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CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD CT 06002

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JAN 19 2006

**OFFICE OF PETITIONS**

In re Application of
Dennis Richard Hayward et al.
Application No. 09/595,201
Filed: June 16, 2000
Attorney Docket Number: MAR-0003

ON PETITION

This is a decision on the petition filed November 14, 2005, under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

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 1.181," or, as explained in more detail below, "...under 37 CFR 1.137(a)" or (b). This is not a final agency decision.

This application became abandoned on June 2, 2001 after the applicant failed to file a timely response to the non-Final Office Action mailed March 1, 2001. Accordingly, a Notice of Abandonment was mailed October 12, 2001.

Petitioner argues that the non-Final Office Action was not received and includes copies of the file jacket and docket to establish non-receipt. Petitioner also argues that petitioner's address was included on a facsimile transmission cover sheet submitted on October 4, 2001.

A review of the file reveals that the non-Final Office Action was mailed to the address of record on March 1, 2001, but was returned by the US Postal Service on March 12, 2001 as undeliverable, that the Notice of Abandonment mailed October 12, 2001 was also returned by the US Postal Service on January 24, 2002 as undeliverable and finally that a proper change of correspondence address was not filed until July 2, 2004.

While petitioner points out that the correspondence address was included on the

facsimile transmission cover sheet submitted on October 4,2001, it should be pointed out that, as was indicated in the Notice of Abandonment, "Applicant failed to provide the office with a proper notification of change of address specifying applicant's new address. The mere inclusion, in a paper filed in the application for another purpose, of an address differing from the previously provided correspondence address, without mentioned the fact that an address change was made, does not constitute a proper change of address notification." See MPEP sections 601.03 and 711.02(c ).

As petitioner has not presented any evidence that the address of record had been changed with the USPTO at the time the non-Final Office Action was mailed, and in the absence of petitioner showing that they acted responsibly with respect to providing the USPTO with up to date addresses, the showing of record is therefore insufficient to warrant withdrawal of the holding of abandonment.

**ALTERNATIVE VENUES**

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(a)[1] or 37 CFR 1.137(b),[2] which now provides that where the delay in reply was unintentional, a

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[1]A grantable petition 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 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 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.

(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 as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

[2]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)).

petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should 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 FAX: (571) 273-8300

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

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OCT 09 2007

OFFICE OF PETITIONS

CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

In re Application of Hayward et al. :
Application No. 09/595,201 : Decision on Petition
Filing Date: June 16, 2000 :
Attorney Docket No. MAR-0003 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 5, 2007, to revive the above-identified application.

The petition is **dismissed**.

Facts:

The original application papers, filed June 16, 2000, stated correspondence should be sent to:

Cantor Colburn, LLP
55 Griffin Road South
Bloomfield, CT 06002

The Office entered the address listed above as the address of record.

On October 27, 2000, applicants filed a signed declaration for the instant application. The declaration stated correspondence should be sent to:

Michael A. Cantor, Esq.
Cantor Colburn LLP
88 Day Hill Road
Windsor, CT 06095

After receipt of the signed declaration, the Office properly changed the address of record to the address listed on the declaration.

The Office mailed a non-final Office action to the address of record on March 1, 2001. The Office action set a shortened statutory period for reply of three (3) months. Therefore, a reply was due on or before June 1, 2001. Since a reply was not filed, the application became abandoned on June 2, 2001.

The Office action was returned undelivered by the USPS. The USPS stamp on the returned envelope states, "undeliverable as addressed - forwarding address expired."

On October 5, 2001, petitioner sent the examiner a letter with information proving the transmittal letter filed with the original papers listed the "Griffin Road" address as the correspondence address.

The examiner mailed a Notice of Abandonment on October 12, 2001.

The Notice of Abandonment was returned undelivered by the USPS. The USPS stamp on the returned envelope states, "undeliverable as addressed - forwarding address expired."

An Associate Power of Attorney, Request for a Change of Address, and a "Status Request" letter, were filed July 2, 2004. The request to change the address was signed by the individual given associate power of attorney by the power of attorney paper filed the same day. The request to change the address stated the correspondence address of record should be the address associated with Customer Number 23413, which was, and is,

Cantor Colburn, LLP
55 Griffin Road South
Bloomfield, CT 06002

The Associate Power of Attorney paper was filed July 2, 2004. A change to 37 CFR 1.34 eliminating Associate Power of Attorney practice became effective June 25, 2004. See Revision of Power of Attorney and Assignment Practice, 69 Fed. Reg. 29865 (May 26, 2004), 1283 Off. Gaz. 148 (Jun. 22, 2004). However, since the Associate Power of Attorney was mailed in compliance with 37 CFR 1.8(a) on June 15, 2004, the papers filed July 2, 2004, were proper. The address of records has been changed to the address associated with Customer No. 23414.

On November 14, 2005, petitioner filed a petition under 37 CFR 1.181 to withdraw the holding of abandonment. A decision dismissing the petition was mailed January 19, 2006. The decision stated the Office had correctly mailed the non-final Office action to the address designated as the address of record.

The January 19, 2006 decision stated petitioner might wish to consider filing a petition under 37 CFR 1.137(b).

*More than 15 months* after the Office mailed the January 19, 2006 decision, petitioner filed the instant petition under 37 CFR 1.137(b).

Discussion:

37 CFR 1.137(b)(3) states, "The Director may require additional information where there is a question whether the delay was unintentional." In view of the delay in the filing of a petition under 37 CFR 1.137(b), the Office seeks additional information regarding reasons for delay in taking steps to revive the application.

In order for a petition under 37 CFR 1.137(b) to be granted, the *entire* period of abandonment must be unintentional. The application became abandoned on June 2, 2001.

Petitioner should provide the information listed below.

(1) Petitioner should state the date petitioner first learned the application was abandoned?

(2) If the date petitioner discovered the application was abandoned was on or before August 14, 2005, petitioner should provide an explanation for any delay in filing the petition to withdraw the holding of abandonment on November 14, 2005.

(3) Petitioner should fully explain and discuss the delay from January 19, 2006, until the date the instant petition was filed.

The response to the instant decision 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 1.137b)."

The response to the instant decision should be submitted by EFS Web. If the response is not submitted electronically, the response 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
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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MAY 09 2008

CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

In re Application of Hayward et al. :
Application No. 09/595,201 : Decision on Petition
Filing Date: June 16, 2000 :
Attorney Docket No. MAR-0003 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed December 10, 2007, to revive the above-identified application.

The petition is **granted**.

The Office mailed a non-final Office action to the address of record on March 1, 2001. The Office action set a shortened statutory period for reply of three (3) months. Therefore, a reply was due on or before June 1, 2001. Since a reply was not filed, the application became abandoned on June 2, 2001. A Notice of Abandonment was mailed October 12, 2001.

The instant petition requests revival of the application.

Petitioner submitted the required petition fee on May 4, 2007. Petitioner submitted a reply to the non-final Office action on May 4, 2007. Petitioner has stated 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 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.

Technology Center Art Unit 3613 will be informed of the instant decision and the application, including the amendment filed May 4, 2007, will be further examined in due course.

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

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ANDRUS, SCEALES, STARKE & SAWALL, LLP
100 EAST WISCONSIN AVENUE, SUITE 1100
MILWAUKEE, WI 53202

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Dennis Richard Hayward | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7641026 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/05/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/595,201 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/16/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **2395** 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.

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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Mailed: JUL 7 2003

BC
Paper Number 14

In re application of
Marcellinus J.H.J. Geromini
Serial No. 09/595,310
Filed: June 16, 2000
For: METHOD FOR MANUFACTURING ELECTRONIC DEVICES, AND APPARATUS FOR CARRYING OUT SUCH A METHOD

DECISION ON PETITION

This is a decision on the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed May 1, 2003 for failure to pay the required issue fee in response to the Notice of Allowability dated December 9, 2002.

**DECISION**

Since petitioner asserts that the issue was timely paid, 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 is sufficient to establish that applicants did pay the required issue in a timely manner. The submitted evidence is a copy of the Issue Fee Transmittal Form with a Certificate of Mailed dated March 7, 2003 showing receipt of the required issue fee.

Therefore, the Notice of Abandonment dated April 18, 2003 is hereby withdrawn. Hence, the case is returned to allowed status. The application shall be returned to ISSUE BRANCH for prompt issuance of the patent.

The Petition is **GRANTED**.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

RC JUL 15 2003

Jack E. Haken
Corporate Patent Counsel
US Phillips Corporation
580 White Plains Road
Tarrytown, NY 10591

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Paper No. 10

STEPHEN M EVANS
SUITE 350
155 108TH AVENUE NE
BELLEVUE WA 98004-5901

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MAR 1 8 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of
Jiyue Zeng
Application No. 09/595,325
Filed: June 16, 2000
Docket No. 976-26-1

This is a decision on the petition filed on January 28, 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 file a reply to the non-final Office action, mailed May 31, 2001, which set a shortened statutory period for reply of three (3) months. Petitioner submitted an amendment on January 22, 2002, with a Certificate of Mailing dated October 31, 2001. However, because petitioner failed to submit the necessary two (2) month extension of time, the application became abandoned on September 1, 2001. A Notice of Abandonment was mailed on January 28, 2002.

