred to as the bulk filing applications, will not contain the paper set of reference copies but will contain other information, e.g., a copy of the decision on petition[3] permitting such procedure and a copy of the Form 1449 (or equivalent);[4] and

(2) an "electronic search tool"[5] containing different types of information.

The information supplied via the paper copies would be updated monthly, rather than as received from U.S. and foreign examiners, and cancellation of this arrangement would be an option for both

---

[1]Reference to MPEP 2001.05, Petition, page 3.

[2]Petition, page 3. The present petition requesting relief does not set forth any commitment nor intent by applicant to screen such information for relevancy to each of the U.S. applications in which the information is being cited.

[3]The original of which would be in the instant holding application.

[4]See, Petition under 37 CFR 1.182, *infra*.

[5]See, Petition under 37 CFR 1.183, *infra*.

Petitioner and the Office upon notice. These, and other more specific conditions, are discussed in further detail in regard to the § 1.182 petition, below.

Petitioner has essentially requested relief in two areas: (1) treatment of information in an electronic search tool, to be submitted independent of any particular application, as in compliance with IDS submission requirements for all bulk filing applications, and (2) the ability to provide the paper copies of each reference in an IDS submission in only one of the bulk filing applications (the instant holding application) as well as two additional sets of copies rather than as is normally required in each application for which the reference (IDS citation) is to be considered. These two areas of relief are independent of each other and drawn toward different regulations. Accordingly, the petition has been treated as two petitions, and the present decision addresses the two areas of requested relief separately. While it is undeniable that relief in both areas would be of benefit to Petitioner, the granting of relief in one area does not, in fact, require the granting of relief in the other. Moreover, in view of the need to further consider the requested relief related to the electronic search tool, deciding the requested relief issues separately permits at this time a partial grant of the original petition.[6]

Part II. Petition under 37 CFR 1.182- Electronic Search Tool

The issues involving the electronic search tool are more extensive than those relating to the requirement for paper copies in each bulk filing application and more time is needed to fully consider and address them. Accordingly, the petition under § 1.182 shall not be decided at this time and is not treated in the instant decision on the § 1.183 petition although it will continue to be considered, with a decision rendered in due course.

[6]It is recognized that petitioner believes the issues presented by the petition may not be decided independent of one another as both the paper copy issue and the electronic search tool issue represent the most complete solution to duty of disclosure issues under 37 CFR 1.56, Petition, fn. 5.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

The submitted petition fee of $130 will be treated as the § 1.183 petition fee.

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, page 600-102, right-hand column, and page 600-103, left-hand column.

Paper copies: Petitioner notes that the instant application is one of 200 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each reference, brought to the attention of the Office in regard to any one individual application, not be required to be submitted in each such application. Rather, it is requested that three complete sets of paper copies be permitted to be filed: one set for the instant application which will be designated as a holding application; one set to be used to establish new subclasses for the technology; and one set to be used as a reference set should either or both of the other two sets become corrupted (Petition, pages 6 and 7).[7]

Once past the initial IDS submission, it is proposed that applicant would update the IDS submissions once a month, rather than every time a new reference is found, although the time frames required by § 1.97 would have to be complied with, which may mean that submissions may occur more frequently than once a month.

Form 1449: In addition to submission of the three sets of paper copies in the instant "holding" application, the petition proposes that each of the bulk filing applications would receive a Form 1449 listing the reference citations (Petition, page 7) and the Form 1449 (in each of the bulk filing applications) would be updated, pursuant to the time requirements of § 1.97, each time the three sets of paper copies are updated. The petition is

[7]It would presumably up to the Technology Center to determine how best to store the reference set and how it is to be accessed.

silent as to whether other types of information that may be submitted in the holding application IDS, e.g., concise explanations of foreign language documents under § 1.98(a)(3), would also be supplied in all the bulk filing applications.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies), the petition states that upon allowance of the instant holding application the right is reserved to file a petition to suspend action in the instant application so that the application can remain as the holding application (Petition, page 7). Alternatively, upon agreement of the Assignee and a Director of the Technology Center involved, an alternate application may be designated as the holding application.

New subclasses: The petition envisions an affirmative duty on the Technology Center to establish new subclasses that will include each of the references submitted during the course of prosecution of the bulk filing applications.[8] In addition, the Office is to agree that "[e]xaminers will be required to search these newly created subclasses" (from submissions by the Assignee and later by others) "as part of the routine patent prosecution process." Petition, page 8.

Termination: Petitioner seeks a right of termination,[9] which is to be a mutual option. Termination is to be by written notice, to the attorney of record if the Office terminates and the filing of a termination request and by contacting the Director of TC 2800 if applicant terminates. Conventional IDS procedures would begin three months after notice of termination.

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[8]The new subclasses will later be supplemented by references supplied by others who may file applications related to the same technology.

[9]Although termination is discussed under a section related to licensing of the electronic search tool and the petition generally (Petition, pages 10 and 11), it is presumed that Petitioner intends to have the termination provision apply to the waiver of paper copies if that alone is granted.

37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of references in 200 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications,[10] on balance, there is seen to be sufficient benefit to justify waiver in this instance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.[11]

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[10]Even thought the technology of the applications may be related, the specific claims of the applications may require different classifications of the applications and the quantity of applications would dictate the need for more than one examiner to timely examine the applications.

[11]The waiver being granted in this instance is not intended to set a general precedent where there is more than one application containing related subject matter. The Office, however, intends to use the instant grant to study whether the opportunity for waiver can be extended to other applicants in similar circumstances, and whether a more general program can be announced. One factor that will be considered is the extent to which relevant information (that may not be necessarily required by § 1.56(b) but which would nonetheless be useful to the examiner, e.g., § 1.56(a)(1) and (2)), is submitted rather than huge dumps of nonrelevant or marginally relevant information.

It is noted that while the petition only refers to the submission of citations that are made by both U.S. and foreign examiners, the term "include" is used (Petition, page 2) which is open ended. The Petition states that it is the intention to submit a copy of every reference identified both by U.S. examiners in the 200 U.S. applications and by foreign examiners in as many as 40 corresponding foreign applications for each U.S. application (Petition, page 3). It has not been stated whether the current 671 reference citations currently of record represent only those citations made by U.S. and foreign examiners or whether they include citations from other sources, such as a

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing application provided that the following 8 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) The (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

   **Note:** Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

   A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in the bulk filing application;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would

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preexamination search or third party citations. See also Petition, page 19.

have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications,[12] or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) The Office has established a series of Official Digests in Class 174 based on the technology represented by the instant invention (a classification schedule thereof is attached). As is the case will all Digests, their usefulness will be continually evaluated. The Office will place the holding application's references in the Digests as they are determined to require such placement and as new ones are brought to the attention of the Office either by Petitioner or a third party. A search of the Digests themselves or what they contain (such as the holding application or reference copy sets), either in paper copy or electronic form, will be

[12]The patent file can be kept in the Technology Center for easy reference, or rather than rely upon the patent, either the reference set of paper copies could be utilized, or the Office may decide to rely on the Digests being created.

conducted when mandatory based on the classification of the claims, or when deemed advisable - on a case by case basis.

## Part IV. Summary

A Decision on the Petition under 37 CFR 1.182, drawn toward submission of the electronic search tool, will be acted upon in due course when all outstanding issues are resolved.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted, however, the following is not agreed to:

- the grant of a future petition under 37 CFR 1.103 for suspension from publication of the holding application should it be allowed,
- the required search of subclasses from one of the three sets of paper copies and placement of one of the other sets of paper copies therein, and
- any termination provision more than two months (rather than the three months that the petition sets forth) from notice of termination.

## Part V. Further Correspondence

Further correspondence with respect to this matter should be addressed to Hiram H. Bernstein, Senior Legal Advisor, Special Program Law Office, as follows:

By mail: Commissioner of Patents and Trademarks
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: Special Program Law Office
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries specific to this matter should be directed to Mr. Bernstein at (703) 305-9285.

The instant application will be retained by this Office: for a period of TWO MONTHS to await any response to the instant Decision, and for the purpose of continuing review of the § 1.182 petition re the electronic search tool.

Robert J. Spar
Director
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Attachment: List of Digests 13-33

| | |
|---|---|
| Digest 13 | HIGH VOLTAGE CABLE (E.G., ABOVE 10KV, CORONA PREVENTION, ETC.) |
| Digest 14 | . Having a particular cable application (e.g., winding, etc.) |
| Digest 15 | .. In a power generation system (e.g., prime-mover dynamo, generator system, etc.) |
| Digest 16 | .. In a motive power system (e.g., electric motor control system, etc.) |
| Digest 17 | .. In an electric power conversion, regulation, or protection system |
| Digest 18 | .. In a power distribution network |
| Digest 19 | .. In a dynamo-electric machine |
| Digest 20 | ... Stator |
| Digest 21 | ... Rotor |
| Digest 22 | ... Winding, per se |
| Digest 23 | .. In a circuit breaker, relay, or switch |
| Digest 24 | .. In an inductive device (e.g., reactor, electromagnet, etc.) |
| Digest 25 | ... Transformer |
| Digest 26 | . Having a plural-layer insulation system |
| Digest 27 | .. Including a semiconductive layer |
| Digest 28 | ... Plural semiconductive layers |
| Digest 29 | . Having a semiconductive layer |
| Digest 30 | . Having insulation with a particular dimension or geometry |
| Digest 31 | . Having a shield or metallic layer |
| Digest 32 | . Having means for cooling |
| Digest 33 | . Method of cable manufacture, assembly, repair, or splicing |

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 18

John P. De Luca
DYKEMA GOSSETT PLLC
1300 I Street N.W.
Washington, D.C. 20005

SEP 13 2002

In re Application of
BERGGREN et al.
Application No. 09/355,728
Filed: October 04, 1999
Attorney Docket No. 66291-042-2

DECISION
ON PETITION

This is a decision on the petition, filed April 15, 2002 requesting that the prosecution in the above-identified patent application be suspended for a period of six months under 37 C.F.R. § 1.103(a), and an additional six months, pursuant to MPEP § 1002.02(c)9, for a total of twelve months, beginning with the filing of the subject Petition.

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
> (1) A showing of good and sufficient cause for suspension of action; and
> (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office

In the Request, to establish cause, Petitioner asserts the claims and issues of the instant application are relevant to the claims and issues in at least U.S. Application No. 08/973,019 which Petitioner has appealed. Further, because the appeal of '019 will materially affect the prosecution of the instant application, the instant application should be suspended pending the decision on appeal of '019.

A review of the record indicates the instant application has claims and issues that are relevant to appealed case '019 . The claims in the instant application and appealed case '019 are both directed toward the particular structure of the high voltage cable. Consequently, since the

outcome of appealed case '019 will materially affect prosecution of the instant application, good and sufficient reasons have been demonstrated to warrant suspension of action.

Accordingly, the petition to suspend prosecution is GRANTED for a period of up to twelve (12) months starting from the filing of petition, April 15, 2002.

Inquiries regarding this decision should be directed to Richard Seidel at (703) 306-3431.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 18

John P. De Luca
DYKEMA GOSSETT PLLC
1300 I Street N.W.
Washington, D.C. 20005

SEP 13 2002

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|---|---|---|
| In re Application of | : | |
| BERGGREN et al. | : | DECISION |
| Application No. 09/355,728 | : | ON PETITION |
| Filed: October 04, 1999 | : | |
| Attorney Docket No. 66291-042-2 | : | |

This is a decision on the petition, filed April 15, 2002 requesting that the prosecution in the above-identified patent application be suspended for a period of six months under 37 C.F.R. § 1.103(a), and an additional six months, pursuant to MPEP § 1002.02(c)9, for a total of twelve months, beginning with the filing of the subject Petition.

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
> (1) A showing of good and sufficient cause for suspension of action; and
> (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office

In the Request, to establish cause, Petitioner asserts the claims and issues of the instant application are relevant to the claims and issues in at least U.S. Application No. 08/973,019 which Petitioner has appealed. Further, because the appeal of '019 will materially affect the prosecution of the instant application, the instant application should be suspended pending the decision on appeal of '019.

A review of the record indicates the instant application has claims and issues that are relevant to appealed case '019 . The claims in the instant application and appealed case '019 are both directed toward the particular structure of the high voltage cable. Consequently, since the

outcome of appealed case '019 will materially affect prosecution of the instant application, good and sufficient reasons have been demonstrated to warrant suspension of action.

Accordingly, the petition to suspend prosecution is GRANTED for a period of up to twelve (12) months starting from the filing of petition, April 15, 2002.

Inquiries regarding this decision should be directed to Richard Seidel at (703) 306-3431.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/355,728 | 10/04/1999 | BERTIL BERGGREN | 705/71955-2/ | 6850 |

25269 7590 08/19/2003

DYKEMA GOSSETT PLLC
FRANKLIN SQUARE, THIRD FLOOR WEST
1300 I STREET, NW
WASHINGTON, DC 20005

| EXAMINER |
|---|
| MULLINS, BURTON S |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2834 | |

DATE MAILED: 08/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

The request for deferral/suspension of action under 37 CFR 1.103 has been approved.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No.

John P. De Luca
DYKEMA GOSSETT PLLC
1300 I Street N.W.
Washington, D.C. 20005

AUG 19 2003

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| In re Application of | : | |
| BERGGRRN et al. | : | DECISION |
| Application No. 09/355,728 | : | ON PETITION |
| Filed: October 04, 1999 | : | |
| Attorney Docket No. 66291-042-2 | : | |

This is a decision on the petition filed on May 01, 2003, requesting that the prosecution in the above-identified patent application be suspended for an additional six months beyond the 12 months that prosecution was suspended under 37 C.F.R. § 1.103(a). The 12 month suspension expired on April 15, 2003.

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
> (1) A showing of good and sufficient cause for suspension of action; and
> (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office

In the Request, to establish cause, Petitioner asserts the claims and issues of the instant application are relevant to the claims and issues in at least U.S. Application No. 08/973,019 which Petitioner has appealed. Further, because the appeal of '019 will materially affect the prosecution of the instant application, the instant application should be suspended pending the decision on appeal of '019.

A review of the record indicates the instant application has claims and issues that are relevant to appealed case '019 . The claims in the instant application and appealed case '019 are both

directed toward the particular structure of the high voltage cable. Consequently, since the outcome of appealed case '019 will materially affect prosecution of the instant application, good and sufficient reasons have been demonstrated to warrant suspension of action.

Accordingly, the petition to suspend prosecution is GRANTED for a period of up to six (6) months, beginning April 15, 2003.

Inquiries regarding this decision should be directed to Elvin Enad at (703) 308-7619.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 21

Bradley D. Lytle
OBLON, SPIVAK, MCCLELAND,
MAIER & NEUSTADT, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202

JUL 17 2002

| | | |
|---|---|---|
| In re Application of | : | |
| KALLDIN et al. | : | DECISION |
| Application No. 09/355,753 | : | ON PETITION |
| Filed: March 17, 2000 | : | |
| Attorney Docket No. 196967US-6X PCT | : | |

This is a decision on the petition, filed April 29, 2002 requesting that the prosecution in the above-identified patent application be suspended for a period of six months under 37 C.F.R. § 1.103(a), and an additional six months, pursuant to MPEP § 1002.02(c)9, for a total of twelve months, beginning with the filing of the subject Petition.

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
> (1) A showing of good and sufficient cause for suspension of action; and
> (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office

In the Request, to establish cause, Petitioner asserts the claims and issues of the instant application are relevant to the claims and issues in at least U.S. Application No. 08/973,019 which Petitioner has appealed. Further, because the appeal of '019 will materially affect the prosecution of the instant application, the instant application should be suspended pending the decision on appeal of '019.

A review of the record indicates the instant application has claims and issues that are relevant to

appealed case '019 . The claims in the instant application and appealed case '019 are both directed toward the particular structure of the high voltage cable. Consequently, since the outcome of appealed case '019 will materially affect prosecution of the instant application, good and sufficient reasons have been demonstrated to warrant suspension of action.

Accordingly, the petition to suspend prosecution is GRANTED for a period of up to twelve (12) months starting from the filing of petition, April 29, 2002.

Inquiries regarding this decision should be directed to Richard Seidel at (703) 306-3431.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 15

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Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202

APR 11 2002

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|---|---|---|
| In re Application of | : | |
| KALLDIN et al. | : | DECISION |
| Application No. 09/355,753 | : | ON PETITION |
| Filed: March 17, 2000 | : | |
| Attorney Docket No. 705/71946-81 | : | |

This is a decision on the petition, filed March 14, 2002 requesting that the prosecution in the above-identified patent application be suspended for a period of six months under 37 C.F.R. § 1.103(a). Petitioner also requests a second suspension of time for an additional six months, pursuant to MPEP § 1002.02(c)9, for a total of twelve months, beginning with the filing of the subject Petition.

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. *The Office will not suspend action if a reply by applicant to an Office action is outstanding.*

A review of the record indicates that an Office Action was mailed on October 29, 2001. To date, no reply to the outstanding Office Action has been received. Accordingly, Petitioner's request for suspension of action in this application under 37 CFR1.103(a) is denied as being improper. The period for response to the outstanding Office Action continues to run three (3) months from the October 29, 2001 mail date.

The petition is **DENIED**.

Inquiries regarding this decision should be directed to Richard Seidel at (703) 306-3431.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No.

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MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, Virginia 22314

JUN 12 2003

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|---|---|---|
| In re Application of | : | |
| HOLMSTROM et al. | : | DECISION |
| Application No. 09/355,753 | : | ON PETITION |
| RCE Filed: April 29, 2002 | : | |
| Attorney Docket No. 196955US-6X PCT | : | |

This is a decision on the petition, filed April 25, 2003, requesting that the prosecution in the above-identified patent application be suspended for an additional six months beyond the 12 months that prosecution has been suspended under 37 C.F.R. § 1.103(a).

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
> (1) A showing of good and sufficient cause for suspension of action; and
> (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office

In the Request, to establish cause, Petitioner asserts the claims and issues of the instant application are relevant to the claims and issues in at least U.S. Application No. 08/973,019 which Petitioner has appealed. Further, because the appeal of '019 will materially affect the prosecution of the instant application, the instant application should be suspended pending the decision on appeal of '019.

A review of the record indicates the instant application has claims and issues that are relevant to appealed case '019 . The claims in the instant application and appealed case '019 are both directed toward the particular structure of the high voltage cable. Consequently, since the

outcome of appealed case '019 will materially affect prosecution of the instant application, good and sufficient reasons have been demonstrated to warrant suspension of action.

Accordingly, the petition to suspend prosecution is GRANTED for a period of up to six (6) months starting from the filing of petition, April 25, 2003.

Inquiries regarding this decision should be directed to Elvin Enad at (703) 308-7619.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Paper No. 22

Bradley D. Lytle
OBLON, SPIVAK, MCCLELAND,
MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, Virginia 22314

AUG 18 2003

In re Application of :
UDO FROMM et al. :
Application No. 09/355,801 :
RCE Filed: July 1, 2002 :
Attorney Docket No. 9847-0020-6X PCT :

DECISION
ON PETITION

This is a decision on the petition, filed July 01, 2003, requesting that the prosecution in the above-identified patent application be suspended for an additional six months beyond the 12 months that prosecution has been suspended under 37 C.F.R. § 1.103(a).

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
> (1) A showing of good and sufficient cause for suspension of action; and
> (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office

In the Request, to establish cause, Petitioner asserts the claims and issues of the instant application are relevant to the claims and issues in at least U.S. Application No. 08/973,019 which Petitioner has appealed. Further, because the appeal of '019 will materially affect the prosecution of the instant application, the instant application should be suspended pending the decision on appeal of '019.

A review of the record indicates the instant application has claims and issues that are relevant to appealed case '019 . The claims in the instant application and appealed case '019 are both directed toward the particular structure of the high voltage cable. Consequently, since the

outcome of appealed case '019 will materially affect prosecution of the instant application, good and sufficient reasons have been demonstrated to warrant suspension of action.

Accordingly, the petition to suspend prosecution is GRANTED for a period of up to six (6) months starting from the filing of petition, July 01, 2003.

Inquiries regarding this decision should be directed to Elvin Enad at (703) 308-7619.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 19

Bradley D. Lytle
OBLON, SPIVAK, MCCLELAND,
MAIER & NEUSTADT, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, Virginia 22202

JUL 18 2002

| | | |
|---|---|---|
| In re Application of | : | |
| FROMM et al. | : | DECISION |
| Application No. 09/355,801 | : | ON PETITION |
| Filed: October 14, 1999 | : | |
| Attorney Docket No. 9847-0020-6X PCT | : | |

This is a decision on the petition, filed July 1, 2002 requesting that the prosecution in the above-identified patent application be suspended for a period of six months under 37 C.F.R. § 1.103(a), and an additional six months, pursuant to MPEP § 1002.02(c)9, for a total of twelve months, beginning with the filing of the subject Petition.

Regarding a suspension on request of the applicant, 37 CFR 1.103(a) provides:

> (a) Suspension for cause. On request of the applicant, the Office may grant a suspension of action by the Office under this paragraph for good and sufficient cause. The Office will not suspend action if a reply by applicant to an Office action is outstanding. Any petition for suspension of action under this paragraph must specify a period of suspension not exceeding six months. Any petition for suspension of action under this paragraph must also include:
> (1) A showing of good and sufficient cause for suspension of action; and
> (2) The fee set forth in § 1.17(h), unless such cause is the fault of the Office

In the Request, to establish cause, Petitioner asserts the claims and issues of the instant application are relevant to the claims and issues in at least U.S. Application No. 08/973,019 which Petitioner has appealed. Further, because the appeal of '019 will materially affect the prosecution of the instant application, the instant application should be suspended pending the decision on appeal of '019.

A review of the record indicates the instant application has claims and issues that are relevant to

appealed case '019 . The claims in the instant application and appealed case '019 are both directed toward the particular structure of the high voltage cable. Consequently, since the outcome of appealed case '019 will materially affect prosecution of the instant application, good and sufficient reasons have been demonstrated to warrant suspension of action.

Accordingly, the petition to suspend prosecution is GRANTED for a period of up to twelve (12) months starting from the filing of petition, July 1, 2002.

Inquiries regarding this decision should be directed to Richard Seidel at (703) 306-3431.

Richard Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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P.O. Box 1450
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NOV 0 9 2006

OFFICE OF PETITIONS

Fitch Even Tabin and Flannery
120 South La Salle Street
Suite 1600
Chicago, IL 60603-3406

| | | |
|---|---|---|
| In re Application of | : | |
| Deborah Knutzon et al. | : | |
| Application No. 09/355,903 | : | DECISION ON PETITION |
| Filed: August 5, 1999 | : | TO WITHDRAW |
| Attorney Docket No. CGAB-320-USA | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 18, 2006.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Scott J. Menghini on behalf of all attorneys of record who are associated with Customer No. 22242.

All attorneys/agents associated with the Customer No. 22242 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed July 14, 2006 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Terri Williams at 571-272-2991.

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Deborah Knutzon**
6110 Rockhurst Way
Granite Bay, CA 95746

cc: **Biotechnology Law Group**
527 N. Highway 101
Suite E
Solana Beach, CA 92075

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 09/355,903 | 08/05/1999 | DEBORAH KNUTZON | CGAB-320-USA |

**CONFIRMATION NO. 7089**

*OC000000021159372*

*OC000000021159372*

22242
FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

Date Mailed: 11/08/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/18/2006.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

---

Terri S. Williams

TERRI S WILLIAMS
OP (571) 272-2991

FORMER ATTORNEY/AGENT COPY

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United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/355,903 | 08/05/1999 | DEBORAH KNUTZON | ALM 86024 US (29135-5) | 7089 |

81774 7590 09/03/2009
Armstrong Teasdale LLP (29135)
Christopher M. Goff
One Metropolitan Square
Suite 2600
St. Louis, MO 63102-2740

| EXAMINER |
|---|
| GRUNBERG, ANNE MARIE |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1661 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 09/03/2009 | 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):

USpatents@armstrongteasdale.com

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Armstrong Teasdale LLP (29135)
Christopher M. Goff
One Metropolitan Square
Suite 2600
St. Louis MO 63102-2740

SEP 0 3 2009

In re Application of :
Knutzon et al. :
Serial No.: 09/355,903 : Decision on Petition
Filed: 5 August 1999 :
Attorney Docket No.: ALM 86024 US (29135-5)

This letter is in response to the petition filed under 37 C.F.R. § 1.144 filed on 25 June 2004 requesting reconsideration of the lack of unity requirement. The petition was only recently brought to the deciding official for consideration. The delay in acting upon this petition is regretted.

This application was filed as a national stage application under 35 USC 371 and as such, is eligible for unity of invention practice. In 2001, the examiner determined that unity was lacking between Group II, (product and method of using such) and Group I, (method of making the product). Applicant elected Group II. At this point in prosecution, there is no prior art rejection on the elected invention,. Because the elected product is free of the prior art, unity of invention exists between Group I and Group II.

The petition is **GRANTED** for the reasons set forth above. The restriction requirement set forth between Group I and II has been withdrawn. Claims 156-169, 172-181, and 183-185 will be examined along with claims 186-195, 197-198, 200-211, 224-235 and 243-244.

The application will be forwarded to the examiner for preparation of an Office action consistent with this decision.

Should there be any questions about this decision, please contact Quality Assurance Specialist Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Remy Yucel
Director, Technology Center 1600

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MILES & STOCKBRIDGE, PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

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OFFICE OF PETITIONS

In re Application of
Joseph Giovanni Barresi, et. al.
Application No. 09/355,987
Filed: November 18, 1999
Attorney Docket No. 6224/JCK

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 10, 2005, to revive the above-identified application. The delay in responding is regretted.

The application became abandoned for failure to file a proper reply to the non-final Office action mailed September 11, 2001, which set a shortened statutory period for reply of three (3) months. Since a three (3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained, the application became abandoned after midnight March 11, 2002. A Notice of Abandonment was mailed on October 31, 2002.

It is noted that while the above application was held abandoned after midnight March 11, 2002, the U.S. Patent and Trademark Office (USPTO), processed the improper CPA (RCE) and a non-final Office action was mailed on May 3, 2002 to which applicant timely responded with a an amendment and two (2) month extension of time on September 27, 2002.

Since the petition is found to be in compliance with 37 CFR 1.137(b), the petition is being treated as having been granted prior to the mailing of the May 3, 2002 Office action. Accordingly, the petition is **GRANTED** and this decision ratifies the ensuing prosecution.

The application is being referred to the Technology Center Art Unit 1742, for consideration of the amendment filed September 27, 2002.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ANSEL M. SCHWARTZ
ONE STERLING PLAZA
201 N CRAIG STREET - SUITE 304
PITTSBURGH, PA 15213

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,901,517 | : | |
| Issue Date: May 31, 2005 | : | |
| Application No. 09/356,086 | : | ON PETITION |
| Filed: July 16, 1999 | : | |
| Patentee(s): Seth Redmore | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed April 22, 2005, to revive the above-identified application.

A review of the record discloses that the application became abandoned for failure to pay the issue on or before January 14, 2005. On April 22, 2005, the present petition was filed, along with the requisite issue fee. While it is noted that the requirements of 37 CFR 1.137(b) were satisfied in the petition filed January 14, 2005, a decision on the petition was never rendered. However, on May 31, 2005, the application issued as U.S. Patent No. 6,901,517.

Since the record shows that a grantable petition was filed on April 22, 2005, the present petition is **granted** *nunc pro tunc*.

This application is being referred to the Files Repository.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

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BAKER & BOTTS LLP
ONE SHELL PLAZA
910 LOUISIANA
HOUSTON, TX 77002-4995

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Elizabeth M. Szabo et al :
Application No. 09/356,236 :
Filed: July 16, 1999 :
Attorney Docket No. 016295.0346 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 28, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed September 24, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 25, 2002.

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on March 28, 2002.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $930 extension of time submitted with the petition on March 28, 2003 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application file is being forwarded to Technology Center 3600 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

FEB 20 2001

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
Paper #: 7

STEVE T ZELSON ESQ
NOVO NORDISK OF NORTH AMERICA INC
405 LEXINGTON AVENUE
SUITE 6400
NEW YORK , NY 10174-6400

| | |
|---|---|
| In re Application of | : |
| Bernd Peschke et al | : |
| Serial No.: 09/356,313 | : WITHDRAWAL OF ABANDONMENT |
| Filed: July 16, 1999 | : |
| Attorney Docket No.: 5573.210 | : |

This is in response to applicants' informal petition under 37 CFR 1.181, filed September 28, 2000, requesting withdrawal of the holding of abandonment based on the filing of a timely response to the Office action mailed January 19, 2000.

A review of the file history shows that the examiner mailed an Office action to applicants on January 19, 2000, setting a one month shortened statutory time period for reply. On August 28, 2000, the examiner mailed a Notice of Abandonment to applicants indicating no response to the Office action had been received..

Applicants state that a reply to the Office action, was filed by facsimile transmission on February 4, 2000, as evidenced by their Office copy of the transmission report showing a completed transmission on February 4, 2000. Applicant provides a copy of the submitted reply with the petition. (The original reply has not been located.) In view of this applicant is considered to have submitted a timely reply.

Applicant's petition is **GRANTED.** The application is restored to pending status with the mailing of this decision and will be forwarded to the examiner for further consideration.

Should there be any questions with regard to this letter please contact William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.

Jasemine C. Chambers
Director, Technology Center 1600

UNITED STATES DEPARTMENT OF C MMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/356,322 | | | |

| EXAMINER | |
|---|---|
| | |
| ART UNIT | PAPER NUMBER |
| | 35 |

DATE MAILED:

The decision on the petition filed in the above entitled application is as follows:

☐ Delay in Prosecution Held Unavoidable (35 U.S.C. 133),

Petition Granted _____

☐ Delayed Payment of Issue Fee Accepted (35 U.S.C. 151),

Petition Granted _____

☒ Petition Granted COLOR DRAWINGS (37 CFR §1.84) (3 MARCH 2003)

☐ Petition Denied _____

☐ Petition Dismissed _____

By direction of the Deputy
Assistant Commissioner for Patents

_____

MPW

MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 19

Shannon Votava, Esq.
Honeywell International Inc.
101 Columbia Road
P.O. Box 2245
Morristown, NJ 07962-1057

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**MAY 0 2 2002**

**OFFICE OF PETITIONS**

In re Application of :
Joseph A. Levert, et al. :
Application No. 09/356,487 :
Filed: July 19, 1999 :
Attorney Docket No. 30-4736 (4780) :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed February 13, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 18, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 19, 2001.

37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. If the statement contained in the instant petition varies from the language required by 37CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $920.00 extension of time submitted with the petition on February 13, 2002 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111, or in her absence, Sherry Brinkley at (703)305-9220.

The application file is being forwarded to Technology Center 1700, Art Unit 1765.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry Brinkley
Petitions Examiner

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALLEN C. TURNER
TRASKBRITT, P.C.
P.O. BOX 2550
SALT LAKE CITY, UT 84110-2550

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JAN 1 2 2004

**OFFICE OF PETITIONS**

In re Application of :
Frits J. Fallaux et al :
Application No. 09/356,575 :
Filed: July 19, 1999 :
Attorney Docket No. 3935US

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

**Effective December 1, 2003, the Office of Petitions can no longer receive hand-carried correspondence, or facsimile transmissions of correspondence. The centralized location for hand-carried correspondence is the Customer Window located at:**

2011 South Clark Place
Crystal Plaza Two, Lobby
Arlington, VA 22202

The centralized facsimile number is **(703) 872-9306.**

This file is being forwarded to the Files Repository.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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**DATE:** October 4, 2004
**TO:** Certificates of Correction Branch
**FROM:** Amy Nelson
SPE, Art Unit 1632
**SUBJECT:** REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 6,265,212 as specified on the attached Certificate.

Amy Nelson

Amy Nelson, SPE
Art Unit 1632

# UNITED STATES PATENT AND TRADEMARK OFFICE

## CERTIFICATE

Patent No. 6,265,212
Patented: July 24, 2001

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

Frits J. Fallaux
Robert C. Hoeben
Abraham Bout
Domenico Valerio
Alex J. Van der Eb

Amy Nelson
Supervisory Patent Examiner
Art Unit 1632

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 9

Testa, Hurwitz & Thibeault, LLP
High Street Tower
125 High Street
Boston, MA 02110

**MAILED**

SEP 1 5 2004

**Technology Center 2100**

In re Application of:
William DUANE, et al.
Application No. 09/356,600
Filed: July 19, 1999
For: SYSTEM AND METHODS FOR MAINTAINING AND DISTRIBUTING PERSONAL SECURITY DEVICES

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed March 8, 2004.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

A review of the file reveals that a non-final Office Action was mailed on October 6, 2003. Therefore, the time for response, including the maximum extendable period, to the Office action mailed October 6, 2003, ended on April 6, 2004. Thus, as of the mailing of this decision, less than thirty days remain in the period for response to the Office action.

Accordingly, the request is **DENIED**. Further communications will continue to be addressed to the address above.

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Anthony L. Meola, Esq.
Shearman & Sterling
599 Lexington Avenue
New York, NY 10022

MAILED

FEB 20 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

| | | |
|---|---|---|
| In re Application of<br>Barbara S. Johnson<br>Application No. 09/356,711<br>Filed : July 20, 1999<br>AUTOMATED PAYMENT | :<br>:<br>:<br>:<br>:<br>: | **DECISION ON PETITION UNDER** For:<br>**37 CFR §1.181** |

This is in response to the petition received on October 22, 2002 for correction of the effect of actions taken by employees of the USPTO with regard to a Continued Prosecution Application (CPA) request that are alleged to be unauthorized and improper. The delay in treating this petition is sincerely regretted.

The petition is **GRANTED**.

A review of the prosecution history of the above-mentioned application shows that a non-final Office action was mailed on January 24, 2002. On July 23, 2002 applicant submitted a request for a three month extension of time and a request for a Continued Prosecution Application (CPA). Applicant did not submit a check for filing the CPA nor did the CPA request include any authorization for fees to be charged to applicant's deposit account. Indeed, the request included the language "filing fee to be paid in response to Notice to File Missing Parts, do not charge deposit account for filing fee". Nevertheless, the filing fee of $370 was charged to Deposit Account 20-0531. On August 22, 2002 the examiner issued a final Office action that repeated the rejections made in the Office action of January 24, 2002 since no amendments or arguments had been submitted in rebuttal to the position taken by the examiner in the January 24, 2002 action. Applicant has indicated that their intent was to wait for a Missing Parts Report indicating that the filing fee for the CPA had not been received at which time they would have submitted the filing fee and the required surcharge. Applicants assert that the USPTO employees who processed the CPA request charged the filing fee without authorization, thus allowing a final rejection to be mailed prematurely.

Applicant's petition asks for relief in the form of:

1) a refund of the filing fee charged in connection with the CPA request,
2) a withdrawal of the final Office action issued by the USPTO on August 22, 2002, and
3) issuance of the Notice to File Missing Parts in connection with the CPA request.

MPEP 201.06(d) provides that "A general authorization to charge fees to a deposit account which was filed in the prior application carries over from the prior nonprovisional application to a CPA. Thus, where a general authorization to charge fees to a deposit account was filed in the prior application the TC should charge the necessary filing fee of the CPA to the deposit account". While there was a general authorization to charge fees to a deposit account in this case, MPEP 201.06(d) further indicates "Where a general authorization to charge fees to a deposit account was filed in the prior application and applicant desires to file a CPA without paying the filing fee on the filing date of the application, applicant may file the CPA with specific instructions revoking the general authorization filed in the prior application". Therefore, given the explicit instructions by the applicant in the request to not charge the filing fee to the deposit account, charging the filing fee is deemed to have been improper.

As a result, the basic filing fee of $370 will be refunded to applicant's deposit account 20-0531. The final rejection of August 22, 2002 is hereby **VACATED** as being mailed prior to the proper payment of the filing fee.

This application will be forwarded to the Supervisory Legal Instruments Examiner for refund of the filing fee as outlined above, before issuing a Notice of Missing Parts in connection with the above-noted CPA request.

Inquiries related to this decision may be directed to me at the number below.

Steven N. Meyers, Special Program Examiner
Technology Center 3600
(703) 308-3868
Facsimile No. (703) 605-0586

Snm: 2/20/03

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

Thomas M. Galgano, Esq.
GALGANO & ASSOCIATES, PLLC
SUITE 204
20 W. PARK AVE.
LONG BEACH NY 11561

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**OFFICE OF PETITIONS**

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| In re Application of<br>Joseph E. Porcelli<br>Application No. 09/356,771<br>Filed: July7 16, 1999<br>Attorney Docket Number: 1310-2<br>Title: CAR AND TRUCK BEVERAGE HOLDER | :<br>:<br>:<br>:<br>:<br>:<br>: | DECISION ON PETITION<br>UNDER 37 C.F.R. §1.137(a) |

This is a decision on the petition pursuant to 37 C.F.R. § 1.137(a)[1], to revive the above-identified application, filed on March 8, 2007.

The concurrently submitted change of correspondence address has been entered and made of record.

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1 A grantable petition pursuant to 37 C.F.R. §1.137(a) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in 37 C.F.R. §1.17(l);
(3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
(4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. §1.20(d)) required pursuant to paragraph (d) of this section.

## THE RELEVANT STANDARD

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[2]

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[3]

Nonawareness of a PTO rule will not constitute unavoidable delay[4]

The burden of showing the cause of the delay is on the person seeking to revive the application[5].

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action[6].

The word 'unavoidable' ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business[7].

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." [8] Nonetheless, a petition cannot be granted where a petitioner has failed to meet

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2 Id.

3 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

4 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawarness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

5 Id.
6 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).
7 In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(*quoting* Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).
8 Smith v. Mossinghoff, 671 F.2d at 538, 213 U.S.P.Q. at 982.

his or her burden of establishing that the delay was "unavoidable."[9]

THE COMMISSIONER IS RESPONSIBLE FOR DETERMINING THE STANDARD FOR UNAVOIDABLE DELAY AND FOR APPLYING THAT STANDARD.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."[10]

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts **clearly** demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked **any** basis in reason or common sense."[11]

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"[12]

> "The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."[13]

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9 Haines v. Quigg, 5 USPQ2d 1130 (N.D. Ind. 1987), 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.

10 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

11 Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

12 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

13 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

## RELEVANT PORTIONS OF THE C.F.R.

37 C.F.R. § 1.2 sets forth, *in toto*:

> All business with the Patent and 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.

37 C.F.R. § 1.113 sets forth, *in toto*:

> (a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for ex parte reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 41.31 of this title), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Director in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an inter partes reexamination filed under § 1.913, see § 1.953.
> (b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.
> (c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

37 C.F.R. § 1.134 sets forth, *in toto*:

> An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.

37 C.F.R. § 1.135 sets forth, in toto:

> (a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
> (b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

> (c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

## BACKGROUND

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R § 1.113 in a timely manner to the final Office action mailed March 4, 2004, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 C.F.R § 1.136(a) were obtained, and no further responses were received. Accordingly, the above-identified application became abandoned on June 5, 2004. A notice of abandonment was mailed on October 20, 2004.

On September 7, 2004, a continuation application was filed, claiming the benefit of the present application. Petitioner further included a three-month extension of time, a preliminary amendment, and remarks. This continuation application was assigned a serial number of 10/935,503.