Petitioner has met the requirements to revive the above-identified application, pursuant to 37 CFR 1.137(b). Petitioner submitted the required reply in the form of an amendment (subsequently filed on February 13, 2002), paid the petition fee, and made the proper statement of unintentional delay.

The petition fee of $640 has been charged to Deposit Account No. 07-1897, as authorized.

The application file is being forwarded to Technology Center 3700 for consideration of petitioner's amendment, filed February 13, 2002.

Telephone inquiries regarding 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

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United States Patent and Trademark Office
P.O. Box 1450
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Paper No. 17

Greer Burns & Crain, LTD.
300 South Wacker Drive – Suite 2500
Chicago, IL 60606

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OFFICE OF PETITIONS

In re Application of :
Lawrence Larson et al. :
Application No. 09/595,508 : ON PETITION
Filed: June 14, 2000 :
Attorney Docket No. 0321.67684 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 13, 2003, to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to timely pay the issue fee. 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. See MPEP 711.03(c)(III)(A)(1). Therefore, the filing of a continuing application is not a proper reply under 37 CFR 1.137(a)(1) or (b)(1). In view of the authorization contained in the petition to charge any additional fees due, the $665 issue fee will be charged to Deposit Account No. 07-2069.

Petitioner is advised that the issue fee paid 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.

The application is being forwarded to Technology Center AU 2683.

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

Latrice Bond
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. 27

JOHN P. O'BRIEN
ILLINOIS TOOL WORKS INC - PATENT DEPT.
3600 WEST LAKE AVENUE
GLENVIEW IL 60025

COPY MAILED

OCT 27 2003

OFFICE OF PETITIONS

In re Application of
Mark S. Hann
Application No. 09/595,531
Filed: June 16, 2000
Attorney Docket No. ITW-12155-01

ON PETITION

This is a decision on the petition, filed October 23, 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 11, 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]

The instant petition under 37 CFR 1.313(c)(2), the RCE and the IDS, filed on October 23, 2003, are not signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of Paul F. Donovan appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he act. However, if Mr. Donovan desires to receive correspondence regarding this file, the appropriate power of attorney documentation must be submitted. A courtesy copy of this decision is being mailed to Mr. Donovan, the

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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).

petitioner herein. Until otherwise instructed, all future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

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

After receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center Art Unit 3636 for processing of the request for continued examination under 37 CFR 1.114 filed October 23, 2003.

Karen Creasy

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

cc:
**PAUL F. DONOVAN**
**ILLINOIS TOOL WORKS INC.**
**3600 WEST LAKE AVENUE**
**GLENVIEW, IL 60025**

UNITED STATES PATENT AND TRADEMARK OFFICE
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Technology Center 2100

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Paper No. 8

Eugene J. A. Gierczak
MILLER THOMSON, LLP
20 Queen Street West, Suite 2500
Toronto, ON M5H 3S1 CA, CANADA

In re Application of: Meyer et al.
Application No. 09/595,533
Attorney Docket No. 10826-07
Filed: June 16, 2000
For: SYSTEM, COMPUTER PRODUCT AND METHOD FOR PROVIDING A PRIVATE COMMUNICATION PORTAL

**DECISION ON PETITION TO MAKE SPECIAL UNDER 37 C.F.R. §1.102 and M.P.E.P. §708.02(II)**

This decision is in response to the communication filed November 20, 2002, which is being treated as a petition under 37 CFR §1.102(d), requesting to make special of the above-identified application in view of M.P.E.P. §708.02(II): Infringement.

The petition is **GRANTED**.

M.P.E.P. §708.02, Section II, 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:

> Subject to a requirement for a further showing as may be necessitated by the facts of a particular case, an application may be made special because of actual infringement (but not for prospective infringement) upon payment of the fee under 37 CFR 1.17(h) and the filing of a petition accompanied by a statement by the applicant, assignee, or an attorney/agent registered to practice before the Office alleging:
>
> (A) That there is an infringing device or product actually on the market or method in use;
>
> (B) That a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and
>
> (C) That he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the pertinent prior art.

> Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.
> Models or specimens of the infringing product or that of the application should not be submitted unless requested.

In support for the petition, Petitioners provide with a declaration of Andrew Cheung, one of the inventors, and in that has (1) identified an infringing product actually on the market or method in use that is "GoToMyPc" (Statements Nos. 6 & 7); (2) provided a rigid comparison of the alleged infringing product and/or method with the claims of the instant application (Statements Nos. 7 & 8); (3) indicated that a careful and thorough search of the prior art with a good knowledge of the pertinent prior art have been made; and (4) a statement has been made to concluded that such method steps of the identified-above product are provided substantially in the same manner as described in the instant application.

Accordingly, the Petition is **GRANTED**. The application file is being forwarded to the Examiner of record for accelerated examination according to the procedure set forth in M.P.E.P. §708.02, Section II.

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

TQD

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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**Ms. Carla Eatwell**
**NCT Group Inc.**
**6 Southgate Court**
**Annapolis, MD 21401**

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MAY 23 2006

OFFICE OF PETITIONS

In re Application of :
Owen Jones :
Application No. 09/595,558 : ON PETITION
Filed: March 8, 1999 :
Attorney Docket No. 373US-C :

This is a decision on the petition under 37 CFR 1.137(b), filed March 8, 2006, 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.

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 lacks item (3). While the petition contains the required statement of unintentional delay, the statement is

presently not acceptable. In this regard, the statement of unintentional delay is signed by the president of NCT Group, Inc., who appears to be signing the statement on behalf of the assignee in this application. However, when an assignee seeks to take action in an application before the U.S. Patent and Trademark Office, compliance with 37 CFR 3.73(b) must be satisfied in order to establish ownership in this application. For petitioner's convenience, a form under 37 CFR 3.73(b) accompanies this decision on petition, which, if properly completed, will satisfy the requirements of 37 CFR 3.73(b).

The completed Certification under 37 CFR 3.73(b) form should be accompanied by a "Renewed Petition under 37 CFR 1.137(b)," and be addressed as follows:

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.

Frances Hicks
Petitions Examiner
Office of Petitions

ATTACHMENT: Blank Certificate under 37 CFR 3.73(b)
Privacy Act Statement

PTO/SB/96 (12-05)
Approved for use through 07/31/2006. OMB 0651-0031
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.

# STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: _____

Application No./Patent No./Control No.: _____ Filed/Issue Date: _____

Entitled: _____

_____, a _____
(Name of Assignee) (Type of Assignee: corporation, partnership, university, government agency, etc.)

states that it is:

1. ☐ the assignee of the entire right, title, and interest; or

2. ☐ an assignee of less than the entire right, title and interest
(The extent (by percentage) of its ownership interest is _____%)

in the patent application/patent identified above by virtue of either:

A. ☐ An assignment from the inventor(s) of the patent application/patent identified above. The assignment was recorded in the United States Patent and Trademark Office at Reel _____, Frame _____, or a true copy of the original assignment is attached.

**OR**

B. ☐ A chain of title from the inventor(s), of the patent application/patent identified above, to the current assignee as follows:

1. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

2. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

3. From: _____ To: _____
The document was recorded in the United States Patent and Trademark Office at
Reel _____, Frame _____, or for which a copy thereof is attached.

☐ Additional documents in the chain of title are listed on a supplemental sheet.

**As required by 37 CFR 3.73(b)(1)(i), the documentary evidence of the chain of title from the original owner to the assignee was, or concurrently is being, submitted for recordation pursuant to 37 CFR 3.11.**

[NOTE: A separate copy (*i.e.*, a true copy of the original assignment document(s)) must be submitted to Assignment Division in accordance with 37 CFR Part 3, to record the assignment in the records of the USPTO. See MPEP 302.08]

The undersigned (whose title is supplied below) is authorized to act on behalf of the assignee.

_____ _____
Signature Date

_____ _____
Printed or Typed Name Telephone Number

_____
Title

This collection of information is required by 37 CFR 3.73(b). 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 12 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 FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MS. CARLA EATWELL
NCT GROUP INC.
6 SOUTHGATE COURT
ANNAPOLIS, MD 21401

COPY MAILED

JUL 26 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Owen Jones | : | |
| Application No. 09/595,558 | : | DECISION GRANTING PETITION |
| Filed: March 8, 1999 | : | UNDER 37 CFR 1.137(b) |
| Attorney Docket No. 373US-C | : | |

This is a decision on the renewed petition under 37 CFR 1.137(b), filed June 6, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the full amount of the issue fee due on or before July 19, 2005 as required by the Notice of Allowance and Fee(s) Due mailed April 19, 2005. A Notice of Abandonment was mailed on December 14, 2005.

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 $1,400 issue fee; (2) the $1,500 petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3218.

The application file is being referred to Publishing Division.

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. 3

SCOTT C. HARRIS
FISH & RICHARDSON P.C.
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO, CA 92122

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SEP 30 2002

OFFICE OF PETITIONS

In re Application of :
Anders Andersson :
Application No. 09/595,592 : NOTICE
Filed: June 15, 2000 :
Attorney Docket No. 08305/073001/ :
99-08/99-09 :

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
www.uspto.gov

Paper No. 5

FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO CA 92122

**MAILED**

FEB 2 4 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application Serial No.:

09/595,592

ON REQUEST TO
WITHDRAW AS ATTORNEY

MA

DIRECT
TECHNOLO

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
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BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

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JUL 0 1 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Wang et al. | : | |
| Application No. 09/595,672 | : | DECISION ON APPLICATION |
| Filed: June 19, 2000 | : | FOR |
| Atty Docket No. 11302-0601 | : | PATENT TERM ADJUSTMENT |
| (KC 15,993) | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed March 17, 2004. Applicants request a patent term adjustment having an additional one hundred forty-three (143) days based in part on the Office taking in excess of three years to issue the patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met.

Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

As to the application for patent term adjustment, it is **DISMISSED**.

On December 17, 2003, 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 to date is 0 days. Applicants, in effect, dispute a reduction of 88 days for applicant delay in responding to the final Office action mailed May 28, 2003.

Applicants' calculation of this delay has been considered and found to be incorrect. Applicants agree that their response in compliance with § 1.113(c) to the May 28, 2003 final Office action was not received in the Office until November 24, 2003. However, applicants calculate the period of delay pursuant to § 1.704(b) as 83 days. In fact, the period is, as shown in PAIR, 88 days (counting the number of days beginning on the day after the date that is three months after the date of mailing of the Office communication, August 29, 2003, and ending on the date the reply was filed, November 24, 2003).

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is zero (0) days (including 45 days of Office delay and 143 days of applicant delay).

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). This fee is required and will not be waived. No additional fees are required.

The Office of Patent Publication has been advised of this decision. The application is, thereby, being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of 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.

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA VA 22304

**COPY MAILED**

APR 23 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Raviv Laor | : | |
| Application No. 09/595,677 | : | ON APPLICATION FOR |
| Filed: June 19, 2000 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. | : | |
| OCLP-3-LAOR-US | : | |

This is in response to the 37 CFR 1.705 APPLICATION FOR PATENT TERM ADJUSTMENT filed on October 29, 2008. Applicant requests that the determination of patent term adjustment be increased by 173 days, or the number of days in excess of three (3) after the date the application was filed until a request for continued examination was filed. Applicant requests this correction on the basis that the Office will take in excess of three years to issue this patent and in light of the recent court decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. September 30, 2008).

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered

pursuant to § 1.703(b)). It is noted that at the time of this decision, the patent has not issued.

Applicant is given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

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. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Nancy Johnson
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
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Paper No.

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA VA 22304

MAILED

APR 16 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 7,599,850 | : | DECISION ON REQUEST |
| Raviv Laor | : | FOR |
| Issue Date: October 6, 2009 | : | RECONSIDERATION OF |
| Application No. 09/595,677 | : | PATENT TERM ADJUSTMENT |
| Filed: June 19, 2000 | : | and |
| Atty Docket No. | : | NOTICE OF INTENT TO ISSUE |
| OCLP-3-LAOR-US | : | CERTIFICATE OF CORRECTION |

This is a decision on the petition filed on October 29, 2009, which is being treated as a petition under 37 CFR 1.705(d) requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by two thousand eighty-five (2085) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by two thousand eighty-four (2084) is **GRANTED to the extent indicated herein.**

As the period from the filing date of the request for continued examination (RCE) to the issue date of the patent is not included in the "B" delay period, the over three year period begins on June 20, 2003 and ends on December 8, 2003, the day before the RCE was filed, and is 172 (not 173) days. See 35 U.S.C. 154(b)(1)(B)(i). As such, the patent term adjustment is 2084, not 2085 days.

The Office will *sua sponte* issue a certificate of correction. Pursuant to 37 CFR 1.322, the Office will not issue a certificate of correction without first providing assignee or patentee an opportunity to be heard. Accordingly, patentees are given **one (1) month or thirty (30) days**, whichever is longer, from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

The application is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **two thousand eighty-four (2084)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3231.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,599,850 B1

DATED : **October 6, 2009** **DRAFT**

INVENTOR(S) : Laor

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,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 1912 days.

Delete the phrase "by 1912 days" and insert – by 2084 days--

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. 7

JOSEPH S TRIPOLI
PATENT OPERATIONS
THOMSON MULTIMEDIA LICENSING INC-CN 5312
PRINCETON, NJ 08543-0028

COPY MAILED

JUN 0 4 2004

OFFICE OF PETITIONS

In re Application of :
Didier Doyen, et al. :
Application No. 09/595,739 : ON PETITION
Filed: June 16, 2000 :
Attorney Docket No. RCA 90, 222 :

This is a decision on the petition, filed May 27, 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 March 14, 2003, 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) was obtained. A Notice of Abandonment was mailed on October 22, 2003. On May 27, 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 AU 2613 for consideration of the amendment filed May 27, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

# 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) |
|---|---|---|---|---|
| 6668199 | 2003-12-23 | 09/595,759 | 2000-06-16 | P201-BF |

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 | /Alessandro Steinfl Reg. No. 56,448/ | Date (YYYY-MM-DD) | 2008-03-17 |
| Name | Alessandro Steinfl | Registration Number | 56448 |

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. 6668199
Issue Date: December 23,2003
Application No. 09595759
Filed: June 16,2000
Attorney Docket No. 856063.654

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

This is a decision on the electronic petition, filed March 17,2008 ,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 March 17,2008 . 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
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Paper No. 17

**APPLIED MATERIALS INC**
**2881 SCOTT BLVD., M/S 2061**
**SANTA CLARA, CA 95050**

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JUN 06 2003

OFFICE OF PETITIONS

In re Application of :
Joseph M. Ranish :
Application No. 09/595,765 :
Filed: June 16, 2000 :
Attorney Docket No. 03998-437001 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 9, 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 July 31, 2002, 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 November 1, 2002.

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.

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 2875 for processing of the request for continued examination (RCE) under 37 CFR 1.114.

Wan Laymon

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

cc: PENNIE & EDMONDS
1155 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-2711

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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FEB 05 2007

OFFICE OF PETITIONS

HUFFMAN LAW GROUP, P.C.
1900 MESA AVE.
COLORADO SPRINGS CO 80906

In re Application of :
Enric Musoll et al :
Application No. 09/595,776 : ON PETITION
Filed: June 16, 2000 :
Attorney Docket No. MIPS.0166-00-US :

This is a decision on the petition, filed January 31, 2007, 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 31, 2007 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 2183 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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 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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MAR 12 2004

| | | |
|---|---|---|
| In re Application of | : | |
| Grimbergen et al. | : | |
| Serial Number : 09/595,778 | : | WITHDRAWAL |
| Filed : June 16, 2000 | : | FROM |
| For : APPARATUS AND METHOD | : | ISSUE |
| FOR MONITORING PROCESSING | : | |
| OF A SUBSTRATE | : | |

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue pursuant to 37 CFR 1.313.

The application is being withdrawn to permit reopening of prosecution. The reasons therefore will be communicated to you by the examiner.

PTO records reveal that the issue fee has not been paid. If the issue fee has been submitted, the applicant may request a refund or may request that the fee be credited to a deposit account. However, applicant may wait until the application is either again found allowable or held abandoned. If the application is allowed, upon receipt of a new Notice of Allowance and Issue Fee Due, applicant may request that the previously submitted issue fee to applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due. If the application is abandoned, applicant may request either a refund or a credit to a deposit account.

The application is being forwarded to the examiner for action.