## ANALYSIS

With the present petition, Petitioner appears to be setting forth that he intended to submit a Request for Continued Examination (RCE), but submitted the wrong form: "it would appear that although there was a minor mistake with respect to the transmittal form used with filing the RCE application…"

Petitioner has met requirements (1) and (2) of Rule § 1.137(a). The fourth requirement is not applicable.

Regarding the third requirement, Petitioner has not established that the entire period of delay was unavoidable. It appears that Petitioner attempted to file an RCE, but filed a continuation application instead. **This is not a "minor mistake."** The RCE transmittal form, form PTO/SB/30 is what constitutes a Request for Continued Examination.

Additionally, the record strongly suggests that Petitioner intended to file a **continuation application, and not an RCE.** Petitioner submitted a "Utility Patent Application Transmittal" form, checked the box that indicates that the filing was a continuation of a prior-filed application, and identified the filing as a continuation of "prior application no. 09/356,771." Moreover, Petitioner submitted a "Fee Transmittal for FY 2003" form, and filled in "$385.00" as the fee submitted for the

utility filing fee. It is noted that the field associated with the payment associated with the filing of an RCE was left blank. Additionally, it is noted that each of these forms was signed not by a secretary or a paralegal, but rather by the Petitioner, who is a registered practitioner.

Moreover, it is noted that **this application has been abandoned for an extended period of time.**

The notice of abandonment was mailed on October 20, 2004. More than two years later, the present petition was filed.

After receiving the notice of abandonment, it is not clear why the Applicant chose to take no course of action for such a long period of time. It does not appear that the Applicant took any action to further the prosecution of this application.

It is equally unclear what, after all of this time, prompted the Applicant to advance the prosecution of this application.

As such, it appears that the Applicant intentionally allowed this application to go abandoned.

The extended inaction of the Applicant appears to be intentional, and Petitioner does not appear to have submitted a statement of facts that would assert a contrary position.

A discussion follows.

In order for a petition under 37 C.F.R. § 1.137(a) to be granted, the holder of the rights to the application must have unintentionally allowed the application to go abandoned, and a delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unavoidable" delay within the meaning of 37 C.F.R. § 1.137(a).

The periods of delay:

There are three periods to be considered during the evaluation of a petition under 37 C.F.R. § 1.137(a):

(1) the delay in reply that originally resulted in the abandonment;
(2) the delay in filing an initial petition pursuant to 37 C.F.R. § 1.137(a) to have the holding of abandonment withdrawn or to revive the application; and
(3) the delay in filing a grantable petition pursuant to 37

C.F.R. § 1.137(a) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (2) or (3).

Here, in view of the inordinate delay of more than two years (the period of time between the mailing of the notice of abandonment and the filing of the present petition to revive this application) in resuming prosecution, there is a question whether at least a portion of the entire delay was intentional.

On renewed petition, Petitioner must explain what effort(s) was made to further the prosecution of this application after receiving the notice of abandonment, and further, why no reply was filed for such an extended period of time. If no effort was made to reply, then Petitioner must explain why the delay in this application does not result from a deliberate course of action (or inaction). Statements are required from any and all persons having firsthand knowledge of the circumstances surrounding the lack of a timely response to the holding of abandonment. **As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action.** See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996)(unpublished)(patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

Punctuality and Due Diligence:

For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894).

Similarly, an invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App.

D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

The lengthy period of inaction does not appear to be consistent with the requirements of punctuality, due diligence, good faith, and the encouragement of reasonable promptness.

On renewed petition, Petitioner will need to address each of these issues, if it is to be established that the entire period of delay was not intentional.

Petitioner is reminded that any statement of facts should be made by one having firsthand knowledge of the facts set forth therein.

Petitioner has referred to a telephonic discussion which purportedly took place with a member of the Office, however pursuant to Rule 37 C.F.R. § 1.2, "No attention can be "paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.'

Petitioner has further referred to **a plurality of status inquiries** that were purportedly submitted to the Office. **Written evidence which would substantiate this allegation should be provided to the Office on renewed petition.**

Pursuant to the discussion above, the petition is **DISMISSED.**

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.137(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Thereafter, there will be no further reconsideration of this matter[14, 15].

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14 For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

15 If, on request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as a

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[16], hand-delivery[17], or facsimile[18].

Alternatively, Petitioner may wish to consider filing a petition under 37 C.F.R. § 1.137(b).

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225[19]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Paul Shanoski

Paul Shanoski
Senior Attorney
Office of Petitions
United States Patent and Trademark Office

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final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will **not** apply to that decision.
16 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
17 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
18 (571) 273-8300- please note this is a central facsimile number.
19 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. §1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

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**OFFICE OF PETITIONS**

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| In re Application of<br>Joseph E. Porcelli<br>Application No. 09/356,771<br>Filed: July7 16, 1999<br>Attorney Docket Number: 1310-2<br>Title: CAR AND TRUCK BEVERAGE HOLDER | :<br>:<br>:<br>:<br>:<br>:<br>: | DECISION ON PETITION<br>PURSUANT TO § 1.137(B) |

This is a decision on the petition, pursuant to 37 C.F.R. § 1.137(b)[1], to revive the above-identified application, filed on October 25, 2007.

This petition is **DISMISSED.**

This application became abandoned for failure to reply within the meaning of 37 C.F.R § 1.113 in a timely manner to the final Office action mailed March 4, 2004, which set a shortened statutory period for reply of three months. No extensions of

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1 A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

time under the provisions of 37 C.F.R § 1.136(a) were obtained, and no further responses were received. Accordingly, the above-identified application became abandoned on June 5, 2004. A notice of abandonment was mailed on October 20, 2004.

On September 7, 2004, a continuation application was filed, claiming the benefit of the present application. Petitioner further included a three-month extension of time, a preliminary amendment, and remarks. This continuation application was assigned a serial number of 10/935,503.

A petition pursuant to 37 C.F.R. § 1.137(a), to revive the above-identified application, was filed on March 8, 2007, and was dismissed via the mailing of a decision on August 24, 2007 for failure to establish that the entire period of delay was unavoidable.

Petitioner has met the first and second requirements of 37 C.F.R. § 1.137(b). The fourth requirement is not applicable.

Regarding the third requirement, Petitioner has included the proper statement of unintentional delay, however, it is noted that **this application has been abandoned for an extended period of time.**

The notice of abandonment was mailed on October 20, 2004. More than two years later, the petition pursuant to 37 C.F.R. § 1.137(a) was filed. After receiving the notice of abandonment, it is not clear why the Applicant chose to take no course of action for such a long period of time. It does not appear that the Applicant took any action to further the prosecution of this application.

<u>It is equally unclear what, after all of this time, prompted the Applicant to advance the prosecution of this application</u>.

As such, it appears that the Applicant <u>intentionally</u> allowed this application to go abandoned.

<u>The extended inaction of the Applicant appears to be intentional</u>, and Petitioner does not appear to have submitted a statement of facts that would assert a contrary position. A discussion follows.

In order for a petition pursuant to 37 C.F.R. § 1.137(b) to be granted, the holder of the rights to the application must have unintentionally allowed the application to go abandoned, and a delay resulting from a deliberately chosen course of action on

the part of the applicant is not an "unintentional" delay within the meaning of 37 C.F.R. § 1.137(b).

The periods of delay:

There are three periods to be considered during the evaluation of a petition pursuant to 37 C.F.R. § 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;
(2) the delay in filing the initial petition to either have the holding of abandonment withdrawn or to revive the application; and
(3) the delay in filing a grantable petition to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1), (2) or (3).

**As to Period (1)**, the patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 C.F.R. § 1.137(b)(3) provides that a petition under 37 C.F.R. § 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R.

§ 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 C.F.R. § 1.137(b). Here, in view of the inordinate delay of more than two years in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 C.F.R. § 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment. That party, in turn must explain what effort(s) was made to reply to the outstanding Office action and further, why no reply was filed. If no effort was made to reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). On renewed petition, it should be explained why a response to the non-final rejection was not provided in a timely manner. Statements should be provided from both the Applicant and former counsel.

As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996)(unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

**As to Period (2)**, where the applicant deliberately chose not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 C.F.R. § 1.137(b)[2].

2 See M.P.E.P. § 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 C.F.R. § 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 C.F.R. § 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated clear that any protracted delay (here, more than two years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. See Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. A statement is required from the Applicant explaining why he failed to file this petition sooner.

**As to Period (3)**, the decision on the petition pursuant to 37 C.F.R. § 1.137(a) indicated that due to the fact that this application has been abandoned for extended period of time, the abandonment appears to have been intentional, and in order to establish otherwise, Petitioner would need to submit "a statement of facts that would assert a contrary position[3]." As such, Petitioner was expressly informed that this extra submission would be required if it were to be established that the entire period of delay was not intentional - yet with this petition, it does not appear that Petitioner submitted any showing but for the statement of unintentional delay that is printed on form PTO/SB/64. Consequently, the entire delay in filing a grantable petition pursuant to 37 C.F.R. § 1.137(b) has not been shown to have been unintentional.

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3 Decision on petition pursuant to 37 C.F.R. § 1.137(a), page 6. See also pages 7-8.

Punctuality and Due Diligence:

For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894).

Similarly, an invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. § 6; 37 C.F.R. §§ 1.181, 182, 183.

The lengthy period of inaction does not appear to be consistent with the requirements of punctuality, due diligence, good faith, and the encouragement of reasonable promptness.

On renewed petition, Petitioner will need to address each of these issues, if it is to be established that the entire period of delay was not intentional.

Petitioner is reminded that any statement of facts should be made by one having firsthand knowledge of the facts set forth therein.

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.137(b)." This is not a final agency action within the meaning of 5 U.S.C § 704.

Thereafter, there will be no further reconsideration of this matter[4, 5].

---

4 For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82;

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[6], hand-delivery[7], or facsimile[8].

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225[9]. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

---

281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

5 If, on request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as a final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. § 1.137(e), will **not** apply to that decision.

6 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

7 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

8 (571) 273-8300- please note this is a central facsimile number.

9 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Paper No.

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DEC 0 8 2008

**OFFICE OF PETITIONS**

Thomas M. Galgano, Esq.
GALGANO & ASSOCIATES, PLLC
SUITE 204
20 W. PARK AVE.
LONG BEACH NY 11561

| | | |
|---|---|---|
| In re Application of | : | |
| Joseph E. Porcelli | : | |
| Application No. 09/356,771 | : | DECISION ON RENEWED PETITION |
| Filed: July7 16, 1999 | : | PURSUANT TO |
| Attorney Docket Number: 1310-2 | : | 37 C.F.R. § 1.137(b) |
| Title: CAR AND TRUCK BEVERAGE | : | |
| HOLDER | : | |

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.137(b), filed on July 28, 2008, to revive the above-identified application. It is noted that this petition contains a certificate of mailing dated July 24, 2008.

This renewed petition is **GRANTED**.

This application became abandoned for failure to reply within the meaning of 37 C.F.R § 1.113 in a timely manner to the final Office action mailed March 4, 2004, which set a shortened statutory period for reply of three months. No extensions of time under the provisions of 37 C.F.R § 1.136(a) were obtained, and no further responses were received. Accordingly, the above-identified application became abandoned on June 5, 2004. A notice of abandonment was mailed on October 20, 2004.

On September 7, 2004, a continuation application was filed, claiming the benefit of the present application. Petitioner further included a three-month extension of time, a preliminary amendment, and remarks. This continuation application was assigned a serial number of 10/935,503.

A petition pursuant to 37 C.F.R. § 1.137(a), to revive the above-identified application, was filed on March 8, 2007, and was dismissed via the mailing of a decision on August 24, 2007 for failure to establish that the entire period of delay was unavoidable.

An original petition pursuant to 37 C.F.R. § 1.137(b) was filed on October 25, 2007, and was dismissed via the mailing of a decision on March 24, 2008.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in 37 C.F.R. § 1.17(m);
(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
(4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

A Request for Continued Examination, along with the associated fee, was submitted on March 8, 2007. The fee that is associated with the filing of a petition pursuant to 37 C.F.R. § 1.137(b) was received on October 25, 2007.

The decision on the original petition pursuant to 37 C.F.R. § 1.137(b) indicated that the first three requirements of Rule 1.137(b) had been met, and that the fourth requirement of Rule 1.137(b) is not applicable, as a terminal disclaimer is not required.

With this renewed petition pursuant to 37 C.F.R. § 1.137(b), Petitioner has included a statement of facts that establishes that the entire period of delay was unintentional. Petitioner has further included a two-month extension of time so as to make timely this submission.

The Technology Center will be notified of this decision. The Technology Center's support staff will notify the Examiner of

this decision, so that the RCE that was submitted on March 8, 2007 can be processed. The amendment that was submitted on October 25, 2007 will serve as the required response.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the revival has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center where that change of status must be effected - **the Office of Petitions cannot effectuate a change of status.**

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.[1] All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

Anthony Knight
Supervisor
Office of Petitions

1 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

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OCT 08 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

REED SMITH SHAW & MCCLAY
2500 ONE LIBERTY PLACE
1650 MARKET STREET
PHILADELPHIA, PA 19103-7301

In re application of
Milton Riseman
Application No. 09/357,066
Filed: July 19, 1999
For: SYSTEM AND METHOD FOR AUTOMATICALLY PROCESSING LOAN APPLICATIONS

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in reply to applicant's Petition To Withdraw Holding of Abandonment under 37 CFR 1.181(a) filed April 17, 2002. There is no fee required for this petition.

The petition is **DISMISSED as moot**.

A review of the application file reveals that a Notice of Abandonment mailed January 16, 2002 specified that the application had become abandoned because of applicant's failure to reply to the Office action of June 19, 2001. The applicant provides, along with the petition, a copy of the amendment that applicant argues was timely filed on December 6, 2001.

A further review reveals that the amendment and extension of time (with a certificate of mailing of December 6, 2001) was received on March 19, 2002. Since a timely amendment and extension of time have been filed, the abandonment is hereby withdrawn. Since the originals of the amendment and extension of time in question are now in the file, there is no need to treat the petition on the merits and it is therefore dismissed as moot.

This application will be forwarded to the Supervisory Legal Instruments Examiner to withdraw the abandonment, return the application to pending status and enter the original amendment and extension of time before forwarding to the examiner.

Telephone inquiries relative to this decision should be directed me at the number below.

Steven N. Meyers, Special Program Examiner
Patent Technology Center 3600
(703) 308-3868
Facsimile No.: (703) 605-0586

SM/dew: 9/16/02

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Paper No. 15

FOLEY & LARDNER
WASHINGTON HARBOUR
3000 K STREET, N.W.
SUITE 500
WASHINGTON, DC 20007-5109

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NOV 03 2004

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Cees A. Van Der Voort :
Application No. 09/357,097 :
Filed: July 19, 1999 :
Attorney Docket No. 082671/0107 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 15, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed May 23, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 24, 2002.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application file is being forwarded to Technology Center 1600, Art Unit 1661 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 17

FOLEY & LARDNER
Washington Harbour
3000 K Street, N.W.
Suite 500
WASHINGTON, DC 20007-5109

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OFFICE OF PETITIONS

In re Application of
Cees A. Van der Voort
Application No. 09/357,103
Filed: July 19, 1999
Attorney Docket No. 082671/0105

ON PETITION

This is a decision on the petition, filed January 13, 2004, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The application became abandoned for a failure to reply in a timely manner to the non-final Office action mailed May 30, 2002. A Notice of Abandonment was mailed on January 23, 2003. On January 13, 2004, an amendment and the present petition were filed.

The petition is **GRANTED**.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9220. All other inquiries regarding this application should be directed to the Technology Center.

The application file is being forwarded to Technology Center 1661 for consideration of the amendment filed January 13, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 2023
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Paper No. 9

MAIL

SEP 02 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Haynes and Boone, L.L.P.
901 Main Street, Suite 3100
Dallas, Texas 75202

| | | |
|---|---|---|
| In re Application of: Rodney G. Adams | ) | |
| Application No.: 09/357,250 | ) | |
| Filed: July 20, 1999 | ) | **DECISION ON PETITION** |
| For: SYSTEM AND METHOD FOR | ) | **UNDER 37 C.F.R. § 1.181 TO** |
| TRANSFERRING INFORMATION IN | ) | **WITHDRAW HOLDING OF** |
| A HYPERTEXT TRANSFER | ) | **ABANDONMENT** |
| PROTOCOL BASED SYSTEM | ) | |

This is a decision on the petition filed July 15, 2003 under 37 CFR § 1.181 to withdraw the holding of abandonment of the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to file a timely response to the Office action of mail date November 5, 2002. A Notice of Abandonment has not been mailed.

In the absence of any apparent irregularity associated with the mailing of an Office communication, the Office may presume that the communication was properly mailed to the address of record. This presumption may be overcome by showing that the Office communication was not received.

M.P.E.P. § 711.03(c), section II states:

> The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

In support of the petition, Applicant's attorney, David L. McCombs, attests that the Office action was not received, and that upon conducting a search, no record of said Office action was found in the Attorney's file for this application. Petitioner supplies a copy of the docket records for Attorney Docket No. 26162.4 (which corresponds to the docket number indicated on papers filed in Application Serial No. 09/357,250) and states that this is where the record would have been entered in the firm's docketing system had the Office action been received and docketed. The docket record shows no entry reflecting receipt of the Office communication mailed November 5, 2002. Petitioner supplies additional evidence in the form of a declaration by Staff Administrator Suzanne M. Kiefer describing the docketing and tracking system of the firm and attesting to the nonreceipt of the aforementioned Office communication as evidenced by the lack of any corresponding entry in the docket records.

Petitioner has met the criteria of set out in MPEP 711.03(c) for establishing failure to receive an Office action. The petition is **GRANTED**. The Notice of Abandonment is **WITHDRAWN**.

The application file is being forwarded to the Technology Center support staff. The Office action of November 5, 2002 will be remailed to the address noted above with the three month Shortened Statutory Period restarted to run from the date of the remailing.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 306-4160

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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RIMAS LUKAS
530 JACKSON ST
2ND FLOOR
SAN FRANCISCO CA 94133

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Baer | : | |
| Application No. 09/357,423 | : | DECISION ON PETITION |
| Filed: July 20, 1999 | : | TO WITHDRAW |
| Attorney Docket No. ARC01-20005.00 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 20, 2006.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Rimas T. Lukas, the sole attorney of record.

All attorneys/agents associated with this application have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the assignee of the entire interest at the first copied address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed May 24, 2006 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to April Wise at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: JAN HUMMEL
MOLECULAR DEVICES CORPORATION
1311 ORLEANS DRIVE
SUNNYVALE, CA 94089

cc: FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

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UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 12

**AXCESS INC.**
**3208 COMMANDER DRIVE**
**CARROLLTON, TX 75006**

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OFFICE OF PETITIONS

In re Application of
Steeves, Wayne E.
Application No. 09/357,435
Filed: July 20, 1999
Attorney Docket No. 065446.0114

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 24, 2004, to revive the above-identified application.

The petition is **granted.**

This application became abandoned for failure to timely reply within three months to the non-final Office action mailed July 7, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on October 8, 2003. A Notice of Abandonment was mailed on February 10, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

The file is now being forwarded to Technology Center 2600 for further examination on the merits.

Telephone inquiries should be directed to the undersigned at (703) 306-0482.

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 21

**NEEDLE & ROSENBERG, P.C.**
**SUITE 1000**
**999 PEACHTREE STREET**
**ATLANTA, GA 30309-3915**

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| | | |
|---|---|---|
| In re Application of | : | |
| Smith et al. | : | |
| Application No. 09/357,452 | : | ON PETITION |
| Filed: July 20, 1999 | : | |
| Attorney Docket No. 19141.0046US | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed May 6, 2004, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply within three months to the non-final Office action mailed December 19, 2002. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on March 20, 2003. A Notice of Abandonment was mailed on September 10, 2003.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

The file is now being forwarded to Technology Center 3700 for further examination on the merits.

Telephone inquiries should be directed to the undersigned at (703) 306-0482.

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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In re Patent No. 6223412
Issue Date: May 1,2001
Application No. 09357482
Filed: July 20,1999
Attorney Docket No. 8402.901

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed May 5,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of May 5,2009 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6223412 | 2001-05-01 | 09357482 | 1999-07-20 | 8402.901 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ◉ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /kathrynlhester/ | Date (YYYY-MM-DD) | 2009-05-05 |
| Name | Kathryn L. Hester, Ph.D. | Registration Number | 46768 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

**DATE** : Jan. 3, 2006

**TO SPE OF** : ART UNIT ~~2622~~ 2625 (*Edward Coles*)

09/357593

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,930,788

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.
***Please see claim changes! In "clmpto", last paragraph in claim 1 is not grammatically cited, etc. Your denial or approval decision is needed below.***

sp Stacy Powell

**Thank You For Your Assistance**

**Certificates of Correction Branch**
***Tel. No. 703-308-9390 x120***

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:**

BEST AVAILABLE COPY

**SPE** **Art Unit** 2625

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Date : March 18, 2010

Patent No. :6524931
Inventor :Perera, Asanga, H.
Patent Issued :February 2, 2003
Title :METHOD FOR FORMINGA TRENCH ISOLATION STRUCTURE IN AN INTEGRATED
:CIRCUIT

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent.

Inspection of the application for the patent reveals that in connection with the alleged error pertaining to the Related Application Data; the printed data in the letters patent with regard to applicants request has been determined to be in accordance with the records within the Patent and Trademark office. Accordingly, there being no fault on the part of the Patent and Trademark Office, it has no authority to a issue certificate of correction under the provisions of 35 U.S.C. 254 and Rule 322 of the Rules of Practice of the United States Patent and Trademark Office in Patent Cases.

In view of the foregoing applicants request in this matter is hereby denied.

To have request further considered, a request for reconsideration filed under 37 CFR 1.323 which includes the required Certificate of Corrrection fee of $100.00 or a reconsideration filing together with documentation in support of applicants request filed under 1.322 should be submitted. Required documentation may include acknowledgement of receipt .

Any telephone inquiry concerning this communication should be directed to Ms. A. Green at (703) 756-1541.

Mary Diggs, Supervisor
Decisions & Certificates
of Correction Branch
(703) 756-1580 or (703) 756- 1544

Freescale Semiconductor, Inc.
Law Department
7700 West Parmer Lane PL02
Austin, TX 78729

/arg

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

LAW OFFICE OF DUANE S. KOBAYASHI
P.O. BOX 4160
LEESBURG, VA 20177

**COPY MAILED**

JUN 30 2009

**OFFICE OF PETITIONS**

In re Patent No. 6,895,557 :
Issue Date: May 17, 2005 :
Application No. 09/357,836 : NOTICE
Filed: July 21, 1999 :
Attorney Docket No. ADMI.0010000

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989).** Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Office record shows the 7 ½ year fee window opens May 17, 2012 and Surcharge Date November 20, 2012. Therefore, the $130 surcharge for payment with the six-month is being credit to petitioner's credit card.

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

UNITED STATES
PATENT AND
TRADEMARK OFFICE

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231
www.USPTO.gov

Mailed: JAN - 3 2003

WAK
Paper Number #24

| | | |
|---|---|---|
| In re Application of<br>Richard Levy<br>Serial No.: 09/357, 957<br>Filed: July 21, 1999<br>For: LUBRICANT COMPOSITIONS AND METHODS | : | DECISION ON PETITION |

This is a Decision on Petitions filed under 37 C.F.R. 1.181 on October 29, 2002 and August 27, 2002. The Petitions request that the Examiner formally reopen prosecution of the application and enter the 37 C.F.R. 1.116 amendment which was filed in response to the new grounds of rejection made by the Examiner in her Examiner's Answer. Petitioner is requesting that the Examiner reopen prosecution based upon the Examiner's response to Appellants arguments concerning the 35 U.S.C. 102(b) rejection stated in the reply brief.

**STATEMENT OF FACTS**

- July 05, 2001. Rejections were made under 35 U.S.C. 112, 102 and 103 in the prosecution of the application. A review of the facts discloses that the Examiner in her initial office action made a rejection to claims 1, 29, 35, 41 and 42 under 35 U.S.C. 102(b) as being clearly anticipated by the Admitted Prior Art. The Examiner discusses the combination of Levy '251 with Brannon-Peppas as anticipating the claimed composition and process of making.

- September 07, 2001. The Applicant responded to the Examiner's action requesting further consideration and examination and arguing that a 35 U.S.C. 102 rejection cannot employ multiple references since a finding of anticipation requires that all aspects of the claimed invention were already described in a single reference and further if it necessary to reach beyond the boundaries of a single reference to provide missing disclosure of the claimed invention, the proper ground is not 102 but 103 obviousness.

- December 19, 2001. The Examiner in her final rejection states that the rejection to claims 29, 35 and 42 under 35 USC 102(b) is maintained for the reasons made of record in Paper

No.10, dated July 5, 2001. The rejection to claim 1 under 35 U.S.C. 102(b) was dropped in view of Applicant canceling claim 1. The Examiner never addressed Applicant's arguments in regards to the 102(b) rejection.

- March 01, 2002. Applicant filed an Appeal Brief and argues the 102(b) rejection to claims 29, 35 and 42 as not being anticipated by the admitted prior art, i.e. Levy '251 combined with Brannon-Peppas.

- May 22, 2002. The Examiner's Answer countered Appellant's arguments by asserting that one cannot show nonobviousness by attacking references individually and notes that Appellant fails to appreciate that the rejection is based on a combination of references.

- July 22, 2002. Appellant files an amendment under 37 C.F.R. 1.116 in response to the new rejection of claims 29, 35 and 42 in the Examiner's Answer of May 22, 2002. Appellant submits that the Examiner's Answer rejected the claims as obvious and as such is a new ground of rejection.

- August 8, 2002. The Examiner responded to the Appellant's arguments by issuing an advisory denying entry of the amendment because new issues would be raised and noting Appellant's argument. The application was forwarded to the Board of Appeal.

- September 3, 2002. The application was remanded to the Examiner noting that the Examiner's response to Appellant's Reply brief did not comply with MPEP 1208.03.

**DECISION**

M.P.E.P. 2131.01 states that normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:

(A) Prove the primary reference contains an "enabled disclosure;"

(B) Explain the meaning of a term used in the primary reference; or

(C) Show that a characteristic not disclosed in the reference is inherent.

There is no evidence of record to indicate that the Examiner followed the procedures outlined in M.P.E.P. 2131.01 when making the 102(b) rejection using multiple references. Further, the Examiner in her Examiner's Answer has argued obviousness in response to Applicant's arguments concerning the 102(b) rejection.

A review of the petitioner's request and the application record indicates that the request can be granted.

The petition is **granted.**

The application is being forwarded to the Examiner for entry of the Amendment filed under 37 C.F.R. 1.116; withdrawal of the final rejection and an issuance of a new office action that addresses Applicant's amendment and clarification of whether the rejection to claims 29, 35 and 42 should be made under 35 U.S.C. 103 or 102(b).

JMStone

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

---

Finnegan, Henderson, Farabow, Garrett & Dunner LLP
1300 I St., N.W.
Washington, DC 20005

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6112471
Issue Date: September 5,2000
Application No. 09358073
Filed: July 21,1999
Attorney Docket No. 019931.167

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed March 23,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of March 23,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6112471 | 2000-09-05 | 09358073 | 1999-07-21 | 11884.9 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Daniel J. Kelly/ | Date (YYYY-MM-DD) | 2010-03-23 |
| Name | Daniel J. Kelly | Registration Number | 55322 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6162111
Issue Date: December 19,2000
Application No. 09358274
Filed: July 21,1999
Attorney Docket No. 12556.1USI1

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed July 14,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 14,2010 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,162,111 | 2000-12-19 | 09/358,274 | 1999-07-21 | 23637US01 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Christopher C. Winslade/ | Date (YYYY-MM-DD) | 2010-07-14 |
| Name | Christopher C. Winslade | Registration Number | 36308 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 25

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875 NORTH MICHIGAN AVE
SUITE 3653
CHICAGO, IL 60611

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MAY 3 1 2002

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Steven M. Utter | : | |
| Application No. 09/358,280 | : | ON PETITION |
| Filed: July 21, 1999 | : | |
| Attorney Docket No. 6030-019 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed April 8, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 6, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 7, 2001.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application file is being forwarded to Technology Center 3700 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 3

BERNARD L KLEINKE
401 WEST A STREET SUITE 2600
SAN DIEGO , CA 92101-7913

Mailed

JUL 20 2000

Director's Office
Group 2700

In re Application of
Chris A. Haudenschild
Application No.: 09/358,355
Filed: July 21,1999
For: ENTERPRISE HEALTHCARE MANAGEMENT SYSTEM

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition to treat the above-identified application as special and advance the examination thereof, under 37 C.F.R. § 1.102 and M.P.E.P. § 708.02(VIII), filed June 5, 2000.

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, Item VIII, must be accompanied by (a) the fee set forth in 37 C.F.R. § 1.17(I), (b) a statement that all claims are directed to a single invention or an offer to make an oral election without traverse should the Patent and Trademark Office hold that the claims are not directed to a single invention, (c) a statement that a pre-examination search has been made by the inventor, attorney, agent, professional searcher, etc., and a listing of the field of search by class and subclass, (d) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims, and (e) a detailed description of the submitted references and discussions pointing out how the claimed subject matter is distinguishable over these references.

The petition lacks requirement (c). The petition does not include a listing of the field of search by class and subclass, or an indication of the search strategy or terms used for computer searches.

For the above stated reasons, the petition is **DENIED**.

Should applicant desire reconsideration, he or she should supplement this petition by including the information as outlined above. No further petition fee is required.

Any request for reconsideration must be filed within **TWO MONTHS** from the date of this decision.

The application file will be forwarded to the Technology Center's Central Files and will await action in its regular turn.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2700
Communications & Information Processing
(703) 305-4710

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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**Mailed**

JUN 2 5 2001

**Technology Center 2100**

Paper No. 1

Bernard L. Kleinke
42 West Broadway, # 2300
San Jose, California 92101-7913

| | | |
|---|---|---|
| In re Application of: Chris A. Haudenschild | ) | **REQUEST FOR** |
| Application No. 09/358,355 | ) | **RECONSIDERATION OF** |
| Filed: July 21, 1999 | ) | **DECISION ON PETITION** |
| For: ENTERPRISE HEALTHCARE | ) | **FOR ACCELERATED** |
| MANAGEMENT SYSTEM AND | ) | **EXAMINATION UNDER** |
| METHOD OF USING SAME | ) | **M.P.E.P. §708.02(VIII)** |

This decision is in response to the letter of September 18, 2000 captioned "Response to Decision on Petition to Make Special" which was filed in response to the decision mailed July 20, 2000 denying the grant of special status based on M.P.E.P. §708.02, Section VIII. This letter is being treated as a request for reconsideration of the aforementioned denial of special status.

The Office received a letter from Mr. Kleinke dated June 6, 2001 indicating that no decision had been issued in response to Applicant's filing of September 18, 2000.

The Office regrets the delay engendered and the inconvenience caused Applicant by the failure to recognize that the letter of September 18, 2000 was meant to be a Request for Reconsideration.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

> A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:
>
> (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);
>
> (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.
>
> (c) Submits a statement(s) that a pre - examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references.

Applicant's submission filed September 18, 2000, corrects the deficiencies noted in the previous decision of mail date July 20, 2000. The combined submissions now meet all the criteria set out above, accordingly, the Petition is **GRANTED**.

The application file is being forwarded to the Examiner of Record for accelerated examination according to the procedures set forth in M.P.E.P. §708.02, Section VIII.

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce
(703) 306-4160

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No.

**FITZPATRICK CELLA HARPER & SCINTO**
**30 ROCKEFELLER PLAZA**
**NEW YORK, NY 10112**

**COPY MAILED**

NOV 0 1 2004

**OFFICE OF PETITIONS**
ON PETITION

In re Application of :
Manabu Ohga :
Application No. 09/358,407 :
Filed: July 22, 1999 :
Attorney Docket No. 862.2934 :

This is a decision on the petition under 37 CFR 1.313(c), filed October 29, 2004, which is being treated under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on September, 1, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Wan Laymon at (571) 272-3220.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2676 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Amendment and IDS.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**FITZPATRICK CELLA HARPER & SCINTO**
**30 ROCKEFELLER PLAZA**
**NEW YORK, NY 10112**

COPY MAILED

JUN 27 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of
Manabu Ohga
Application No. 09/358,407
Filed: July 22, 1999
Attorney Docket No. 862.2934

This is a decision on the petition under 37 CFR 1.313 (c)(2), filed June 24, 2005, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on May 6, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2676 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Amendment.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6358478
Issue Date: March 19,2002
Application No. 09358648
Filed: July 23,1999
Attorney Docket No. HPX0031-CON

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed February 8,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 8,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6358478 | 2002-03-19 | 09358648 | 1999-07-23 | 1542-9818(1) |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | | Small Entity | | |
|---|---|---|---|---|---|
| | Fee | Code | | Fee | Code |
| ○ | 3 ½ year | (1551) | ◉ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (1552) | ○ | 7 ½ year | (2552) |
| ○ | 11 ½ year | (1553) | ○ | 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Benoit Castel/ | Date (YYYY-MM-DD) | 2007-02-08 |
| Name | Benoit Castel | Registration Number | 35041 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 13

STEFAN J. KIRCHANSKI, ESQ.
HOGAN & HARTSON, L.L.P.
BILTMORE TOWER
500 SOUTH GRAND AVENUE, SUITE 1900
LOS ANGELES, CA 90071

COPY MAILED

MAY 21 2001

OFFICE OF PETITIONS
AND PATENTS

In re Application of :
Tobin, et al. :
Application No. 09/359,026 : DECISION GRANTING PETITION
Filed: July 22, 1999 :
Attorney Docket No. 36316.00007 :

This is a decision on the petition filed January 29, 2001, requesting that above-identified application be accorded a filing date of July 22, 1999, with page 4 of the specification as part of the original disclosure.

On July 22, 1999, applicants filed the above-identified application. On January 29, 2001, applicants filed the present petition, a copy of page 4 of the specification. The petition is accompanied by a copy of applicants' postcard receipt acknowledging receipt of 31 pages of specification in the United States Patent and Trademark Office (Office) on July 22, 1999. Applicants request that the application, including page 4 of the specification, be accorded a filing date of July 22, 1999.

Upon review of the record, page 4 of the specification, deposited on July 22, 1999, has not been located among the application papers. However, the evidence is convincing that the application papers deposited on July 22, 1999, included page 4 of the specification, which was subsequently misplaced in the Office. Therefore, the application, including page 4 of the specification, was complete on filing and entitled to a filing date of July 22, 1999.

Accordingly, the petition is granted. No petition fee is required.

The application file is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of July 22, 1999, using pages 1-3 and 5-31 of the specification submitted on July 22, 1999, and page 4 of the specification submitted on January 29, 2001.

Any inquiries related to this decision should be directed to Petitions Attorney Christina T. Tartera at (703) 306-5589.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 7

FISH & RICHARDSON PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO, CA 92122

| | | |
|---|---|---|
| In re Application of<br>Barmak Mansoorian<br>Application No. 09/359,056<br>Filed: July 21, 1999<br>Attorney Docket No. 08305-038001 /<br>98-06 | :<br>:<br>:<br>:<br>:<br>: | NOTICE |

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MAR 1 2 2002
OFFICE OF PETITIONS

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989).** Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center AU 2612.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Paper No. 9

FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO CA 92122

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JAN 3 1 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application Serial No.:
09/359,056

ON REQUEST TO
WITHDRAW AS ATTORNEY

The Request to Withdraw as Attorney is **GRANTED**.

Further communications will be directed to the address listed below until such a time as applicant properly notifies the Patent and Trademark Office of a change of address. This address has been provided by the withdrawing attorney(s).

Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4701

cc: Micron Technology, Inc.
C/o Tom D'Amico
Dickstein, Shapiro, Moran & Oshinsky
2101 L Street NW
Washington DC 20037-1526

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 14

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON, LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA GA 30309

COPY MAILED

OCT 2 8 2003

OFFICE OF PETITIONS

In re Application of
Carl G. Hellerqvist, et al.
Application No. 09/359,167
Filed: July 21, 1999
Attorney Docket No. CARB-008/01U

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 18, 2003, to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed December 17, 2002, which set a shortened statutory period for reply of three(3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 18, 2003.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $465.00 extension of time submitted with the petition on July 18, 2003 was subsequent to the maximum extendable period for reply, the extension of time filed with the instant petition is unnecessary and the fee will be credited to petitioner's deposit account no. 11-0855.

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111.

The application file is being forwarded to Technology Center 1600, Art Unit 1646.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 17

Ira V. Haffan
TESTA, HURWITZ, & THIBEAULT, LLP
High Street Tower
125 High Street
Boston, MA 02110

MAIL

MAR 1 7 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
Duane et al.
Application No. 09/359,205
Filed: July 22, 1999
For: SYSTEM AND METHOD FOR CERTIFICATE EXCHANGE

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed March 08, 2004.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request filed March 08, 2004 meets all the requirements. Accordingly the request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

James R. Matthews

for Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

cc: Eric L. Prahl, Esq.
HALE AND DORR LLP
60 State Street
Boston, MA 02109

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

SEYFARTH SHAW LLP
131 S. DEARBORN ST., SUITE 2400
CHICAGO, IL 60603-5803

Mail Date: 07/12/2010

| | | |
|---|---|---|
| **Applicant** | : ROBERT A. LUCIANO JR. | : DECISION ON REQUEST FOR |
| **Patent Number** | : 6290603 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/18/2001 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 09/359,234 | : OF WYETH |
| **Filed** | : 07/22/1999 | : |
| | | : |

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A). Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154 (b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 25

**AGILENT TECHNOLOGIES INC**
**INTELLECTUAL PROPERTY ADMINISTRATION**
**LEGAL DEPT.**
**P.O. BOX 7599 M/S DL429**
**LOVELAND, CO 80537-0599**

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OCT 1 0 2003

OFFICE OF PETITIONS

In re Application of
Peter G. Webb et al
Application No. 09/359,527
Filed: July 22, 1999
Attorney Docket No. 10990641-1

ON PETITION

This is a decision on the petition, filed October 6, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on July 7, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to Wan Laymon at (703) 306-5685.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 1631 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

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Paper No. None

PATTERSON & SHERIDAN, LLP/
SEDNA PATENT SERVICES, LLC
595 SHREWSBURY AVENUE
SUITE 100
SHREWSBURY NJ 07702

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JAN 23 2006

OFFICE OF PETITIONS

In re Application of
Edward A. Ludvig et al.
Application No. 09/359,561
Filed: July 22, 1999
Attorney Docket Number: SEDN/168CIP1
Title: METHOD AND APPARATUS FOR ENCODING A USER INTERFACE

DECSION ON PETITION

This is a decision on the petition filed January 3, 2006, pursuant to 37 C.F.R. §1.137(a)[1, 2], to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment, mailed October 17, 2003, which set a 1-month period for reply. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on November 18, 2003. A notice of abandonment was mailed on December 21, 2005.

---

1 A grantable petition pursuant to 37 CFR §1.137(a) must be accompanied by:

(1) the required reply (in a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application; in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof);
(2) the petition fee;
(3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable, and;
(4) a terminal disclaimer (and fee as set forth in §1.20(d)) required pursuant to paragraph (d) of this section.