JMStone

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

APPLIED MATERIALS, INC.
2881 SCOTT BLVD. M/S 2061
SANTA CLARA CA 95050

cc:Allowed Files, Pk3-910

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
www.uspto.g

MAIL

Paper No. 16

Laura Majerus
FENWICK & WEST LLP
Two Palo Alto Square
Palo Alto, CA 94306

APR 25 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
Daniel Schreiber
Application No. 09/595,814
Filed: June 16, 2000
For: METHOD AND APPARATUS FOR PREVENTING REUSE OF TEXT, IMAGES, AND SOFTWARE TRANSMITTED VIA NETWORKS

**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed February 19, 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 February 19, 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: Marc Sockol
SQUIRE, SANDERS & DEMPSEY L.L.P.
600 Hansen Way
Palo Alto, CA 94304-1043

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAR 0 6 2003

Technology Center 2100

Paper No. 16

Laura A. Majerus
FULBRIGHT & JAWORSKI L.L.P.
865 South Figueroa Street
29 Floor
Los Angeles, CA 90017-2576

In re Application of:
Daniel Schreiber
Application No. 09/595,839
Filed: June 16, 2000
For: METHOD AND APPARATUS FOR PREVENTING REUSE OF TEXT, IMAGES AND SOFTWARE TRANSMITTED VIA NETWORKS

**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed February 14, 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 signed by Laura A. Majerus alone and does not contain a clear indication that Ms. Majerus is authorized to sign on behalf of the other attorneys of record and is signing on behalf of the other attorneys of record. Furthermore, there is no indication that Applicant has been notified of the request for withdrawal.

Accordingly, the request is **DENIED**.

All future communications from the United States Patent and Trademark Office (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.

James R. Matthews

for Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture and Software
(703) 305-9750

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

THELEN REID & PRIEST
P O BOX 640640
SAN JOSE, CA 95164-0640

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JUN 15 2006

OFFICE OF PETITIONS

In re Application of
Jean-Rene Lequepeys et al
Application No. 09/595,893
Filed: June 20, 2000
Attorney Docket No. 034299-259

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 April 20, 2006.

The request is **NOT 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 cannot be approved because no reasons for withdrawal have been provided. The Office cannot, at this time, determine whether practitioner's request is one of the mandatory or permissive reasons enumerated in 37 CFR 10.40. Any subsequent requests must include reasons for withdrawal. Please note that there is a space provided for on PTO/SB/83 (Request to Withdraw as Attorney or Agent) to supply practitioner's reasons.

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicants.

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

This application is being referred to Technology Center AU 2611 to await a reply to the non-final Office action mailed February 7, 2006.

Amelia Au
Petitions Examiner
Office of Petitions

cc: BERKELEY LAW & TECHNOLOGY GROUP
ATTN: JESSICA A HARVEY
1700 NW 167TH PLACE, SUITE 240
BEAVERTON, OR 97006

UNITED STATES PATENT AND TRADEMARK OFFICE

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**CLAUDE F. MONDIERE, M.D.**
**P.O. BOX 460-301**
**HOUSTON TX 77056**

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SEP 18 2008

Patent No. 6,406,267 :
Application No. 09/595,984 :
Filed: June 16, 2000 : ON PETITION
Issued: June 18, 2002 :
Title: Extracorporeal Circulation Pump :

This is a decision on the petition under 37 CFR 1.378(c), filed August 14, 2008, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED**.

**A petition under 37 CFR 1.378(c) must be filed within twenty-four months after the six month grace period specified in 35 USC 41(b).** The patent issued on June 18, 2002. The six month grace period for the instant patent expired at midnight on June 18, 2006. Accordingly, an unintentional petition to reinstate the instant patent must have been submitted no later than June 18, 2008. Since the original petition was filed on August 14, 2008, it was not timely filed and the instant patent will not be reinstated under the unintentional provisions of 37 CFR 1.378(c).

Patentee may wish to pursue reinstatement of the patent under the unavoidable provisions of 37 CFR 1.378(b). A petition to accept the delayed payment of a maintenance fee under 35 USC 41(c) and 37 CFR 1.378(b) must be accompanied by (1) an adequate, verified showing that the delay was unavoidable, since reasonable care was taken to insure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent, (2) payment of the appropriate maintenance fee, unless previously submitted, and (3) payment of the surcharge set forth in 37 CFR 1.20(i)(1).

If petitioner does not wish to pursue reinstatement of this expired patent, petitioner may request a refund of the $465.00 maintenance fee and the $1,640 surcharge fee submitted with the petition. The request should be made in writing and addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

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 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. Petitioner should note that a change of correspondence address would not affect the fee address. Therefore, if petitioner desires to receive future correspondence, which **may** be mailed regarding maintenance fees for the above-identified patent, the "fee address" and/or "customer number" forms should be submitted.

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 Window located at:
U.S. Patent and Trademark Office
Customer Service Window Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Any questions concerning this matter may be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

cc:

DR. CLAUDE MONDIERE
1702 ENTERPRISE STREET
ATHENS, TX 75751

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. 9

CROMPTON CORPORATION
LEGAL DEPARTMENT
199 BENSON ROAD
MIDDLEBURY, CT 06749

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APR 0 7 2003

OFFICE OF PETITIONS

In re Application of
Wangqi Hou et al
Application No. 09/595,996
Filed: June 16, 2000
Attorney Docket No. W32.2-8510

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 24, 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 September 27, 2001, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 28, 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

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

cc:

Michelle J. Burke
Akzo Nobel Inc.
Intellectual Property Department
7 Livingstone Avenue
Dobbs Ferry, NY 10522-3408

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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James P. Krueger
Fitch, Even, Tabin & Flannery
120 South LaSalle Street
Suite 1600
Chicago, IL 60603

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SEP 0 6 2005

OFFICE OF PETITIONS

In re Application of
BIEDERMANN, et al.
Application No.: 09/596,086
Filed: June 16, 2000
Attorney Docket No.: 69054

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed May 18, 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 March 22, 2004, which set a shortened statutory period for reply of three (3) months. While a timely reply was filed on August 23, 2004 (reply was accompanied by petition for a two-month extension of time with certificate of mailing of August 23, 2004), that reply did not prima facie place this application in condition for allowance as indicated by the Advisory Action of September 13, 2004. A Notice of Appeal was not filed. Accordingly, by operation of law, the above-identified application became abandoned on August 23, 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 March 22, 2004 is accepted as having been unintentionally delayed.

The application is being referred to Technology Center AU 1624.

Telephone inquires concerning this decision should be directed to Derek A. Putonen at (571) 272-3294 or in his absence, the undersigned at (571) 272-3217

Frances Hicks for

Brian Hearn
Petitions Examiner
Office of Petitions

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. 22

Allen C. Turner
Trask Britt
PO Box 2550
Salt Lake City, UT 84110

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MAY 2 2 2003

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Baetselier et al. | : | |
| Application No. 09/596,101 | : | ON PETITION |
| Filed: June 16, 2000 | : | |
| Attorney Docket No. 4432US | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed October 31, 2002.

The petition is Dismissed as moot.

A review of the file reveals that in reply to the Final Office action mailed April 9, 2002, a one-month extension of time accompanied by an Amendment were submitted via facsimile transmission on July 19, 2002. Therefore, the petition to revive is unnecessary since the application is not abandoned.

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 1645 for further processing.

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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ALEXANDRIA, VA 22313-1450
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Paper No. 27

Allen C Turner
TRASK BRITT
P O Box 2550
Salt Lake City, UT 84110

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SEP 0 4 2003
OFFICE OF PETITIONS

In re Application of :
De Baetselier :
Application No. 09/596,101 :
Filed: June 16, 2000 :
Attorney Docket No. 4432US :

DECISION ON PETITION

This is a decision on the "Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 C.F.R. § 1.137(b)," filed August 21, 2003.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a timely and proper reply to the final Office action mailed April 9, 2002. An amendment had been filed on July 19, 2002 (along with an extension of time for response within the first month and extension fee); however, the amendment was determined by the examiner not to place the application in condition for allowance (Advisory Action mailed June 17, 2003). No proper reply having been filed and no further extension of time obtained, the application became abandoned effective August 10, 2002. The instant petition precedes the mailing of a courtesy Notice of Abandonment.

An initial petition under § 1.137(b), filed October 31, 2002 was dismissed as moot (Decision mailed May 22, 2003). Because the examiner had not yet acted on the amendment filed July 19, 2002, as of the time of consideration of the petition, it had not yet been determined that the amendment was not a proper reply and thus, the application was abandoned. Rather then dismiss the petition as moot, the application file should have been forwarded to the examiner for such a determination.

Nonetheless, on instant renewed petition, petitioner filed the required reply in the form of a request for continuing examination under § 1.114 (RCE), with an amendment as the submission, and payment of the RCE fee. Petitioner has met all other requirements for a grantable petition under § 1.137(b).

The application file is being forwarded to Technology Center 1645 for consideration of the RCE and amendment by the examiner.

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-0309.

Nancy Johnson
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. 8

MAY 4 2001

Joseph R. Snyder
TOWNSEND and TOWNSEND and CREW L.L.P.
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834

| | | |
|---|---|---|
| In re Application of: | : | |
| Steven A. Sunshine et al. | : | |
| Application No. 09/596,169 | : | DECISION ON PETITION |
| Filed: June 16, 2000 | : | TO MAKE SPECIAL |
| Attorney Docket No. 18564-003610US | : | |

This is a decision on the petition under 37 C.F.R. § 1.102, filed March 05, 2001, to make the above-identified application special.

Petitioner requests that the above-identified application be made special under the accelerated examination procedure set forth in the Manual of Patent Examining Procedure (M.P.E.P.), Section 708.02, Item VIII: Accelerated Examination.

A grantable petition to make special under 37 C.F.R. § 1.102, and in accordance with M.P.E.P., Section 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 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 second petition contains items (a)-(e) in accordance with M.P.E.P., Section 708.02, Item VIII.

Accordingly, the petition is granted.

The application is being forwarded to the examiner for examination under the accelerated examination procedure.

If the examiner determines that restriction is necessary, he/she will follow the established telephone practice to resolve the restriction. If applicant elects with traverse the application will be forwarded to the Special Programs Examination unit to vacate this decision, and the application will be taken up by the examiner for action in its regular turn.

If the examiner can make this application special without prejudice to any possible interfering applications, and he/she should make a rigid search for such, he/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/she should consider such application simultaneously with this application and should state in the official letter of such application that she/he 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.

After allowance, this application will be given priority for printing. See M.P.E.P. Section 1309.

The petition is granted to the extent indicated.

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

HHP:lmm

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. 111904

Townsent and Townsend and Crew, LLP
Two Embarcadero Center
Eighth Floor
San Francisco, CA 94111-3834

In re Application of:
Steven A. Sunshine et al.
Serial No.: 09/596169
Filed: June 16, 2000
Attorney Docket No.: **018564-003610US**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney/agent of record under 37 C.F.R. § 1.36, filed March 8, 2004.

A grantable request to withdraw as attorney of record must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of others. A request to withdraw will not be approved unless at least thirty (30) 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 meets all the above stated requirements. The request was signed by Joseph R. Snyder, on behalf of himself and all the attorneys/agents of record. There is no outstanding Office action at this time.

The request is **APPROVED**.

There are no attorneys/agents of record at this time.

All future communications from the Office will be directed Foley & Lardner, at the below address, until otherwise notified by applicant.

Inquiries related to this decision should be directed to Hien Phan at (571) 272-1606.

Hien Phan, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Foley & Lardner
3000 K St. N.W., Suite 500
Washington, DC 20007

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. 18

RENEE S. POLIZOTTO
HYSEQ INC
670 ALMANOR AVENUE
SUNNYVALE, CA 94086

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MAY 2 0 2003

OFFICE OF PETITIONS

In re Application of :
Dana A. Haley et al :
Application No. 09/596,196 : NOTICE
Filed: June 17, 2000 :
Attorney Docket No. HYS-14 :

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 Publishing Division.

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

CC: NUVELO
675 ALMANOR AVENUE
SUNNYVALE, CA 94086

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

LOTUS DEVELOPMENT CORPORATION
STEPHEN T KEOHANE ESQ
LDB 600 8W
55 CAMBRIDGE PARKWAY
CAMBRIDGE , MA 02142

**COPY MAILED**

**JUN 2 2 2001**

**OFFICE OF PETITIONS**
**A/C PATENTS**

In re Application of :
Kraenzel, et al. :
Application No. 09/596,282 : DECISION ON PETITION
Filed: June 19, 2000 :
Attorney Docket No. LOT9 2000 :
00 :

This is a decision on the Petition under 37 CFR 1.182, filed December 18, 2000 (Certificate of Mailing dated December 13, 2000), 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. Carl J. Kraenzel
2. John D. Immerman
3. Charles W. Kaufmann
4. Suze Berthold

This application is being forwarded to Technology Center 2100 via Application Branch Data Input to change the order of inventorship.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions 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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P.O. Box 1450
Alexandria, VA 22313-1450
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**AMIN & TUROCY**
**24TH FLOOR, NATIONAL CITY CENTER**
**1900 EAST NINTH STREET**
**CLEVELAND, OH 44114**

COPY MAILED

JUL 0 7 2005

OFFICE OF PETITIONS

In re Application of :
Eric J. Horvitz et al :
Application No. 09/596,365 : ON PETITION
Filed: June 17, 2000 :
Attorney Docket No. 1018.101US1 :

This is a decision on the petition, filed October 4, 2004. The petition asserts timely response to an Office action and is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment for the above-identified application.

The petition is **GRANTED**.

On January 14, 2004, a final Office action was mailed, setting forth a 3-month shortened statutory reply period.

On April 14, 2004, Applicants filed a proposed amendment which, as indicated in the April 28, 2004 Advisory Action, did not place the application in condition for allowance and was not entered by the Examiner. The Advisory action also pointed out that the reply period would remain that set forth in the January 14, 2004 final Office action.

No further response was filed on or before April 14, 2004 and no extension of time under 37 CFR 1.136(a) was obtained. The application was held abandoned as of April 15, 2004.

The instant petition asserts that a response was submitted by facsimile on May 3, 2004. In support, the petition is accompanied by a copy of the purportedly transmitted paper: a request for continued examination (RCE) and an authorization to charge Deposit Account No. 50-1063 for the following fees: RCE, Extension of time fee; and Any other fees.

In view of the above, the RCE should have been considered timely filed on May 3, 2004, and the application should not have been held abandoned.

The holding of abandonment in this application is hereby withdrawn, and the September 2, 2004 Notice of Abandonment vacated. The petition is thus granted.

As authorized, the $770 RCE fee and $110 for a one month extension of time is being charged to

petitioner's Deposit Account No. 50-1063. The $1,370 petition fee enclosed with the petition has been credited to petitioner's credit card.

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

This matter is being referred to Technology Center AU 2154.

Karen Creasy

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

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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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JEFFREY S. WHITTLE
ALLEN DYER DOPPELT MILBRATH & GILCHRIST P A
255 S ORANGE AVENUE
SUITE 1401
ORLANDO, FL 32802-3791

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MAY 0 8 2006
OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Gerald A. Pierson | : | |
| Application No. 09/596,374 | : | DECISION ON PETITION |
| Filed: June 19, 2000 | : | TO WITHDRAW |
| Attorney Docket No. 00-CIP-23111 | : | 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, 2005.

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 Enrique G. Estevez on behalf of the listed attorneys/agents.

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

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: Jeffrey Whittle
711 Louisiana Street, Suite 2300
Houston, TX 77002-2781

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JUL 2 1 2006

OFFICE OF PETITIONS

Greenlee, Winner and Sullivan, P.C.
4875 Pearl East Circle, Suite 200
Boulder, CO 80301

In re Application of
Goodrich Jr. et al.
Application 09/596,429
Filed: June 15, 2000
Atty Docket No. 27-98B

: DECISION GRANTING PETITION

This decision is in response to applicant's "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705" timely[1] filed on April 14, 2006. Applicants' request that the patent term adjustment at the time of the notice of allowance be adjusted to reflect a determination of seven hundred and seven (707) days.

The application for patent term adjustment is **GRANTED**. The Office will adjust the PTA calculation to reflect a PTA amount of seven hundred and seven (707) days at the time of the mailing of the notice of allowance.

Applicants assert that the Office erred in assessing a PTA delay of 133 days under 37 CFR 1.704(b) for the reply to the non-final rejection received by the Office on January 14, 2005. Applicants assert that the response was only 44 days delayed because the Office mailed a notice restarting applicants' response clock.[2] Accordingly, applicants assert that the applicant should receive an additional 89 days of patent term and that such amount should be 707 days of PTA at the time of the mailing of the notice of allowance. Applicants did not contest any of the other delays, either applicant or USPTO.

Applicants' arguments are persuasive. A review of the file reveals that the Office did mail a notice to applicants on September 1, 2004 restarting the period of response. Accordingly, applicants could reply on/before December 1, 2004 without any PTA penalty under 37 CFR 1.704(b). Because applicants' response was filed on January 14, 2005, a delay of 44 days should have been assessed. The one hundred and thirty-three (133) day assessment was in error. Accordingly, the correct amount of USPTO delay is 780 days (727 days pursuant to 37 CFR 1.702(a)(1) and 53 days pursuant to 37 CFR 1.702(a)(2)). Applicants delay amount to 73 (44 +

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[1]Issue fee paid on April 14, 2006.

[2]The Office mailed the Office action on 6/3/2004 and mailed a letter to applicants on 9/1/2004 notifying applicants that the response period had been restarted.

29) days pursuant to 37 CFR 1.704(b). Accordingly, 707 days of PTA is proper (780-73 =707).

After the mailing of this Office action, the file will be forwarded to the Office of Patent Publication for a prompt issuance of the patent. Any USPTO delays under 37 CFR 1.702(a)(4) or 1.702(b) will be added to the determination at the time of the issuance of the patent and will be reflected in the issue notification letter that is mailed to applicants approximately three weeks prior to issuance.