2 Petitioner has also submitted a petition under 37 CFR §1.137(b), which is rendered moot by the granting of the petition under the unavoidable standard.

With the present petition, Petitioner has submitted the petition fee and a statement of facts. The terminal disclaimer is not required. The required response was previously submitted on October 4, 2004[3].

As such, the petition under 37 C.F.R. 1.137(a) is **GRANTED**.

After this decision is mailed, Technology Center 2600 will be made aware of this decision.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. **All other inquiries concerning examination procedures or <u>status of the application</u> should be directed to the Technology Center**.

**Paul Shanoski**
**Senior Attorney**
**Office of Petitions**
**United States Patent and Trademark Office**

3 It appears that on this date, Petitioner attempted to combine his response with the filing of a petition to withdraw the holding of abandonment. Pursuant to 37 C.F.R. §1.4(c), each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

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ARENT FOX PLLC
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

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JUN 22 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| ETO et al | : | |
| Application No.: 09/359,767 | : | DECISION ON PETITION |
| Filing Date: July 22, 1999 | : | UNDER 37 CFR 1.137(B) |
| Attorney Docket No.: P21-9026 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed March 20, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed January 24, 2002, which set a statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on April 25, 2002.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the issue fee and publication fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the payment of the issue fee and publication fee is accepted as having been unintentionally delayed.

The above-identified application has been abandoned for an extended period of time. The USPTO is relying on petitioner's duty of candor and good faith and accepting applicant's statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. See Changes to Patent Practice and Procedure 62 Fed. Reg. at 53160 and 53718, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the United States Patent and Trademark Office.)

This application is being referred to the Office of Publications.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3303.

Bryan Lin

Bryan Lin
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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M 15

Dennis H. Rainear
Patent & Trademark Division
Ethyl Corporation
P.O. Box 2189
330 South Fourth Street
Richmond, VA 23219

(For Patent Owner)

MAILED

SEP 19 2000

REEXAM UNIT

Bruce S. Londa
Londa and Gluck LLP
20 Exchange Place, 37th Floor
New York, NY 10005

(For Requester)

In re reissue application of
Gatto et al.
Application No. 09/359,770
Filed: July 22, 1999
For: U.S. Patent No. 5,650,381

In re Gatto et al.
Reexamination Proceeding
Control No. 90/005,720
Filed: May 10, 2000
For: U.S. Patent No. 5,650,381

DECISION TO MERGE
REEXAMINATION AND
REISSUE PROCEEDINGS

The above noted reissue and reexamination proceedings are before the Office of Patent Legal Administration for consideration of whether the proceedings should be merged at this time.

## REVIEW OF FACTS

1. U.S. Patent No. 5,650,381 issued July 22, 1997.

2. Certificates of Correction issued on November 18, 1997, and on April 21, 1998, in the '381 patent.

3. On July 22, 1999, an application for reissue of the '381 patent was filed, and it was assigned Application No. 09/359,770.

4. The filing of the reissue application was published in the *Official Gazette* on November 16, 1999.

5. A first Office action was mailed in the reissue application on March 31, 2000.

6. On May 10, 2000, a request for reexamination was filed by a third party requester, and the proceeding was assigned Control No. 90/005,720.

7. An amendment was filed in the reissue application on June 26, 2000.

8. On July 20, 2000, reexamination was ordered.

9. A waiver of Patent Owner's statement under 37 C.F.R. § 1.530 was filed in the reexamination proceeding by patent owner on August 10, 2000. A first Office action has not yet been issued in the reexamination.

## DISCUSSION REGARDING MERGER

Under 37 CFR § 1.565(d):

> (d) If a reissue application and a reexamination proceeding on which an order pursuant to § 1.525 has been mailed are pending concurrently on a patent, a decision will normally be made to merge the two proceedings or to stay one of the two proceedings....

As evidenced by the above review of facts, the reissue application and the reexamination proceeding are currently pending. Since the order to reexamine has been mailed in the reexamination proceeding, a decision under 37 C.F.R. § 1.565(d) is timely.

The general policy of the Office is that a reissue application examination and a reexamination proceeding will not be conducted separately at the same time as to a particular patent. The reason for this policy is to prevent inconsistent, and possibly conflicting, amendments from being introduced into the two proceedings on behalf of the patent owner. Normally, the proceedings will be merged when it is desirable to do so in the interest of expediting the prosecution of both proceedings. In making a decision on whether or not to merge the two proceedings, consideration will be given to the status of each proceeding. See MPEP 2285.

A review of the reissue application shows that an Office action was mailed on March 31, 2000, and new claims have been added. A review of the reexamination file shows that reexamination was ordered on July 20, 2000. A waiver of a statement under 37 C.F.R. § 1.530 has been filed by patent owner, and the reexamination is presently awaiting the issuance of a first Office action. No amendments have been filed in the reexamination proceeding. Accordingly, the claims are not identical in both proceedings.

In order to provide efficient and prompt handling of both proceedings and to prevent inconsistent, and possibly conflicting, amendments from being introduced on behalf of the patent owner, it is appropriate that the reissue and the reexamination proceedings be merged and a joint examination be conducted. Accordingly, the examination of the reissue application and the reexamination will be merged in accordance with the decision set forth below.

## DECISION MERGING THE REISSUE AND REEXAMINATION PROCEEDINGS

I. Merger of Proceedings

The above-noted reissue and reexamination proceedings are hereby merged. A joint examination will be conducted in accordance with the following guidelines and requirements.

II. Requirement for Same Amendments in Both Proceedings

1. The patent owner is required to maintain identical amendments in the reissue and the reexamination files for purposes of the merged proceeding. This maintenance of identical amendments in the two files is required as long as the proceedings remain merged. See 37 CFR § 1.565(d).

2. A proposed housekeeping amendment must be filed **within ONE (1) month of the mailing date of this decision**, to thereby place the same amendments in both cases.

III. Conduct of the Merged Reissue Application Examination and Reexamination Proceeding

1. After the appropriate housekeeping amendment (see Part II above) is received, or after the time for same expires, the examiner should promptly prepare an Office action.

2. In the event that a housekeeping amendment is not timely submitted, any claim that does not contain identical text in both proceedings should be rejected under 35 U.S.C. 112, paragraph 2, as being indefinite as to the content of the claims, and thus failing to particularly point out the invention.

3. Because the statutory provisions for reissue application examination include, *inter alia*, provisions equivalent to 35 U.S.C. § 305 relating to the conduct of reexamination proceedings, the merged examination will be conducted on the basis of the rules relating to the broader, reissue application, examination. The examiner will apply the reissue statute, rules, and case law to the merged

proceeding. **However, periods of response should be set at TWO (2) months to comply with the statutory requirement for special dispatch in reexamination (35 U.S.C. 305).**

4. Each Office action issued by the examiner will take the form of a *single action* which jointly applies to both the reissue application and the reexamination proceeding. Each action will contain identifying data *for both* the reissue application and the reexamination proceeding, and each action will be physically entered into both files (which will be maintained as separate files).

5. Any response by the applicant/patent owner must consist of a single response, filed in duplicate, each bearing a signature, for entry in both files.

6. If the reissue application ultimately matures into a reissue patent, the reexamination proceeding shall be terminated by the grant of the reissued patent, and the reissued patent will serve as the certificate under § 1.570. See MPEP 2285.

7. If the applicant/patent owner fails to file a timely and appropriate response to any Office action, the merged proceeding will be terminated. The reissue application will be held abandoned. The Commissioner will proceed to issue a reexamination certificate under § 1.570 in accordance with the last action of the Office, unless further action is clearly needed in view of the difference in rules relating to reexamination and reissue proceedings.

8. If the applicant/patent owner files an express abandonment of the reissue application pursuant to 37 CFR § 1.138, the next Office action of the examiner will accept the express abandonment, dissolve the merged proceeding, and continue the reexamination proceeding. Any grounds of rejection which are not applicable under reexamination would be withdrawn (*e.g.*, based on public use or sale), and any new grounds of rejection which are applicable under reexamination (*e.g.*, improper broadened claims) would be made by the examiner upon dissolution of the merged proceeding. The existence of any questions remaining which cannot be considered under reexamination following dissolution of the merged proceeding would be noted by the examiner as not being proper under reexamination pursuant to 37 CFR § 1.552(c).

9. Applicant/patent owner is advised that the filing of a continued prosecution (CPA) reissue application under 37 CFR § 1.53(d), whereby the current reissue application is considered to be expressly abandoned, will most likely result in the dissolution of the merged proceeding, a stay of the CPA reissue application, and separate, continuation of prosecution of the reexamination proceeding.

## IV. Conclusion

1. The above noted reissue application and reexamination proceeding ARE MERGED.

2. The reissue and reexaminations file are being forwarded to the examiner via the Director of Technology Center 1700. Upon receipt of same, the examiner should not issue an Office action for the present merged proceeding of the reissue application and reexamination proceeding until the expiration of one (1) month from the mailing date of this decision to await the housekeeping amendment requested in Part II above.

3. All further examination should be conducted in accordance with Part III of this decision.

4. Telephone inquiries related to this decision should be directed to Lynn M. Kryza at (703)306-5682.

Kenneth M. Schor
Senior Legal Advisor
Special Program Law Office
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

September 19, 2000

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

| SERIAL NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NO. |
|---|---|---|---|
| 09/359,770 | 07/22/99 | Vincent J. Gatto | |

| PATENT NUMBER | DATE OF THIS NOTICE | PAPER NUMBER |
|---|---|---|
| 5,650,381 | 09/19/00 | 16 |

NOTICE OF MERGED REEXAM - REISSUE PROCEEDING

This reissue application has been merged with the reexamination proceeding listed below:

Control No. 90/ 005,720 Filing Date: May 10, 2000

Requester (name, address) Bruce S. Londa
Londa and Gluck LLP
20 Exchange Place, 37th Floor
New York, NY 10005

The front face of the reissue patent will include the following paragraph:

REEXAMINATION RESULTS

The questions raised in reexamination request No. 90/005,720, filed May 10, 2000, have been considered and the results thereof are reflected in this reissue patent which constitutes the reexamination certificate required by 35 U.S.C. 307 as provided in 37 CFR 1.570(e).

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Paper No. 28

ARENT FOX KINTNER PLOTKIN & KAHN PLLC
1050 CONNECTICUT AVENUE NW, SUITE 600
WASHINGTON DC 20036-5339

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Youichi Yamada et al :
Application No. 09/359,793 :
Filed: July 26, 1999 :
Attorney Docket No. P7156-9038 :

This is a decision on the petition, filed by facsimile transmission on November 14, 2002,[1] under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on July 23, 2002 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[2]

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

The application file is being forwarded to Technology Center AU 2837 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The petition, Request for Continued Examination, and the amendment acknowledged as having been received in the USPTO on October 8, 2002 have not to date been associated with the application file.

[2] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 11

Patterson Thuente Skaar & Christensen
4800 IDS Center
80 South, 8th Street
Minneapolis, MN 55402-2100

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JAN 07 2004

OFFICE OF PETITIONS

In re Application of
Okamoto, Shinken
Application No. 09/360,025
Filed: July 23, 1999
Attorney Docket No. 2418.05US01

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 31, 2003, to revive the above-identified application.

The petition is DISMISSED.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is not final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lack(s) item(s) (1).

As to item (1), The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of December 11, 2002. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that prima facie places the application in condition for allowance, or the filing of a continuing application. See MPEP 711.03(c)(III)(A)(2). Since the amendment submitted does not prima facie place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee) or the filing of a continuing application. Alternatively, the reply requirement may be met by the filing of a submission under 37 CFR 1.129(a) if the above-identified application is eligible for such transitional practice.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $475 extension of time submitted with the petition on October 31, 2003 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Further correspondence with respect to this matter should be addressed as follows:

| | |
|---|---|
| By mail: | Mail Stop Petitions<br>PO Box 1450<br>Alexandria, VA 22313-1450 |
| By facsimile: | (703) 872-6906<br>Attn: Office of Petitions |
| By hand: | Customer Service Window<br>2011 South Clark Place<br>Crystal Plaza 2, Room 1B03<br>Arlington, VA 22202 |

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Advisory Action

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No. 15

Patterson Thuente Skaar & Christensen
4800 IDS Center
80 South 8th Street
Minneapolis, MN 55402-2100

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**OFFICE OF PETITIONS**

In re Application of :
Okamoto, Shinken :
Application No. 09/360,025 : ON PETITION
Filed: July 23, 1999 :
Attorney Docket No. 2418.05US01 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed February 2, 2004, to revive the above-identified application.

The petition is granted.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113, to the final Office action mailed December 11, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 12, 2003.

The application file is being forwarded to Technology Center AU 2113 for processing the Request for Continued Examination pursuant to 37 CFR 1.114 filed with the instant petition.

Telephone inquiries concerning this decision may be directed to Latrice Bond at (703) 308-6911.

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
For Patent Examination Policy

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 4

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NOV 29 1999
SHERIDAN ROSS PC

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NOV 22 1999
SPECIAL PROGRAMS OFFICE
DAC FOR PATENTS

Joseph E. Kovarik
Sheridan Ross PC
1700 Lincoln Street
Suite 3500
Denver, CO 80203

In re Application of
John N. Lee et. al.
Serial No. 09/360,029
Filed: July 23, 1999
Attorney Docket No. 3404-2

ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed October 13, 1999, to change the order of the names of the inventors.

The petition is granted.

The order of the names of the inventors will be changed as follows:

1. Alyn Rockwood
2. John N. Lee
3. Lance Hagen
4. Scott Hagen

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

This application is being forwarded to Technology Center 2700 via Application Branch Data Input to change the order of inventorship.

Andrea Coram
Legal Instruments Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Marianne Morgan
Petitions Examiner

CC: Joseph E. Kovarik
1560 Broadway, Suite 1200
Denver, CO 80202-5141

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Paper No. 28

**SHERIDAN ROSS PC**
**1560 BROADWAY**
**SUITE 1200**
**DENVER CO 80202**

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**OFFICE OF PETITIONS**

ON PETITION

In re Application of
John N. Lee et al
Application No. 09/360,029
Filed: July 23, 1999
Attorney Docket No. 3404-2

This is a decision on the petition, filed by facsimile transmission on November 13, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on August 18, 2003, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2671 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 6283070
Issue Date: September 4,2001
Application No. 09360061
Filed: July 23,1999
Attorney Docket No. 079903

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 25,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 25,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6283070 | 2001-09-04 | 09360061 | 1999-07-23 | SEAL |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | | Small Entity | | |
|---|---|---|---|---|---|
| | Fee | Code | | Fee | Code |
| ○ | 3 ½ year | (1551) | ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (1552) | ◉ | 7 ½ year | (2552) |
| ○ | 11 ½ year | (1553) | ○ | 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Rick B. Yeager/ | Date (YYYY-MM-DD) | 2010-02-25 |
| Name | Rick B. Yeager, Attorney | Registration Number | 39434 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

OCT - 6 2005

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

| | |
|---|---|
| In re Application of | : |
| John R. McDonald et al | : |
| Serial No.: 09/360,242 | : PETITION DECISION |
| Filed: July 2, 1999 | : |
| Attorney Docket No.: 17080-002002 | : |

This is in response to the petition under 37 CFR 1.181, filed June 10, 2005, requesting withdrawal of the Final rejection, mailed April 7, 2005.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on February 18, 2004, setting a three month shortened statutory period for reply. Claims 26-29, 31-32, 34-37, 40, 42, 44-46, 48-54, 57 and 65-95 were rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. All other rejections were withdrawn and the action was made Final.

Applicants replied on August 18, 2004, by filing RCE papers with a response and a request and fee for a three month extension of time. Applicants further amended claims 29, 31, 40, 86 and 87 and added claims 96-97. Applicants replied to the lone rejection with 39 pages of argument.

The examiner mailed a Final Office action to applicants on April 7, 2005, setting a three month shortened statutory period for reply. The examiner again rejected claims 26-29, 31-32, 35-37, 40, 42, 44-46, 48-54, 57 and 65-95 and new claims 96-97 under 35 U.S.C. 112, first paragraph, for lack of enablement as the sole rejection and made the action Final.

Applicants then filed this petition on June 10, 2005. The examiner in view of the petition then withdrew the finality of the Office action, mailed April 7, 2005, and mailed a revised final Office action to applicants on August 10, 2005.

DISCUSSION

Applicants requested withdrawal of the finality of the Office action of April 7, 2005, even though the rejection set forth is on the same basis as in Final Office action, mailed February 18, 2004. The examiner's action has rendered decision on this petition moot as the examiner *sua sponte* withdrew the finality of the Office action and prepared a new Office action.

The petition is **DISMISSED.**

**Applicants remain under obligation to reply to the new Office action mailed August 10, 2005, within the time period set, or as extended under 37 CFR 1.136(a).**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

George C. Elliott

George C. Elliott
Director, Technology Center 1600

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: ____

DATE : 3/13/07

TO SPE OF : ART UNIT 1647

SUBJECT : Request for Certificate of Correction for Appl. No.: 9/360242 Patent No.: 7157418B1

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

*Virginia Tolbert*
**Certificates of Correction Branch**

**703-308-9390 ext. 113**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

SPE

12/4/07 A.U. 1647
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APR 10 2002

Paper No. 10

In re Application of
Hiroshi Sugitani *et al*
Application No. 09/360,453
Filed: July 16, 1999
Attorney Docket No. 03560.001250.1

DECISION ON PETITION

This is a decision on the petition filed on March 11, 2002 by which petitioners request withdrawal of the examiner's holding that this application stands abandoned for failure to file a reply to the Office letter dated May 30, 2001. No fee is required for the petition.

The petition is granted.

Petitioners allege that this application was not in fact abandoned because petitioners did not in fact receive the Office letter in question. Petitioners support this allegation in a manner that satisfies the minimum requirements for a showing of nonreceipt of Office correspondence, as established by the Notice published at 1156 OG 53, and as discussed in MPEP § 711.03(c).

The Office letter dated May 30, 2001, paper No. 5, indicates that the period for filing a reply to paper No. 4, an Office letter dated April 4, 2001, was being restarted to run "one month or 30 days" from the date of mailing of paper No. 5. Paper No. 5 reflects the fact that paper No. 4 was not mailed to the correspondence address of record. While paper No. 5 also reflects the fact that a telephone conversation was had by counsel, presumably regarding the remailing of paper No. 4, paper No. 5 does not reflect that a copy of paper No. 4 was remailed as part of paper No. 5. While neither the record nor the petition indicate why counsel did not thereafter seasonably inquire regarding paper No. 4 so that a reply thereto could be filed, the fact remains that without receipt of paper No. 4, petitioners could obviously not reply thereto. Therefore, it is clear from the record and from the submission in the petition that this application was not in fact abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for Patent Examining Group 3720 for remailing a complete copy of paper No. 4, that is, the Office letter dated April 5, 2001, together with all attachments thereto including references. The correct correspondence address is currently contained in the PALM ExPo system. The period for reply to the remailed Office action will run ONE MONTH OR THIRTY DAYS, WHICHEVER IS LONGER, from the date upon which paper No. 4 is remailed, and can be extended up to the statutory maximum of six months under the provisions of 37 CFR 1.136(a).

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Fitzpatrick Cella Harper & Scinto
30 Rockefeller Plaza
New York, NY 10112-3801

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Paper No.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

**COPY MAILED**

MAR 03 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Restle et al. | : | DECISION ON APPLICATION |
| Application No. 09/360,521 | : | FOR |
| Filed: July 23, 1999 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 05725.0446-0 | : | |

This is in response to the "NOTICE OF POSSIBLE PTO ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT AND REQUEST FOR REVIEW OF CALCULATION," filed December 3, 2008. This paper is properly treated pursuant to 37 CFR 1.705(b). Applicants request that the Office correct the patent term adjustment at the time of the mailing of the notice of allowance from five hundred fifty (550) days to four hundred twelve (412) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **five hundred sixty-eight (568)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 6, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 550 days. Applicants disclose that a period of reduction pursuant to 37 CFR 1.704(c)(7) should have been entered for the filing of an appeal brief with an omission on May 24, 2006. Further, applicants maintain that a period of adjustment of 18 days should be entered for the Office taking in

excess of four months to issue a Notice of Allowance in response to a favorable decision by the Board of Patent Appeals and Interferences.

37 CFR 1.702(a)(3) provides that the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

> Act on an application not later than four months after the date of a decision by the Board of Patent Appeals and Interferences under 35 U.S.C. 134 or 135 or a decision by a Federal court under 35 U.S.C. 141, 145, or 146 where at least one allowable claim remains in the application;

37 CFR 1.703(a)(5) provides that:

> The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

As stated in the Final Rule[1] and in pertinent part in MPEP 2731,

> For a Board of Patent Appeals and Interferences decision to be a "decision by the Board of Patent Appeals and Interferences under [35 U.S.C.] 134" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)), the decision must sustain or reverse the rejection(s) of the claim(s) on appeal. For a Board of Patent Appeals and Interferences decision to be a "decision by the Board of Patent Appeals and Interferences under [35 U.S.C.] 135" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii) (and 1.703(a)(5)), the decision must include a decision on the patentability of the claims or priority of invention. A remand or other administrative order by the Board of Patent Appeals and

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[1] See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

> Interferences (even if by a merits panel) is not a "decision" within the meaning of 35 U.S.C. 154(b)(1)(A)(iii)(and 1.703(a)(5)).

In this instance, such a favorable decision by the Board was mailed on June 19, 2008. The Office did not mail an Office action, a notice of allowance, in response until November 6, 2008, four months and 18 days later. Pursuant to 37 CFR 1.703(a)(5), a period of adjustment of 18 days should have been entered. The period of adjustment of 18 days is being entered.

However, entry of a period of reduction, pursuant to 37 CFR 1.704(c)(7), is not warranted. An appeal brief is not a reply within the meaning of 37 CFR 1.704(c)(7). Accordingly, entry of a period of reduction for filing a defective appeal brief is not warranted.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is five hundred sixty-eight (568) days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of the patent. Any further period of adjustment accrued pursuant to 37 CFR 1.702(a)(4) and 1.702(b) will be reflected in the patent term adjustment shown on the issue notification letter mailed approximately three weeks prior to the issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PALM Screen

PALM INTRANET

Day : Monday
Date: 3/2/2009
Time: 11:52:17

| PTA Calculations for Application: 09/360521 | | | |
|---|---|---|---|
| Application Filing Date: | 07/23/1999 | PTO Delay (PTO): | 878 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 328 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 568 |
| PTO Delay Adjustment: | 18 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 144 | 03/02/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | 18 | | |
| 137 | 11/06/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 136 | 11/05/2008 | ISSUE REVISION COMPLETED | | | |
| 135 | 11/05/2008 | DOCUMENT VERIFICATION | | | |
| 134 | 10/22/2008 | DOCUMENT VERIFICATION | | | |
| 133 | 10/20/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 132 | 10/20/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 131 | 09/29/2008 | NOTICE OF ALLOWABILITY | | | |
| 130 | 09/02/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 129 | 06/19/2008 | MAIL BPAI DECISION ON APPEAL - REVERSED | 878 | | 97 |
| 128 | 06/19/2008 | BPAI DECISION - EXAMINER REVERSED | | | |
| 127 | 05/13/2008 | MISCELLANEOUS INCOMING LETTER | | | |
| 126 | 05/14/2008 | CONFIRMATION OF HEARING BY APPELLANT | | | |
| 125 | 04/25/2008 | CONFIRMATION OF HEARING BY APPELLANT | | | |
| 124 | 04/04/2008 | NOTIFICATION OF APPEAL HEARING | | | |
| 122 | 11/15/2007 | DOCKETING NOTICE MAILED TO APPELLANT | | | |
| 120 | 11/14/2007 | ASSIGNMENT OF APPEAL NUMBER | | | |
| 119 | 10/23/2007 | APPEAL AWAITING BPAI DOCKETING | | | |
| 118 | 10/11/2007 | MAIL REPLY BRIEF NOTED BY EXAMINER | | | |
| 117 | 10/09/2007 | REPLY BRIEF NOTED BY EXAMINER | | | |
| 116 | 04/06/2007 | RETURN OF UNDOCKETED APPEAL TO THE TC | | | |
| 115 | 04/06/2007 | EXAM. ANS. REVIEW COMPLETE | | | |
| 114 | 04/05/2007 | DATE FORWARDED TO EXAMINER | | | |
| 113 | 03/29/2007 | REPLY BRIEF FILED | | | |
| 112 | 03/29/2007 | REQUEST FOR ORAL HEARING | | | |
| 111 | 01/29/2007 | MAIL EXAMINER'S ANSWER | | | |

| | | | | | |
|---|---|---|---|---|---|
| 110 | 01/22/2007 | EXAMINER'S ANSWER TO APPEAL BRIEF | | | |
| 109 | 11/08/2006 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 108 | 11/08/2006 | DATE FORWARDED TO EXAMINER | | | |
| 107 | 10/27/2006 | APPEAL BRIEF FILED | | | |
| 106 | 09/27/2006 | NOTICE -- DEFECTIVE APPEAL BRIEF | | | |
| 105 | 09/20/2006 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 104 | 09/20/2006 | DATE FORWARDED TO EXAMINER | | | |
| 103.1 | 09/11/2006 | DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED | | | |
| 103 | 09/11/2006 | APPEAL BRIEF FILED | | | |
| 102 | 08/10/2006 | NOTICE -- DEFECTIVE APPEAL BRIEF | | | |
| 101 | 05/31/2006 | DATE FORWARDED TO EXAMINER | | | |
| 100.1 | 05/24/2006 | DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED | | | |
| 100 | 05/24/2006 | APPEAL BRIEF FILED | | | |
| 99 | 05/24/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 98 | 03/29/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 97 | 01/24/2006 | NOTICE OF APPEAL FILED | | 61 | 95 |
| 96 | 01/24/2006 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 95 | 08/24/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 94 | 08/22/2005 | FINAL REJECTION | | | |
| 93 | 07/05/2005 | DATE FORWARDED TO EXAMINER | | | |
| 92 | 06/08/2005 | RESPONSE AFTER NON-FINAL ACTION | | 31 | 90 |
| 91 | 06/08/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 90 | 02/08/2005 | MAIL NON-FINAL REJECTION | | | |
| 89 | 02/07/2005 | NON-FINAL REJECTION | | | |
| 88 | 11/18/2004 | DATE FORWARDED TO EXAMINER | | | |
| 87 | 10/27/2004 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 86 | 11/18/2004 | DATE FORWARDED TO EXAMINER | | | |
| 85 | 10/27/2004 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 84 | 11/18/2004 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 83 | 10/27/2004 | REFERENCE CAPTURE ON IDS | | | |
| 82.7 | 10/27/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 82 | 10/27/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 81 | 11/08/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 80 | 10/27/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 79 | 10/27/2004 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 78 | 07/28/2004 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 77 | 07/26/2004 | FINAL REJECTION | | | |
| 76 | 06/21/2004 | DATE FORWARDED TO EXAMINER | | | |
| 75 | 05/04/2004 | RESPONSE AFTER NON-FINAL ACTION | | 84 | 72 |
| 74 | 05/04/2004 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 73 | 05/04/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 72 | 11/10/2003 | MAIL NON-FINAL REJECTION | | | |
| 71 | 11/04/2003 | NON-FINAL REJECTION | | | |
| 70 | 09/17/2003 | DATE FORWARDED TO EXAMINER | | | |
| 69 | 09/12/2003 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 68 | 09/17/2003 | DATE FORWARDED TO EXAMINER | | | |
| 67 | 09/12/2003 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 66 | 09/17/2003 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 65 | 09/12/2003 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 64 | 07/15/2003 | MAIL EXAMINER'S ANSWER | | | |
| 63 | 07/14/2003 | EXAMINER'S ANSWER TO APPEAL BRIEF | | | |
| 62 | 05/08/2003 | DATE FORWARDED TO EXAMINER | | | |
| 61 | 03/27/2003 | APPEAL BRIEF FILED | | | |
| 60 | 02/26/2003 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 59 | 02/24/2003 | ADVISORY ACTION (PTOL-303) | | | |
| 52 | 02/03/2003 | DATE FORWARDED TO EXAMINER | | | |
| 51 | 01/28/2003 | AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL | | | |
| 50 | 01/28/2003 | NOTICE OF APPEAL FILED | | 90 | 48 |
| 49 | 01/28/2003 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 48 | 07/30/2002 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 47 | 07/29/2002 | FINAL REJECTION | | | |
| 46 | 07/02/2002 | DATE FORWARDED TO EXAMINER | | | |
| 45 | 06/13/2002 | RESPONSE AFTER NON-FINAL ACTION | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 44 | 03/13/2002 | MAIL NON-FINAL REJECTION | | | |
| 43 | 03/08/2002 | NON-FINAL REJECTION | | | |
| 42 | 02/04/2002 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 41 | 02/12/2002 | DATE FORWARDED TO EXAMINER | | | |
| 40 | 02/04/2002 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 31 | 30 |
| 39 | 02/12/2002 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 38 | 02/04/2002 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 37 | 02/04/2002 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 36 | 01/31/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 35 | 01/31/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 34 | 01/22/2002 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 33 | 01/22/2002 | ADVISORY ACTION (PTOL-303) | | | |
| 32 | 01/10/2002 | DATE FORWARDED TO EXAMINER | | | |
| 31 | 01/04/2002 | AMENDMENT AFTER FINAL REJECTION | | | |
| 30 | 10/04/2001 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 29 | 10/04/2001 | FINAL REJECTION | | | |
| 28 | 09/25/2001 | DATE FORWARDED TO EXAMINER | | | |
| 27 | 09/04/2001 | RESPONSE AFTER NON-FINAL ACTION | | 31 | 25 |
| 26 | 09/04/2001 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 25 | 05/04/2001 | MAIL NON-FINAL REJECTION | | | |
| 24 | 05/02/2001 | NON-FINAL REJECTION | | | |
| 23 | 04/03/2001 | DATE FORWARDED TO EXAMINER | | | |
| 22 | 03/26/2001 | SUPPLEMENTAL RESPONSE | | | |
| 21 | 04/03/2001 | DATE FORWARDED TO EXAMINER | | | |
| 20 | 03/26/2001 | CONTINUING PROSECUTION APPLICATION - CONTINUATION (ACPA) | | | |
| 19 | 03/26/2001 | MAIL EXPRESS ABANDONMENT (DURING EXAMINATION) | | | |
| 18 | 03/26/2001 | EXPRESS ABANDONMENT (DURING EXAMINATION) | | | |
| 17 | 03/26/2001 | WORKFLOW - REQUEST FOR CPA - FINISH | | | |
| 16 | 03/26/2001 | WORKFLOW - REQUEST FOR CPA - BEGIN | | | |

**Search Another: Application#** Search

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5/18/09

TO SPE OF : ART UNIT 1617 Wang Shengjun

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/360521 Patent No.: 7514091

Please respond to this request for a certificate of correction within 7 days.

**FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

Certificates of Correction Branch

**703-308-9390 ext. _____**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- [x] **Approved** — **All** changes apply.
- [ ] **Approved in Part** — Specify below which changes **do not** apply.
- [ ] **Denied** — State the reasons for denial below.

**Comments:** _____

SPE

1627
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

SHEEN PADMANABHAN
SUPERVISORY PATENT EXAMINER

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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OFFICE OF PETITIONS

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS MN 55402

In re Application of :
Rogers, et al. : DECISION ON PETITION
Application No. 09/360,719 :
Filed: July 27, 1999 :
Atty. Dkt. No.: 3548/010 :

The above-identified application has been forwarded to the Office of Petitions for consideration of the petition, filed April 11, 2006, under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition is hereby **DISMISSED**.

This application was became abandoned February 24, 2006 for failure to timely submit a proper reply to the Notice of Allowance ("Notice") mailed November 23, 2005. Notice of Abandonment was mailed April 14, 2006.

Petitioners allege non-receipt of the Notice.

In the absence of any irregularity in the mailing of the Notice, there is a strong presumption that the Office communication was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. *See*, MPEP 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

Office records indicate the Office communication was properly mailed to the correspondence address of record at the time of mailing. Accordingly, there was no irregularity in mailing the Office communication on the part of the United States Patent and Trademark Office.

The instant petition is not accompanied by a statement from practitioner of record to the effect that a search of the file jacket and docket records indicates that the Office communication was not received. Moreover the copy of the docket report submitted herewith is illegible in that the copy of docket report is too dark and cannot be read.

Any renewed petition should be accompanied by the required statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received, and should also include a legible copy of the docket report.

Further correspondence with respect to this matter should be addressed as follows:

By mail: **Mail Stop Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300

By hand delivery: U.S. Patent and Trademark Office
Customer Window, **Mail Stop Petition**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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WELSH & KATZ, LTD
120 S. RIVERSIDE PLAZA
22ND FLOOR
CHICAGO, IL 60606

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JUL 17 2006
OFFICE OF PETITIONS

In re Application of :
Rogers, et. al : DECISION ON PETITION
Application No. 09/360,719 :
Filed: July 27, 1999 :
Docket No.: 0600/96760 :

This is a decision on the renewed petition under 37 CFR 1.181, filed June 12, 2006.

This application became abandoned February 24, 2006 for failure to timely submit a proper reply to the Notice of Allowance (Notice) mailed November 23, 2005. Notice of Abandonment was mailed April 14, 2006. The petition filed April 11, 2006 was dismissed May 5, 2006.

Petitioners assert non-receipt of the Notice mailed November 23, 2005.

In the absence of any irregularity in the mailing of the non-final Office action, there is a strong presumption that the non-final Office was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. *See*, MPEP 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

Where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed

to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply), petitioners are required to establish that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address (See, MPEP 601.03), and must include an adequate showing that a timely notification of the change of address was filed in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of a change of address. See, MPEP 711.03(c).

Office records indicate the Office communication was properly mailed to the correspondence address of record at the time of mailing. Accordingly, there was no irregularity in mailing the Office communication on the part of the United States Patent and Trademark Office.

It is noted that a change of correspondence address was submitted in the instant application on May 2, 2006. It is unclear what effect, if any, the change of correspondence address may have had on petitioners' contention of non-receipt of the Notice as the petitions under 37 CFR 1.181 fail to disclose any information relevant to the change of correspondence address.

Accordingly, the petition under 37 CFR 1.181 to withdraw the holding of abandonment is hereby **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is not a final agency decision.

**ALTERNATE VENUE**

Petitioners are strongly urged to consider filing a petition stating that the delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

Further correspondence with respect to this matter should be addressed as follows:

By mail: **Mail Stop Petition**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By facsimile: (571) 273-8300

By hand delivery: U.S. Patent and Trademark Office
Customer Window, **Mail Stop Petition**
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Application of :
Rogers, et. al : DECISION ON PETITION
Application No. 09/360,719 :
Filed: July 27, 1999 :
Docket No.: 0600/96760 :

This is a decision on the petition renewed under 37 C.F.R. § 1.137(b), filed August 1, 2006.

This application became abandoned February 24, 2006 for failure to timely submit a proper reply to the Notice of Allowance (Notice) mailed November 23, 2005. Notice of Abandonment was mailed April 14, 2006. The petition filed April 11, 2006 was dismissed May 5, 2006. A renewed petition was filed June 12, 2006 and dismissed July 17, 2006.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4)any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been reviewed and found in compliance with the provisions of 37 C.F.R. § 1.137(b). Accordingly, the failure to timely submit a proper reply to the Notice is accepted as having been unintentionally delayed.

This application will be forwarded to the Office of Patent Publication for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

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APR 21 2005

OFFICE OF PETITIONS

In re Reissue Application No. 10/614,543
Filed: July 3, 2003
Original Patent No 6,254,574
Issue Date: July 3, 2001
Original Application No. 09/360,877
Filed: July 23, 1999
Inventors: Burzynski, Jones, Kearns, Polidoro, Sahi, Smutney

DECISION ACCORDING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the petition filed March 17, 2005, under 37 CFR 1.47(a) to accord this reissue application status in the absence of the signatures of all the named inventors but Kearns.

The petition is granted.

This application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status and the Office of Initial Patent Examination (OIPE) is authorized to

(1) accept this application under Rule 1.47(a);

(2) process the application with the inventors being Burzynski, Jones, Kearns, Polidoro, Sahi,and Smutney, using the reissue declaration filed on March 17, 2005; and

(3) mail a filing receipt with a filing date of July 3, 2003.

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventors at the addresses given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

This application is being referred to OIPE for further processing.

Inquiries related to this communication may be addressed to the undersigned at (571)272-3217.

Brian Hearn

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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MAR 26 2004

Paper No. 7

In re Application of
Randy Henry
Application No. 09/360,881
Filed: July 23, 1999
Attorney Docket No. HE01-003

DECISION ON PETITION

This is a decision on the petition filed that was originally filed on December 2, 2001 and has now been resubmitted on March 1, 2004 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned for failure to file a proper and timely reply to the Office action dated April 11, 2001. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioner alleges that this application is not abandoned because a proper reply to the Office letter in question was in fact filed on October 11, 2001. Petitioner further alleges that the reply was timely because it was accompanied by a request for extension of time and the fee of $460.00 for a three month extension. Petitioner supports these allegations by furnishing a copy of a request for the filing of a Continued Prosecution Application (CPA) under 37 CFR 1.53(d), a copy of a preliminary amendment and an itemized filing receipt for these items showing that they were in fact received in the Office on October 11, 2001, a date within the period set by the Office letter in question for filing a reply, as extended by three months. Based upon this evidence, it is clear that this application is not abandoned. It is also noted that the fee for the CPA and the fee for the extension have in fact been received by the Office and applied.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for processing as a CPA, and entry of the concurrently filed preliminary amendment. The date of the CPA will be October 1, 2001. Thereafter, the application will be forwarded to the examiner for action.

Petitioner should note that 37 CFR 1.53(d) was amended, effective July 14, 2003, to abolish CPA practice with respect to nonprovisional utility applications. See 68 Fed. Reg. 32376, Vol. 68, No. 104. While the request for the filing of a CPA obviously predates the rule change, and while the application obviously qualified for CPA practice under the previous version of 37 CFR 1.53(d), it **may** not be systemically possible to create a CPA. In that unlikely event, petitioner will be so notified and the request for filing a CPA will be treated as a Request for Continued Examination (RCE) pursuant to 37 CFR 1.114. See also MPEP § 706.07(h), item IV.

PETITION GRANTED.

E. Rollins Cross, Director
Technology Center 3700

John S. Reid
1926 South Valleyview Lane
Spokane, WA 99212-0157

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 9

Todd Mattingly
Haynes and Boone, LLP
1000 Louisiana
Suite 4200
Houston, TX 77002-5012

MAILED

DEC 0 5 2000

Technology Center 2600

In re Application of:
James Iseli, et al.
Application No.: 09/361,020
Filed: July 23, 1999
For: SEISMIC TELEMETRY SYSTEM

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request To Withdraw from Representation filed October 19, 2000.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The Power of Attorney to petitioner has been revoked by the assignee.

For the above stated reasons, the request is **DISMISSED AS MOOT**.