The $200.00 application fee has been assessed. No additional fees are required. The Office had additionally assessed a $400.00 fee that was not required. Accordingly, the Office will refund $400.00.

Any questions directed to this application should be directed to Kery A. Fries, Senior Legal Advisor, at 571-272-7757.

Kery A. Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner for Patent
Examination Policy

cc: Copy of Adjusted PAIR calculation

Pet. Dec.

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

Mailed: 11/3/04

| | | |
|---|---|---|
| In re application of | : | |
| Andrew Booth et al. | : | DECISION ON |
| Serial No. 09/596,549 | : | PETITION |
| Filed: June 19, 2000 | : | |
| For: THICK FILM HEATER APPARATUS | | |

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed January 8, 2004.

The instant petition was filed on June 7, 2004. In the petition, it is urged that the final office action mailed January 8, 2004 was improperly made final.

**DECISION**

It is noted that a Request for Continued Examination was filed by applicants on September 8, 2004, thereby making the instant petition moot. Accordingly the petition is **DISMISSED.**

JMStone

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

PATENT ADMINSTRATOR
KATTEN MUCHIN ZAVIS ROSENMAN
525 WEST MONROE STREET
SUITE 1600
CHICAGO IL 60661-3693

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JEFFREY S. WHITTLE
ALLEN DYER DOPPELT MILBRATH & GILCHRIST P A
P.O. BOX 3791
ORLANDO, FL 32802-3791

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MAY 18 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Colin Allmark | : | |
| Application No. 09/596,565 | : | DECISION ON PETITION |
| Filed: June 19, 2000 | : | TO WITHDRAW |
| Attorney Docket No. 24124 | : | 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, 2005.

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 Enrique G. Estevez on behalf of the listed attorneys/agents. Jeffrey S. Whittle remains of record.

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

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: Jeffrey Whittle
711 Louisiana Street, Suite 2300
Houston, TX 77002-2781

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. 5

STEPHEN T. KEOHANE, ESQ.
LOTUS DEVELOPMENT CORPORATION
55 CAMBRIDGE PARKWAY
CAMBRIDGE, MA 02142

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JAN 0 9 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
John D. Immerman et al :
Application No. 09/596,745 : ON PETITION
Filed: June 19, 2000 :
Attorney Docket No. LOT9-2000-0011 US1 :

This is a decision on the petition under 37 CFR 1.182, filed December 18, 2000, 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. **Carl J. Kraenzel**

2. **John D. Immerman**

3. **William A. Mills**

4. **Jeannie J. Lu**

This application is being forwarded to Technology Center Art Unit 2755.

Karen Creasy

Karen Creasy
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. 4

SCOTT C. HARRIS
FISH & RICHARDSON P.C.
4350 LA JOLLA VILLAGE DRIVE, SUITE 500
SAN DIEGO, CA 92122

COPY MAILED

SEP 3 0 2002

OFFICE OF PETITIONS

In re Application of :
Yibing Michelle Wang et al :
Application No. 09/596,757 :
Filed: June 15, 2000 :
Attorney Docket No. 08305/074001 / 99-15 :

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

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Paper No. 6

FISH & RICHARDSON, PC
4350 LA JOLLA VILLAGE DRIVE
SUITE 500
SAN DIEGO CA 92122

**MAILED**

JAN 3 1 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application Serial No.:

09/596,757

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
Washington, D.C. 20231
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Paper No. 5

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MAR 30 2001

OFFICE OF PETITIONS
A/C PATENTS

LOTUS DEVELOPMENT CORPORATION
55 CAMBRIDGE PARKWAY
CAMBRIDGE, MA 02142

In re Application of
Kraenzel et al.
Application No. 09/596,783 : ON PETITION
Filed: 19 June, 2000 :
Attorney Docket No. LOT9-2000-00 :

This is a decision on the petition under 37 CFR 1.182, filed on 18 December, 2000, 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. Carl J. Kraenzel
2. John D. Immerman
3. William A. Mills
4. Mark A. Nowacki
5. Jeanne J. Lu

Counsel's deposit account, No. 12-2158, will be charged the $130.00 petition fee.

This application is being forwarded to Technology Center 2100 via Application Branch Data Input to change the order of inventorship.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 308-6918.

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
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Michael L. Goldman
Nixon Peabody LLP
Clinton Square
P O Box 31051
Rochester, NY 14603

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DEC 10 2004

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bogdanove, et al. | : | LETTER REGARDING PTA |
| Application No. 09/596,784 | : | |
| Filed: June 19, 2000 | : | |
| Atty. Dkt. No. 19603/3296 | : | |
| (CRF D-2098B) | : | |

The above-identified application file has been referred to the Office of Patent Legal Administration for consideration of the "REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT," filed August 11, 2004. The Office thanks applicant for their good faith and candor in bringing this to our attention.

The correct Patent Term Adjustment at the time of the Determination of Patent Term Adjustment is 0 days.

The Office will adjust the PAIR screen to reflect that the Patent Term Adjustment (PTA) determination at the time of mailing of the Notice of Allowance reflects an adjustment of 0 days. A copy of the updated PAIR screen showing the correct determination is enclosed.

Applicants request recalculation of the patent term adjustment of the instant application.

A review of the application history reveals that the initial patent term adjustment of 124 days is in error.

A delay of 116 days can be attributed to the Office under 37 CFR 1.703(a)(1). The delay began August 26, 2003, the day after the date that is four months after the date the request for continued examination ("RCE") under 37 CFR 1.114 was filed, and ended December 19, 2003, the date the non-final Office action was mailed in response to the RCE.

The delay of 116 days is reduced a total of 202 days for applicants' failure to engage in reasonable efforts to conclude

prosecution. A reduction of 105 days under 37 CFR 1.704(b) can be attributed to applicants. The delay began September 6, 2001, the day that is three months after the date the non-final Office action was mailed, and ended December 19, 2001, the date a response to the non-final Office action was filed. A further reduction of 97 days under 37 CFR 1.704(b) can be attributed to applicants. The delay began June 22, 2002, the date that is three months after the date final Office action was filed, and ended September 27, 2002, the date a notice of appeal was filed.

As applicant is advising us of an error in providing too much patent term adjustment in this application, no fee is due in connection to this matter.

This application will be forwarded to the Publishing Branch for timely issuance of a patent.

Any inquiries regarding this matter may be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kerry A. Ferriter for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Officer of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Adjustment PAIR Calculation

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov
DIW 03-01

Paper No. 6

STEPHEN T. KEOHANE, ESQ.
LOTUS DEVELOPMENT CORPORATION
55 CAMBRIDGE PARKWAY
CAMBRIDGE, MA 02142

**COPY MAILED**

**MAR 30 2001**

**OFFICE OF PETITIONS**
**A/C PATENTS**

In re Application of
Kraenzel et al.
Application No. 09/596,845 : ON PETITION
Filed: 19 June, 2000 :
Attorney Docket No. LOT9 2000 00 :

This is a decision on the petition under 37 CFR 1.182, filed on 18 December, 2000, 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. Carl J. Kraenzel
2. John D. Immerman
3. William A. Mills
4. Jeanne J. Lu

Counsel's deposit account, No. 12-2158, will be charged the $130.00 petition fee.

This application is being forwarded to Technology Center 2700 via Application Branch Data Input to change the order of inventorship.

Telephone inquiries concerning this matter may be directed to the undersigned 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
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In re Patent No. 6214202
Issue Date: April 10,2001
Application No. 09596852
Filed: June 19,2000
Attorney Docket No. IL-10574

:

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

:

This is a decision on the electronic petition, filed September 18,2009 ,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 September 18,2009 . 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) |
|---|---|---|---|---|
| 6214202 | 2001-04-10 | 09596852 | 2000-06-19 | IL-10574 |

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 | /John H. Lee, #59,193/ | Date (YYYY-MM-DD) | 2009-09-18 |
| Name | John H. Lee | Registration Number | 59193 |

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

Paper No. 15

HOWREY SIMON ARNOLD & WHITE, LLP
750 BERING DRIVE
HOUSTON, TX 77210-2198

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APR 05 2004

OFFICE OF PETITIONS

In re Application of
Menard et al.
Application No. 09/596,876
Filed: June 19, 2000
Attorney Docket No. 12554.0004.NPUS00

ON PETITION

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

The petition is **granted.**

This application became abandoned for failure to timely and properly reply within three months to the final Office action mailed August 20, 2002. A two-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, this application became abandoned on January 21, 2003. A Notice of Abandonment was mailed on March 12, 2003.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

Effective October 1, 2003, the petition fee was increased from $650.00 to $665.00. Accordingly, petitioner's deposit account will be charged $665.00 as authorized.

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 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.