A courtesy copy of this decision is being mailed to petitioner at the address on the petition; however, all future communications from the Office will be directed to the below-listed correspondence address unless the Office receives proper notification otherwise.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: Todd A. Bynum
Madan, Mossman & Sriram, P.C.
2603 Augusta, Suite 700
Houston, TX 77057

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COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
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ALEXANDRIA, VA 22313-1450
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MAIL

Paper No. 15

PAUL S MADAN
MADAN, MOSSMAN & SRIRAM, PC
2603 AUGUSTA, SUITE 700
HOUSTON TX 77057-1130

APR 2 8 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
James Iseli, et al.
Application No. 09/361,020
Filed: July 23, 1999
For: **SEISMIC TELEMETRY SYSTEM**

DECISION ON PETITION
TO WITHDRAW HOLDING OF
ABANDONMENT

This is a decision on the petition to Withdraw Holding of Abandonment pursuant to 37 C.F.R.§ 1.181(a) filed December 29, 2003. No fee is required.

The petition is **GRANTED.**

The application was abandoned for failure to respond in a timely and effective manner to the Restriction Requirement mailed May 28, 2003. A Notice of Abandonment was mailed on December 15, 2003.

Petitioner asserts that a proper response was timely filed on September 24, 2003. In support of the petition, Petitioner has submitted a copy of Applicant's response and a date-stamped post card receipt evidencing receipt of the response within the United States Patent & Trademark Office on September 24, 2003. The petition also includes a copy of a transmittal, a request for three months extension of time and a copy of a check for $1,074.00.

The original correspondence filed was not matched with the file and cannot be located. However, M.P.E.P. § 503 states, "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the U.S.PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the response was timely filed in the Patent and Trademark Office but not matched with the application file.

In view of the above stated reasons, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The fee of $1,074.00 for three months extension of time and additional claims has not been credited to the instant application. However, the transmittal authorizes the charging of applicant's deposit account any underpayment.

Accordingly, the application file will be forwarded to the Technology Center's technical support staff for charging $1,074.00 to applicant's deposit account No. 13-0010 and for entering the copy of the response accompanying the petition. From there, the file will be forwarded to the examiner for appropriate action in due course.

Allen MacDonald

Allen R. MacDonald, Director
Technology Center 2600
Communications

OIPE JC117
OCT 1 5 2003
PATENT & TRADEMARK OFFICE

**Express Mail Label No.: EV 312713625 US**
**Date of Deposit: October 15, 2003**

**Attorney Docket No. 19721-005**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | | | |
|---|---|---|---|
| APPLICANTS: | Murdin *et al.* | | |
| SERIAL NUMBER: | 09/361,443 | EXAMINER: | J. Hines |
| FILING DATE: | July 26, 1999 | ART UNIT: | 1645 |
| FOR: | *CHLAMYDIA* ANTIGENS AND CORRESPONDING DNA FRAGMENTS AND USES THEREOF | | |

**MAIL STOP ISSUE FEE**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO DECISION ON THE PETITION UNDER 37 C.F.R. 1.137(b)**

The present paper is filed in response to the decision granting the Petition for Revival of an Unintentionally-Abandoned Patent Application under 37 C.F.R. 1.137(b) mailed October 3, 2003.

The decision states that there is no indication that petitioner has submitted an Issue Fee Transmittal Form (PTOL-85B) and accordingly requests submission of that form if the petitioner desires to have the information normally found thereon printed on the patent. Applicants herewith submit copies of the Response to Notice of Allowance, Completed Form PTOL-85B, check (#17155) for $1630.00 to cover the issue fee ($1300.00), publication fee ($300.00) and the advanced order of ten (10) copies ($30.00) which were originally submitted on September 16, 2003.

Note that pursuant to the instructions of Ms. Latrice Bond at the Office of Petitions, received in a telephone conference today with Dr. Matthew Pavao, these documents are being forwarded to Mail Stop Issue Fee and not the Publishing Division as indicated on the decision.

Applicants believe no additional fees are due. However, the Commissioner is hereby authorized to charge any additional fees that may be due, or to credit any overpayment, to Account 50-0311 (Ref. No. 19721-005).

Respectfully submitted,

Ivor R. Elrifi, Reg. No. 39,529
Nicholas P. Triano III, Reg. No. 36,397
Attorneys for Applicants
c/o MINTZ, LEVIN
Tel: (617) 542-6000
Fax: (617) 542-2241
**Customer Number 30623**

Dated: October 15, 2003

TRA 1842419v1

Express Mail Label No: EV 312 713 625 US

Date of Deposit: October 15, 2003

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Paper No. 37

Mintz Levin Cohn Ferris
Glovsky and Popeo
One Financial Center
Boston, MA 02111

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☑ Docket Entry 1113 Final
☐ Docket Cross Off
☐ Previously Entered
☐ No Docketing Req
☐ Annuities

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OCT 0 3 2003
OFFICE OF PETITIONS

In re Application of
Andrew D. Murdin et al.
Application No. 09/361,443
Filed: July 26, 1999
Attorney Docket No. 19721-005-~~PC~~ PA
Aventis Pasteur

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed September 16, 2003, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is granted.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the Notice of Allowance mailed March 6, 2003, which set a shortened statutory period for reply of three months from the mail date of the Notice. Accordingly, the application became abandoned on June 7, 2003.

There is no indication that petitioner has submitted an Issue Fee Transmittal Form (PTOL-85b). Accordingly, if petitioner desires to have the information normally found thereon printed on the patent, the attached blank Issue Fee Transmittal Form should be completed and returned to the Publishing Division within **ONE MONTH** from the mail date of this decision.

**Telephone inquiries regarding this decision should be directed to Latrice Bond at (703) 308-6911.**

**The application file is being forwarded to the Publishing Division.**

Latrice Bond

**Latrice Bond**
**Paralegal Specialist**
**Office of Petitions**
**Office of the Deputy Commissioner**
**for Patent Examination Policy**

RECEIVED
OCT 0 6 2003
MINTZ LEVIN, BOSTON
PATENT DOCKET DEPT.

cc: PTOL-85(b) Issue Fee Transmittal Form

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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MAIL Paper No 13

DEC 1 9 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

JOHN C. COOPER III
FOLEY & LARDNER
777 EAST WISCONSIN AVENUE
MILWAUKEE WI 53202-5367

In re Application of:
Brian S. HONECK, et al.
Application No. 09/361,449
Filed: July 26, 1999
For: **REMOTE DISPLAY SYSTEM WITH INDEPENDENT POWER SOURCE**

DECISION
ON PETITION

This is a decision on the Petition For Withdrawal Holding of Abandonment, filed July 3, 2002 pursuant to 37 CFR 1.181. No fee is required.

The petition is ***GRANTED***.

This application became abandoned for failure to timely file a response to the Final Office action mailed October 24, 2001. A Notice of Abandonment was mailed June 18, 2002.

Petitioner alleges to have timely filed a reply on December 26, 2001. To support this position, Petitioner has included with the instant petition a copy of the response bearing a proper certificate of facsimile transmission with a transmission date of December 26, 2001. Also included with the petition is a copy of an Auto-Reply Facsimile Transmission indicating that a 10 page document from Petitioner was received in the U.S. Patent and Trademark Office on December 26, 2001.

37 C.F.R. § 1.8(b) states that in the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence,

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

Petitioner has met the requirements above. Accordingly, the Notice of Abandonment is vacated and the holding of abandonment withdrawn.

It appears that there were substantial delays in the matching of the instant petition with the file. The Office sincerely regrets any inconvenience to applicant.

The application is being forwarded to the Technology Center's technical support staff for entry of the response which accompanied the instant petition. From there, the file will be forwarded to the examiner for consideration in due course.

Krista Zele
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

FEB - 6 2002

#13

FROMMER LAWRENCE & HAUG LLP
745 FIFTH AVENUE
NEW YORK, NY 10151

| | |
|---|---|
| In re Application of | : |
| Erwin Hacker et al | : |
| Serial No.:09/361,461 | :PETITION DECISION |
| Filed: July 27, 1999 | : |
| Attorney Docket No.:514413-3762 | : |

This is in response to applicants' petition under 37 CFR 1.181, filed September 26, 2001 to withdraw the abandonment of the above identified application based on timely filing of a reply.

A review of the file history shows that the examiner mailed a non-final Office action to applicants on September 29, 2000, setting a three month shortened statutory period for reply. After receiving no reply, a Notice of Abandonment was mailed to applicants on September 10, 2001. Applicants state that they filed a response under 37 CFR 1.111 on March 29, 2001, accompanied by a petition for a three month extension of time under 37 CFR 1.136(a), and filed a further supplemental response on April 26, 2001. The original amendment filed March 29, 2001 and the original supplemental amendment filed April 26, 2001, have now been located and placed in the file. In view thereof the Notice of Abandonment mailed September 10, 2001 is vacated and the application is restored to pending status with the mailing of this decision.

Applicant's petition is **GRANTED**. The application is restored to pending status with the mailing of this decision and will be forwarded to the examiner for further consideration.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-4205 or by facsimile transmission at (703) 746-5006.

John Doll
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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CALIPER LIFE SCIENCES, INC.
605 FAIRCHILD DRIVE
MOUNTAIN VIEW CA 94043-2234

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AUG 1 0 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Parce et al. | : | DECISION ON PETITION |
| Application No. 09/361,478 | : | |
| Filed: 26 July, 1999 | : | |
| Atty Docket No. 100/02510 | : | |

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on 18 July, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." This is not a final agency decision.

This application became abandoned on 2 January, 2005, for failure to file a timely reply to the final Office action mailed on 1

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[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

October, 2004, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply were filed in accordance with 37 CFR 1.136(a). The filing of the present petition precedes the mailing of Notice of Abandonment.

The petition lacks the required reply. The only proper reply to a final Office action is a Notice of Appeal and fee, Request for Continuing Examination and submission under 37 CFR 1.114, a continuing application, or an amendment placing the application in *prima facie* condition for allowance. The examiner has determined that the amendment filed on 18 July, 2005, does not place the case in *prima facie* condition for allowance. An Advisory Action Before the Filing of An Appeal Brief is enclosed for petitioners' information.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Service Window
Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Receipt of the Power of Attorney and Correspondence Address Indication Form is acknowledged.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: Advisory Action Before the Filing of an Appeal Brief
Notice Regarding Change of Power of Attorney
Notice of Acceptance of Power of Attorney

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CALIPER LIFE SCIENCES, INC.
605 FAIRCHILD DRIVE
MOUNTAIN VIEW CA 94043-2234

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Parce et al. | : | DECISION ON PETITION |
| Application No. 09/361,478 | : | |
| Filed: 26 July, 1999 | : | |
| Atty Docket No. 100/02510 | : | |

This is a decision on the renewed petition under 37 CFR 1.137(b),[1] filed on 29 August, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on 2 January, 2005, for failure to file a timely reply to the final Office action mailed on 1 October, 2004, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply were filed in accordance with 37 CFR 1.136(a). The filing of the present petition precedes the mailing of Notice of Abandonment. The petition filed on 18 July, 2005, was dismissed on 10 August, 2005.

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[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

Petitioners have filed a Request for Continued Examination (RCE) and have indicated that the previously filed amendment (a copy has been provided with the petition) is the submission required under 37 CFR 1.114.

This application is being referred to Technology Center Art Unit 2857 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3231.

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

POLYONE CORPORATION
33587 WALKER ROAD
AVON LAKE, OH 44012

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : TODD R. HAWKINS | : DECISION ON REQUEST FOR |
| **Patent Number** | : 6231789 | : RECALCULATION of PATENT |
| **Issue Date** | : 05/15/2001 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/361,505 | : OF WYETH |
| **Filed** | : 07/23/1999 | : |
| | | : |

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A). Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154 (b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

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WASHINGTON, D.C. 20231
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Paper No. 15

Cummins Engine Company Inc.
M C 60701
Box 3005
Columbus, IN 47202-3005

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SEP 03 2002

OFFICE OF PETITIONS

In re Application of :
James A. McEwan :
Application No. 09/361,612 : ON PETITION
Filed: July 27, 1999 :
Attorney Docket No. 8-02-6004 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 15, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure submit the issue fee and formal drawings in a timely manner in reply to the Notice of Allowance/Notice of Allowability mailed January 17, 2002, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on April 18, 2002.

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111, or in her absence, Sherry Brinkley at (703)305-9220.

This application is being forwarded to the Office of Publications to be processed into a patent.

Cheryl Gibson Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry Brinkley

Sherry Brinkley
Petitions Examiner

UNITED STATES PATENT AND TRADEMARK OFFICE

#27

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FEB 2 2004

TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

| | |
|---|---|
| In re Application of | : |
| Charles S. Zuckeret al | : |
| Serial No.: 09/361,630 | : PETITION DECISION |
| Filed: July 27, 1999 | : |
| Attorney Docket No.: 02307E-084210 | : |

This is in response to the petition under 37 CFR 1.181, filed October 3, 2003, for withdrawal of abandonment of the above identified application based on non-receipt of an Office action. The delay in acting on this petition is regretted.

A review of the file history shows that the examiner mailed an Office action to applicants on August 13, 2002, setting a three month shortened statutory period for reply. The Office action was mailed to PILLSBURY WINTHROP in McLean, VA, in accordance with a change is mailing address submitted by them in April, 2002. This address change was apparently in error. In October, 2002, applicants resubmitted a copy of an earlier Power of Attorney correcting the mailing address to the original attorneys. A Notice of Abandonment was mailed to applicants on April 7, 2003. In view of the address change error caused by PILLSBURY WINTROP, it is concluded that applicants did not receive the last Office action. In view of the evidence of record, the Notice of Abandonment is withdrawn and the application is restored to pending status with the mailing of this decision

The petition is **GRANTED**.

**The application will be forwarded to the examiner for mailing of a new Office action.**

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number.

Jasemine C. Chambers
Director, Technology Center 1600

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**OFFICE OF PETITIONS**

Christopher B. Eide
MORRISON & FOERSTER LLP
755 Page Mill Road
Palo Alto CA 94304

| | | |
|---|---|---|
| In re Patent No. 7,029,726 | : | |
| Issue Date: April 18, 2006 | : | |
| Application No. 09/361,669 | : | DECISION ON PETITION |
| Filed: July 27, 1992 | : | |
| Attorney Docket No. QUK-015.01 | : | |

This is a decision on the petition under 37 CFR 1.182, filed October 16, 2006, requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is **GRANTED**.

The Office of Patent Publication is directed to issue a duplicate Letters Patent.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3215.

Inquiries regarding the issuance of a duplicate Letters Patent may be directed to Krystal Paige in the Office of Patent Publication at (703) 308-9250, Ext. 139.

A copy of this decision is being faxed to the Office of Patent Publication for issuance of a duplicate Letters Patent.

Charlema R. Grant

Charlema R. Grant
Petition Attorney
Office of Petitions

cc: Krystal Paige, South Tower, 8th Floor, Room C32 (Fax No. (571) 270-9937)

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WASHINGTON, D.C. 2023
www.uspto.g

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MAY 1 2 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 9

Dennis
FERNANDEZ & ASSOCIATES LLP
1047 El Camino Real
Suite 201
Menlo Park, CA 94025

| | | |
|---|---|---|
| In re Application of: | ) | |
| Oliver et al. | ) | |
| Application No. 09/361,678 | ) | **DECISION ON REQUEST FOR** |
| Filed: July 27, 1999 | ) | **WITHDRAWAL AS ATTORNEY** |
| For: METHOD AND SYSTEM FOR INTERNET PERSONALIZATION | ) | |

This is a decision on the Request To Withdraw from Representation filed April 29, 2003.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request filed April 29, 2003 meets all the requirements. Accordingly the request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

James R. Matthews

For Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture and Software
(703) 305-9750

cc: Kevin Coleman
188 The Embarcadero, Suite 800
San Francisco, CA 94105

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 16

Kevin Coleman
188 The Embarcadero
Suite 800
San Francisco, CA 94105

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Jonathan Oliver, et al. | : | |
| Application No. 09/361,678 | : | ON PETITION |
| Filed: July 27, 1999 | : | |
| Attorney Docket No. MAILP019 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed July 12, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The application file does not indicate a change of address has been filed in this case, although the address given on the petition differs from the address of record. A change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

The application file is being forwarded to Technology Center 2100.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Lee Van Pelt
Van Pelt & Yi LLP
10050 N. Foothill Blvd.
Suite 200
Cupertino, CA 95014

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www.uspto.gov

VAN PELT, YI & JAMES LLP
10050 N. FOOTHILL BLVD #200
CUPERTINO CA 95014

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MAR 0 2 2006

OFFICE OF PETITIONS

In re Application of
Jonathan Oliver et al.
Application No. 09/361,678
Filed: July 27, 1999
Attorney Docket No.: 358.02

ON PETITION

This is a decision on the petition filed December 21, 2005 under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the non-Final Office Action mailed August 24, 2004. A shortened statutory period of three months was set for replying to the non-Final Office Action. No extensions of time having been requested, this application became abandoned November 25, 2004. The instant petition and this decision precede the mailing of the Notice of Abandonment.

Additionally, please be advised that the fee for a petition under the unintentional standard has been increased from $1370.00 to $1500.00 for a large entity effective December 8, 2004. Petitioner's deposit account no. 50-0685 has been charged the difference in the amount of $130.00.

This matter is being referred to Technology Center 2166 for appropriate action on the amendment filed December 21, 2005.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

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United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 15

JAMES H MORRIS
WOLF GREENFIELD & SACKS PC
FEDERAL RESERVE PLAZA
600 ATLANTIC AVENUE
BOSTON MA 02210-2211

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OFFICE OF PETITIONS

In re Application of
Pierrick Descure
Application No. 09/361,700
Filed: July 27, 1999
Attorney Docket No. S1022/8201

DECISION ON PETITION

This is a decision on the petition filed April 1, 2002 (Certificate of Mailing dated March 21, 2002), pursuant to 37 CFR 1.137(b), to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely reply to the Notice to File Missing Parts of Application (CPA), mailed May 22, 2001. This Notice set a period for reply of two months from the mail date of the Notice to submit the statutory basic filing fee and additional claims fee. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. No filing fees having been received, the above-identified application became abandoned on July 23, 2001. The mailing of the instant decision precedes the mailing of a Notice of Abandonment.

With the instant petition, petitioner submitted the filing fees (and the surcharge for its late filing), paid the petition fee, and made the a statement of unintentional delay. 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3). The statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

Petitioner only submitted a check for the amount of $1,612, not sufficient to cover the $1,280 petition fee, $740 basic filing fee, $130 surcharge fee, and $462 additional claims fee. Accordingly, Deposit Account No. 23-2825 has been charged $1000 to cover the deficiency, as authorized.

The application file is being forwarded to Technology Center 2800 for examination in due course.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-0272.

Cliff Congo
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

5-1-08

Commissioner for Patents
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P.O. Box 1450
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Patent No. : 7,242,782
Ser. No. : 09/361,734
Inventor(s) : Kasai, et. al.
Issued : July 10, 2007
Title : AUDIO SIGNAL PROCESSING CIRCUIT
Docket No. :

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

*In the Request*, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

**Eva James**
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) **308-9390 ext. 124** or 105

Paul, Hastings
Janofsky & Walker LLP
875 15th Street, NW
Washington, DC 20005

ej

UNITED STATES DEPARTMENT OF COMMERCE
**Patent and Trademark Office**
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

#4

JUN 4 2002

| | | |
|---|---|---|
| Applicant: Yasuaki Tsuzuki et al. | : | |
| Serial No. 09/361,980 | : | DECISION ON PETITION |
| Filed: July 28, 1999 | : | |
| For: METHOD OF ETCHING METALLIC THIN FILM RESISTOR | : | |

This is a decision on the petition filed on May 2, 2002 under 37 C.F.R. 1.48(b) requesting that the inventorship of this application be corrected by deleting ICHIRO ITO, SATOSHI SHIRAKI, TOMIO YAMAMOTO, MAKOTO OHKAWA, and ATSUMI TAKAHASHI. Petitioner has met the requirements of 37 C.F.R. 1.48(b).

The petition is **GRANTED**.

Benjamin L. Utech
Supervisory Patent Examiner
Art Unit 1765
Technology Center 1700
Chemical Materials & Engineering

Pillsbury Madison & Sutro LLP
Intellectual Property Group
1100 New York Avenue NW
Ninth Floor East Tower
Washington, DC 20005-3918

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Janelle D. Strode
SONNENSCHEIN NATH & ROSENTHAL
P.O. Box 061080
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Sears Tower
Chicago, Illinois 60606-1080

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A/C PATENTS

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|---|---|---|
| In re Application of | : | |
| Gosain et al. | : | |
| Application No. 09/362,055 | : | ON PETITION |
| Filed: July 28, 1999 | : | |
| Attorney Docket No. 9792909-4275 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed April 25, 2001, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the Final Office action mailed August 15, 2000. Accordingly, this application became abandoned on November 16, 2000. A Notice of Abandonment was mailed on April 9, 2001.

A proper response in the form of a Continued Prosecution Application request accompanied by a preliminary amendment was received April 25, 2001.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the $890.00 extension of time submitted with the petition on April 25, 2001 was subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

The file is being forwarded to Technology Center 2800.

Telephone inquiries concerning this matter may be directed to Lesley D. Morris at (703) 306-0028.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

## REQUEST FOR PATENT FEE REFUND

1 Date of Request: 5/14/01

2 Serial/Patent # 09/362055

| | 3 Please refund the following fee(s): | 4 PAPER NUMBER | 5 DATE FILED | 6 AMOUNT |
|---|---|---|---|---|
| | Filing | | | $ |
| | Amendment | | | $ |
| ✓ | Extension of Time | 13 | 4/25/01 | $ 890.00 |
| | Notice of Appeal/Appeal | | | $ |
| | Petition | | | $ |
| | Issue | | | $ |
| | Cert of Correction/Terminal Disc. | | | $ |
| | Maintenance | | | $ |
| | Assignment | | | $ |
| | Other | | | $ |

7 TOTAL AMOUNT OF REFUND $

8 TO BE REFUNDED BY:

| | |
|---|---|
| | Treasury Check |
| X | Credit Deposit A/C #: |

9 19--3140

10 REASON:

| | |
|---|---|
| | Overpayment |
| | Duplicate Payment |
| ✓ | No Fee Due (Explanation): |

Extension of Time is outside the maximum time period available.

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Leslie D. Morris TITLE:

SIGNATURE: PHONE:

OFFICE:

** **********

THIS SPACE RESERVED FOR FINANCE USE ONLY:

APPROVED: Liana Chase DATE: 5/15/01

*Instructions for completion of this form appear on the back. After completion, attach white and yellow copies to the official file and mail or hand-carry to:*

**Office of Finance**
**Refund Branch**
**Crystal Park One, Room 802B**

FORM PTO 1577
(01/90)

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6322633
Issue Date: November 27,2001
Application No. 09362157
Filed: July 28,1999
Attorney Docket No. 243/190

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed January 26,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of January 26,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6322633 | 2001-11-27 | 09362157 | 1999-07-28 | P99-0035 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ◉ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /craig e. bohn/ | Date (YYYY-MM-DD) | 2010-01-26 |
| Name | Craig E. Bohn | Registration Number | 52629 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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MAILED Paper No.
APR 26 2010
OFFICE OF PETITIONS

KENYON & KENYON LLP
ONE BROADWAY
NEW YORK NY 10004

| | |
|---|---|
| In re Application of<br>Spartiotis et al.<br>Application No. 09/362,195<br>In re Patent No. 6,410,922<br>Filing Date: July 28, 1999<br>Issue Date: June 25, 2002<br>Attorney Docket Number:<br>2338/47801<br>Title: FORMING CONTACTS ON SEMICONDUCTOR SUBSTRATES FOR RADIATION DETECTORS AND IMAGING DEVICES | DECISION ON PETITION PURSUANT TO 37 C.F.R. § 3.81(B) |

This is a decision on the "PETITION TO ACCEPT A DELAYED CLAIM FOR PRIORITY UNDER 35 U.S.C. 119(a)-(d) or (f) - DELAY UNINTENTIONAL," filed November 21, 2008, to add a priority claim to an international application.

The petition is **GRANTED**.

With this petition, Petitioner requests that a Certificate of Correction be issued to add a priority claim to an international application: GB 9524387.9, filed on November 29, 1995.

A certificate of correction under 35 U.S.C. 255 and 37 CFR 1.323 may be requested and issued in order to perfect a claim for foreign priority benefit in a patented continuing application if the requirements of 35 U.S.C. 119(a)-(d) or (f) had been satisfied in the parent application prior to issuance of the patent and the requirements of 37 CFR 1.55(a) are met. Furthermore, if the continuing application (other than a design application), which issued as a patent, was filed on or after November 29, 2000, in addition to the filing of a certificate of correction request, patentee must also file a petition for an

unintentionally delayed foreign priority claim under 37 CFR 1.55(c).

However, a claim to foreign priority benefits cannot be perfected via a certificate of correction if the requirements of 35 U.S.C. 119(a)-(d) or (f) had not been satisfied in the patented application, or its parent, prior to issuance and the requirements of 37 CFR 1.55(a) are not met. In this latter circumstance, the claim to foreign priority benefits can be perfected only by way of a reissue application in accordance with the rationale set forth in Brenner v. State of Israel, 158 USPQ 584.

Application No. 08/755,826, which matured into U.S. Patent No. 6,046,068 on April 4, 2000, was filed on November 26, 1996, within twelve-months of the filing of the foreign application to which priority is sought. The present patent is a continuation-in-part of Application No. 08/755,826.

It is noted that this patent matured from an application which was filed prior to November 29, 2000, and as such, Rule 1.55(c) is not applicable.

The requirements of 35 U.S.C. 119(a)-(d) or (f) have been satisfied, and Office records (PALM) show that application No. 08/755,826 claims priority to GB 9524387.9. Therefore, the requirements of 37 CFR 1.55(a) have been met.

Both the $100 certificate of correction fee and the $130 processing fee will be charged to Deposit Account number 11-0600 in due course, as authorized on the second page of this petition. The $1410 submission is not necessary, and will be credited to this Deposit Account.

The Certificates of Correction Branch will be notified of this decision so that the requested Certificate of Correction can be issued.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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BEDMINSTER NJ 07921

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|---|---|---|
| In re Application of | : | |
| JAVITT et al. | : | |
| Application No.: 09/362,199 | : | DECISION ON PETITION |
| Filing Date: July 28, 1999 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No.: 2685/5226 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed January 25, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance mailed August 1, 2006, which set a statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on November 1, 2006.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the issue fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the payment of the issue fee is accepted as having been unintentionally delayed.

This application is being referred to the Office of Publications.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3301.

Daniel Stemmer
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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OCT 25 2007

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|---|---|---|
| In re Application of | : | |
| JAVITT et al. | : | |
| Application No.: 09/362,199 | : | DECISION ON PETITION |
| Filing Date: July 28, 1999 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No.: 2685/5226 | : | |

The decision mailed 26 September 2007 granting applicants' petition to revive under 37 CFR 1.137(b) is hereby VACATED.

This is a decision on the petition under 37 CFR 1.137(b), filed January 25, 2007, to revive the above-identified application.

The petition is **DISMISSED.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Allowance and Fees Due (Form PTOL-85) and the Notice of Allowability (Form PTOL-37) both mailed August 1, 2006, which set a shortened statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on November 1, 2006.

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before June 8, 1995.

The instant petition does not satisfy requirement (1) above. The Notice of Allowability required corrected drawings but these drawings have not been provided.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)."

Further correspondence with respect to this matter should be addressed to:

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3301.

Daniel Stemmer
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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| | | |
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| In re Application of | : | |
| JAVITT et al. | : | |
| Application No.: 09/362,199 | : | DECISION ON PETITION |
| Filing Date: July 28, 1999 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No.: 2685/5226 | : | |

This is a decision on the renewed petition under 37 CFR 1.137(b), filed December 26, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Allowance and Fees Due (Form PTOL-85) and the Notice of Allowability (Form PTOL-37) both mailed August 1, 2006, which set a shortened statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on November 1, 2006.

A decision mailed September 26, 2007 dismissed applicants' petition to revive under 37 CFR 1.137(b) filed December 18, 2006 because the required reply, corrected drawings, had not been provided. The renewed petition includes corrected drawings.

Thus, the petition now satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue fee and corrected drawings; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the payment of the issue fee and the corrected drawings are accepted as having been unintentionally delayed.

This application is being referred to the Office of Publications.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3301.

/Daniel Stemmer/

Daniel Stemmer
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 6186201
Issue Date: February 13,2001
Application No. 09362218
Filed: July 28,1999
Attorney Docket No. 0180-0001

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 2,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 2,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,186,201 | 2001-02-13 | 09/362,218 | 1999-07-28 | 10-065-US |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

◉ The assignee of record of the entire interest

| The Assignee of record of the entire interest | | | |
|---|---|---|---|
| Under 37 CFR 3.71 an assignee becomes of record by filing a statement in compliance with 37 CFR 3.73(b). Signature requirements are set forth in 37 CFR 1.4(d), and the undersigned certifies that he / she is empowered to act on behalf of the assignee of the entire interest | | | |
| Signature | /Julie S. Greenstein/ | Date (YYYY-MM-DD) | 2010-02-01 |
| Name | Julie S. Greenstein | | |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 012590 | Frame Number | 0587 |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 023861 | Frame Number | 0260 |
| Click ADD for additional Reel Number and Frame Number | | Add | |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

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The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**BROOKHAVEN SCIENCE ASSOCIATES/**
**BROOKHAVEN NATIONAL LABORATORY**
**BLDG. 185 - P.O. BOX 5000**
**UPTON NY 11973**

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AUG 06 2008

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,593,367 | : | |
| Issue Date: July 15, 2003 | : | |
| Application No. 09/362,592 | : | ON PETITION |
| Filed: July 28, 1999 | : | |
| Attorney Docket No. BSA-99-18 | : | |

This is a decision on the petition under 37 CFR 1.378(c), filed August 29, 2007, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED**.

This patent expired on July 16, 2007 for failure to pay the three and one-half year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The three and one-half year maintenance is currently $465 and the surcharge after expiration (late payment is unintentional) is $1,640 which makes a total of $2,105 being charge to the deposit account provided.

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay. In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that the delay in paying the maintenance fee under 37 CFR 1.378(c) was intentional, petitioner must notify the Office. Also, it is not apparent whether the person signing the instant petition was ever given power of attorney or authorization of agent to prosecute this patent. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a

representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts.

Telephone inquiries concerning this decision should be directed to Terri Williams at (571) 272-2991.

The patent file is being forwarded to Files Repository.

Chris Bottorff
Petitions Examiner
Office of Petitions

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: **Dewey, et al.**

U.S. Patent No.: **6,593,367** Group No.: **1627**

Issued: **July 15, 2003**

For: **TREATMENT OF ADDICTION AND ADDICTION-RELATED BEHAVIOR**

08/05/2008 CKHLOK 00000001 023977 6593367
01 FC:2551 450.00 DA
02 FC:1558 1640.00 DA

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

**PETITION TO THE COMMISSIONER**
**UNDER 37 CFR 1.378(c)**

The Patentee in the referenced patent, Brookhaven Science Associates, LLC. (BSA), hereby petitions for acceptance of a delayed payment of the 3 and one-half (3 ½) year maintenance fee for the referenced patent. Patentee's failure to timely pay the maintenance fee was unintentional and resulted from a clerical error on the part of the Patentee in combination with incorrect information available to the Patentee in the PAIR system at the US Patent and Trademark Office (USPTO).

Upon issue of the referenced patent on July 15, 2003, BSA unintentionally incorrectly docketed the 3½ year maintenance fee payment to be made on August 15, 2007. On August 10, 2007, BSA was prompted by its docketing system to prepare to make the maintenance fee payment. Upon said prompting the BSA became aware of the unintentional error in the payment due date.

As soon as BSA became aware of the error on August 10, the PAIR system was accessed to check the status of the maintenance fees. The attached print-out of the PAIR page from August 10, 2007 shows that the USPTO indicates that no fees are due for this patent. *See* Attachment 1. Clearly this is an error on the part of USPTO.

In addition, BSA checked the PAIR system to determine if any notifications had been mailed to BSA regarding past due fees or patent expiration. The print out from the Transaction History in the PAIR system shows that no notices had been sent to BSA regarding the maintenance fee or the expiration of the patent. *See* Attachment 2.

Thus, through errors on the part of BSA and on the part of the USPTO, the maintenance fee payment date was missed.

BSA has now taken the steps to file this petition in a timely manner. Patentee requests acceptance of the delayed payment and reinstatement of the patent.

Please charge the maintenance fee ($450.00), the late payment within six (6) months surcharge ($65.00) and any fees required for the filing of this Petition to Deposit Account No. 02-3977.

Respectfully submitted,

Christine L. Brakel
Patent Agent for Applicants
Registration No. 45,772

Date: August 29, 2007

Christine L. Brakel, Patent Agent
Brookhaven National Laboratory
Bldg. 185
P.O. Box 5000
Upton, New York 11973-5000
(631) 344-7134

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 16

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**ALEXANDRIA, VIRGINIA 22320**

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**OFFICE OF PETITIONS**
**A/C PATENTS**

| | | |
|---|---|---|
| In re Reissue Application of | : | |
| Motoyuki Fujimori et al | : | |
| Application No. 09/362,623 | : | ON PETITION |
| Filed: July 28, 1999 | : | |
| Attorney Docket No. 103614.99 | : | |

This is a decision on the petition, filed June 7, 2001, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on January 24, 2001 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

The application is being forwarded to Technology Center AU 2851 for processing of the request for continued examination under 37 CFR 1.114.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : August 9, 2007

TO SPE OF : ART UNIT 2872

SUBJECT : Request for Certificate of Correction for Appl. No09/362698 patent no6829091

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**Magdalene Talley**

**Certificates of Correction Branch**

**703-308-9390 ext. 116**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

- ☐ **Approved** — **All** changes apply.
- ☑ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** All changes approved except for insertion of paragraph in column 30, line 51 since it does not meet statutory requirement that the type of mistake must be (1) of a clerical nature; (2) of a typographical nature or (3) a mistake of minor character. (see MPEP 1481)

Stephone B. Allen
Supervisory Patent Examiner

SPE

2872
Art Unit

00684.002621.1

OIPE JC81
FEB 25 2005
PATENT & TRADEMARK OFFICE

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| In re Patent of: | ) | |
| Takashi KATO et al. | ) | Examiner: A. V. Amari |
| Application No.: 09/362,698 | ) | Group Art Unit: 2872 |
| Filed: July 29, 1999 | ) | |
| For: OPTICAL SYSTEM AND OPTICAL INSTRUMENT WITH DIFFRACTIVE OPTICAL ELEMENT | ) | February 25, 2005 |
| U.S. Patent No. 6,829,091 B2 | ) | |
| Issued: December 7, 2004 | ) | |

Certificate
MAR 07 2005
of Correction

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
**Attention: Certificate of Correction Branch**

REQUEST FOR
CERTIFICATE OF CORRECTION
UNDER RULES 322 AND 323

Sir:

Patentees request that a Certificate of Correction be issued by the Patent and Trademark Office due to errors which appear in the printed patent as a result of Patent and Trademark Office mistakes and mistakes of a minor nature which are not the fault of the Patent and Trademark Office. A Certificate of Correction form, in duplicate, is enclosed.

03/01/2005 MBEYENE1 00000083 6829091
01 FC:1811 100.00 OP



MAR 17 2005

Accompanying this letter is a check for $100.00 to cover the statutory fee for such Certificate of Correction. Any additional fee required by this paper may be charged to Deposit Account No. 06-1205. A duplicate of this paper is enclosed for that purpose.

Patentees' undersigned attorney may be reached in our Washington, D.C. Office by telephone at (202) 530-1010. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

Steven E. Warner

Attorney for Patentees
Steven E. Warner
Registration No. 33,326

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3801
Facsimile: (212) 218-2200
SEW/eab

DC_MAIN 194412v1

MAR 17 2005

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UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 6,829,091 B2

DATED : December 7, 2004

INVENTOR(S): Takashi KATO et al.



It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

ON THE COVER PAGE:

In section "(*) Notice:" after "0 days.", insert the following paragraph:

-- This patent issued on a continued prosecution application filed under 37 C.F.R. 1.53(d), and is subject to the twenty year patent term provisions of 35 U.S.C. 154(a)(2). --

In section "(56) **References Cited,**" under "FOREIGN PATENT DOCUMENTS," "JP 6-242373 2/1994" should read -- JP 6-242373 9/1994 --.

COLUMN 2:

Line 38, "fiat" should read -- flat --.

COLUMN 3:

Line 33, "system" should read -- system. --.

MAILING ADDRESS OF SENDER:

PATENT NO. 6,829,091 B2

**FITZPATRICK, CELLA, HARPER & SCINTO**
**30 Rockefeller Plaza**
**New York, New York 10112-3801**
**(212) 218-2100 - Telephone**
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UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 6,829,091 B2

DATED : December 7, 2004

INVENTOR(S): Takashi KATO et al.



It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

COLUMN 5:

Line 54, "element" should read -- element. --.

COLUMN 7:

Line 8, "$x = \{ch^2 / 1 + \sqrt{1} - (1+k)c^2h^2]\} + Ah^4 + Bh^6 +$" should read

-- $x = \{ch^2 / [1 + \sqrt{1 - (1+k)c^2h^2}]\} + Ah^4 + Bh^6 +$ --.

Line 59, "$f(h) = a1 \cdot h^2 + a2h^4 + a3 \cdot h^6 + a4 \cdot h^8 + \ldots g(h)2\pi / \lambda \cdot f(h)$" should read

$f(h) = a1 \cdot h^2 + a2 \cdot h^4 + a3 \cdot h^6 + a4 \cdot h^8 + \ldots$

-- $g(h) = 2\pi / \lambda \cdot f(h)$ --.

COLUMN 8:

Line 45, "Distributicn" should read -- Distribution --.

MAILING ADDRESS OF SENDER:

PATENT NO. 6,829,091 B2

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UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 6,829,091 B2

DATED : December 7, 2004

INVENTOR(S): Takashi KATO et al.



It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

COLUMN 9:

Line 12, "Distributicn" should read -- Distribution --.

COLUMN 10:

Line 45, "problems)," should read -- problem), --.

COLUMN 11:

Line 24, "can not" should read -- cannot --.

COLUMN 13:

Line 2, "10-30 ml." should read -- 10-30 mm. --.
Line 3, "water," should read -- wafer, --.
Line 10, "agent.)" should read -- agent). --.

COLUMN 15:

Line 28, "boding" should read -- bonding --.
Line 30, "sued" should read -- used --.

MAILING ADDRESS OF SENDER:

PATENT NO. 6,829,091 B2

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UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 6,829,091 B2

DATED : December 7, 2004

INVENTOR(S): Takashi KATO et al.



It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

COLUMN 16:
Line 38, "water" should read -- wafer --.

COLUMN 17:
Line 64, "my" should read -- may be --.

COLUMN 18:
Line 33, "Walls" should read -- Waals --.

COLUMN 20:
Line 32, "embodiment" should read -- embodiment. --.

COLUMN 22:
Line 6, "plat" should read -- plate --.
Line 21, "of" should read -- or --.

COLUMN 25:
Line 46, "hating" should read -- having --.

MAILING ADDRESS OF SENDER:

PATENT NO. 6,829,091 B2

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# CERTIFICATE OF CORRECTION

PATENT NO. : 6,829,091 B2

DATED : December 7, 2004

INVENTOR(S): Takashi KATO et al.



It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

COLUMN 26:

Line 60, the first occurrence of "the" should be deteled.

COLUMN 27:

Line 38, "race" should read -- face --.

COLUMN 29:

Line 6, "lasers" should read -- laser --.

COLUMN 30:

Line 51, following "period." insert the following paragraph:

-- In the embodiment described above, optical elements being bonded by a hydrogen bond may be placed in a closed casing filled with a nitrogen gas ambience and a pressurizing treatment may be made to it. This is effective to increase the bonding strength. --.

Line 59, the second occurrence of "on" should be deleted.

MAILING ADDRESS OF SENDER:

PATENT NO. 6,829,091 B2

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New York, New York 10112-3801
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Nixon & Vanderhye, P.C.
1100 North Glebe Road, 8th Floor
Arlington, VA. 22201

In re Application of :
James D. Martin, et al. :
Application No. 09/363,013 :
Filed: July 29, 1999 :
Attorney Docket No. 2920-223 :

ON PETITION

This is a decision on the petition under 37 CFR 1.182, filed December 2, 1999, to change the order of the names of the inventors.

The petition is granted.

The order of the names of the inventors will be changed as follows:

1. James D. Martin
2. Norman H. Lundstrom
3. Robert S. Scheffee

This application is being forwarded to Initial Patent Examination Division via Application Branch Data Input to change the order of inventorship.

Janice Ford
Janice Ford
Legal Instruments Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

Karen Creasy for
Marianne Morgan
Petitions Examiner

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6545402
Issue Date: April 8,2003
Application No. 09363048
Filed: July 29,1999
Attorney Docket No. 0465-0592P-S

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed July 27,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 27,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Approved for use through 04/30/2009. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6545402 | 2003-04-08 | 09363048 | 1999-07-29 | 0465-0592P-S |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ◉ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Kendal M. Sheets/ | Date (YYYY-MM-DD) | 2007-07-27 |
| Name | Kendal M. Sheets | Registration Number | 47077 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 11

KILPATRICK STOCKTON LLP
607 14TH STREET, N.W.
SUITE 900
WASHINGTON DC 20005

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MAR 25 2003

OFFICE OF PETITIONS

In re Application of
Lalgudi V. Natarajan et al.
Application No. 09/363,169
Filed: July 29, 1999
Attorney Docket No. SAIC0004

ON PETITION

This is a decision on the petition filed October 1, 2002 under 37 CFR 1.181 to withdraw the holding of abandonment for the above-identified application.

The petition under 37 CFR 1.181 is **GRANTED**.

The application was held abandoned on September 21, 2000 for failure to timely submit a response to the non-Final Office Action mailed June 20, 2000. A three (3) month period for reply was set and no extensions of time to file the response were requested or granted. Accordingly, a Notice of Abandonment was mailed February 28, 2001.

Petitioner asserts that a reply and a request for a three month extension of time was timely filed December 20, 2000.

In support, petitioner has submitted, copies of the reply, three month extension request and a copy of the itemized post card receipt, with a United States Patent & Trademark Office date stamp of December 20, 2000. In view of the above, the holding of abandonment for failure to timely reply to the non-Final Office Action is being withdrawn.

A review of the file reveals that the reply and the extension request were in fact received by the PTO on December 20, 2000. (Papers 9 and 10) unfortunately, the documents were not matched to the file and only now receives consideration. In view of the above, the holding of abandonment for failure to timely reply to the non-Final Office Action is being withdrawn. No petition fee is due and none has been charged.

The application file is being forwarded to Technology Center 1700 for further examination.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (703) 305-4497.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

D. EDWARD DOLGORUKOV
MARSHALL AND MELHORN, LLC
FOUR SEAGATE, 8TH FLOOR
TOLEDO, OH 43604

**COPY MAILED**

SEP 15 2004

**OFFICE OF PETITIONS**

In re Application of
Ott, Douglas, et. al.
Application No. 09/363,234
Filed: July 27, 1999
For: METHOD AND APPARATUS FOR TREATING GAS FOR DELIVERY TO AN ANIMAL

: Three
: Week
: Letter

A petition for access under 37 CFR 1.14(a)(1) and (h) was filed by John C. Freeman on behalf of Northgate Technologies, Inc. for access to the above-identified application on February 20, 2004, without proof of service on applicants. A copy of the petition is enclosed with this letter.

A member of the public may be entitled to access if "special circumstances" are shown which warrant a grant of access under 35 U.S.C. § 122. See Manual of Patent Examining Procedure (MPEP), Section 103. The use of such application to interfere with the business of others may be such special circumstances. Ex parte Bonnie-B Co. Inc., 1923 C.D. 42; In re Application for Trimless Cabinets, 128 USPQ 95 (Comm'r Pats. 1960); and In re Crossman, Kenrick, and LeMieux, 187 USPQ 367 (PTO Sol. 1975).

Petitioner states that access should be granted to the above-identified application because of actions taken in petitioner's application no. 09/896,821. Petitioner also states that access should be granted due to interference in Northgate's business.

With respect to actions taken in the '821 application, a paper with a September 2, 2003 date was filed in the '821 application and identified as an Information Disclosure Statement (IDS) on the top of page 2. The signer identified himself in the signature block as "Carl L. Johnson" with Reg. No. 24,273 and as "Attorney for Applicant," which suggests that the IDS needed to comply with 37 CFR 1.97 and 1.98, not 37 CFR 1.99, and that Mr. Johnson was acting in a representative capacity on behalf of the patent applicant when the IDS was filed. See 37 CFR 1.34.

Had the papers filed on September 2, 2003 been reviewed for compliance with 37 CFR 1.99, the patent applications cited therein would not have been considered. Patent applications are neither patents nor publications, and, as a result, the citation of a patent application would not have been permitted pursuant to 37 CFR 1.99. Had the paper been properly identified as a submission under 37 CFR 1.99, it would not have been considered because the fee, copy, or service requirements of 37 CFR 1.99(b)(1), (3) or (c) were not met. The matters in the petition relating to this conduct and possible sanctions are being referred to the Office of Enrollment and Discipline for resolution and will not be further addressed in the petition decision.

In view of the petition, it is apparent Mr. Johnson does not represent the applicant of the '821 application. The petition on page 2, states that petitioner was informed that the September 2, 2003

communication was filed by Lexion's attorney. Lexion is the assignee of record of the above referenced application.

With respect to interference in Northgate's business the petition includes, as exhibits, correspondence with Lexion, the assignee of record of the above referenced application. The correspondence relates infringement of Lexion's patents which are stated by petitioner to be related to the above referenced application. While interference with business relations may be sufficient to warrant access, the filing of the Information Disclosure Statement is more material. By filing the IDS, Mr. Johnson appears to have given the applicant in which the IDS was filed a right to inspect the applications cited in the IDS.

The Office will not permit third parties to interfere in the prosecution of another party's application by filing a protest without the consent of the applicant of the other application. It appears from the petition however, that petitioner will consent to "IDS," filed September 2, 2003, if given access to applications cited therein (the above-identified application and another application). If petitioner is denied access to the above referenced application the Office will *sua sponte* expunge the paper filed by Carl Johnson from the record of the '821 application.

Applicants are hereby given THREE WEEKS from the date of this letter to file a response to this letter consenting to or opposing access. The response should also state who Carl Johnson represents and his relationship to the parties. If applicant fails to respond within the three week period, petitioner may be allowed access to the entire application.

Any correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia

By FAX: (703) 872-9306
Attn: Office Patent Legal Administration/Michael L. Lewis

Telephone inquiries should be directed to Michael L. Lewis at (703) 306-5585.

Michael L Lewis

for/Karin Ferriter, Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

cc: JOHN C. FREEMAN
BRINKS HOFER GILSON & LIONE
N B C TOWER, SUITE 3600
455 NORTH CITYFRONT PLAZA DR.
CHICAGO IL 60611

Attachment: Petition filed February 20, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 19

LERNER AND GREENBERG
Post Office Box 2480
Hollywood, FL 33022-2480

JUN 23 2003

In re Application of )
WURSTER et al. )
Application No. 09/363,277 )
Filed: July 28, 1999 )
For: Trench Capacitor with an Insulation Collar )
and Method for Producing a Trench Capacitor )

DECISION ON PETITION

This is a decision on the petition, filed on August 1, 2002, to withdraw the holding of abandonment based on failure to receive an Office action.

The petition is **GRANTED**.

This application was held abandoned for failure to respond in a timely manner to the final Office action mailed on January 9, 2002. A Notice of Abandonment was mailed on July 15, 2002.

Petitioner states that the Office action of January 9, 2002 was never received by counsel and attests to the fact that a search of the file jacket and docket records indicates that the Office action was not received. The petition includes a copy of the docket record where the non-received Office action would have been entered had it been received and docketed

In view of the above showing, the Notice of Abandonment is hereby vacated, and the holding of abandonment is withdrawn.

The application file is being forwarded to the technical support staff for Technology Center 2800 for remailing of the Office action of January 9, 2002. The period for reply will be restarted along with the remailing of the action.

Hien H. Phan, Special Program Examiner,
Technology Center 2800 - Semiconductors, Electrical
and Optical Systems and Components
(703) 308-7502

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6509985
Issue Date: January 21,2003
Application No. 09363408
Filed: July 29,1999
Attorney Docket No. JNP-0617

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed April 19,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 19,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Approved for use through 04/30/2009. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,509,985 | 2003-01-21 | 09/363,408 | 1999-07-29 | JNP-0617 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ◉ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Paul A. Harrity/ | Date (YYYY-MM-DD) | 2007-04-19 |
| Name | Paul A. Harrity | Registration Number | 39574 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6019034 | 2000-02-01 | 09/363,487 | 1999-07-29 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Gordon G. Waggett/ | Date (YYYY-MM-DD) | 2009-10-26 |
| Name | Gordon G. Waggett | Registration Number | 34476 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6019034
Issue Date: February 1,2000
Application No. 09363487
Filed: July 29,1999
Attorney Docket No. 031170.9001.

:

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

:

This is a decision on the electronic petition, filed October 26,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 26,2009 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6437793
Issue Date: August 20,2002
Application No. 09363513
Filed: July 29,1999
Attorney Docket No. BIT99-2

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed April 25,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 25,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Approved for use through 04/30/2009. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,437,793 | 2002-08-20 | 09/363,513 | 1999-07-29 | BIT99-2 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ◉ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | / Edward W. Porter / | Date (YYYY-MM-DD) | 2007-04-25 |
| Name | Edward W. Porter | Registration Number | 28892 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 17

F. CHAU & ASSOCIATES
1900 HEMPSTEAD TURNPIKE
SUITE 501
EAST MEADOW, NY 11554

COPY MAILED

JUN 04 2002

OFFICE OF PETITIONS

In re Application of :
Rajarao Jammy et al :
Application No. 09/363,523 : ON PETITION
Filed: July 28, 1999 :
Attorney Docket No. 99 P 7722 US (8055-98) :

This is a decision on the petition under 37 CFR 1.137(b), filed April 15, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed April 10, 2001, which set a shortened statutory period for reply of three (3) months. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)). Since the amendment submitted does not *prima facie* placing the application in condition for allowance, no Notice of Appeal (and appeal fee) was timely filed, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 11, 2001.

The above-identified application is being revived solely for purposes of continuity with a continued prosecution application (CPA) filed on April 15, 2002.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 305-9282.

The application file is being forwarded to Technology Center 2823 for further processing.

Wan Laymon
Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6135715
Issue Date: October 24,2000
Application No. 09363727
Filed: July 29,1999
Attorney Docket No. 13DV12844

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed November 5,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of November 5,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Approved for use through 04/30/2009. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,135,715 | 2000-10-24 | 09/363,727 | 1999-07-29 | 13DV12844 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ◉ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /mm52020/ | Date (YYYY-MM-DD) | 2008-11-05 |
| Name | Mardson McQuay | Registration Number | 52020 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

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The information provided by you in this form will be subject to the following routine uses:

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

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5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**DATE** : 4/19/2010 **Paper No.:** ____

**TO SPE OF** : ART UNIT 2876

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 9/363728 Patent No.: 7077328 B2

Please respond to this request for a certificate of correction within 7 days.

**FOR IFW FILES:**

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**FOR PAPER FILES:**

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

**Certificates of Correction Branch (CofC)**
**Randolph Square – 9D10-A**
**Palm Location 7580**

Virginia Tolbert
**Certificates of Correction Branch**
571-272-0460

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☒ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** The provisional application has been indicated in Oath/Declaration but was not included in the issued patent.

The Request for Certificate of Correction filed on 04/09/10 has been reviewed and approved.

/Steven S. Paik/ 2887

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JJGJR.: 07-06

Paper No: __

JAMES H MORRIS
WOLF GREENFIELD & SACKS P C
600 ATLANTIC AVENUE
BOSTON MA 02210

**COPY MAILED**

JUL 19 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Pezzani | : | |
| Application No. 09/363,768 | : | DECISION |
| Filing Date: 29 July, 1999 | : | |
| Attorney Docket No.: S11022/8212 | : | |

This is a decision on the petition filed on 24 March, 2004, seeking withdrawal of the holding of abandonment under 37 C.F.R. §1.181.

The petition was received by the attorneys in the Office of Petitions only at this writing.

For the reasons set forth below, the petition considered under 37 C.F.R.§1.181 is **DISMISSED**.

**The record at this writing suggests there has not been a single status inquiry by Petitioner since the instant petition was filed twenty-seven (27) months ago. Such inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.**

NOTES:

(1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

(If Petitioner is unable to present even a satisfactory showing to support a petition under 37 C.F.R. §1.137(a), and Petitioner's only alternative will be to file a petition under 37 C.F.R. §1.137(b).)

(2) Thereafter, there will be no further reconsideration of this matter.[1]

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 5 August, 2003, with reply due absent extension of time on or before Monday, 6 October, 2003;
- the Office mailed a Notice of Abandonment on 9 March, 2004;
- on 24 March, 2004, Petitioner filed the instant petition alleging timely reply, and providing what are averred to be true copies of, *inter alia*, an amendment (with request and fee for extension of time) and date-stamped ("FEB 09 2004 OIPE") receipt card (see: MPEP §503[2]);

---

[1] For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Louden, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R.§§1.181, 182, 183.

[2] MPEP §503 provides in pertinent part:

**§503 Application Number and Filing Receipt**

* * *

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. §1.53(a)).

* * *

**RETURN POSTCARD**

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of

- the instant application went abandoned after midnight 5 February, 2004.

Notably, while Petitioner's date-stamped receipt card refers to submission of an amendment, petition for extension of time, transmittal letter and certificate of mailing, what is absent is any reference to the drawings as required in the 5 August, 2003, Office action, specifically, at item 11 of the Office Action Summary:

> The proposed drawing correction filed on 09 October is: (a) X approved * * * by the Examiner. If approved, corrected drawings are required in reply to this Office action. (Emphasis supplied.)

The record evidences that the drawings in question were not filed by Petitioner until 1 April, 2004–two months after abandonment and one month after Notice thereof.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and those registered to practice *and* all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[3]

---

oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the post-card initialed by the person receiving the items. Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO. (Emphasis supplied.)

[3] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

**§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.**
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[4]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[5]

---

practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[4] 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[5] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.[6] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[7] And the Petitioner must be diligent in attending to the matter.[8] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and of a holding of abandonment.[9]

The commentary at MPEP §711.03(c) provides:

* * *

**B. Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed**

37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), * (e), or (g) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card

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[6] See: *Changes to Patent Practice and Procedure*; *Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[7] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[8] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[9] See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP § 512. As stated in 37 C.F.R §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. 1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP § 512.

* * *

And the regulation requires that relief be sought within two (2) months of the act complained of.

Thus, as of this writing Petitioner appears not to have satisfied and not to be able to satisfy the showing requirement described above.

## CONCLUSION

Because it appears that Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 hereby is **dismissed**.

## ALTERNATIVE VENUE

Petitioner's only alternative to irretrievable abandonment may be petition alleging unintentional delay under 37 C.F.R. §1.137(b).[10]

Petitioner may wish to file such a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay. (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c )

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply (the amendment), the petition fee, and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form available online.)

Further correspondence with respect to this matter should be addressed as follows:[11]

By mail: Commissioner for Patents[12]
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

By hand: Mail Stop: Petition
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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[10] The regulations at 37 C.F.R. §1.183 sets forth that waiver of the rules is "subject to such other requirements as may be imposed."

[11] On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. The old FAX number no longer is in service and (571) 273-8300 will be the only facsimile number recognized for centralized delivery. (For further information. see: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf .)

[12] To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JJGJR.: 07-06

Paper No: __

JAMES H MORRIS
WOLF GREENFIELD
& SACKS PC
600 ATLANTIC AVENUE
BOSTON MA 02210

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Pezzani | : | |
| Application No. 09/363,768 | : | DECISION |
| Filing Date: 29 July, 1999 | : | |
| Attorney Docket No.: S11022/8212 | : | |

This is a decision on the petition filed on 4 August, 2006, seeking revival of the application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

The Office regrets the delay in addressing this matter, however, the petition was presented to the attorneys in the Office of Petitions only at this writing.

For the reasons set forth below, the petition considered under 37 C.F.R.§1.137(b) is **GRANTED**.

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 5 August, 2003, with reply due absent extension of time on or before Monday, 6 October, 2003;
- the Office mailed a Notice of Abandonment on 9 March, 2004;
- on 24 March, 2004, Petitioner filed the original petition requesting withdrawal of the

holding of abandonment under 37 C.F.R.§1.181 alleging timely reply, and providing what are averred to be true copies of, *inter alia*, an amendment (with request and fee for extension of time) and date-stamped ("FEB 09 2004 OIPE") receipt card (see: MPEP §503), all submitted over a 5 February, 2004 certificate of mailing; notably, while Petitioner's date-stamped receipt card refers to submission of an amendment, petition for extension of time, transmittal letter and certificate of mailing, what is absent is any reference to the drawings as required in the 5 August, 2003, Office action, specifically, at item 11 of the Office Action Summary:

> The proposed drawing correction filed on 09 October is: (a) X approved * * * by the Examiner. If approved, corrected drawings are required in reply to this Office action. (Emphasis supplied.)

- the application went abandoned after midnight 5 February, 2004
- the drawings in question were not filed by Petitioner until 1 April, 2004—two months after abandonment and one month after Notice thereof;
- the instant petition (with fee) filed, *inter alia*, with an additional copy of the reply in the form of drawings (and amendment) and Petitioner's statement of unintentional delay (which is read to state that the entire delay from the due date of the reply until the filing of a grantable petition was unintentional and if this is not correct Petitioner must notify the Office immediately) seeks to overcome these deficiencies.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

---

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

See specifically, the regulations at 37 C.F.R. §10.18.

## STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5]

And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.7))

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2 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

3 Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

4 See: *Changes to Patent Practice and Procedure*; *Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

5 See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989)

6 See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

7 Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

As to the Allegations
of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and–where appropriate—a terminal disclaimer and fee.

It appears that Petitioner has satisfied the requirements of the regulation.

CONCLUSION

The instant petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to OIPE for further processing in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[8]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[8] The regulations at 37 C.F.R. §1.2 provide:
**§1.2 Business to be transacted in writing.**
All business with the Patent and 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.

O.I.P.E.
DEC 1 1 2003
PATENT & TRADEMARK OFFICE

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 6

David Volejnicek
Avaya Inc.
307 Middletwon-Lincroft Raod
Room 1N-391
Lincroft, NJ 07738

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OFFICE OF PETITIONS

In re Application of :
Dieter J. H. Knollman :
Application No. 09/363,775 :
Filed: July 29, 1999 :
Attorney Docket No. Knollman 18 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 27, 2003, to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance mailed May 19, 2003, which set a shortened statutory period for reply of three months from the mail date of the Notice. Accordingly, the above-identified application became abandoned on August 20, 2003.

There is no indication that petitioner has submitted an Issue Fee Transmittal Form (PTOL-85b). Accordingly, if petitioner desires to have the information normally found thereon printed on the patent, the attached blank Issue Fee Transmittal Form should be completed and returned to the Publishing Division within ONE MONTH from the mail date of this decision.

The application is being forwarded to Publishing Division.

Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond
Paralegal Specialist
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: PTOL-85(b) Issue Fee Transmittal Form

AVAYA

OIPE JC46
DEC 11 2003
PATENT & TRADEMARK OFFICE

Via First Class Mail

December 4, 2003

RECEIVED
DEC 11 2003
Office of Patent Publication
Director's Office

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Publishing Division
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Re: Knollman 18 Serial No. 09/363,775

Dear Sir:

Enclosed please find a completed Issue Fee Transmittal Form (PTOL-85b) which contains the information we would like to have printed on the patent with reference to the above matter.

Also enclosed is a copy of the Decision of Petition dated November 5, 2003.

Please charge any associated fees to Deposit Account Number 501602.

Thank you.

Very truly yours,

Paul Gardon

Paul Gardon
Corporate Counsel
Reg. No. 48,761
(732) 852-2120
(732) 852-1143 (Fax)

:lkk

I hereby certify that this correspondence is being deposited in the United States Postal Service in an envelope with sufficient postage addressed to: The U.S. Patent and Trademark Office, 2011 South Clark Place, Customer Window, Mail Stop Publishing Division, Crystal Plaza Two, Lobby, Room 1B03, Alexandria, Virginia 22202 on December 4, 2003.

Linda K. Krichman

Linda K. Krichman

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

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Bruce A. Rosenthal
6 Bulaire Road
East Rockaway, NY 11518

In re Application of
ROSENTHAL, Bruce A.
U.S. Application No.: 09/363,988
Int. Filing Date: 22 July 1999
Attorney's Docket No.: None
For: LENTICULAR OPTICAL SYSTEM

DECISION ON PETITION

This decision is in response to applicant's letter submitted on 05 September 2000 to Mr. Charles Pearson of the United States Patent and Trademark Office ("Office").

## BACKGROUND

On 14 December 1999, applicant filed a "Petition to Revive Unavoidably Abandoned Application or in the Alternative, an Unintentionally Abandoned Application" ("Pet. Rev.") requesting to revive PCT/IB96/00224 in order to obtain copendency with U.S. Application Number 09/363,988.

On 12 June 2000, a decision granting applicant's petition to revive under 37 CFR 1.137(b) was mailed, however, applicant's request pursuant to 37 CFR 1.137(a) was dismissed without prejudice.

On 05 September 2000, applicant submitted a letter requesting that the Office review the 12 June 2000 decision. The letter was accompanied by a copy of the petition filed 14 December 1999 and several pages of the decision mailed 12 June 2000.

On 22 September 2000, after discussing the situation with James Thomson of PCT Legal, applicant submitted a "Petition to Withdraw Condition of Abandonment in U.S. Case."

## DISCUSSION

### Decision Mailed 12 June 00

In the letter submitted via facsimile on 05 September 2000, applicant requests that the Office reconsider the decision mailed 12 June 2000 granting applicant's petition to revive the above-captioned application under 37 CFR 1.137(b) filed 14 December 1999 because it appears that the purpose of the aforementioned petition was in fact not granted.

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(It is noted that the petition to revive pursuant to 37 CFR 1.137(a) was dismissed because applicant failed to provide a showing to the satisfaction of the Commissioner that the entire delay was unavoidable within the meaning of 35 U.S.C. 151 and 37 CFR 1.137(a)).

A review of the above-captioned U.S. application reveals that the objective of the aforementioned petition was to revive international application PCT/IB96/00224 so as to be copending with U.S. application 09/363,988. However, the Office erroneously revived U.S. application 09/363,988. (The U.S. application was also abandoned at that time).

Accordingly, the decision mailed 12 June 2000 is hereby **VACATED**. We now consider applicant's 14 December 1999 petition to revive PCT/IB96/00224.

**Petition Under 37 CFR 1.137(a)**

A petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in Section 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer if required.

Applicant argues that the "lateness of 5 days beyond the July 17, 1999 last date of my PCT Application time limit was Unavoidable, due to the following: I was instructed by the Patent Office Assistance line that I could file the application at the United States Post Office, together with a declaration sending it first class mail, and would thereby receive that date of deposit (July 17, 1999), the date I required to meet the time limit for copendency. Because I knew I had the deadline of that day, I phoned the Patent Office twice to make sure I was being given correct information in accordance with their instructions, I used first class mail." Pet. Rev. ¶ 2 (Emphasis included).

This situation is discussed in section 711.03(c), pg. 700-94, (Rev.1 Feb. 2000) of the MPEP which states, in part:

> Delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP, however, does not constitute "unavoidable" delay. *See Haines*, 673 F. Supp. at 317, 5 USPQ2d at 1132; *Vincent v. Mossinghoff*, 230 USPQ 621, 624 (D.D.C. 1985); *Smith v. Diamond*, 209 USPQ 1091 (D.D.C. 1981); *Potter v. Dann*, 201 USPQ 574 (D.D.C. 1978); *Ex parte Murray*, 1891 Dec. Comm'r Pat. 130, 131 (1891). . .
>
> Likewise, as a "reasonably prudent person" would file papers or fees in compliance with 37 CFR 1.8 or 1.10 to ensure their timely filing in the PTO, as well as preserve adequate evidence of such filing, a delay caused by an applicant's failure to file papers or fees in compliance with 37 CFR 1.8 and 1.10 does not constitute

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"unavoidable" delay. *See Krahn*, 15 USPQ2d at 1825. Finally, **a delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice or the MPEP is not rendered "unavoidable" due to: (A) the applicant's reliance upon oral advice from PTO employees**; or (B) the PTO's failure to advise the applicant of any deficiency in sufficient time to permit the applicant to take corrective action. *See In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985). (Emphasis added).

Applicant's lack of knowledge of pertinent rules and regulations or reliance upon oral advice from personnel constitutes an unavoidable delay. Therefore, applicant's petition under 37 CFR 1.137(a) is **DISMISSED** without prejudice.

**Petition Under 37 CFR 1.137(b)**

Nevertheless, applicant's petition under 37 CFR 1.137(b) to revive international application PCT/IB96/00224 abandoned under 35 U.S.C. 371(d) is hereby **GRANTED** as to the present U.S. national application as follows:

International application PCT/IB96/00224 became abandoned as to the United States of America for failure to pay the basic national fee by thirty months from the earliest claimed priority date, *i.e.*, 18 July 2000.

The filing of the instant petition and paying the petition fee of $605.00 is accepted as an appropriate response under 37 CFR 1.137(b). Thus, international application PCT/IB96/00224 is being revived for purposes of continuity only and since continuity has been established by this decision reviving the international application, the international application is again abandoned in favor of the present continuing U.S. Application Number 09/363,988.

**Correction of Filing Date**

A review of Office records for U.S. Application Number 09/363,988 reveals that the correct filing date is 22 July 1998, not the 22 July 1999 listed on the filing receipt.

Accordingly, a new receipt indicating a filing date of **22 July 1998** will be mailed.

**Petition to Withdraw Holding of Abandonment**

Applicant's petition under 37 CFR 1.181 to withdraw the holding of abandonment on U.S. Application No. 09/363,988, filed September 5, 2000, is hereby **GRANTED**.

U.S. Application No. 09/363,988 became abandoned for failure to respond in a timely manner to the Notice to File Missing Parts of Application ("Notice") mailed August 19, 1999. The Notice set a period for response of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this

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application became abandoned on October 20, 1999.

Applicant has provided an adequate showing of non-receipt of the Notice as required by 37 CFR 1.181. Accordingly, the petition is granted and the holding of abandonment is withdrawn.

## CONCLUSION

The above-captioned revived U.S. application with a filing date of 22 July 1998 has copendency with PCT/IB96/00224.

This application will be forwarded to the appropriate Technology Center for further processing.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions

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Paper No. 19

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& ZAFMAN LLP
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90024

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OFFICE OF PETITIONS

In re Application of
Weber et al.
Application No. 09/364,170
Filed: July 29, 1999
Attorney Docket No. 005004.P010

ON PETITION

This decision concerns the March 3, 2004 petition under 37 CFR 1.137(b).

The petition is **GRANTED.**

The application became abandoned on October 9, 2003 for failure to timely respond to the July 8, 2003 non-final Office Action.

The instant petition encloses an amendment; authorizes the USPTO to charge the $665 petition fee (small entity) to Deposit Account No. 02-2666; and states in effect that the entire delay in responding to the July 8, 2003 non-final Office Action from the due date until the filing of a grantable §1.137(b) petition was unintentional. The petition is thus granted.

The application file is being returned to Technology Center 2100 for further examination.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6,176,788 | 2001-01-23 | 09364279 | 1999-07-30 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ○ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ◉ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

◉ The assignee of record of the entire interest

| The Assignee of record of the entire interest | | | |
|---|---|---|---|
| Under 37 CFR 3.71 an assignee becomes of record by filing a statement in compliance with 37 CFR 3.73(b). Signature requirements are set forth in 37 CFR 1.4(d), and the undersigned certifies that he / she is empowered to act on behalf of the assignee of the entire interest | | | |
| Signature | /Richard Allen/ | Date (YYYY-MM-DD) | 2009-02-25 |
| Name | Richard Allen, Chief Operating Officer | | |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 016570 | Frame Number | 0187 |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 019204 | Frame Number | 0830 |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 022288 | Frame Number | 0592 |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 022288 | Frame Number | 0596 |
| Click ADD for additional Reel Number and Frame Number | | Add | |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

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2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

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6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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In re Patent No. 6176788
Issue Date: January 23,2001
Application No. 09364279
Filed: July 30,1999
Attorney Docket No. PCHERR-C

:
:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)
:

This is a decision on the electronic petition, filed February 25,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 7.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 25,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 9/364449

Paper No.: —

DATE : 8/17/05

TO SPE OF : ART UNIT 2188

SUBJECT : Request for Certificate of Correction on Patent No.: 6915385 B1

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Virginia Tolbert

**Thank You For Your Assistance**

**Certificates of Correction Branch**
***Tel. No. 703-308-9390 ext. 113***

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

☒ **Approved** — **All** changes apply.

☐ **Approved in Part** — Specify below which changes **do not** apply.

☐ **Denied** — State the reasons for denial below.

**Comments:**
Certificate of Correction is approved as filed with these additional corrections: in claim 1, lines 11 and 14, and claim 4, lines 12 and 15, replace "#" with "≤" (eight occurrences), to match the claims of 3/7/05 in the file.

Reginald G Bragdon — SPE

2189 — Art Unit

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# CERTIFICATE OF CORRECTION

PATENT NO. : 6,915,385 B1 Page 1 of 7
DATED : July 5, 2005
INVENTOR(S) : Leasure et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On front page of patent, item (75) Inventors, please replace "George Mcneil" with –George McNeil--.

Column 7, line 5 through column 8, line 11 please replace all claims with the following claims:

-- 1 An apparatus for cache read operations comprising:

a cache line having a plurality of storage units wherein each storage unit is operable for storing a data signal from a bus operable for communicating a plurality of data signals, and wherein a first sequence of said plurality of data signals is remapped into a second sequence of data signals in said plurality of storage units wherein said plurality of storage units further comprises a plurality of groups of storage units, and wherein each group of the plurality of groups is operable for reading a data value from a corresponding storage unit in said group,

wherein said plurality of groups comprises a number, N, of groups, wherein each group comprises a number, M, of storage units, and wherein said plurality of data signals comprises a number, K, of signals, such that K = M*N, ≤ ≤

wherein, for 0 ≤ r ≤ N, an rth group has a first storage unit operable for storing a data value received on an rth data line, a second storage unit operable for storing a data value received on an (r + M)th data line, a third storage unit operable for receiving a data value received on an (r + 2M)th data line, and an Mth storage unit operable for storing a data value received on an (r + (M-1)M)th data line, and, for 3 ≤ s ≤ M-2, storage units operable for receiving data values on (r + sM) th data lines.

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# CERTIFICATE OF CORRECTION

PATENT NO. : 6,915,385 B1

DATED : July 5, 2005

INVENTOR(S) : Leasure et al.



It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

2. A data processing system comprising:
a central processing unit (CPU);

a bus operable for communicating a plurality of data signals;

a cache coupled to said bus, operable for reading in response to an address from said CPU, wherein said cache includes a cache line having a plurality of storage units, wherein each storage unit is operable for storing a data signal received on said bus, wherein a first sequence of said plurality of data signals is remapped into a second sequence of data signals in said plurality of storage units wherein said plurality of storage units further comprises a plurality of groups of storage units, and wherein each group is operable for reading a data value from a corresponding storage unit in said group; and

a plurality of logic arrays, each logic array associated with a corresponding group of storage units, wherein each logic array is operable for receiving said address and outputting a signal operable for selecting said data value.

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# CERTIFICATE OF CORRECTION

PATENT NO. : 6,915,385 B1 Page 3 of 7
DATED : July 5, 2005
INVENTOR(S) : Leasure et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

3. The data processing system of claim 2 further comprising a plurality of multiplexers (MUX) wherein each MUX is associated with a corresponding group of storage units, each having a plurality of inputs operable for receiving a data value from a corresponding storage unit in said group, and wherein each MUX is operable for selecting one of said data values in response to said signal operable for selecting said data value.

4. A data processing system comprising:
a central processing unit (CPU);

a bus operable for communicating a plurality of data signals; and

a cache coupled to said bus, operable for reading in response to an address from said CPU, wherein said cache includes a cache line having a plurality of storage units, wherein each storage unit is operable for storing a data signal received on said bus, wherein a first sequence of said plurality of data signals is remapped into a second sequence of data signals in said plurality of storage units wherein said plurality of storage units further comprises a plurality of groups of storage units, and wherein each group is operable for reading a data value from a corresponding storage unit in said group;

wherein said plurality of groups comprises a number, N, of groups, wherein each group comprises a number, M, of storage units, said plurality of data signals comprising a number, K, of signals, such that K = M*N, and wherein, for 0 ≤ r ≤ N, an rth group has a first storage unit operable for storing a data value received on an rth data line, a second storage unit operable for storing a data value received on an (r + M)th data line, a third storage unit operable for receiving a data value received on an (r + 2M)th data line, and an Mth storage unit operable for storing a data value received on an ((r + (M-1)M)th data line, and, for 3 ≤ s ≤ M-2, storage units operable for receiving data values on (r + sM) th data lines.

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# CERTIFICATE OF CORRECTION

PATENT NO. : 6,915,385 B1 Page 4 of 7
DATED : July 5, 2005
INVENTOR(S) : Leasure et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

5. A method of unaligned cache read operations comprising the steps of:
remapping a plurality of data signals for storage into a cache line including a plurality of storage units;

selecting a subset of said plurality of storage units for reading in response to an address therefor;

wherein said step of selecting said subset comprises the step of selecting each storage unit from a corresponding one of a plurality of groups of storage units;

wherein said step of selecting said subset comprises the steps of:

for each group, providing a selection circuit operable for outputting a signal on one of a plurality of inputs, wherein each input is coupled to one of a plurality of storage units in said group; and

outputting said signal in response to said address.

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# CERTIFICATE OF CORRECTION

PATENT NO. : 6,915,385 B1 Page 5 of 7
DATED : July 5, 2005
INVENTOR(S) : Leasure et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

6. The method of claim 5 wherein said selection circuit comprises a multiplexer (MUX) having a plurality of inputs, each input being coupled to one of said plurality of storage units in said group, wherein said MUX is operable for selecting for outputting a signal on one of said inputs.

7.. A method of unaligned cache read operations comprising the steps of:
remapping a plurality of data signals for storage into a cache line including a plurality of storage units;

selecting a subset of said plurality of storage units for reading in response to an address therefor;

wherein said step of selecting said subset comprises the step of selecting each storage unit from a corresponding one of a plurality of groups of storage units;

wherein said step of selecting said subset comprises the steps of:

for each group, providing a selection circuit operable for outputting a control signal for selecting a data value, wherein said control signal is output in response to said address; and

outputting said signal in response to said control signal.

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# CERTIFICATE OF CORRECTION

PATENT NO. : 6,915,385 B1
DATED : July 5, 2005
INVENTOR(S) : Leasure et al.



It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

8. A method of unaligned cache read operations comprising the steps of:
remapping a plurality of data signals for storage into a cache line including a plurality of storage units;
selecting a subset of said plurality of storage units for reading in response to an address therefor; and
sequencing a set of data values output in response to said selecting step;
wherein said step of selecting said subset comprises the step of selecting each storage unit from a corresponding one of a plurality of groups of storage units.

9. The method of claim 8 wherein said sequencing step comprises the step of rotating said set of data values by a preselected number of positions.

10. The method of claim 7 wherein said control signal comprises a plurality of bits, and wherein a first bit is asserted and each remaining bit is negated in response to said address.

11. The method of claim 7 wherein said selection circuit comprises a programmable logic array (PLA).

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# CERTIFICATE OF CORRECTION

PATENT NO. : 6,915,385 B1
DATED : July 5, 2005
INVENTOR(S) : Leasure et al.



It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

12. An apparatus for cache reads comprising a bus, coupled to a cache, for transmitting data, including bytes of data, to storage in the cache, the cache having cache blocks, with the bytes of the cache blocks being distributed among a number of groups, wherein the coupling includes byte ordering on the bus being interleaved with respect to byte ordering in the cache; and circuitry for selectively accessing corresponding ones of the bytes from each ones' respective group of the cache blocks.

13. The apparatus of claim 12 wherein the interleaved coupling comprises each one of the bytes in a word of the bus being coupled to one of the cache line groups that is different than the ones of the cache line groups to which each other one of the bytes in the word is coupled.

14. The apparatus of claim 12 wherein the interleaved coupling comprises the bus lines being physically disposed on the substrate with one byte of the bus interleaved in relative ordering with respect to other bytes of the bus.

15. The apparatus of claim 12 wherein the interleaved coupling comprises logic circuitry, interposed between the bus and the cache line, for interleaving the data from the bus, with respect to the cache, under the control of logic gates.—



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In re Application of
Ying-Wai Ho et al
Application No. 09/364,512
Filed: July 30, 1999
Attorney Docket No. 19427-009700

ON PETITION

This is a decision on the petition, filed December 17, 2002, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on November 25, 2002 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2124 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice must be made in writing and should be accompanied by the new Issue Fee Transmittal Form PTOL-85(b), along with a copy of this decision. Additionally, if the issue fee has increased from the previously paid issue fee, the balance due must be submitted. **Failure to *timely* request *in writing* that the previously paid issue fee be applied towards the new Notice and payment of any balance due will result in the abandonment of the application.**

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ON PETITION

In re Application of
John Kelley et al
Application No. 09/364,514
Filed: July 30, 1999
Attorney Docket No. 7-008910

This is a decision on the petition, filed December 17, 2002, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

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Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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| In re Application of | : | |
| Rudolf Wiedemann | : | |
| Application No. 09/364,565 | : | DECISION ON PETITION |
| Filed: 30 July, 1999 | : | |
| Attorney Docket No. 003588.P003 | : | |

This is a decision on the petition filed on 15 September, 2005, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 13 March, 2005, for failure to timely file a response to the Office action in accordance with *Ex parte Quayle*[2], mailed on 12 January, 2005, which set a two (2) month shortened statutory period for reply. No extensions of the

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[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continuing examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may required additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

[2] 1935 C.D. 11, 453 O.G. 213

time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 11 August, 2005.