The file is now being forwarded to Technology Center 2800 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

cc: MATTHEW ZISES
HOWREY SIMON ARNOLD & WHITE, LLP
P.O. BOX 4433
HOUSTON, TX 77210-4433

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

PVF -- PARC
c/o PARK, VAUGHAN & FLEMING LLP
2820 FIFTH STREET
DAVIS CA 95618-7759

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DEC 17 2007

**OFFICE OF PETITIONS**

In re Application of :
Berson, et al. : DECISION ON PETITION
Application No. 09/596,924 :
Filed: June 19, 2000 :
Dkt. No.: PARC-DA0461-US-NP :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed October 5, 2007.

The Notice of Abandonment, mailed July 5, 2007, states the application is abandoned for failure to timely submit a proper reply to the final Office action mailed January 27, 2005. The final Office action set a three month shortened statutory period of time for reply.

Petitioners assert that a response to the final Office action was timely filed April 25, 2005. Petitioners further argue that a reply to the non-final Office action mailed October 18, 2005 was timely submitted January 18, 2006.

The original responses referenced by petitioners have been located in the application file.

In view of the evidence thereof, the petition to withdraw the holding of abandonment is hereby **GRANTED**.

The Notice of Abandonment is hereby **VACATED** and the holding of abandonment is **WITHDRAWN**.

The application file is being forwarded to Technology Center 2100 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
www.uspto.gov

Patent No : 7,421,583
Inventors: : Thomas a. Berson, et. al.
Ser. No. : 09/596,924
Issued : September 2, 2008
Title : SYSTEM, METHOD AND ARTICLE OF MANUFACTURE FOR DETERMINING A PRICE OF CRYPTOGRAPHIC SERVICES BASED ONA COMPUTATIONAL BURDEN THEREOF
Docket No. : PARC-DA0461-US-NP

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. , Davis 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 Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) **308-9390 ext. 124** or 105

Shuyn Yao
Park, Vaughan & Fleming LLP
2820 5th Street
Davis, CA 95618

ej

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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PVF -- PARC
c/o PARK, VAUGHAN & FLEMING LLP
2820 FIFTH STREET
DAVIS CA 95618-7759

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| | | |
|---|---|---|
| In re Application of | : | |
| Berson et al. | : | |
| Application No. 09/596924 | : | DECISION |
| Filing or 371(c) Date: 06/19/2000 | : | ON PETITION |
| Patent No.: 7421583 | : | |
| Issue Date: 09/02/2008 | : | |
| Attorney Docket No.: PARC-DA0461-US-NP | : | |

This is a decision on the request for Petition to Correct Assignee Under 37 C.F.R. S 3.81(b), filed October 8, 2008, requesting correction of the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The Petition is **granted**.

The petition was accompanied by a certificate of correction as required by 3.81(b), and the fee submitted with the present petition. Further, Office assignment records reflect that XEROX CORPORATION is the assignee of record. As the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to be processed.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a certificate of correction after issuance of this application into a patent.

/Derek L. Woods/
Derek L. Woods
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. 13

DAVID A. BURGE, ESQ.
DAVID A. BURGE CO., LPA.
POST OFFICE BOX 221011
CLEVELAND, OH 44122-0992

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JUN 1 0 2003

OFFICE OF PETITIONS

In re Patent No. 6,490,895
Issue Date: December 10, 2002
Application No. 09/596,951
Filed: June 16, 2002
Attorney Docket No. 5-629

ON PETITION

This is a decision on the petition, filed May 2, 2003, requesting issuance of duplicate Letters Patent for the above-identified patent.

The petition is dismissed.

The file record discloses that the instant application matured into U.S. Patent No. 6,490,895 on December 10, 2002. However, petitioner contends that the patent was never received.

The showing required to establish non-receipt of an Office communication (in the instant case, the letters patent) 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 or any mail log where the non-received Office communication would have been entered had it been received must be attached to and referenced in practitioner's statement.

Petitioner should submit a copy of their docket record or mail log for the instant application that indicates non-receipt of the letters patent.

Please note, 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.

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

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

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

Any questions concerning this matter may be directed to the undersigned at (703) 306-9200.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

cc.
LOW AND LOW
P.O. BOX 2184
ARLINGTON, VA 22202

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. 4

MICHAEL C HLAVATY
C/O DEERE & COMPANY
ONE JOHN DEERE PLACE
MOLINE , IL 61265-8098

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NOV 0 8 2000

OFFICE OF PETITIONS
DECISION ON PATENTS
PETITION

In re Application of:
THORMAN, CHRISTOPHER SCOTT, *et al.*
Application No. 09/597,069
Filed: 06/20/2000
Attorney Docket No. 15301-US
Title of Invention :
CLEANING DEVICE FOR A MOWER CUTTING CHAMBER

This is a decision on the petition under 37 C.F.R. §1.10(c), filed September 19, 2000, requesting that the above-identified application be accorded a filing date of June 19, 2000, rather than the presently accorded filing date of June 20, 2000.

**THE RULE**

*37 C.F.R. § 1.10 Filing of correspondence by "Express Mail."*

(a)...

(b)...

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d)...

...

**ANALYSIS**

This petition lacks a true copy of the Express Mail mailing label as required under 37 C.F.R. §1.10(c)(3) above.

In view of the above, *this 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 C.F.R. §1.136(a) are permitted. *37 C.F.R. §1.137(d).* The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)".

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

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
Four Crystal Plaza, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Petitions Attorney Scott M. Ledford in the Office of Petitions at (703) 306-5593.

Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Assistant 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. 9

OFFICE OF PETITIONS
A/C PATENTS

MICHAEL C HLAVATY
C/O DEERE & COMPANY
ONE JOHN DEERE PLACE
MOLINE , IL 61265-8098

In re Application of:
THORMAN, CHRISTOPHER SCOTT, *et al.*
Application No. 09/597,069
Filed: 06/20/2000
Attorney Docket No. 15301-US
Title of Invention :
CLEANING DEVICE FOR A MOWER CUTTING CHAMBER

DECISION ON PETITION

This is a decision on the renewed petition under 37 C.F.R. §1.10(c), filed December 11, 2000, requesting that the above-identified application be accorded a filing date of June 19, 2000, rather than the presently accorded filing date of June 20, 2000.

**THE RULE**

*37 C.F.R. § 1.10 Filing of correspondence by "Express Mail."*

(a)...

(b)...

(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" and

(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit.

(d)...

...

## ANALYSIS

The decision of November 8, 2000 dismissed Petitioner's petition for a June 19, 2000 filing date for failure to meet the requirement of including with the petition "a true copy of the "Express Mail" mailing label showing the "date-in", and of any other official notation by the USPS relied upon to show the date of deposit".[1] In this petition for reconsideration, Petitioner alleges that the United States Postal Service (hereinafter "USPS") did not provide Petitioner with the required copy of the "Express Mail" label and that, therefore, Petitioner does not have a copy to provide. Petitioner then interprets the rule to allow proof of deposit by means of either an "Express Mail" label *or* some other official USPS documentation. In making this interpretation, Petitioner relies on the following passage of rule 1.10(c).

> "(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation..."

It is apparently from that passage that Petitioner reaches the conclusion that "when there is a discrepancy between the filing date accorded by the office and date of deposit, an applicant can show that discrepancy by either :

'The date-in', on the 'Express Mail' mailing label, **or**

**'other official USPS notation'.**"[2]

This is an incorrect interpretation. Petitioner's focus on the above-quoted section ignores the rest of the rule, which is reproduced below, with the pertinent part in italics.

> "(c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, *provided that:*
>
> > (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date other than the USPS deposit date;

---

[1] *Decision on Petition, U.S. Patent Application No. 09/597,069*, Paper No. 4

[2] *Renewed Petition Under 37 C.F.R. §1.10(c)*, Paper No. 8.

(2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail;" *and*

*(3) The petition includes a true copy of the "Express Mail" mailing label showing the "date-in," and of any other official notation by the USPS relied upon to show the date of deposit."*

A plain reading of the italicized portion leads to the conclusion that the portion that Petitioner relies on is simply a passage stating a remedy that can be obtained "*provided that*" the petition is accompanied by at least a true copy of the "Express Mail" label showing the "date in", if not also a true copy of "any other official notation of the USPS relied upon to show the date of deposit". In other words, a true copy of the "Express Mail" is minimal, not optional, documentary evidence required for a successful petition under 37 C.F.R. §1.10(c).

It is noted that Petitioner did supply "other" USPS notation in the form of a printout of the USPS official mail tracking and delivery web site, showing delivery of the application to the USPTO on June 20, 2000. However, it is also noted that the date of delivery to the USPTO is not at issue and that therefore, this evidence does nothing more than confirm the current filing date accorded to this application while raising the implication that the application was probably deposited with the USPS on some undetermined earlier date. Again, Petitioner needs to supply the "Express Mail" receipt in order to establish the exact earlier date of deposit.