Petitioner's reply filed on 15 September, 2005, has been deemed to place this case in condition for allowance.

The application file is being referred to Technology Center Art Unit 2622 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.: X**

**DATE** : **OCTOBER 19, 2006**

**TO SPE OF** : ART UNIT **2644**

**SUBJECT** : Request for Certificate of Correction for Appl. No.: **09364625** Patent No.: **6985598B1**

A response is requested with respect to a request for a certificate of correction.

With respect to the change(s) requested to correct Office and/or Applicant's errors, should the patent read as shown in the certificate of correction attached herewith or the COCIN document(s), in IFW images for the above-identified patented application? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

If the response is for an IFW, within **7** days, please complete and forward the response, to the employee (named below) via scanning into application images, using document code **COCX**.

**DO NOT SENT TO ATTORNEY**

If the response is for a paper file wrapper, please complete the response and forward the response with the paper file wrapper, to the employee (named below), within **7** days, to:

**Certificates of Correction Branch (CofC)**
**South Tower - 9A22**
**Palm Location 7580**

*VIRGINIA TOLBERT*
**Certificates of Correction Branch**
**703-308-9390 ext. 113**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

_____

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**SPE** — **Art Unit** 2615

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Paper No. 72

**HELLER EHRMAN WHITE & MCAULIFFE LLP**
**4350 LA JOLLA VILLAGE DRIVE**
**7TH FLOOR**
**SAN DIEGO CA 92122-1246**

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JUL 01 2003

OFFICE OF PETITIONS

In re Application of
Daniel P. Little et al
Application No. 09/364,774
Filed: July 30, 1999
Attorney Docket No. 24736-2001E

ON PETITION

This is a decision on the petition, filed July 1, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on May 5, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 1743 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

United States Patent and Trademark Office

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 19

Michael V. Messinger
Stern, Kessler, Goldstein & Fox, P.L.L.C.
1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 2005-3934

MAR 3 2003

In re Application of )
Benjamin N. Eldridge et al. )
Application No. 09/364,788 )
Filed: July 30, 1999 )
For: INTERCONNECT ASSEMBLIES AND )
METHODS )

DECISION ON PETITION

This is a decision on the petition, filed February 13, 2003, via facsimile transmission, requesting reconsideration of the holding of abandonment. The petition is being treated as a petition to remail of the final Office action of July 31, 2002 in the above-identified application.

The petition is GRANTED.

A Final Office action was mailed July 31, 2002. The issue fee and corrected formal drawings were due within three (3) months of this mail date.

Petitioner states that he was made aware of the status of the instant application upon receiving a telephone call from the examiner inquiring whether a response to the final Office action has been submitted. Petitioner asserts that the final Office action was not received, that a search of the file jacket and records indicates that it was not received. A copy of the docket record "where the 30th [sic, 31st] Office action would have been entered had it been received."

A review of the application file record indicates a "Revocation and Power of Attorney by Assignee to Exclusion of Inventor Under 3.71 and Change of Correspondence Address" was filed on May 29, 2002. The correspondence address was changed but incorrectly recorded. Consequently, the final Office action was mailed to an incorrect address of record. Although there is no evidence of record that the final Office action was returned undelivered to the Patent and Trademark Office, it is clear from the record that the applicant was not duly served notice that a response to the final Office action was due within the statutory period set therein. The application is not abandoned in fact.

The file record and the showing accompanying the petition are adequate to establish non-receipt

of the final Office action. Accordingly, the petition is granted and the final Office action will be remail.

The application file is being forwarded to the technical support staff for remailing the final Office action. The statutory period set therein to file a response will be reset to run three (3) months from the date the Office action is remailed. Extensions of these periods are governed by 37 C.F.R. § 1.136(a).

Hien H. Phan, Special Program Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components
(703) 308-7502

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Thomas A. Ward
FLIESLER MEYER, LLP
Four Embarcadero Center, 4th Floor
San Francisco, CA 94111-4156

OCT 2 1 2005

In re Application of:
Benjamin N. Eldridge et al.
Serial No.: 09/364,788
Filed: July 30, 1999
For: VARIABLE WIDTH RESILIENT CONDUCTIVE CONTACT STRUCTURES

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on the "REQUEST FOR WITHDRAWAL OF HOLDING OF ABANDONMENT DUE TO LOST OR MISSING OFFICE ACTION INDICATED TO HAVE BEEN MAILED BY USPTO" filed on August 30, 2004. It is being treated as a petition to withdraw the holding of abandonment under 37 C.F.R. § 1.181. There is no fee for this petition.

The petition is **GRANTED**.

This application became abandoned for failure to timely file a proper reply to the Office action mailed on September 12, 2003. A Notice of Abandonment was mailed on April 22, 2004.

Petitioner asserts that the Office action was never received by the applicant. As evidence of nonreceipt at the correspondence address at the time the Office action was mailed, petitioner provides: (1) an e-mail from someone at Stern, Kessler, Goldstein & Fox, P.L.L.C. to someone at FormFactor, Inc. (the assignee); (2) a record from Stern, Kessler, Goldstein & Fox, P.L.L.C. of the actions for the above-identified application; and (3) a statement of nonreceipt signed by the petitioner. This evidence is insufficient under MPEP 711.03(c) to establish nonreceipt of the Office action.

MPEP 711.03(c) requires a statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. This statement must be from a practitioner who can properly make such a statement (in this case, a practitioner from Stern, Kessler, Goldstein & Fox, P.L.L.C.) and must be directed to the Patent and Trademark Office so that it qualifies as a certification under 37 C.F.R. § 10.18(b). Thus, neither the statement titled "DECLARATION ATTESTING TO LOST PAPER" signed by petitioner (who is not a practitioner from Stern, Kessler, Goldstein & Fox, P.L.L.C.) nor the provided e-mail (which was not directed to the Patent and Trademark Office) would qualify as the required statement under MPEP 711.03(c).

Nevertheless, the petition is granted since the Office action was mailed to an incorrect address. The "REVOCATION AND POWER OF ATTORNEY BY ASSIGNEE TO EXCLUSION OF INVENTOR UNDER 3.71 AND CHANGE OF CORRESPONDENCE ADDRESS" filed on May 29, 2002 requested that the correspondence address be changed to "1100 New York Avenue . . . ". The correspondence address was incorrectly changed to "110 New York Avenue . . .".

Therefore, the Notice of Abandonment mailed April 22, 2004 is **VACATED** and the holding of abandonment is withdrawn.

The Office action originally mailed on September 12, 2003 will be remailed to Thomas A. Ward at the correspondence address noted above as requested in the Change of Address filed with the petition. Mr. Ward was given power of attorney in the "REVOCATION AND POWER OF ATTORNEY BY ASSIGNEE TO EXCLUSION OF INVENTOR UNDER 3.71 AND CHANGE OF CORRESPONDENCE ADDRESS" filed, via facsimile transmission, on October 5, 2005. (The paper filed on October 5, 2005 is a copy of a paper that included a Certificate of Mailing dated November 21, 2003 but was never matched with the application file.) The period for response to the Office action will be reset to three months from the date of remailing.

Any inquiries regarding this decision should be directed to Edward Westin at (571) 272-1638.

Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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FORMFACTOR, INC.
LEGAL DEPARTMENT
7005 SOUTHFRONT ROAD
LIVERMORE, CA 94551

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|---|---|---|
| In re Application of | : | |
| N. Benjamin Eldridge et al. | : | |
| Application No. 09/364,788 | : | DECISION ON PETITION |
| Filed: July 20, 1999 | : | |
| Attorney Docket No. P84-US | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 4, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to submit formal drawings in a timely manner in reply to the Notice of Allowability, mailed October 10, 2007, which set a period for reply of three (3) months. Accordingly, this application became abandoned on January 11, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the corrected formal drawings, (2) the petition fee of $1540.00; and (3) a proper statement of unintentional delay.

Accordingly, the instant petition was signed by an attorney of record. However, the address on the petition differs from the address of record. There is no indication that a power of attorney or a change of address has been filed in this application. Therefore, if petitioner desires to receive future correspondence to the address listed on the petition regarding this application, the appropriate power of attorney or change of address must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584.

This application is being referred to Office of Data Management for processing into a patent.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: N. Kenneth Burraston
P.O. Box 45120
Salt Lake City, UT 84145-0120

UNITED STATES PATENT AND TRADEMARK OFFICE

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Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041

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NOV 0 2 2004

**Technology Center 2100**

In re Application of:
Chi DARREN
Application No. 09/364,821
Filed: July 30, 1999
For: GENERIC DETECTION AND ELIMINATION OF MACRO VIRUSES

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed June 3, 2003.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

For Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

cc: Edward J. Radlo
Sonnenschein Nath & Rosenthal LLP
685 Market Street
6th Floor
San Francisco, CA 94105

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Paper No.

EUGENE C. RZUCIDLO, ESQ.
GREENBERG TRAURIG, LLP
885 THIRD AVENUE
21ST FLOOR
NEW YORK, NY 10022

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JUL 2 6 2004

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application<br>Maingault et al.<br>Application No. 09/364,908<br>Filed: July 27, 1999<br>Atty Docket No. 43869.016200 | DECISION ON PETITION |

This is a decision on the Petition under 37 CFR 1.137(b), filed June 21, 2004.

The petition is **GRANTED**.

The above-identified application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 1.17(c)) within the time period provided in 37 CFR 1.192(a). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed August 13, 2003, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.192(b), 1.197(c). As no claim was allowed, the above-identified application became abandoned on October 14, 2003. See MPEP 1215.04. A Notice of Abandonment was mailed on May 21, 2004.

The petition includes the required reply in the form of an appeal brief (and fee required by 37 CFR 1.17(c)), the required statement of unintentional delay and the petition fee.

Technology Center 1651 has been advised of this decision reviving the application. The appeal brief will be considered by the examiner in due course.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0309.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/364,967 | 07/31/1999 | KEVIN J. KELLY | P-8035 | 1149 |

23322 7590 02/24/2005

IPLM GROUP, P.A.
POST OFFICE BOX 18455
MINNEAPOLIS, MN 55418

| EXAMINER |
|---|
| TSAI, CAROL S W |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2857 | |

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 20050104

Applicant : Kelly et al.
Application No.: 09/364,967
Filed: July 31, 1999

**DECISION GRANTING PETITION UNDER** *37 CFR 1.59*

This decision is in response to the petition filed April 29, 2003 in the above-identified application. Petitioner requests that proprietary material be expunged, in accordance with 37 C.F.R. 1.59(b).

Petitioner requests that a document marked "PROPRIETARY MATERIAL NOT OPEN TO PUBLIC. TO BE OPENED ONLY BY EXAMINER OR OTHER AUTHORIZED U.S. PATENT AND TRADEMARK OFFICE EMPLOYEE" (the "Information"), filed June 28, 2004, be expunged from the record. Petitioner states that the information contains proprietary material which has not been made public. The petition fee set forth in 37 CFR 1.17(h) has been paid.

The information in question has been determined by the undersigned to not be material to the examination of the instant application.

Applicant is required to retain the expunged materials for the life of any patent which issues on the above-identified application.

The expunged material is returned herewith.

Howard Goldberg
Director, Technology Center 2800

Enclosure: Thera software manual pages 4-6, 4-7, and 4-10; Meta DDDR Model 1254 Physician's Manual; Medtronic, Inc. Itrel ™ 3 Battery, product description; Medtronic, Inc. InSync III ™ Battery, product description

IPLM GROUP, P.A.
POST OFFICE BOX 18455
MINNEAPOLIS, MN 55418

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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29 JAN 2002

Paper No. 13

| | | |
|---|---|---|
| In re Application of<br>T. Slattery et al.<br>Serial No. 09/365,243<br>Filed: July 30, 1999<br>For: METHODS AND APPARATUS FOR COMPUTER BASED TRAINING RELATING TO DEVICES | : | DECISION ON PETITION REGARDING WITHDRAWAL OF ATTORNEY |

Counsel has filed a petition on January 18, 2002, seeking to withdraw from prosecution in this application. The petition is DENIED.

As noted at MPEP 402.06, the usual requirement is that there be at least thirty days between approval of a request to withdraw as attorney and the date of expiration of a running time period. While this requirement is now construed as permitting withdrawal when an extension to a running time period is available so as to achieve the thirty days between approval of a request to withdraw and the expiration date, it is noted that this application had an Office Action mailed on August 6, 2001, with a response being due on or before November 6, 2001, although the response period could have been extended until February 6, 2002.

Accordingly, since there are not thirty days remaining between approval of the withdrawal and the expiration date of the running time period, the withdrawal cannot be permitted.

WITHDRAW DENIED.

E. Rollins-Cross, Director
Technology Center 3700

Finnegan, Henderson, Farabow, Garrett & Dunner
1300 I Street, N.W.
Washington, DC 20005

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RICHARD ARON OSMAN
SCIENCE AND TECHNOLOGY LAW GROUP
242 AVE VISTA DEL OCEANO
SAN CLEMEMTE CA 92672

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**OFFICE OF PETITIONS**

| | |
|---|---|
| In re Application of | : |
| Terry et al. | : |
| U.S. Patent No.: 6,974,896 | : Decision on Petition for |
| Issue Date: December 13, 2005 | : Patent Term Extension |
| Application No. 09/365,348 | : |
| Filing Date: July 30, 1999 | : |
| Attorney Docket No.: B99-084 | : |
| For: TRACE ELEMENT PHYTOREMEDIATION | : |

The above-identified application has been forwarded to the undersigned for consideration on a petition for patent term extension entitled "Petition Under 37 CFR 1.181," received on November 28, 2005. The petition is being treated under 37 CFR 1.181 and 37 CFR 1.701, as a petition for patent term extension.

The petition is GRANTED.

Petitioner argues that the patent should get a patent term adjustment because the application was subject to an appeal and the Board vacated all the rejection on July 31, 2003, and the application was subsequently allowed.

35 U.S.C. § 154(b) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000, and, as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113, for those delays and others in applications filed on or after May 29, 2000

A Notice of Appeal was filed in the above-identified application on July 31, 2000. On July 31, 2003, the Board of Appeals and Interferences vacated the rejections and remanded the application to the examiner in the above-identified application. Since the above-identified application was filed after June 7, 1995, there is no terminal disclaimer due to the issue of another patent claiming subject matter that is not patentably distinct from that under appellate review, and issuance of the application as a patent was delayed due to appellate review resulting in a remand by a panel of the BPAI to the

Examiner, the patent to issue from the application is entitled to an extension of the patent term.[2] The period of delay in the above-identified application is the period beginning on July 31, 2000, the date that the Notice of Appeal was filed and ending on July 31, 2003, the date of the remand by a panel of the BPAI, which is a final decision in favor of the applicant. Three years after the earliest effective filing date of the application is July 30, 2002. Accordingly, the period of extension is required to be reduced pursuant to 37 CFR 1.701(d)(1) by the amount of time prior to three years after the filing date of the application. As a result, the first period of extension is **367-days**, the period from July 30, 2002 to July 31, 2003, including the beginning and end dates.

The Office will issue a certificate of correction in order to rectify the error regarding the patent term extension information. See 35 U.S.C. 254 and 37 CFR 1.322. The certificate of correction will indicate that the patent term extension or adjustment under 35 U.S.C. 154(b) is **367-days**.

After mailing of this decision, the application will be forwarded to Certificates of Correction Branch for issuance of a Certificate of Correction.

Petitioner's deposit account has not been charged a petition fee.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

[2] Revision of Patent Term Extension and Patent Term Adjustment Provisions, 78 FR 21704, 21705 (April 22, 2004), 1282 Off. Gaz. Pat. Office Notices 100 (May 18, 2004) (final rule).

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

# UNITED STATES PATENT AND TRADEMARK OFFICE

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## BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Ex parte NORMAN TERRY, ELIZABETH PILON-SMITS, and YONG LIANG ZHU

MAILED
JUL 31 2003
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

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Appeal No. 2002-0252
Application No. 09/365,349

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ON BRIEF

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Before WILLIAM F. SMITH, ADAMS, and GREEN, Administrative Patent Judges.

GREEN, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-24. In the Examiner's Answer, the examiner stated that claims 4, 9-12, 16-18, 21, 23 and 24 were inadvertently included in the rejection of October 24, 2000, thus claims 1-3, 5-8, 13-15, 19-20 and 22 are the subject of this appeal. It is thus our understanding that it is examiner's position that claims 4, 9-12, 16-18, 21, 23 and 24 are free of any rejection. Moreover, in deciding this appeal, we have also considered the record in related Appeal No. 2002-0254, Application No. 09/365,348.

Claims 1, 3 and 8 are representative of the subject matter on appeal, and read as follows:

1. A plant which is genetically engineered to overexpress glutamylcysteine synthetase and thereby provides enhanced heavy metal accumulation as compared with a corresponding wild type plant.

3. A plant according to claim 1 which is a member of the brassicaceae family.

8. A plant according to claim 1, wherein the enhanced accumulation is at least 50% greater than an otherwise comparable untransformed plant.

The examiner relies upon the following references:

De Knecht et al. (De Knecht) "Evidence against a role for Phytochelatins in Naturally Selected Increased Cadmium Tolerance in Siliene Vulgaris (Moench) Garcke," New Phytol., Vol. 122, pp. 681-688 pp. 685-687 (1992)

Delhaize et al. (Delhaize) "Poly (gamma-glytamylcysteinyl)glycine Synthesis in Datura Innoxia and Binding with Cadmim: Role in Cadmium Tolerance," Plant Physiology, Vol. 89, pp. 700-706 (1989)

Noctor et al. (Noctor) "Glutathione: Biosynthesis, Metabolism and Relationship to Stress Tolerance Explored in Transformed Plants," Journal of Experimental Botany, Vol. 49, No. 321, pp. 623-647 (1998)

Goldsbrough "Metal Tolerance in Plants: The Role of Phytochelatins and Metallothioneins," Ann Arbor Press, pp. 221-228 (1999)

Chen et al. (Chen) "Increased Activity of Gamma-Glutamylcysteine Synthetase in Tomato Cells Selected for Cadmim Tolerance," Plant Physiology, Vol. 106 pp. 233-239 (1994)

Arisi et al. (Arisi) "Modification of Thiol Contents in Poplars (Populus tremula X P. alba) Overexpressing Enzymes Involved in Glutahione Synthesis," Planta, Vol. 203 pp. 362-372 (1997)

Claims 1-3, 5-8, 13-15, 19-20 and 22 stand rejected under 35 U.S.C. § 112, first paragraph, on the grounds that the specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. After careful review of the record and consideration of the issues before us, we affirm the rejection as to claims 1, 2, 5-8, 13-15, 19-20 and 22, but reverse the rejection as to claim 3.

## BACKGROUND

The invention relates to phytoremediation, wherein plants are used to remove heavy metals by sequestering, stabilizing or biochemically transforming them. One such plant that is useful in phytoremediation is a hyperaccumulator: A hyperaccumalator is a plant that accumulates heavy metals from metal-containing sites. See Specification, page 1.

According to the specification:

> Non-protein thiols (NPTs), which contain a high percentage of cysteine sulfhydryl residues in plants, play a pivotal role in heavy metal detoxification. Glutathione (γ-Glu-Cys-Gly, GSH) is one of the most important components of NPT metabolism. . . . Glutathione is synthesized from its constituent amino acids in two sequential, ATP-dependent enzymatic reactions, catalyzed by γ-glutamyl-cysteine synthetase (ECS) and glutathione synthetase (GS), respectively.

Id. at 1-2 (citations omitted).

The invention relates to

> methods and compositions for heavy metal phytoremediation. The subject compositions include plants which are genetically engineered to overexpress glutamylysteine synthetase and thereby provide enhanced heavy metal accumulation. In particular embodiments, the plants comprise a gene encoding ECS operably linked to a heterologous promoter, the plant is a member of the Brassicaceae family, such as Brassica juncea, and/or the heavy metal is cadmium.

Id. at 3.

According to the specification, "[s]uitable plants are readily screened for requisite engineeribility and expression," and the specification presents a laundry list of plants. See id. at 4-6. In an exemplary embodiment, Brassica juncea plants were transformed with an ECS construct that was described in the prior art by Arisi. The construct contains the E. coli gshI gene, fused to a pea chloroplast transit sequence and driven by a double-enhanced 35S CaMV promoter. See id. at 8.

## DISCUSSION

Claims 1-3, 5-8, 13-15, 19, 20 and 22 stand rejected under 35 U.S.C. § 112, first paragraph, on the grounds that the specification fails to enable the full scope of the claimed subject matter. We affirm the scope of enablement rejection as to claims 1, 2, 5-8, 13-15, 19, 20 and 22, but reverse as to claim 3.

As an initial matter, we acknowledge appellant's letter received June 2, 2003 in related Appeal No. 2002-0253, Application No. 09/365, 349. In that letter, appellants state that an identical continuing application to the 09/365,349

application was filed, which application was issued on June 10, 2003 as U.S. Patent No. 6,576,816. Issued claim 1 reads as:

> 1. A Brassica plant which is genetically engineered to overexpress glutamylcysteine synthetase and thereby provides enhanced heavy metal accumulation as compared with a corresponding wild type plant.

The above issued claim is very similar to claim 1 that is the subject of these appeal, except that it is limited to a Brassica plant. Given the allowed claim, we reverse the rejection as to instant claim 3, as claim 3 specifies that the genetically engineered plant is a member of the brassicacae family. Moreover, in view of the examiner's allowance of the above claim in the continuation application of the instant application, we limit our review of the scope of enablement rejection to how it pertains to plant species other than Brassica.

We also note appellants statement that claims 5, 7 and 14, claim 6, and claim 19 do not stand or fall with claim 1. See Supplemental Brief on Appeal, pages 3-4. But because we are limiting our analysis as noted above, and because those claims are not limited to Brassica plants, we also affirm the scope of enablement rejection with respect to those claims.

According to the rejection,

> the specification, while being enabling for transformed Brassica juncea overexpressing a glutamylcysteine synthetase (ECS) for an improved tolerance to selected heavy metals, does not reasonably provide enablement for any transformed plant capable of enhancing accumulation of a wide variety of heavy metals by overexpressing an ECS, and a method for decreasing heavy metal content of a medium by growing said plant. The specification does not enable any person skilled in the art to which it pertains, or with

> which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims.

Examiner's Answer, page 6.

The rejection asserts that "the specification provides guidance only for the transformation of Brassica juncea with the ECS gene from E. coli driven by double-enhanced 35S CaMV promoter, and wherein the analysis of heavy metal tolerance involves only hydroponic or agar medium with Cd concentrations of 0.15-0.25 mM of CdSO4." Id. While the rejection acknowledges that a table in the specification states that the ECS gene was introduced into other plant species, it states that "it is unclear how these results were obtained, especially the '+++' for every transgenic species and '+/-' for every corresponding wild-type plant." The rejection further notes that no data was presented to support the results presented by the table, and that it is unclear how the "+++" corresponds to the "at least 50%" enhanced heavy metal accumulation as compared to wild-type. Id. at 7.

The examiner relies upon Noctor, as well as Goldsbrough, De Knecht, Chen and Dehaize to demonstrate that it would require an undue amount of experimentation by one skilled in the art to practice the full scope of the claimed invention. With respect to Noctor specifically, the examiner notes that the reference teaches that overexpession of an ECS enzyme in poplars did not increase Cd tolerance in transgenic poplars grown in Cd contaminated soil. Id. at 7-8.

"[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as in compliance with the enabling requirement of the first paragraph of § 112 unless there is reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support." In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971) (emphasis in original). "[It] is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement." Id. at 224, 169 USPQ at 370. The examiner, however, has provided objective evidence, in the form of Arisi and Noctor, that the specification fails to enable the full scope of the claims, and thus it would require an undue amount of experimentation by one skilled in the art to practice the claimed invention with plants other than Brassica plants.

As noted by the examiner, appellants provide a table on pages 7 to 8 of the specification setting forth exemplary plant species demonstrating enhanced heavy metal accumulation in wild-type plants and the corresponding plant overexpressing recombinant glutamylcysteine synthetase. Each wild-type plant received a "+/-", and each recombinant plant received a "+++". No data is

presented in the specification in support of the table, nor does the specification define what amounts correspond the "+/-" and "+++" designations.

The specification provides a single example of transformation of Brassica juncea (Indian mustard seeds), along with the supporting data. See Specification, pages 8-12. According to the specification,

> The ECS gene construct used was described earlier by Arisi et al. (1997). It contains the E. coli gshI gene, fused to pea chloroplast transit sequence and driven by the double-enhanced 35S CaMV promoter.

Id. at 8.

Arisi, which is the same reference cited in the above passage from the specification, teaches transformation of a hybrid poplar with the E. coli gene for glutamylcysteine synthase gene, resulting in a poplar that overexpresses the ECS gene. See, e.g., Arisi, page 369. As also noted above, the construct taught by Arisi is the same construct used to generate the hyper-accumulating Brassica plants exemplified by the specification. As taught by Noctor, however, the hybrid poplar plants of Arisi are not hyper-accumulators. According to Noctor,

> Poplar overexpressing [ECS] presents an excellent model system in which to investigate the roles of this enzyme . . . in phytochelatin-mediated resistance to heavy metals. In preliminary experiments, transformants overexpressing [ECS] in the cytosol . . . were exposed for 14 d to different Cd. Concentrations (0-1000$\mu$g $g^{-1}$ soil). In transformed and untransformed poplars, Cd accumulated to a similar extent.

Noctor, page 640, col. 1.

Moreover, with respect to the hybrid poplars of Arisi that overexpress the ECS enzyme, appellants have stated on the record, citing Noctor, that the genetically engineered poplars produced by Arisi do not demonstrate increased heavy metal accumulation when compared to wild-type. See Appeal Brief, page 3. Appellants specifically noted that:

> The prior art establishes an uncertain and unpredictable relationship between ECS expression and heavy metal accumulation, and specifically teaches (in both Noctor [ ] and Goldsbrough) that over expression of ECS will not yield heavy metal accumulators.

Id. at 4-5.

Because, as recognized by appellants, the prior art establishes an uncertain and unpredictable relationship between overexpression of glutamylcysteine synthetase, and because, as discussed above, the specification provides only a single example of a hyperaccumulating plant, it would require an undue amount of experimentation by one skilled in the art to practice the invention using plants other that Brassica plants without further guidance from the inventors of why overexpression of glutamylcysteine synthetase produced hyperaccumulating Brassica plants, but failed to produce hyperaccumulating poplar plants.

Appellants argue that "[t]he claims do not encompass 'any plant' as repeatedly alleged by the Examiner, but rather only a plant structurally limited to a plant genetically engineered to overexpress glutamylcysteine synthetase and functionally limited to one which does in fact overexpress the recited

glutamylcysteine synthetase and thereby provides enhanced accumulation of the targeted heavy metal as compared with a corresponding wild type plant." Supplemental Brief on Appeal, page 4 (emphasis in original). Appellants contend that suitable plants are readily screened for "requisite engineerability," and the specification offers a large number of suitable, commercially available plant source materials. Appellants also asserts that "exemplified plants include Brassica juncea, Populus angustifolia, Nicotiana tabacum and Silene cucubalis. The suitability of any given plant is readily ascertained by simple substitution into the same method." Id. Page 5.

In order to meet the enablement requirement of 35 U.S.C. § 112, first paragraph, the specification need to teach the skilled artisan to make and use the claimed invention. Although appellant asserts that exemplified plants include Brassica juncea, Populus angustifolia, Nicotiana tabacum and Silene cucubalis, as discussed above, the Populus angustifolia, Nicotiana tabacum and Silene cucubalis plants are only presented in a table with heavy metal accumulation represented by the "+/-" and "+++" designations. As also noted above, there is no data presented in the specification to support the results presented by the table. The only example provided by the specification that is supported by a description of the methodology used, as well as supporting data, is the transformation of a Brassica juncea with glutamylcysteine synthetase to provide a plant that demonstrates heavy metal accumulation.

The Noctor reference, however, teaches that a hybrid poplar plant, transformed with the same glutamylcysteine synthetase construct as used in the example, did not result in a plant that provides enhanced heavy metal accumulation as compared with a corresponding wild type plant. Thus, the specification provides an example of a Brassica hyperaccumulator, while the prior art teaches that a poplar transformed with the same construct did not result in a hyperaccumulator. In view of the Noctor reference, and the fact that the specification provides only a single example of a hyperaccumulating plant, wherein the example is supported by a description of the methodology used and the supporting data, it would require an undue amount of experimentation by one skilled in the art to practice the invention using plants other that Brassica plants.

With respect to Noctor, appellants argue that Noctor did not have the benefit of the instant specification, which teaches how to make hyper-accumulating plants, including poplars. Appellants argue further that:

> We do not know how Noctor [ ] did their experiments, so it is not possible for us to determine why they failed: we do not know in what form they provided the Cd, we do not know whether their poplars were subject to other variables that would have interfered with accumulation, we do not know how they made their transformants, we do not know whether their preliminary experiments were based on one or two anomalous plants, we do not know if their soil had other toxins or confounding microorganisms that may have independently depleted the supplemented Cd, etc. It is possible that the results of Noctor [ ] are based on experimental error or contaminated materials. On the other hand, it is possible that they result merely from an insufficient sample size – had they generated sufficient data, they may well have obtained hyper-accumulators. Unless she has secret information about Noctor['s] [ ] work, the Examiner's proposed "only

> reasonable explanation" [ ][1] for Appellants success does not reflect even a basic understanding of the scientific methodology.

Reply Brief on Appeal, page 2.

As noted by the examiner, the specification provided no data to support the results in the table. The specification also did not provide information on how the hyperaccumulating plants, including the poplars, were produced, under what conditions they tested, in what form the Cd was provided, nor the sample size tested. Thus, we are unable to determine from appellants specification why the poplars were presented in the table as hyperaccumulators, and how they differed from the poplars produced by Arisi.

Appellants argue further that the prior art, such as Noctor, demonstrates that simple upregulation of a gene, such as ECS, in response to cultivation of the plant in the presence of a heavy metal, does not suggest that the plant will demonstrate enhanced accumulation. According to appellants:

> The prior art establishes an uncertain and unpredictable relationship between gultamylcysteine synthetase and heavy metal exposure, and specifically teaches (in Noctor [ ] . . .) that overexpression of enzymes upregulated upon heavy metal exposure, including glutamylcysteine synthetase, will not yield heavy metal accumumulators.
>
> This unpredictability relates to extrapolating from gene upregulation to metal accumulation and has no bearing on substituting one plant for another in the claimed methods, wherein enhanced accumulation is demonstrated—in fact, it is

---

[1] "The only reasonable explanation for Appellants' apparent success in a single Brassica species, namely Brassica juncea, is that the genetic background of the plant species to be transformed has a strong influence on the ability of the introduced transgene to cause heavy metal overaccumulation or tolerance." Examiner's Answer, page 11.

> demonstrated in a variety of diverse exemplary plants. The specification aptly enables one of ordinary skill in the art to practice the method in any plant which is genetically engineered to overexpress glutamylcycteine synthetase and thereby provide enhanced accumulation of the heavy metal.

Supplemental Brief on Appeal, pages 8-9.

That argument is not found to be convincing for the reasons already discussed supra. Noctor does not relate to any enzyme that is upregulated upon exposure to heavy metal, but teaches that a poplar plant, which was transformed with the same construct used in the instant specification and demonstrated by Arisi to overexpress glutamylcysteine synthetase, does not result in a plant that provides enhanced heavy metal accumulation as compared with a corresponding wild type plant. Thus, Noctor does have bearing on substituting one plant for another.

Finally, appellants argue that the experimentation required to substitute one plant for another compares favorably with the experimentation that was not found to be undue by the Court of Appeals for the Federal Circuit in In re Wands, 858 F.2d 731, 8 USPQ2d 1400 (Fed. Cir. 1988). Specifically, appellants argue that practicing the methods of the instant invention "is minor compared with the permitted experimentation under Wands," and that the vast majority of Wands efforts to produce the claimed antibodies fail. Supplemental Brief on Appeal, page 9. Finally, appellants contend, it is not the function of the claims to exclude possible inoperative embodiments. See id.

We agree with appellants that "[e]nablement is not precluded by the necessity for some experimentation such as routine screening." Wands, 858 F.2d at 736-37, 8 USPQ2d at 1404. But, "[t]he determination of what constitutes undue experimentation in a given case requires the application of a standard of reasonableness, having due regard for the nature of the invention and the state of the art." Id. at 737, 738. In this case, the art demonstrates that a hybrid poplar plant transformed with the same construct used by appellants, wherein the poplar plant was shown to overexpress glutamylcysteine synthetase, failed to hyperaccumulate heavy metals when compared to a corresponding wild type plant. The specification, however, provides only a single example that is supported by a description of the methodology used, as well as supporting data, of a Brassica plant that demonstrates heavy metal accumulation. Thus it would require an undue amount of experimentation to produce hyperaccumulating plants other than Brassica plants without further guidance from applicants as to why the construct produced a hyperaccumulating Brassica plant but failed to produce a hyperaccumulating poplar.

We also agree with appellants that a claim may encompass inoperative embodiments and still meet the enablement requirement of 35 U.S.C. § 112, first paragraph. See Atlas Powder Co. v. E.I. Du Pont De Nemours & Co., 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984), In re Angstadt, 537 F.2d 498, 504, 190 USPQ 214, 218 (CCPA 1976), In re Cook, 439 F.2d 730, 732, 169 USPQ 298, 300 (CCPA 1971). But as noted by the court in In re Cook, 439 F.2d

730, 169 USPQ 298 (CCPA 1971), the skilled artisan must be able to determine, without an undue amount of experimentation, those embodiments that would be inoperable. Id. at 735, 169 USPQ at 302 ("[I]t seems to be conceded that a person skilled in the relevant art could determine which conceived but not-yet-fabricated embodiments would be inoperative with expenditure of no more effort than is normally required of a lens designer checking out a proposed set of parameters."); see also Angstadt, 537 F.2d at 504, 190 USPQ at 219 ("Without undue experimentation . . . the combinations which do not work will readily be discovered and, of course, nobody will use them and the claims do not cover them."). But, as has already been discussed above, we are unable to determine from appellants specification how the poplars presented in Table 2 differ from the poplars produced by Arisi. It would therefore require an undue amount of experimentation to determine other plants that would provide enhanced heavy metal accumulation as compared with a corresponding wild type plant without further guidance from appellants.

## CONCLUSION

For the reasons set forth above, the enablment rejection made under 35 U.S.C. § 112, first paragraph, is reversed as to claim 3, but affirmed as to claims 1, 2, 5-8, 13-15, 19-20 and 22.

AFFIRMED-IN-PART; REVERSED-IN-PART

| | |
|---|---|
| William F. Smith<br>Administrative Patent Judge | ) |
| Donald E. Adams<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS AND |
| Lora M. Green<br>Administrative Patent Judge | ) INTERFERENCES |

LG/dym

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Paper No. 10

MAY 30 2001

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| | | |
|---|---|---|
| In re Application of | : | |
| Tongbi Jiang | : | DECISION ACCEPTING |
| Application No. 09/365,356 | : | PAPERS PURSUANT TO |
| Filed: July 30, 1999 | : | 37 C.F.R. § 1.8(b) |
| Attorney Docket No. 500182.01 | : | |

This is a response to the communication filed April 26, 2001, via facsimile transmission , and supplemented May 9, 2001, which is treated as a request to accept papers as being timely filed pursuant to 37 C.F.R. § 1.8(b) for the above-identified-application.

The request is GRANTED.

A non-final Office action was mailed October 4, 2000, setting a three-month shortened statutory period for filing a response. In the apparent absence of a response, a telephone call was made by the examiner of record to inquire whether a response has been submitted. Requester/applicant asserted that a response was timely filed.

In support of the assertion that a response was timely filed, petitioner submitted the following papers as evidence of timely submission: 1) a copy of a response entitled "AMENDMENT" which bears a Certificate of Mailing under 37 C.F.R. § 1.8(a) dated January 4, 2001, 2) a copy of a self-addressed postcard for use as receipt, and 3) a statement in support of the petition under 37 C.F.R. § 1.8(b) signed by Cheryl Ammerlahn. The Certificate of Mailing dated January 4, 2001, would have made the response timely if received in the Patent and Trademark Office.

The file record does not include the originally submitted papers.

The request satisfies the conditions for accepting a response filed using a certificate of transmission under 37 C.F.R. § 1.8(a) but not received by the USPTO. Accordingly, the request is granted.

The copy of the response submitted on April 26, 2001 with the request is accepted since the USPTO apparently did not receive the response originally submitted.

The application filed is being forwarded to the technical support staff for entry of the amendment. From there, the file will be returned to the examiner for further examination.

Hien H. Phan, Special Program Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Paper No. 35

**DORSEY & WHITNEY**
**INTELLECTUAL PROPERTY DEPARTMENT**
**SUITE 3400**
**1420 FIFTH AVENUE**
**SEATTLE WA 98101**

**COPY MAILED**

**SEP 3 0 2003**

**OFFICE OF PETITIONS**

ON PETITION

In re Application of
Tongbi Jiang
Application No. 09/365,356
Filed: July 30, 1999
Attorney Docket No. 660073.774

This is a decision on the petition, filed September 30, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

**Petitioner is advised that the issue fee paid on September 8, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.**[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8859.

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2813 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : June 19, 2006

TO SPE OF : ART UNIT 1734 (S.P.E. Christopher Fiorilla)

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/365,510 Patent No.: 6986824

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

Stan Powell

Certificates of Correction Branch

703-308-9390 ext. 120

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — **Specify below** which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

SPE

1734

Art Unit

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO Box 1450 Alexandria VA 22313-1450
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NOV 26 2003

KAREN L. ELBING, PH.D
CLARK & ELBING, LLP
101 FEDERAL STREET
BOSTON, MA 02110

| | |
|---|---|
| In re Application of | : |
| MOORE et al | : |
| Serial No.: 09/365,576 | : Decision on Petition |
| Filing Date: 2 August 1999 | : |
| Attorney Docket No. 1944 | : |

This letter is in response to the Petition to withdraw finality, filed with a certificate of mailing date of 23 October 2003.

**BACKGROUND**

The petition concerns the finality of the rejection of claims under 35 USC 102(e).

A review of the file history shows that the claims were first rejected under 35 USC 102(e) as being anticipated by Liao et al (U.S. Patent No. 5,639,616) on 28 June 2001. Applicants responded with arguments and a Declaration by Dr. Moore on 28 December 2001. The rejection was maintained and made final on 23 April 2002, without acknowledgement of or consideration of the first Dr. Moore declaration. Applicants then filed a Notice of Appeal on 29 October 2002 concurrent with the filing of arguments and a second Declaration of Dr. Moore, which presents additional documentation of the sequencing of the RIP15 prior to the filing date of Liao. On 24 March 2003, applicants filed their Appeal Brief and again argued that Liao cannot be considered prior art because the instant invention was reduced to practice prior to Liao's earliest filing date.

On 30 June 2003, the Examiner prepared an Advisory Action, stating that the request for reconsideration has been considered but does not place the application in condition for allowance, as follows.

> In regard to the 102(e) rejection as being anticipated by Liao et al, the Declaration of Dr. Moore filed 28 December 2001 does not overcome the rejection because applicant did not provide a showing under 37 CFR 1.608(b). See MPEP 2308.02.

An Examiner's Answer has not yet been prepared.

**DISCUSSION**

The application, file history and petition have been considered carefully.

The petition argues that the Office's requirement for a showing under 37 CFR 1.608(b) was first raised in its advisory action mailed 30 June 2003. To properly raise this issue, the petition goes on, the finality of the rejection must be withdrawn in order to apply the new ground of rejection concerning the showing under 37 CFR 1.608(b).

MPEP 706.02(b) provides applicants with five ways to overcome a rejection under 35 USC 102(e): (1) persuasive argument, (2) amendment of the claims to distinguish over prior art (3) filing a declaration or affidavit under 37 CFR 1.132 showing the reference invention is not by another (4) filing an affidavit or declaration under 37 CFR 1.131 showing prior invention or (5) perfecting a claim to priority.

Applicants chose the fourth option and, in support of this position, filed two declarations by Dr. Moore, the first in response to the first action on the merits and the second in response to the Final action. The first declaration filed on 28 December 2001 stated that the RIP15 clone was isolated and sequenced prior to filing of Liao, and supported this assertion with laboratory notebook excerpts. The final Office action does not address this declaration. The second declaration was filed on 23 October 2003 and contains additional sequence information. The Advisory action mailed 30 June 2003 refers to the first declaration but does not mention the second declaration.

Because the statements issued in the advisory action concerning 1.608 (b) showing arose from and related to applicants' response to the first action on the merits, these statements should have been made in the second Office action. As such, the second action was incomplete and its' finality premature.

**DECISION**

The petition is **GRANTED** for the reasons set forth above. Finality of the Office action mailed 23 April 2002 has been withdrawn. The application will be forwarded to the

examiner for consideration of the amendment filed 29 October 2002 as a proper reply to a non-Final Office action.

The application will be forwarded to Examiner for action consistent with this decision.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria VA, 22313-1450 or by telephone at (703) 308-7553 or by facsimile transmission at (703) 308-7230.

Jasemine C. Chambers

Jasemine Chambers
TC1600 Group Director

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DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JUL -8 2002

Paper No. 5

In re Application of
Günter Wolf *et al*
Application No. 09/365,613
Filed: August 2, 1999
For: Grip For A Portable Hand-Guided Working Tool And Molding Same

DECISION ON PETITION

This is a decision on the petition filed on May 1, 2002 by which petitioners request withdrawal of the holding that this application stands abandoned for failure to file a reply to the Office letter dated January 18, 2001.

The petition is granted.

Petitioners allege that the Office letter in question and the subsequent Notice of Abandonment were not received. A review of the application file shows that these letters were not properly addressed to the correspondence address of record. Therefore, it is clear that this application was not abandoned.

This application is being forwarded to the Head Supervisory Applications Examiner to correct the correspondence address of record in the PALM system. Specifically, the address of record is in New Mexico, not Mexico as currently in PALM. A copy of the January 18, 2001 Office letter will thereafter be mailed to petitioners. However, prior to mailing that Office letter, a telephone call will be made to petitioners to ascertain whether the address at 11896 N. Highway 14 is still currently the correct correspondence address, because it is noted that the return address on the instant petition is different. In the event that it is ascertained that petitioners have changed their correspondence address, the Head Supervisory Applications Examiner should require that petitioners immediately file, via facsimile transmission, a change of correspondence address. Appropriate changes in the PALM system should be made prior to remailing the Office letter in question.

As a courtesy, a copy of this decision is being mailed to two different addresses. No further correspondence will be mailed to two addresses.

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Robert W. Becker & Associates
11896 N. Highway 14,
Suite B
Tijeras, New Mexico 87059

cc: Robert W. Becker & Associates
707 Highway 66 East, Suite B
Tijeras, NM 87059

# UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 6697879
Issue Date: February 24,2004
Application No. 09365830
Filed: August 3,1999
Attorney Docket No. 112966.102

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed June 1,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 1,2009 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6697879 | 2004-02-24 | 09365830 | 1999-08-03 | |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

○ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

◉ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| A Joint Patentee and I certify that I am authorized to sign this submission on behalf of all the other patentees | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature. | | | |
| Signature | /J. Bryan Blundell/ | Date (YYYY-MM-DD) | 2009-06-01 |
| Name | J. Bryan Blundell | | |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these records.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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TRASK BRITT
P O BOX 2550
SALT LAKE CITY, UT 84110

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OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of<br>Warren M. Farnworth et al<br>Application No. 09/365,943<br>Filed: February 12, 2003<br>Attorney Docket No. 2269-3926.2US<br>(99-0039.02/US) | DECISION GRANTING PETITION<br>UNDER 37 CFR 1.313(c)(2) |

This is a decision on the petition, filed March 16, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on March 1, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 1732 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] *The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form* ***must*** *be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).*

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 19

STEPHEN C. MACEVICZ
LYNX THERAPEUTICS INC
25861 INDUSTRIAL BOULEVARD
HAYWARD, CA 94545

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MAR - 6 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Sydney Brenner :
Application No. 09/366,081 :
Filed: August 2, 1999 :
Attorney Docket No. 802-04RE (55525-8029.US07) :

This is a decision on the petition under 37 CFR 1.137(b), filed January 8, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed April 9, 2001, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 10, 2001.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application file is being forwarded to Technology Center 1600.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DIW Jul-06

PERKINS COIE LLP
P.O. BOX 2168
MENLO PARK CA 94026

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Sydney Brenner | : | DECISION ON PETITION TO |
| Application No. 09/366,081 | : | WITHDRAW HOLDING OF |
| Filed: 2 August, 1999 | : | ABANDONMENT |
| Atty Docket No. 802-04RE | : | |
| (55525-8029.US07) | : | |

This is a decision on the petition filed on 18 May, 2006, to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the non-final Office action mailed on 3 November, 2005, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. The filing of the present petition precedes the mailing of Notice of Abandonment.

Petitioners assert that the Office action mailed on 3 November, 2005, was never received.

In the absence of any irregularity in the mailing of the non-final Office action, there is a strong presumption that the non-final Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the non-final Office action was not in fact received. The showing required to establish the failure to receive an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received

Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the final Office action may have been lost after receipt rather than a conclusion that the final Office action was lost in the mail.

A review of the record indicates that the Office action was properly mailed to the petitioners at the correspondence address of record at the time of mailing. Thus, there was no irregularity in mailing the Office action on the part of the United States Patent and Trademark Office.

In support of the petition, the petitioners have submitted a statement by the practitioner that a search of the file jacket and docket records indicates that the Office action was not received. A copy of petitioner's docket records and mail log is included with the petition and referenced therein.

The petitioner has made a sufficient showing of nonreceipt of the Office action. Accordingly, the holding of abandonment is withdrawn.

The petition is **GRANTED.**

The application file is being referred to Technology Center 1600 technical support staff for remailing of the Office action mailed 3 November, 2005. The period for reply will be reset from the mailing date thereof.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

Paper No. 4

MAIL

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

MICHAEL B MCNEIL
511 S MADISON STREET
PO BOX 2417
BLOOMINGTON IN 47402

In re Application of:
Stuart, et al.
Application No. 09/366,114
Filed: August 2, 1999
For: SYSTEM AND METHOD FOR PROVIDING A SERVICE TO A CUSTOMER VIA A COMMUNICATION LINK

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition to make special filed on July 22, 2002 under MPEP 708.02 (IV), applicant's age.

A petition to make special under MPEP 708.02, IV, must show that petitioner is 65 years of age, or more. Acceptable evidence includes a birth certificate, copy of a driver's license, or simply a statement by the applicant. No fee is required.

The petition includes a statement by applicant. Accordingly, the petition is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant.

The application will be forwarded to the examiner for action on the merits.

Reinhard J. Eisenzopf
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4711

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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DILWORTH & BARRESE, LLP
333 EARLE OVINGTON BLVD.
UNIONDALE NY 11553

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APR 19 2006

OFFICE OF PETITIONS
ON PETITION

In re Application of :
Seok-Jin Ham :
Application No. 09/366,299 :
Filed: August 2, 1999 :
Attorney Docket No. 678-318(P882 :

This is a decision on the petition filed on February 13, 2006 under 37 CFR 1.181 to withdraw the holding of abandonment.

The petition under 37 CFR 1.181 is **GRANTED**.

The application was held abandoned on August 10, 2004, for failure to timely file a proper reply to the non-Final Office Action mailed May 7, 2004. Accordingly, a Notice of Abandonment was mailed on April 20, 2005.

Petitioner asserts that a proper response was timely filed with a certificate of mailing on August 6, 2004 and has submitted a copy of the response and certificate of mail dated August 6, 2004, asserted to have been timely filed.

A search of the application file and the USPTO records does not reveal receipt of the response but, the petition complies with the requirements set forth in 37 CFR 1.8(b).

Accordingly, the Notice of Abandonment mailed on April 20, 2005, is hereby withdrawn. No petition fee is due and none has been charged.

This matter is being referred to Technology Center 2684 for appropriate action on the response originally filed August 6, 2004 and resubmitted February 13, 2006 with the instant petition.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6536189 | 2003-03-25 | 09/366,446 | 1999-08-03 | 13737.00002 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Barry E. Negrin/ | Date (YYYY-MM-DD) | 2007-10-15 |
| Name | Barry E. Negrin | Registration Number | 37407 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6536189
Issue Date: March 25,2003
Application No. 09366446
Filed: August 3,1999
Attorney Docket No. THERM2/924

:

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

:

This is a decision on the electronic petition, filed October 15,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 15,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

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AGERE SYSTEMS INC.
DOCKET ADMINISTRATOR
FOUR CONNELL DRIVE
BERKELEY HEIGHTS, NJ 07922

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APR 24 2006

**OFFICE OF PETITIONS**

In re Application of :
Fischer et al. :
Application No. 09/366,614 :
Filed: August 3, 1999 :
Title of Invention: POWER UP RESET :
CIRCUIT FOR LINE POWERED CIRCUIT :

This is a decision in response to the petition under 37 CFR 1.137(b), filed March 13, 2006, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowability, mailed May 6, 2005. The Notice set a non-extendable three (3) month period for reply. No reply having been received, the application became abandoned August 7, 2005. A Notice of Abandonment was mailed on February 21, 2006.

With the instant petition, Applicant has submitted formal drawings.

The address on the petition is different from the address of record. If Petitioner desires to receive further correspondence with respect to this application, a change of correspondence address must be filed. A courtesy copy of this Decision is being forwarded to Petitioner at the address appearing on the petition; however, all future correspondence will be sent to address of record until instructions to the contrary are received.

This application is being forwarded to Publishing Division for processing into a patent.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

Cc: SYNNESTVEDT & LECHNER LLP
SUITE 2600 ARAMARK TOWER
1101 MARKET STREET
PHILADELPHIA, PA 19107

UNITED STATES PATENT AND TRADEMARK OFFICE

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

DALE F. REGELMAN
LAW OFFICE OF DALE R. REGELMAN, PC
4231 S. FREMONT AVENUE
TUCSON AZ 85714

In re Application of
Jonathan Wade Ain, et al.
Application No. 09/366,768
Filed: August 4, 1999
For: **FIBRE CHANNEL ADDRESS BLOCKING**

:DECISION ON PETITION

This is a decision on the petition filed September 8, 2003, based on M.P.E.P. 711.03(c)(II), and pursuant to 37 C.F.R. § 1.181(a), to withdraw the holding of abandonment. No fee is required.

This application became abandoned for failure to timely file a proper reply to the non-final Office action mailed September 12, 2002. A Notice of Abandonment was mailed on July 29, 2003.

Petitioner alleges that the non-final Office action mailed September 12, 2002 was not received.

Based on M.P.E.P. § 711.03(c) *[See also Notice entitled Withdrawing the Holding of Abandonment When Office Actions Are Not received, 1156 O.G. 53 (November 16, 1993)]*, in absence of any irregularity in the mailing of an Office Action, there is a strong presumption that the Office action was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Office action was not in fact received. The showing required to establish the failure to receive an Office communication must include:

(a) a statement from the practitioner stating that the Office communication was not received by the practitioner;

(b) a statement attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received; and,

(c) a copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

A review of the records indicate that the Office action was properly mailed to the practitioner of record at the correspondence address at the time of mailing. Thus, there was no irregularity in mailing the Office action on the part of the U.S. Patent and Trademark Office.

The allegation of non-receipt is supported by a statement from Ms. Jean Barkley, an in-house IBM patent attorney (9000 South Rita Road correspondence address), attesting that the Office Action was not received at the IBM Corporation (9000 South Rita Road correspondence address), and that a search of the contents of the files and docket records reveal no evidence of receipt. Although the statement from Ms. Barkley does not specifically mention the South Rita Road address, a review of the US PTO PALM Intranet Attorney Registration and Customer Information screen finds that practitioner Barkley is associated with the IBM, South Rita Road correspondence address. It is also noted that the statement from Ms. Barkley does not specifically state that she searched the "file jacket"; however, her statement, "We have checked our files and our records with respect to Serial No.l 09/366,768" is being interpreted to include a search of the file jacket. Copies of the docket records have also been included to corroborate petitioner's claim.

The showing offered is therefore deemed to comply with the requirements of a successful petition to withdraw the holding of abandonment due to non-receipt of an Office action. Therefore, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Accordingly, the petition is **GRANTED.**

Due to the time lapse between the original mailing and the date of this decision, the application file is being forwarded to the examiner for updating the search and other action as appropriate. From there, the file will be forwarded to the Technology Center's technical support staff for mailing a new Office Action. The period for response will be set to run from the date of the new mailing.

Jin Ng, Director
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 4

Evelyn M. Sommer, Esq
Skadden, Arps, Slate, Meagher & Flom LLP
919 Third Avenue
New York, New York 10022

DEC 22 2000

| | | |
|---|---|---|
| In re Application of: William Orentell et al. | ) | |
| Application No. 09/366,858 | ) | |
| Filed: August 4, 1999 | ) | **DECISION ON REQUEST FOR** |
| For: METHOD AND SYSTEM FOR | ) | **WITHDRAWAL AS ATTORNEY** |
| COMPUTER SCREEN LAYOUT | ) | |
| BASED ON A RECOMBINANT | ) | |
| GEOMETRIC MODULAR | ) | |
| STRUCTURE | ) | |

This is a decision on the Request To Withdraw from Representation filed November 30, 2000.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1. 136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

There is no statement that Mr. Strobert is ***authorized*** to sign on behalf of the other listed attorneys. Therefore, the request for withdrawal is **DENIED**. However, because Mr. Strobert is of record, the change of address is **ACCEPTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant.

Pinchus M. Laufer

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce
(703) 306-4160

cc: Evelyn M. Sommer, Esq
Patterson, Belknap, Webb & Tyler
1133 Avenue of the Americas
New York, New York 100369

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6378384
Issue Date: April 30,2002
Application No. 09366875
Filed: August 4,1999
Attorney Docket No. F99.17

:

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

:

This is a decision on the electronic petition, filed November 23,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of November 23,2007. This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6378384 | 2002-04-30 | 09366875 | 1999-08-04 | F99.17 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☒ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | Small Entity | |
|---|---|---|---|
| Fee | Code | Fee | Code |
| ○ 3 ½ year | (1551) | ◉ 3 ½ year | (2551) |
| ○ 7 ½ year | (1552) | ○ 7 ½ year | (2552) |
| ○ 11 ½ year | (1553) | ○ 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Kendal M. Sheets/ | Date (YYYY-MM-DD) | 2007-11-23 |
| Name | Kendal M. Sheets | Registration Number | 47077 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

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MONSANTO COMPANY / ABBOTT LABORATORIES
C/O MCCUTCEN, DOYLE, BROWN & ENERSEN LLP
THREE EBARCADERO
SUITE 1800
SAN FRANCISCO CA 94111-4067

| | |
|---|---|
| In re Application of | : |
| Knutzon et al. | : |
| Serial No.: 09/367,013 | : PETITION DECISION |
| Filed: August 5, 1999 | : |
| Attorney Docket No.: CGAB-210-USA | : |

This is in response to the petition under 37 CFR 1.181, filed February 6, 2004, requesting relief from the withdrawal of claims 189-214 and 285-290 from consideration. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 on August 5, 1999, and contained claims 1-64. A preliminary amendment was filed on August 5, 1999 canceling claims 1-64 and adding new claims 65- 188. In a first Office action, mailed May 8, 2001, the examiner set forth a restriction requirement under 35 U.S.C. 121 and 372, as follows, and further requiring a species election:

> Group I, claim(s) 65-66, 93, 94, 99, 100 and 187, drawn to methods for making oleic acids, linolenic acid, y-linolenic acid, steariodonic acid, and alpha-linolenic acid.
> Group II, claim(s) 67, 69-72, 91, 100, 102-105, 126, 131-134, 153, 156, 158-161, 180, 185, 186, and 188, drawn to microbial oil and pharmaceutical compositions.
> Group III, claim(s) 97 and 98, drawn to methods for making y-linolenic acid from linolenic acid.
> Group IV, claim(s) 73-75, 106-108, 135-137, and 162-164, drawn to nutritional compositions.
> Group V, claim(s) 76-78, 110, 111, 138-140, and 165-167, drawn to infant formula.
> Group VI, claim(s) 79-86, 112-119, 142-148, and 168-175, drawn to a dietary supplement and substitute.
> Group VII, claim(s), 68, 87-88, 101, 121-123, 130, 149, 157, 176, and 177, drawn to a method of treatment.

Group VIII, claim(s) 89, 90, 124, 125, 151, 152, 178, and 179, drawn to a cosmetic composition.
Group IX, claim(s) 92, 127, 154, and 181, drawn to an animal feed.
Group X, claims(s) 95 and 96, drawn to the polypeptides of SEQ ID NO's: 34-40.
Group XI, claim 182, drawn to nucleic acid sequences of SEQ ID NO's: 19, 21, 23, and 25.
Group XII, claim 183, drawn to the polypeptides of SEQ IS NO's: 20, 22, 24, and 26.

On July 31, 2001, Applicant filed a response and elected Group I without traverse and stearidonic acid as the species. On October 12, 2001, the examiner mailed a non-final Office action to applicants rejecting claims 65, 66, 93, 94, 99, 100, and 187; and withdrawing claims 67-92, 95-98, 101-186 and 188 from consideration. The reply to this Office action was filed by applicants on April 12, 2002, adding claims 189-284, and canceling claims 65-160 and 187.

On June 28, 2002, the examiner mailed a final rejection to applicants, in which the examiner rejected claims 215-284, and withdrew claims 189-214 from consideration. The examiner stated in his Office action that new claims 189-214 and 215-284 are drawn to two independent methods which do not relate to a single inventive concept under PCT Rule 13.1. The methods of claims 189-214 are drawn to a method of making a transformed host cell using the nucleic acid sequence of SEQ ID NO: 1. Thus, the special technical feature for the invention of claims 189-214 is the nucleic acid of SEQ ID NO:1. In contrast, the method of claims 215-284 are drawn to a method of making oil, presumably, enriched in stearidonic acid. The special technical feature for the method of claims 215-284 are the transformed host cells produced by the method of claims 189-214. Thus, the inventions of claims 189-214 and 215-284 do not share a common inventive concept under PCT Rule 13.1.

Applicants filed the reply to this Office action, including RCE papers, on October 28, 2002, with a traversal statement concerning the withdrawal. Applicants also cancelled claims 197, 198, 209 and 245-254, and added claims 285-296; claims 285-290, 293 and 296 being product claims.

On December 31, 2002, the examiner issued a non-final Office action rejecting claims 215-244, 255-284, 292, and 295; and withdrawing claims 189-196, 199-208, 210-214, 285-291, 293, 294, and 296 from consideration.

In the response filed by applicants on June 30, 2003, reconsideration of the withdrawal was made and claim 297 was added.

On October 6, 2003, a final Office action was mailed to applicants rejecting claims 225-244, 265-284 and 297; allowing claims 215-224 and 255-264; and withdrawing claims 189-214, 285-290 from consideration. It is pointed out that claims 197, 198 and 209 were actually cancelled in the previous response of June 30, 2003.

## DISCUSSION

This application was filed under 35 U.S.C 371 and as such the requirement for Unity of Invention is as follows: An international or a national stage application is considered to have unity of invention where there exists a "special technical feature" that defines a contribution which each of the claimed inventions, considered as a whole, makes over the prior art. See PCT Rule 13.2:

PCT 13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

*See Annex B, Part 2 of the PCT Administration Instructions*

MPEP 1850 states *Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims and (i) If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims; (ii) If however, an independent claim does not avoid the prior art, then the question whether there is still an inventive link between all the claims dependent on the claim need to be carefully considered. If there is no link remaining an objection of lack of unity a posteriori (that is, arising only after assessment of the prior art) may be raised. See ANNEX B: Unity of Invention Part 1 "Instructions Concerning Unity of Invention" MPEP AI-6 (Rev. 1. Feb. 2003).*

37 CFR 1.475(b)-(d) provides guidance for treatment of second and subsequent products and methods.

*(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:*

*(1) A product and a process specially adapted for the manufacture of said product; or*

*(2) A product and process of use of said product; or*

*(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or*

*(4) A process and an apparatus or means specifically designed for carrying out the said process; or*

*(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.*

*(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention*

*might not be present.*
*(d) If multiple products, processes of manufacture or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).*

Applicants argue that claims 189-196, 199-208, and 210-214, and 285-290 are within the elected invention under PCT rules. The Office action of June 28, 2002 stated that claims 189-214 and 215-284 were drawn to two independent methods which do not relate to a single inventive concept under PCT Rule 13.1. The Office action of December 31, 2002 stated that claims 185-214, 291, and 294 were not within Group I elected by applicants. Applicants argue that the single inventive concept to which all the claims relate is a product that is a microbial cell culture with an altered fatty acid profile by virtue of expression of a sufficient amount of a delta 6-desaturase, and that claims 189-214 relate to a method for production of this product, claims 215-284 relate to a method of use of this product to produce an oil with an altered fatty acid profile, and claims 285-290 relate to the microbial culture itself. Applicants point out that these claims were not restricted from each other in the original restriction requirement, and the subsequent withdrawal of claims 189-196, 199-208, 210-214, and 285-290 was timely traversed. Applicants state that they have presented claims for a method of making a given product, claims for a method for use of that product, and claims to the product itself. Applicants argue that since the MPEP states that these sets of claims share unity of invention under PCT rules, applicant should get relief from the withdrawal of claims 189-214 and 285-290 from consideration.

The examiner correctly states in his Office action of June 28, 2002, that new claims 189-214 and 215-284 are drawn to two independent methods which do not relate to a single inventive concept under PCT Rule 13.1. Therefore, no unity of invention existed between these two groups. The special technical feature between these two groups would be the product. However, there was no product present at the time of election which precluded there being a special technical feature which unites the different groups. Applicant later added product claims after the election and examination. As the product was added after examination, they were withdrawn from consideration. These product claims, withdrawn by original presentation, have not been searched and therefore, cannot constitute a special technical feature. Applicants cannot add a special technical feature after the election.

<u>DECISION</u>

The petition is **DENIED**.

**Applicants remain under obligation to file a proper reply to the Notice of Appeal of February 9, 2004, within the time period set therein or as may be extended under 37 CFR 1.136(a).**

Should there be any questions about this decision please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

Bruce M. Kisliuk
Director, Technology Center 1600

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OFFICE OF PETITIONS

Fitch Even Tabin and Flannery
120 South La Salle Street
Suite 1600
Chicago, IL 60603-3406

In re Application of :

Deborah Knutzon et al. :
Application No. 09/367,013 : DECISION ON PETITION
Filed: August 5, 1999 : TO WITHDRAW
Attorney Docket No. 86014/8145 : FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed August 18, 2006.

The request is **APPROVED**.

A grantable request to withdraw as attorney/agent of record must be signed by every attorney/agent seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a).

The request was signed by Scott J. Menghini on behalf of all attorneys of record who are associated with Customer No. 22242.

All attorneys/agents associated with the Customer No. 22242 have been withdrawn.

Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed July 18, 2006 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Terri Williams at 571-272-2991.

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Deborah Knutzon**
6110 Rockhurst Way
Granite Bay, CA 95746

cc: **Biotechnology Law Group**
527 N. Highway 101
Suite E
Solana Beach, CA 92075

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
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| APPLICATION NUMBER | FILING OR 371 (c) DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO./TITLE |
|---|---|---|---|
| 09/367,013 | 08/05/1999 | DEBORAH KNUTZON | 86014/8145 |

**CONFIRMATION NO. 3773**

*OC000000021168542*

*OC000000021168542*

22242
FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

Date Mailed: 11/09/2006

## NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 08/18/2006.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

---

Terri Williams

TERRI S WILLIAMS
OP (571) 272-2991

FORMER ATTORNEY/AGENT COPY

UNITED STATES PATENT and TRADEMARK OFFICE
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

td

AUG 30 2004

Mailed:

| | | |
|---|---|---|
| In re application of | : | |
| Michael P. Daniels | : | DECISION ON |
| Serial No. 09/367,455 | : | PETITION |
| Filed: March 19, 1999 | : | |
| For: WET SURFACE ADHESIVES | | |

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed April 19, 2004.

The instant petition was filed on May 27, 2004. In the petition, it is urged that the final office action mailed April 19, 2004 was improperly made final.

**DECISION**

It is noted that the examiner prepared a new non-final office action which was mailed on June 14, 2004. The previous final office action was withdrawn thereby making the instant petition moot. Accordingly the petition is **DISMISSED.**

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL MN 55133-3427

29 AUG 2000

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Patent Group
Foley, Hoag & Eliot LLP
One Post Office Square
Boston, MA 02109-2170

| | |
|---|---|
| In re Application of | : |
| MITTERER et al. | : DECISION ON |
| Application No.: 09/367,459 | : |
| PCT No.: PCT/AT98/00043 | : PETITION |
| Int. Filing Date: 27 February 1998 | : |
| Priority Date: 27 February 1997 | : UNDER 37 CFR 1.10(e) |
| Attorney's Docket No.: BHV-305.01 | : |
| For: A METHOD . . . CHROMATOGRAPHY | : |

This decision is in response to applicants' "Petition for Filing Date under §1.10(e)" filed 12 November 1999.

## BACKGROUND

On 27 February 1998, applicants filed international application PCT/AT98/00043, which claimed priority of an earlier application filed 27 February 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 03 September 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 19 September 1998, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 27 August 1999.

On 13 August 1999, applicants filed a transmittal letter (including an authorization to charge any additional fees which may be required to Deposit Account No. 06-1448) for entry into the national stage in the United States, which was accompanied by, *inter alia*,: the requisite basic national fee; a translation of the international application; a preliminary amendment; an unexecuted declaration; and copies of various papers related to international application PCT/AT98/00043. These papers were assigned US application number 09/367,459 and were date-stamped 13 August 1999.

On 12 November 1999, applicants filed a petition under 37 CFR 1.10(e) requesting that applicants be granted the filing date of 13 August 1999 for the national stage entry from the above-identified international application. The petition was accompanied by copies of the papers

filed 13 August 1999. These papers were assigned US application number 09/423,781. Also, the basic national fee, *inter alia*, was charged to Deposit Account No. 06-1448 based on the authorization in the copy of the transmittal letter.

On 05 April 2000, the United States Designated/Elected Office mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) for application number 09/367,459 indicating that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) and the surcharge for filing the oath or declaration later than thirty months from the priority date were required.

On 08 May 2000, applicants filed a RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 accompanied by, *inter alia*, a declaration of inventors and the requisite surcharge.

## DISCUSSION

As is evident from the above recited facts, the United States Patent and Trademark Office incorrectly treated the submission filed 12 November 1999 as a request for entry into the national stage in the United States. Accordingly, the papers filed on 12 November 1999 have been placed in application number 08/367,459. Also, the fees which were charged to deposit account number 06-1448 based on the authorization in the copy of the transmittal letter filed 12 November 1999 will be refunded to that same deposit account number.

Applicant should use application number **09/367,459** in all future communications with the Patent and Trademark Office in regards to the U.S. national stage of international application PCT/AT98/00043.

The declaration filed 08 May 2000 complies with 37 CFR 1.497(a)-(b). Accordingly, the requirements under 35 USC 371(c) were satisfied as of that date. It is noted that the declaration lists the third named inventor as Oyvind L. Schonberger while the published international application lists the third named inventor as Oyving L. Schonberger. Upon review of a copy of the original Request, however, it appears that the published application contains a typographical error and that the spelling on the declaration is correct. If the spelling on the declaration is not correct, applicants should *immediately* notify the PCT Legal Office.

## CONCLUSION

For the reasons set forth above, the petition under 37 CFR 1.10(e) is **DISMISSED** as moot.

The papers filed on 12 November 1999 have been placed in application number 08/367,459.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application including according the application 35 U.S.C. 102(e) and 371(c) dates of **08 May 2000**.

Daniel Stemmer
Legal Examiner
PCT Legal Office
Telephone: (703) 308-2066
Facsimile: (703) 308-6459

Leonard Smith
Legal Examiner
PCT Legal Office

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 4-27-07

TO SPE OF : ART UNIT 1652

SUBJECT : Request for Certificate of Correction on Patent No.: 6831159

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Valerie Jackson

**Thank You For Your Assistance**

**Certificates of Correction Branch**
***Tel. No. 703-308-9390 ext. 114***

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☒ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments:

SPE

1652
Art Unit

PTO/SB/44 (04-04)

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION

OK to enter

PATENT NO : 6,831,159 B1

DATED : Dec. 14, 2004

INVENTOR(S) : Arthur MITTERER et al.

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

On the cover page, at (54), in the title, kindly delete "METHOD FOR PURIFYING FACTOR VIII/VWF COMPANY BY CATION-EXCHANGE CHROMATOGRAPHY" and insert therefor --A METHOD OF PURIFYING FACTOR VIII/VWF-COMPLEX BY MEANS OF CATION EXCHANGE CHROMATOGRAPHY--

MAILING ADDRESS OF SENDER: Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94116

PATENT NO. 6,831,159

No. of additional copies:

60501815 v1

JUL 18 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAIL

SEP 22 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

THOMSON LICENSING INC.
PATENT OPERATIONS
PO BOX 5312
PRINCETON NJ 08543-5312

In re Application of :
Christophe LORIN :
Application No. 09/367,623 : DECISION ON PETITION
Filed: November 23, 1999 :
For: **METHOD FOR AUTOMATICALLY ADAPTING LEVELS OF SIGNALS EXCHANGED IN A COMMUNICATION NETWORK** :

This is a decision on the Petition filed July 14, 2005, which is being treated under 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment. No fee is required.

The application was held abandoned for failure to respond in a timely manner to the final Office action mailed on February 9, 2004. The application became abandoned when no further response was received. A Notice of Abandonment was mailed January 26, 2005.

Petitioner alleges to have timely filed a proper response to the final Office action on July 28, 2004. In support, petitioner has provided a copy of a response to the final Office action and a copy of a post card receipt showing a receipt date of July 30, 2004. A copy of a request for three month extension is also included with the petition.

A review of the application record reveals that the after-final response submitted on July 28, 2004 was in fact received in the Office on July 30, 2004. The after-final response has been deemed to be timely filed.

MPEP § 714.13 [R-1] Amendments After Final Rejection or Action, Procedure Followed, states in part:

> FINAL REJECTION — TIME FOR REPLY
> If an applicant initially replies within 2 months from the date of mailing of any final rejection setting a 3-month shortened statutory period for reply and the Office does not mail an advisory action until after the end of the 3-month shortened statutory period, the period for reply for purposes of determining the amount of any extension fee will be the date on which the Office mails the advisory action advising applicant of the status of the application, <u>but in no event can the period extend beyond 6 months from the date of the final rejection</u>...
>
> ENTRY NOT A MATTER OF RIGHT
> It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate

previously canceled claims. Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(c) is expected in all amendments after final rejection. Failure to properly reply under 37 CFR 1.113 to the final rejection results in abandonment. A reply under 37 CFR 1.113 is limited to:

(A) an amendment complying with 37 CFR 1.116;
(B) a Notice of Appeal (and appeal fee); or
(C) a request for continued examination (RCE) filed under 37 CFR 1.114 with a submission (i.e., an amendment that meets the reply requirement of 37 CFR 1.111) and the fee set forth in 37 CFR 1.17(e). RCE practice under 37 CFR 1.114 does not apply to utility or plant patent applications filed before June 8, 1995 and design applications.

If no appeal has been filed within the period for reply and no amendment has been submitted to make the application allowable or which can be entered in part (see MPEP § 714.20), the application stands abandoned. [emphasis added]

While the response filed July 30, 2004 to the Final rejection has been deemed to be timely filed, petitioner should note that a proper response to a Final Office action must consist of either an amendment which places the case in condition for allowance, a Notice of Appeal, or the filing of a continuation application. See requirement stated above and also 37 CFR §1.113 and §1.116. The application was forwarded to the examiner to determine if the response filed July 30, 2004 places the application in condition for allowance. The examiner determined that the after final response fails to place the application in condition for allowance as set forth in an Advisory Action, a copy of which is enclosed with this decision.

Accordingly, the petition to withdraw holding of abandonment is **DENIED**.

Applicant may wish to consider a petition under 37 C.F.R. §1.137 if they wish to revive the application.

Kenneth Wieder
Special Program Examiner
Technology Center 2600
Communications

Enclosure: Advisory Action

| Advisory Action Before the Filing of an Appeal Brief | Application No. 09/367,623 | Applicant(s) LORIN, CHRISTOPHE | |
|---|---|---|---|
| | Examiner Jefferey F. Harold | Art Unit 2646 | |

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

THE REPLY FILED 30 July 2004 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 3 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 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 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Jefferey F Harold
Jefferey F Harold
Primary Examiner
Art Unit: 2646

Continuation of 11. does NOT place the application in condition for allowance because: Claim 10 is an improper dependent claim, it is dependent upon cancelled claim 6.

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THOMSON LICENSING INC.
PATENT OPERATIONS
PO BOX 5312
PRINCETON NJ 08543-5312

**COPY MAILED**

NOV 1 6 2005

**OFFICE OF PETITIONS**

In re Application of
Lorin
Application No. 09/367,623
Filed: November 23, 1999
Attorney Docket No. PF970008
For: METHOD FOR AUTOMATICALLY ADAPTING LEVELS OF SIGNALS EXCHANGED IN A COMMUNICATION NETWORK

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 14, 2005 (certificate of mailing date October 7, 2005), to revive the above-identified application.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." Petitioners are advised that this is not a final agency decision.

This application became abandoned for failure to timely and properly reply to the final Office action, mailed February 9, 2004, which set an extendable three month period for reply. On July 30, 2004 (certificate of mailing date July 28, 2004), petitioner filed an amendment after final in response to the February 9, 2004 final Office action and a three month extension of time. This amendment after final failed to place the application in *prima facie* condition for allowance. Therefore, the application became abandoned on August 10, 2004. A Notice of Abandonment was mailed on January 26, 2005.

Petitioner filed a petition under 37 CFR 1.181 to withdraw the holding of abandonment on July 14, 2005 (certificate of mailing date July 12, 2005). The 181 petition was dismissed on September 22, 2005 because the July 30, 2004 (certificate of mailing date July 28, 2004) amendment, while submitted timely due to the purchase of a three month extension of time, failed

to place the application in *prima facie* condition for allowance. This was explained in the Advisory Action Before the Filing of An Appeal Brief mailed with the September 22, 2005 decision on petition.

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application.;

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the **entire** delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

The instant petition does not satisfy requirement (1) above.

Petitioner requests that the Office consider the July 30, 2004 (certificate of mailing date July 28, 2004) amendment after final as the required reply. Petitioner is reminded that after a final Office action, there are only five possible replies: (1) a Notice of Appeal, (2) the filing of a continuing application, (3) a 37 CFR 1.129(a) submission, if appropriate, (4) an amendment after final that makes the case ready for issuance or (4) a RCE. To be a proper reply, an amendment after final must eliminate all of the Examiner's objections and rejections, and thus place the case in *prima facie* condition for allowance.

Petitioner's amendment after final failed to eliminate all of the Examiner's rejections. The July 30, 2004 (certificate of mailing date July 28, 2004) amendment after final amendment did not place the application in *prima facie* condition for allowance, as stated in the Advisory Action Before the Filing of An Appeal Brief mailed with the September 22, 2005 decision on petition.

Therefore, petitioner has NOT filed a proper reply to the February 9, 2004 final Office action. The application remains abandoned.

Regarding the petition fee, the fee payment listed as an enclosure to the instant petition cannot be located. Therefore, deposit account no. 07-0832 will be charged the $1,500.00 petition fee.

Further correspondence with respect to this matter should be addressed as follows:

**By mail:** Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

**By hand:** U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

**By FAX:** (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THOMSON LICENSING LLC
Two Independence Way
Suite 200
PRINCETON NJ 08540

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Lorin | : | |
| Application No. 09/367,623 | : | DECISION ON PETITION |
| Filed: November 23, 1999 | : | |
| Attorney Docket No. RCA89726 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed August 2, 2007, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely and properly reply to the final Office action, mailed February 9, 2004, which set an extendable three month period for reply. On July 30, 2004 (certificate of mailing date July 28, 2004), petitioner filed an amendment after final in response to the February 9, 2004 final Office action and a three month extension of time. This amendment after final failed to place the application in *prima facie* condition for allowance. Therefore, the application became abandoned on August 10, 2004. A Notice of Abandonment was mailed on January 26, 2005.

Petitioner filed a petition under 37 CFR 1.181 to withdraw the holding of abandonment on July 14, 2005 (certificate of mailing date July 12, 2005). The 181 petition was dismissed on September 22, 2005 because the July 30, 2004 (certificate of mailing date July 28, 2004) amendment, while submitted timely due to the purchase of a three month extension of time,

failed to place the application in *prima facie* condition for allowance. This was explained in the Advisory Action Before the Filing of An Appeal Brief mailed with the September 22, 2005 decision on petition.

Petitioner filed a petition under 37 CFR 1.137(b) on October 14, 2005 (certificate of mailing date October 7, 2005) to revive the above-identified application. This petition was dismissed on November 16, 2005. Petitioner was given an extendable two month period from the mail date of the decision to file a reconsideration petition.

The present petition was filed on August 2, 2007, over 1 year and 8 months from the mail date of the November 16, 2005 decision.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (3).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for period (3).

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the delay in filing a grantable petition was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b).

Where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing petition(s) seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons then at Thomson Licensing LLC and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the November 16, 2005 decision on petition was mailed, in seeking revival.

Petitioner should include a showing as to how the lengthy delay in filing a reconsideration petition occurred despite the exercise of due care or diligence on the part of the applicant.

Applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay.

Petitioner has paid two petition fees. Only one is required. Deposit account no. 07-0832 will be credited $1,500.00.

Any renewed petition may be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

The centralized facsimile number is **(571) 273-8300.**

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

THOMSON LICENSING LLC
Two Independence Way
Suite 200
PRINCETON NJ 08540

**COPY MAILED**

JUN 2 3 2008

**OFFICE OF PETITIONS**

In re Application of :
Lorin :
Application No. 09/367,623 : DECISION ON PETITION
Filed: November 23, 1999 :
Attorney Docket No. RCA89726 :

This is a decision on the reconsideration petition under the unintentional provisions of 37 CFR 1.137(b), filed January 24, 2008, to revive the above-identified application.

This application became abandoned for failure to timely and properly reply to the final Office action, mailed February 9, 2004, which set an extendable three month period for reply. On July 30, 2004 (certificate of mailing date July 28, 2004), petitioner filed an amendment after final in response to the February 9, 2004 final Office action and a three month extension of time. This amendment after final failed to place the application in *prima facie* condition for allowance. Therefore, the application became abandoned on August 10, 2004. A Notice of Abandonment was mailed on January 26, 2005.

Applicant has submitted a RCE and required fee and amendment in reply to the February 9, 2004 final Office action, an acceptable statement of the unintentional nature of the delay in responding to the February 9, 2004 final Office action, and the petition fee.

The petition is **GRANTED**.

After the mailing of this decision the application will be forwarded to Technology Center AU 4113 for consideration of the RCE and amendment filed on August 2, 2007.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3230.

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

AUG 20 20

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Ave.
Boston, MA 02210

| | |
|---|---|
| In re Application of<br>BALLON, Christian<br>Application No.: 09/367,645<br>PCT No.: PCT/FR98/02907<br>Int. Filing Date: 29 December 1998<br>Priority Date: 30 December 1997<br>Attorney's Docket No.: S1022/8141<br>For: SUBSCRIBER INTERFACE PROTECTION CIRCUIT | DECISION ON PETITION<br>TO WITHDRAW HOLDING<br>OF ABANDONMENT |

This decision is in response to applicant's "Letter to Examiner Requesting Withdrawal of Abandonment" filed on 04 June 2001. No fee is required.

## BACKGROUND

On 29 December 1998, applicant filed international application PCT/FR98/02907 claiming priority to a French patent application filed 30 December 1997. A Demand for the international preliminary examination was not filed. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 30 August 1999.

On 14 August 1999, applicant filed a transmittal letter for entering the national stage in the United States under 35 U.S.C. 371, however, applicant did not include the basic national fee or provide authorization to charge counsel's Deposit Account for the required basic national fee.

On 17 November 1999, applicant claims to have called the PCT Branch of the United States Patent and Trademark Office (PTO) after discovering that the fees were not authorized to be charged from counsel's Deposit Account.

On 22 November 1999, applicant purportedly sent a check of $840.00 for the basic national fee in the above-captioned application

On 20 November 2000, applicant filed a "Progress Inquiry" in the above-captioned application.

On 05 April 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned because applicant failed to provide the full basic

national fee by twenty months pursuant to 37 CFR 1.494(b)(2).

On 12 April 2001, applicant submitted via facsimile various letters concerning the subject application.

On 04 June 2001, applicant filed the instant petition which was accompanied by, *inter alia*, exhibits A-J.

## DISCUSSION

### All Business to be Transacted in Writing

It is first noted that 37 CFR 1.2 states, in part that "[t]he 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." Therefore, any prior discussion between applicant and the PCT Branch of the PTO concerning the above-identified international application shall have no effect on this decision.

### Paying the Basic National Fee

A review of the above-identified application confirms that the U.S. basic national fee was not properly paid prior to the expiration of twenty months from the earliest claimed priority date. Applicant did not include a check for the basic national fee when entering the national stage or provide authorization for the PTO to charge the required fee to counsel's Deposit Account.

In the instant petition to withdraw the holding of abandonment, applicant has not alleged that the proper basic national fee was provided prior to 30 August 1999. Consequently, the subject application was properly abandoned pursuant to 35 U.S.C. 371(d) and 37 CFR 1.494(b)(2) by the DO/EO/US.

### Applicant Paid $840.00 on 22 November 1999

Applicant also provided a date stamped filing receipt that a check of $840.00 was received for the above-captioned application on 22 November 1999. MPEP 503 states that a postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

Therefore, applicant has provided *prima facie* evidence that a check of $840.00 was received by the PTO for the above-identified application on 22 November 1999.

However, the postcard receipt does not serve as *prima facie* evidence that the

check was cashed by the PTO. A review of the financial records does not demonstrate that a check of $840.00 was cashed in the above captioned application. Applicant must provide evidence that the $840.00 check (No. 17101) was cashed by the PTO to be credited for this money.

It is also noted that the DO/EO/US inadvertently charged the $840.00 basic national fee from Deposit Account No. 23-2825 without proper authorization on 25 August 1999. This was a mistake. The $840.00 was credited back to Deposit Account No. 23-2825 on 13 February 2001.

## DECISION

For the reasons discussed above, applicant's petition requesting to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The above-captioned remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw Holding of Abandonment."

Applicant may wish to file a petition to revive the above-captioned application pursuant to 37 CFR 1.137(a) or 1.137(b).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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PCT Legal Examiner
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James Thomson
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UNITED STATES PATENT AND TRADEMARK OFFICE

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WOLF, GREENFIELD & SACKS, P.C.
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Boston, MA 02210

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| In re Application of<br>BALLON, Christian<br>Application No.: 09/367,645<br>PCT No.: PCT/FR98/02907<br>Int. Filing Date: 29 December 1998<br>Priority Date: 30 December 1997<br>Attorney's Docket No.: S1022/8141<br>For: SUBSCRIBER INTERFACE PROTECTION CIRCUIT | DECISION ON<br>PETITION<br>UNDER 37 CFR 1.137(b) |

Applicant's "Petition for Revival of an International Application for Patent Designating the US Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 06 September 2001 in the above-captioned application is hereby **GRANTED** as follows:

Applicant provided a check of $2,210.00 for the basic national fee ($840.00), surcharge fee ($130.00), and petition fee ($1,240.00). However, the basic filing fee is now $860.00. Counsel's Deposit Account No. 23-2825 has been charged the remaining $20.00 as authorized. Applicant states that "[t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal claim is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A declaration in compliance with 37 CFR 1.497(a) and (b) was submitted on 10 April 2000. Applicant has completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 29 December 1998, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **06 September 2001**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

James Thomson

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31 MAR 2000

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

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Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

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|---|---|---|
| In re Application of | : | |
| Klockseth et al. | : | DECISION ON |
| Application No. 09/367666 | : | |
| PCT No.: PCT/AU98/00099 | : | PETITION UNDER |
| Int. Filing Date: 18 February 1998 | : | |
| Priority Date: 18 February 1997 | : | 37 CFR 1.47(a) |
| For: Pressure Compensating Valve | : | |

This is a decision on the petition under 37 CFR § 1.47(a) filed on 06 March 2000.

## BACKGROUND

This international application was filed on 18 February 1998, claiming priority of an earlier application filed on 18 February 1997. A Demand electing the United States was filed on 10 September 1998, which was prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 27 August 1998. Accordingly, the 30 month time period for paying the basic national fee in the United States expired as of midnight on 18 August 1999.

On 17 August 1999, applicants filed a Transmittal Letter for entry into the national stage in the United States. The Transmittal Letter was not accompanied by, *inter alia*, the required basic national fee and an unsigned declaration of the inventors.

On 03 November 1999, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) was transmitted to applicant, indicating *inter alia* that "the current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917." The Notification of Missing Requirements further required the submission of a surcharge under 37 CFR 1.492(e). Indicating that A Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) was transmitted therewith, indicating that the "oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it is not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68."

On 06 March 2000, applicants filed the instant petition under 37 CFR 1.47(a), along with, *inter alia*, a petition and fee authorization for a three month extension of time under 37 CFR 1.136(a) and a declaration signed by inventor Goran Bertil Claes Berndtsson.

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1), (3) and (4).

With respect to requirement (2), petitioner suggests that the reason for the absence of the signatures of joint inventors Mr. Jervmo and Mr. Klockseth is that they refuse to execute the declaration and/or could not be found or reached, but does not provide an adequate showing that they "refuse to join" in the application or "cannot be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a). Petitioner alleges that "Attempts have been made to have Mr. Bengt Jervmo and Mr. Oliver Klockseth execute the declaration. They have not responded." In support of this assertion, petitioner states that "Copies of the patent application and the Declaration were forwarded to each of them at their last known addresses on August 30, 1999, but were never returned. Repeated efforts to have the signed Declarations returned have been unsuccessful." These statements are insufficient because it is not clear that they are made by a person having first-hand knowledge of the events recounted. Moreover, only the August 30, 1999 mailing is specifically identified. If possible, specific facts underlying the assertion that " Repeated efforts to have the signed Declarations returned have been unsuccessful" should be provided. Also, copies of any available documentary evidence, such as certified mail return receipts, cover letters, or telegrams should be provided. Further discussion of the character of the evidence required may be found at MPEP 409.03(d). Based on the evidence currently of record, it would be inappropriate to grant the requested relief.

## DECISION

For the reasons explained *supra*, the petition is **DISMISSED**, without prejudice.

**Petitioner's Deposit Account 20-1430 is being charged in the following amounts, as authorized by the papers filed on 06 March 2000: (1) $130.00 (fee code 122); (2) $130.00 for the surcharge under 37 CFR**

**1.492(e) (fee code 154); and (3) $870.00 for a three month extension of time under 37 CFR 1.136(a)(fee code 117).**

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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08 JUN 2000

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San Francisco, CA 94111

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| In re Application of | : | |
| Klockseth et al. | : | DECISION ON |
| Application No. 09/367666 | : | |
| PCT No.: PCT/AU98/00099 | : | PETITION UNDER |
| Int. Filing Date: 18 February 1998 | : | |
| Priority Date: 18 February 1997 | : | 37 CFR 1.47(a) |
| For: Pressure Compensating Valve | : | |

This is a decision on the renewed petition under 37 CFR § 1.47(a) filed on 30 May 2000.

## BACKGROUND

This international application was filed on 18 February 1998, claiming priority of an earlier application filed on 18 February 1997. A Demand electing the United States was filed on 10 September 1998, which was prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 27 August 1998. Accordingly, the 30 month time period for paying the basic national fee in the United States expired as of midnight on 18 August 1999.

On 17 August 1999, applicants filed a Transmittal Letter for entry into the national stage in the United States. The Transmittal Letter was not accompanied by, *inter alia*, the required basic national fee and an unsigned declaration of the inventors.

On 03 November 1999, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) was transmitted to applicant, indicating *inter alia* that "the current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917." The Notification of Missing Requirements further required the submission of a surcharge under 37 CFR 1.492(e). Indicating that A Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) was transmitted therewith, indicating that the "oath or declaration does not comply with 37 CFR 1.497(a) and (b)

in that it is not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68."

On 06 March 2000, applicants filed the instant petition under 37 CFR 1.47(a), along with, *inter alia*, a petition and fee authorization for a three month extension of time under 37 CFR 1.136(a) and a declaration signed by inventor Goran Bertil Claes Berndtsson.

On 31 March 2000, a decision on petition was mailed to applicants. The petition was dismissed on the basis that applicants had not provided adequate evidence that non-signing inventors Mr. Jervmo and Mr. Klockseth "refuse to join" in the application or "cannot be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a).

Applicants filed the instant renewed petition on 30 May 2000.

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1), (3) and (4).

With respect to requirement (2), the renewed petition includes a document signed by joint inventor Mr. Berndtsson. Mr. Berndtsson attests that he has first-hand knowledge that Mr. Jervmo did not respond to "the necessary formal papers" being forwarded to his last known address on 30 August 1999. However, Mr. Berndtsson does not affirmatively state that the papers he refers to as the "necessary formal papers" include a complete copy of the application and a declaration of the inventors. Without such an affirmative statement, it cannot be concluded from the present record that Mr. Jervmo refused to sign the declaration within the meaning of 37 CFR 1.47. Moreover, Mr. Berndtsson's statement that he has made "several attempts to contact Bengt Jervmo and Oliver Klockseth and obtain the required signatures but have been unsuccessful" does not indicate the particulars of any of the attempted contacts, nor does it indicate whether (1) the inventor(s) could not be reached, or (2) the inventor(s) were reached but refused to sign.

Mr. Berndtsson also notes that "Mr. Klockseth was contacted by telephone and was verbally reluctant to sign the required formal papers." This statement does not clearly indicate that Mr. Klockseth *expressly refused* to sign the *declaration*; instead, it

may be that the papers referred to as the "required formal papers" do not include the declaration. Also, Mr. Berndtsson does not identify the time of the telephone call(s). *See* MPEP 409.03(d). Mr. Berndtsson also indicates that papers were forwarded to Mr. Klockseth's "last known business address," but does not indicate what efforts if any were undertaken to send a copy of the declaration and application to Mr. Klockseth's last known *residential* address. In view of the deficiencies identified above, it would be inappropriate to grant the requested relief on the basis of the evidence currently of record.

## DECISION

For the reasons explained *supra*, the petition is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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31 AUG 2000

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| In re Application of | : | |
| Klockseth et al. | : | DECISION ON |
| Application No. 09/367666 | : | |
| PCT No.: PCT/AU98/00099 | : | PETITION UNDER |
| Int. Filing Date: 18 February 1998 | : | |
| Priority Date: 18 February 1997 | : | 37 CFR 1.47(a) |
| For: Pressure Compensating Valve | : | |

This is a decision on the renewed petition under 37 CFR § 1.47(a) filed on 11 August 2000.

## BACKGROUND

This international application was filed on 18 February 1998, claiming priority of an earlier application filed on 18 February 1997. A Demand electing the United States was filed on 10 September 1998, which was prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 27 August 1998. Accordingly, the 30 month time period for paying the basic national fee in the United States expired as of midnight on 18 August 1999.

On 17 August 1999, applicants filed a Transmittal Letter for entry into the national stage in the United States. The Transmittal Letter was not accompanied by, *inter alia*, the required basic national fee and an unsigned declaration of the inventors.

On 03 November 1999, a Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US) (Form PCT/DO/EO/905) was transmitted to applicant, indicating *inter alia* that "the current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917." The Notification of Missing Requirements further required the submission of a surcharge under 37 CFR 1.492(e). Indicating that A Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) was transmitted therewith, indicating that the "oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it is not executed in accordance with 37 CFR 1.66 or 37 CFR 1.68."

On 06 March 2000, applicants filed the instant petition under 37 CFR 1.47(a), along with, *inter alia*, a petition and fee authorization for a three month extension of time under 37 CFR 1.136(a) and a declaration signed by inventor Goran Bertil Claes Berndtsson.

On 31 March 2000, a decision on petition was mailed to applicants. The petition was dismissed on the basis that applicants had not provided adequate evidence that non-signing inventors Mr. Jervmo and Mr. Klockseth "refuse to join" in the application or "cannot be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a).

Applicants filed the a renewed petition on 30 May 2000.

On 08 June 2000, the renewed petition of 30 May 2000 was dismissed without prejudice on the basis that petitioner had not provided sufficient factual proof that missing joint inventors Jervmo and Klockseth refused to execute the application or cannot be reached after diligent effort.

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1) and (4).

With respect to requirement (2), the renewed petition is accompanied by "Exhibit A", which is a letter signed by June Maidens. Regarding Mr. Klockseth, the letter indicates steps which were taken to secure Mr. Klockseth's signature on assignment documents, but does not show steps taken in order to secure his signature on an oath or declaration of the inventors. Specifically, the letter indicates, that in a telephone conversation on 30 August 1999, "Mr. Klockseth stated that he was not prepared to sign any documents." This is not sufficient to establish his refusal to execute an oath or declaration because it appears from the evidence of record that the telephone conversation concerned an assignment document, not an oath or declaration of the inventors. Moreover, the letter indicates that "a copy of the declaration application was not sent to Mr. Klockseth's residential address as he had moved and we did not have any details of his then current address." This does not establish that he could not be reached after diligent effort because it is not alleged that any attempt was made to transmit an oath or declaration and a complete copy of the application to *his last known residential address*, as required by 37 CFR 1.47. Moreover, no attempt to reach him at his alleged current address or telephone number has been alleged. Accordingly, on the basis of the present record, it would not be appropriate to conclude that Mr. Klockseth "refuses to execute the application or cannot be

reached after diligent effort."

With respect to Mr. Jervmo, the letter signed by June Maidens indicates that a single attempt was made to mail an unspecified set of "the documents" to his last known residential address, and that the envelope allegedly was not returned. There is no clear indication that "the documents" included the required set of documents (oath or declaration and complete copy of the application) as opposed to some other documents (such as assignment documents). Moreover, the alleged mailing does not amount to a "diligent effort" because no return receipt is alleged to have been requested, and because only a single attempted mailing has been alleged. Also, it is unclear whether the mailing was in fact to his last known address, since the documents were allegedly mailed to an address in Green Point, NSW, but the letter also states that "We believe Mr. Jervmo is still in Sweden." Based on the evidence of record, it would not be appropriate to conclude that Mr. Jervmo "refuses to execute the application or cannot be reached after diligent effort."

With respect to requirement (3), the petition does not clearly indicate what Mr. Klockseth's last known address is, since it does not indicate whether the Corella Street address is in fact his last *known* address. Moreover, the statement that "We believe Mr. Jervmo is still in Sweden but have no knowledge of his address or whereabouts" calls into question whether his last known address is in Green Point, NSW, or whether it is in Sweden.

## DECISION

For the reasons explained *supra*, the petition is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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SEP 21 2001

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| In re Application of | : | |
| Klockseth et al. | : | DECISION ON |
| Application No. 09/367666 | : | |
| PCT No.: PCT/AU98/00099 | : | PETITION UNDER |
| Int. Filing Date: 18 February 1998 | : | |
| Priority Date: 18 February 1997 | : | 37 CFR 1.47(a) |
| For: Pressure Compensating Valve | : | |

This is a decision on the renewed petition under 37 CFR § 1.47(a) filed on 02 March 2001.

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1) and (4).

With respect to requirement (2), the renewed petition is accompanied by a letter from Peter Leonard to Chris O'Sullivan, stating that a copy of a declaration was forwarded to non-signing inventor Mr. Klockseth on 27 November 2000, and that he orally refused to sign the document on 11 December 2000. However, petitioner has not established that this refusal occurred after a complete copy of the application was transmitted to Mr. Klockseth, as required by 37 CFR 1.47. Accordingly, on the basis of the present record, it would not be appropriate to excuse the absence of Mr. Klockseth's signature.

With respect to Mr. Jervmo, the renewed petition indicated that a declaration was mailed to his last known address. The petition is accompanied by a "returned registered mailing" indicating that Mr. Jervmo was "unknown at address." This evidence establishes that Mr. Jervmo could not be found or reached after diligent effort within the meaning of 37 CFR 1.47.

With respect to requirement (3), the petition does not clearly indicate what Mr. Klockseth's last known address is, since it does not indicate whether the Corella Street address is in fact his last *known* address.

## DECISION

For the reasons explained *supra*, the petition is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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13 SEP 2004

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| In re Application of | : | |
| Klockseth et al. | : | DECISION |
| Application No. 09/367666 | : | |
| PCT No.: PCT/AU98/00099 | : | ON |
| Int. Filing Date: 18 February 1998 | : | |
| Priority Date: 18 February 1997 | : | PETITION |
| For: Pressure Compensating Valve | : | |

This is a decision on the renewed petition under 37 CFR § 1.47(a) and the petition under 37 CFR 1.137(b) filed on 24 December 2003.

## DISCUSSION

Review of the record reveals that a decision on petition was mailed to counsel on 21 September 2001. That decision set a two-month period for response, extendable under 37 CFR 1.136(a). This application became abandoned for failure to timely reply to that decision on petition. The submission filed on 24 December 2003 included a petition under 37 CFR 1.137(b).

*Petition Under 37 CFR 1.137(b)*

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the required reply (in the form of the renewed petition under 37 CFR 1.47(a)) accompanied the petition.

Regarding requirement (2), the petition fee accompanied the petition.

Regarding requirement (3), the petition includes an appropriate statement.

Regarding requirement (4), no terminal disclaimer is required because the international filing date of this application is later than 8 June 1995.

As all of the requirements of 37 CFR 1.137(b) have been satisfied, the petition to revive is **GRANTED**, and it would now be appropriate to treat the merits of the renewed petition under 37 CFR 1.47(a).

*Renewed Petition Under 37 CFR 1.47(a)*

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1) and (4) previously.

With respect to requirement (2), the decision mailed on 21 September 2001 indicated that the evidence of record at that time established that Mr. Jervmo could not be found or reached after diligent effort within the meaning of 37 CFR 1.47. With respect to Mr. Klockseth, the decision mailed on 21 September 2001 noted the letter from Peter Leonard to Chris O'Sullivan, stating that a copy of a declaration was forwarded to non-signing inventor Mr. Klockseth on 27 November 2000, and that he orally refused to sign the document on 11 December 2000. However, that decision indicated that petitioner had not established that this refusal occurred after a complete copy of the application was transmitted to Mr. Klockseth, as required by 37 CFR 1.47.

The "Statement" signed by Melinda Butterworth and accompanying the instant petition indicates that a parcel sent to his last known address was returned, marked "Left Address." The Statement also details attempts undertaken to ascertain the whereabouts of Mr. Klockseth, including a search of the "White Pages in each State of Australia," a search of "the Swedish White Pages," and the mailing of a registered letter to Mr. Klockseth's last known business address, all of which attempts are described as fruitless. On the basis of the evidence now of record, it would be appropriate to conclude that Mr. Klockseth could not be found or reached after diligent effort.

With respect to requirement (3), the renewed petition clearly indicates Mr. Klockseth's last known address to be the address at 20 Corella Street, Harbord, NSW, Australia.

**DECISION**

For the reasons explained *supra*, the petition is **GRANTED**.

The $130.00 surcharge under 37 CFR 1.492(e) is being charged to counsel's Deposit Account No. 20-1430, as authorized by the petition filed on 06 March 2000.

This application is being forwarded to the National Stage Processing Branch. The date of the application under 35 U.S.C. 371 (c)(1), (2) and (4) is **06 March 2000**.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721; (571) 272-3283
Fax: (703) 308-6459; (571) 273-0459

13 SEP 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Bengt Jervmo
40 James Sea Drive
Green Point, NSW
AUSTRALIA

In re Application of
Klockseth et al.
Application No. 09/367,666
PCT No.: PCT/AU98/00099
Int. Filing Date: 18 February 1998
Priority Date: 18 February 1997
For: Pressure Compensating Valve

Dear Mr. Jervmo:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 308-6721 or (571) 272-3283. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Requests for information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1(800) 972-6382 (outside the Washington D.C. area).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

J. Georg Seka
Townsend and Townsend and Crew, LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

13 SEP 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
www.uspto.go

Oliver Klockseth
20 Corella Street
Harbord, NSW
AUSTRALIA

In re Application of
Klockseth et al.
Application No. 09/367,666
PCT No.: PCT/AU98/00099
Int. Filing Date: 18 February 1998
Priority Date: 18 February 1997
For: Pressure Compensating Valve

Dear Mr. Klockseth:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 116 (United States Code), and 37 CFR 1.47(a), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as a joint inventor.

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 308-6721 or (571) 272-3283. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Requests for information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1(800) 972-6382 (outside the Washington D.C. area).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

J. Georg Seka
Townsend and Townsend and Crew, LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
ALEXANDRIA, VA 22313-1450
www.uspto.go

# OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of an application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventors whose signatures are missing (Oliver Klockseth and Bengt Jervmo) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/AU98/00099 and was filed on February 18, 1998 in the names of Oliver Klockseth, Bengt Jervmo, and Claes Berndtsson for the invention entitled PRESSURE COMPENSATING VALVE. The national stage application number is 09/367,666 and has a 35 U.S.C. 371(c)(1), (2) and (4) date of March 6, 2000.

SPE: ~~D. Schuberg~~
S. Allen

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

Paper No.: _____

DATE : 5/8/07

TO SPE OF : ART UNIT 2872 / 2834

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/367,949 Patent No.: 6211989

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.


Lamonte M. Newsome
Certificates of Correction Branch
703-308-9390 ext. 112


**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

- ☒ **Approved** — All changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** _____

Stephone B. Allen
Supervisory Patent Examiner

Stephone B. Allen — **SPE**

2872 — **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Date :08/02/07

Patent No. : 6211989 C1
Ser. No. : 09/367,949
Inventor(s) : WULF, JURGEN
Issued : 03/20/07
Title : **LIGHT-SCANNING DEVICE**
Docket No. : 4539US

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

In view of the foregoing, your request, in this mater, is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

*In the Request*, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

By mail: Mail Stop PETITIONS
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: Customer Service Window
Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

**Lamonte M. Newsome**
For Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 #112 or (703) 308-8309

**FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP**
**901 NEW YORK AVENUE, NW**
**WASHINGTON DC 20001-4413**

LMN

Approved for use through 04/30/2009. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

# PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

| Patent Number | Issue Date (YYYY-MM-DD) | Application Number | Filing Date (YYYY-MM-DD) | Docket Number (if applicable) |
|---|---|---|---|---|
| 6374175 | 2002-04-16 | 09367982 | 1999-08-23 | 2001P11268 |

CAUTION: Maintenance fee (and surcharge, if any) payment must correctly identify: (1) the patent number and (2) the application number of the actual U.S. application leading to issuance of that patent to ensure the fee(s) is/are associated with the correct patent. 37 CFR 1.366(c) and (d).

SMALL ENTITY
☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS
☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

| NOT Small Entity | | | Small Entity | | |
|---|---|---|---|---|---|
| | Fee | Code | | Fee | Code |
| ◉ | 3 ½ year | (1551) | ◯ | 3 ½ year | (2551) |
| ◯ | 7 ½ year | (1552) | ◯ | 7 ½ year | (2552) |
| ◯ | 11 ½ year | (1553) | ◯ | 11 ½ year | (2553) |

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

◯ A sole patentee

◯ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

◯ A joint patentee; all of whom are signing this e-petition

◯ The assignee of record of the entire interest

| Patent Practitioner | | | |
|---|---|---|---|
| A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature | | | |
| Signature | /Werner H. Stemer/ | Date (YYYY-MM-DD) | 2007-10-04 |
| Name | Werner H. Stemer | Registration Number | 34956 |

This collection of information is required by 37 CFR 1.378(c). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/ or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **This form can only be used when in conjunction with EFS-Web. If this form is mailed to the USPTO, it may cause delays in reinstating the patent.**

# Privacy Act Statement

The Privacy Act of 1974 (P.L. 93-579) requires that you be given certain information in connection with your submission of the attached form related to a patent application or patent. Accordingly, pursuant to the requirements of the Act, please be advised that: (1) the general authority for the collection of this information is 35 U.S.C. 2(b)(2); (2) furnishing of the information solicited is voluntary; and (3) the principal purpose for which the information is used by the U.S. Patent and Trademark Office is to process and/or examine your submission related to a patent application or patent. If you do not furnish the requested information, the U.S. Patent and Trademark Office may not be able to process and/or examine your submission, which may result in termination of proceedings or abandonment of the application or expiration of the patent.

The information provided by you in this form will be subject to the following routine uses:

1. The information on this form will be treated confidentially to the extent allowed under the Freedom of Information Act (5 U.S.C. 552) and the Privacy Act (5 U.S.C. 552a). Records from this system of records may be disclosed to the Department of Justice to determine whether the Freedom of Information Act requires disclosure of these record s.

2. A record from this system of records may be disclosed, as a routine use, in the course of presenting evidence to a court, magistrate, or administrative tribunal, including disclosures to opposing counsel in the course of settlement negotiations.

3. A record in this system of records may be disclosed, as a routine use, to a Member of Congress submitting a request involving an individual, to whom the record pertains, when the individual has requested assistance from the Member with respect to the subject matter of the record.

4. A record in this system of records may be disclosed, as a routine use, to a contractor of the Agency having need for the information in order to perform a contract. Recipients of information shall be required to comply with the requirements of the Privacy Act of 1974, as amended, pursuant to 5 U.S.C. 552a(m).

5. A record related to an International Application filed under the Patent Cooperation Treaty in this system of records may be disclosed, as a routine use, to the International Bureau of the World Intellectual Property Organization, pursuant to the Patent Cooperation Treaty.

6. A record in this system of records may be disclosed, as a routine use, to another federal agency for purposes of National Security review (35 U.S.C. 181) and for review pursuant to the Atomic Energy Act (42 U.S.C. 218(c)).

7. A record from this system of records may be disclosed, as a routine use, to the Administrator, General Services, or his/her designee, during an inspection of records conducted by GSA as part of that agency's responsibility to recommend improvements in records management practices and programs, under authority of 44 U.S.C. 2904 and 2906. Such disclosure shall be made in accordance with the GSA regulations governing inspection of records for this purpose, and any other relevant (i.e., GSA or Commerce) directive. Such disclosure shall not be used to make determinations about individuals.

8. A record from this system of records may be disclosed, as a routine use, to the public after either publication of the application pursuant to 35 U.S.C. 122(b) or issuance of a patent pursuant to 35 U.S.C. 151. Further, a record may be disclosed, subject to the limitations of 37 CFR 1.14, as a routine use, to the public if the record was filed in an application which became abandoned or in which the proceedings were terminated and which application is referenced by either a published application, an application open to public inspections or an issued patent.

9. A record from this system of records may be disclosed, as a routine use, to a Federal, State, or local law enforcement agency, if the USPTO becomes aware of a violation or potential violation of law or regulation.

# UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6374175
Issue Date: April 16,2002
Application No. 09367982
Filed: August 23,1999
Attorney Docket No. PHF-97.631

:

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

:

This is a decision on the electronic petition, filed October 4,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 4,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

Telephone inquires related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**:20060914

**DATE** : September 14, 2006

**TO SPE OF** : ART UNIT 1641

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,078,495

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - PK 3-910**
Palm location **7590** - Tel. No. 305-8201

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**
Note your decision on the appropriate box.

☒ **Approved** Mary E. Ceperley MARY E. CEPERLEY PRIMARY EXAMINER AU1641 — **All** changes apply.

☐ **Approved in Part** — Specify below which changes **do not** apply.

☐ **Denied** — State the reasons for denial below.

**Comments:**

LONG V. LE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

**SPE:** Long V. Le **Art Unit** 1641

PTO/SB/44 (04-05)
Approved for use through 04/30/2007 OMB 0651-0033
U S Patent and Trademark Office; U.S DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995. no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

# UNITED STATES PATENT AND TRADEMARK OFFICE
## CERTIFICATE OF CORRECTION



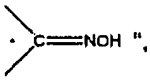
PATENT NO. : 7,078,495

APPLICATION NO : 09/368,010

ISSUE DATE : July 18, 2006

INVENTOR(S) : Kasper et al.

It is certified that an error appears or errors appear in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

1) On Fig. 7, please delete the handwritten notes " Oxime  ", below the molecular structure.

MAILING ADDRESS OF SENDER (Please do not use customer number below):

Dade Behring Inc.
1717 Deerfield Road
Deerfield, IL 60015

This collection of information is required by 37 CFR 1 322, 1.323. and 1 324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application Confidentiality is governed by 35 U.S C. 122 and 37 CFR 1 14. This collection is estimated to take 1 0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P O. Box 1450, Alexandria, VA 22313-1450 DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

*If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2*

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

THE FARRELL LAW FIRM, LLP
290 Broadhollow Road
Suite 210E
Melville, NY 11747

Mail Date: 05/21/2010

| | | |
|---|---|---|
| **Applicant** | : HI-CHAN MOON | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7653040 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 09/368,129 | : OF WYETH |
| **Filed** | : 08/04/1999 | : |
| | | : |

The Patentee's Request for Recalculation is **DISMISSED.**

This Request is deemed ineligible for consideration for one or more of the following reasons:

(A). The patent for which PTA recalculation is requested is either a design or reissue application or is a reexamination proceeding;

(B). The patent for which PTA recalculation is requested resulted from a utility or plant application filed under 35 USC 111(a) before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(C). The patent for which PTA recalculation is requested resulted from an international application in which the international filing date was before May 29, 2000 and no CPA filed in the application on/after May 29, 2000;

(D). The patent for which PTA recalculation is requested issued on/after March 2, 2010;

(E). The Request for Recalculation was filed more than 180 days after the grant date of the patent and the request was not filed within two months of a dismissal of a request for reconsideration of the of the patent term under 37 CFR 1.705(d);

(F). The Request for Recalculation is not solely limited to USPTO pre-Wyeth interpretation of 35 U.S.C. 154(b)(2)(A);

or

(G). A civil action was filed pursuant to 35 U.S.C. 154(b)(4)(A)concerning the same patent at issue in this request.

Patentee may file a reply to this decision dismissing the Request for Recalculation. Patentee must file such reply within one month or thirty days, whichever is longer, of the mail date of the decision dismissing the Request for Recalculation. No fee is required if patentee is asserting in the reply that the dismissal for ineligibility is improper.

Patentee should use document code PET.OP if electronically filing a reply to this dismissal. If the USPTO finds that the request was improperly deemed ineligible, the USPTO will mail applicant a recalculation determination.

Patentee should be aware that in order to preserve the right to review in the United States District Court for the District of Columbia of the USPTO patent term adjustment determination, patentee must ensure that he or she also take the steps required under 35 U.S.C. 154(b)(4)(A). Nothing in the request for recalculation should be construed as providing an alternative time frame for commencing a civil action under 35 U.S.C. 154 (b)(4)(A).

Any questions concerning this decision should be directed to the Office of Patent Legal Administration at 571-272-7702.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

**Exhibit A**

PAPER NO.

PSC

ROHM AND HAAS COMPANY
PATENT DEPARTMENT
100 INDEPENDENCE MALL WEST
PHILADELPHIA PA 19106-2399

OIPE JC141
DEC 2 9 2003
PATENT & TRADEMARK OFFICE

COPY MAILED

SEP 1 6 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of
Tod C. Duvall, et al.
Application No. 09/368,150
Filed: August 4, 1999
Attorney Docket No. 2543-28-85

This is a decision on the petition under 37 CFR 1.313(c)(2), filed by facsimile transmission on September 15, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

***Petitioner is advised that the issue fee paid on December 16, 2002, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.***[1]

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

After receipt in the Office of Petitions, the application will be forwarded to Technology Center AU 1713 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1]The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).

RECEIVED
SEP 2 2 2003
PATENT DEPARTMENT

UNITED STATES DEPARTMENT OF COMMERCE
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Paper No. 11

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**NOV 17 2000**

**OFFICE OF PETITIONS**
**A/C PATENTS**

In re Application of
Jerome Knoplioch et al.
Application No. 09/368,201
Filed: August 4, 1999
Attorney Docket No. 14XT00047

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 26, 2000, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed February 3, 2000, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on May 4, 2000.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 306-5684.

The application file is being forwarded to Technology Center 2800.

Irvin Dingle
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

In re Application of
Knoplioch et al.
Application No. 09/368,201
Filed: August 4, 1999
Attorney Docket No. 14XZ00047

Decision on Petition

This a decision on the petition under 37 CFR 1.137(b), filed December 28, 2004, to revive the above-identified application.

The petition is **granted.**

This application became abandoned for failure to timely reply to the non-final Office action mailed October 10, 2001. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on January 11, 2002. A Notice of Abandonment was mailed on June 14, 2002.

The instant petition requests revival of the application. Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Therefore, the petition is granted and the application is revived.

The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional.[1]

The file does not indicate a change of address has been submitted, although the zip code listed on the petition differs from the zip code which is part of the address of record. The United States Postal Service web site indicates the correct zip code is the code listed on the petition - 06828. However, the Office is unable to change the address of record since petitioner has not actually requested a change of address. If appropriate, a request to change the address of record should be filed. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Technology Center Art Unit 2123 will be informed the application has been revived and the examiner will consider the amendment filed on December 28, 2004, in due course.

Telephone inquiries may be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

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[1] See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178; 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

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**OFFICE OF PETITIONS**

In re Application of :
Wood et al :
Application No. 09/368,507 : ON PETITION
Filed: August 5, 1999 :
Attorney Docket Number: 004-3631 :
Title of Invention: SINGLE SIGN-ON :
FRAMEWORK WITH TRUST-LEVEL MAPPING :
TO AUTHENTICATION REQUIREMENTS

This is a decision on the petition filed January 28, 2005, under 37 CFR 1.137(b) to revive the above-identified application.

This application became abandoned for failure to timely submit the issue fee, as required by the Notice of Allowance and Fee (s) Due which was mailed September 28, 2004. The Notice of Allowance and Fee (s) Due set a three (3) month statutory period for reply. Extensions of time were not available under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on December 29, 2004. This decision precedes the mailing of a Notice of Abandonment.

The requirements for a grantable petition under 37 CFR 1.137(b) have been met. This petition is hereby **Granted**.

This application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries should be directed to the undersigned at (571) 272-3215.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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| | | |
|---|---|---|
| In re Patent No. 6,924,097 | : | |
| Issue Date: August 2, 2005 | : | |
| Application No. 09/368,572 | : | DECISION ON PETITION |
| Filed: August 5, 1999 | : | |
| Attorney Docket No. OHBA=1A | : | |

This is a decision on the "PETITION TO CORRECT NAME OF ASSIGNEE ON GRANTED PATENT", filed September 10, 2007.

The petition is **GRANTED**.

An application may issue in the name of an assignee rather than the applicant if requested prior to issuance of a patent.[1] However, in the event the request is not made prior to issuance, a Certificate of Correction under 37 CFR 1.323 may be requested. A request for a Certificate of Correction under 37 CFR 1.323 to correct the assignee's name will not be granted unless a petition under 37 CFR 3.81(b) is granted. Such request under 37 CFR 3.81(b) should include:

(A) the processing fee required by 37 CFR 1.17(i);

(B) a request for issuance of the application in the name of the assignee, or a request that a patent be corrected to state the name of the assignee;

(C) a statement that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent; and

[1] See 37 CFR 3.81.

(D) a request for a certificate of correction under 37 CFR 1.323 accompanied by the fee set forth in 37 CFR 1.20(a).[2]

Receipt of the $130 processing fee set forth in 37 CFR 1.17(i) and the $100 fee for the Certificate of Correction is acknowledged.

The file is being forwarded to the Certificate of Corrections Branch for issuance of the requested Certificate of Correction.

Telephone inquiries related to this decision should be directed to the undersigned at (571)272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

[2] MPEP 307.

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No**.:20080630

**DATE** : June 30, 2008

**TO SPE OF** : ART UNIT 4142

**SUBJECT** : Request for Certificate of Correction on Patent No.: 7,349,902

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
**Certificates of Correction Branch - ST (South Tower) 9A22**
Palm location **7590** - Tel. No. (703) 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

**Thank You For Your Assistance** **Certificates of Correction Branch**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

☐ **Approved in Part** Specify below which changes **do not** apply.

☐ **Denied** State the reasons for denial below.

**Comments:**

**SPE:** /Joon H. Hwang/ Art Unit 4142

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : August 14, 2006

**TO SPE OF** : ART UNIT 2876

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 09/368817 Patent No.: 7,044,373

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

**Magdalene Talley**

**Certificates of Correction Branch**

**703-308-9390 ext. 116**

**Thank You For Your Assistance**

**The request for issuing the above-identified correction(s) is hereby:**

Note your decision on the appropriate box.

- ☑ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

**Comments:** It corrects typographical errors.

SPE

2876
Art Unit