In light of the foregoing, because this petition still lacks a true copy of the Express Mail mailing label as required under 37 C.F.R. §1.10(c)(3) above, *this petition 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 C.F.R. §1.10(c)".

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

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
Four Crystal Plaza, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries concerning this matter may be directed to Petitions Attorney Scott M. Ledford in the Office of Petitions at (703) 306-5593.

/Beverly Flanagan/
Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Assistant 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

Michael C. Hlavaty
c/o Deere & Company
One John Deere Place
Moline IL 61265-8098

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JAN 15 2003

OFFICE OF PETITIONS

In re Application of :
Thorman et al. :
Application No. 09/597,069 : DECISION ON PETITION
Filed: June 20, 2000 : AND WITHDRAWAL OF
Attorney Docket No. 15301-US : THE HOLDING OF ABANDONMENT

This is in response to the petition under 37 CFR 1.181, submitted by facsimile transmission on June 26, 2002, to withdraw the holding of abandonment mailed September 14, 2001. The application file was recently forwarded to the Office of Petitions for a decision on the present petition. The Office sincerely apologizes for any inconvenience.

In the present petition, applicants asserted that the Notice of Abandonment was issued in error. Applicants requested that the holding of abandonment be withdrawn. The following is a brief discussion of the pertinent facts.

On September 19, 2000, applicants filed a petition under 37 CFR 1.10(c) to accord a filing date of June 19, 2000, instead of the instant filing date of June 20, 2000. The petition was dismissed by the decision of November 18, 2000. On December 11, 2000, applicants filed a request for reconsideration of the decision dismissing the original petition. The request for reconsideration was dismissed on February 5, 2001. However, applicants were informed that they were **entitled, but not required**, to file a request for reconsideration of the decision of February 5, 2001, within **TWO (2) MONTHS** of the date of that decision.

On September 14, 2001, a Notice of Abandonment was mailed for failing to timely reply to the decision of February 5, 2001.

On June 26, 2002, applicants filed the present petition. Applicants asserted that the decision of February 5, 2001, provided "an *invitation* to submit a response *rather than a requirement for a response*" if applicants accepted its holding. More specifically, applicants stated that pursuant to the language of the decision on petition, no further remedial attempts to obtain an earlier filing date were required for continued processing and prosection of the above-identified application.

Upon a thorough review of the circumstances and the decision on petition of February 5, 2001, applicants are correct that they were not required to reply to the decision and no further action was necessary on applicants' part for processing and examination of the application. Applicants were not compelled to file a request for reconsideration if applicants accepted the decision on petition.

Accordingly, the petition under 37 CFR 1.181 to withdraw the holding of abandonment is **granted** and the application is restored to pending status. The Office apologizes for the error.

**The application file will be forwarded to the Office of Initial Patent Examination for further processing. Additionally, the Notice of Abandonment shall be vacated and the application shall be examined in due course.**

Any inquiries regarding this decision should be addressed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
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

Paper No. 17

MICHAEL C HLAVATY
C/O DEERE & COMPANY
ONE JOHN DEERE PLACE
MOLINE, IL 61265-8093

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MAR 25 2004

OFFICE OF PETITIONS

In re Application of :
Christopher Scott Thorman, et al. :
Application No. 09/597,069 : ON PETITION
Filed: June 20, 2000 :
Attorney Docket No. 15301-US :

This is a decision on the petition under 37 CFR 1.137(b), filed March 6, 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 June 2, 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 application became abandoned on September 3, 2003.

The application file is being forwarded to Technology Center 3600, Art Unit 3671 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5594.

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

FISH & NEAVE IP GROUP
ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

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FEB 14 2005

**OFFICE OF PETITIONS**

In re Application of
Short
Application No. 09/597,101
Filed: June 20, 2000
Attorney Docket No. UON-P02-003

Decision on Petition

This a decision on the petition filed October 18, 2004, which is being treated as a petition under 37 CFR 1.181 for a refund of a portion of the extension of time fee submitted on September 24, 2004.

The petition is **granted.**

The difference in cost ($530) between the five month extension of time submitted ($1,005) and a three month extension of time ($475) will be credited to petitioner's deposit account.

Telephone inquiries may be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 16

ENTERED
10/08/03

Jerome J. Norris Esq.
Law Offices of Jerome J. Norris
1901 Pennsylvania Avenue, SW
Suite 305
Washington, DC 20006

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OCT 0 3 2003
OFFICE OF PETITIONS

In re Application of :
Xiaoming Yin et al. :
Application No. 09/597,123 : ON PETITION
Filed: June 20, 2000 :
Attorney Docket No. 00P7704US :

This is a decision on the petition under 37 CFR 1.137(b) filed August 21, 2003, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is granted.

This application became abandoned for failure to timely pay the issue fee. 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. See MPEP 711.03(c)(III)(A)(1). Therefore, the filing of a continuing application is not a proper reply under 37 CFR 1.137(a)(1) or (b)(1). In view of the authorization contained in the petition to charge any additional fees due, the $1300 issue fee will be charged to Deposit Account No. 50-1065. The issue fee is not refundable and may not be applied towards payment of the issue fee in the continuing application (in the event it is allowed).

**Petitioner is advised that the issue fee paid 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]

The application file is being forwarded to Technology Center AU 2881 for processing the Request for Continued Examination pursuant to 37 CFR 1.114 filed with the instant petition.

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

---

[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. The request and pertinent attachments should be addressed to **Box Issue Fee**. Additionally, if the issue fee has increased from the previously paid issue fee, the balance due must be submitted. **Failure to 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.**

The application file is being forwarded to the Publishing Division to be processed into a patent.

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

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Paper No. 6

Thomas M. Isaacson
AT&T Corp.
Room 2A-207
One AT&T Way
Bedminster, NJ 07921

MAIL

AUG 25 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
Salman Abbasi et al.
Application No. 09/597,130
Filed: June 20, 2000
For: METHODS AND SYSTEMS FOR IMPROVING DATA TRANSMISSION RATES HAVING ADAPTIVE PROTOCOLS

DECISION ON PETITION UNDER 37 CFR §1.181 TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the petition filed 08 April 2004 under 37 CFR §1.181 to withdraw the holding of abandonment of the above-identified application.

This application was held abandoned for failure to respond in a timely manner to the Office Action mailed 25 June 2003 (paper no. 3). A Notice of Abandonment was mailed 05 February 2004 (Paper No. 4).

In support of the petition, Petitioner provides a copy of (1) a postcard receipt (without a UPSTO date stamp); (2) a revocation of associate power and appointment of new associate attorney and change of correspondence address; (3) an amendment; (4) 4 sheets of formal drawings with cover letter; (5) a transmittal form with a certificate of mailing signed by Thomas M. Isaacson and dated 25 September 2003 indicating transmittal of an amendment, drawing(s), power of attorney, revocation, and change of correspondence address, and return postcard; and (6) a personal statement under 37 CFR 1.8(b)(3) from Thomas M. Isaacson.

## BASIS OF OPINION

The relevant portion of the Rules are reproduced below.

**37 C.F.R. § 1.8 Certificate of mailing or transmission**

(b) 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 promptly informed the Office of the previous transmission, supplied a copy of the previously transmitted correspondence, and provided a statement that attests on a personal knowledge basis to the previous timely transmission of the correspondence.

In reviewing the petition and the attached copies of the postcard receipt, transmittal form, and amendment, it is noted the papers were timely filed, but with an incorrect application serial number 09/597,120. The correct application serial number should be --09/597,130--.

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, includes name of the inventor, filing date of the application, title of the invention and the name of an examiner in the TC examining the application, is sufficient to associate the papers with the instant file.

Thus, Petitioner has established that a response was timely filed and the Abandonment was the result of Office error in not matching the response to the application file.

The petition is **GRANTED**. The Notice of Abandonment is **WITHDRAWN**.

The application file is being forwarded to the Technology Center support staff for entry of the amendment. After processing, the application will then be forwarded to the Examiner for appropriate action.

Any inquiry concerning this decision should be directed to Vincent N. Trans whose telephone number is (703) 305-9750.

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

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400 M&T BANK BUILDING
118 N. TIOGA STREET
ITHACA, NY 14850

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OFFICE OF PETITIONS

In re Patent No. 6,471,929 :
Issue Date: October 29, 2002 :
Application No. 09/597,147 : ON PETITION
Filed: June 20, 2000 :
Attorney Docket No. 09793822-0014 :

This is a decision on the petition filed May 9, 2005, 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.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3208. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

This matter is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Karen Creasy

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

[1]See Official Gazette of June 22, 2004

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POTOMAC FALLS, VA 20165

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OFFICE OF PETITIONS

In re Application of
Jun Koyama
Application No. 09/597,399
Filed: June 21, 2000
Attorney Docket No. 0756-2161

ON PETITION

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 June 25, 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 February 21, 2002, with a Certificate of Mailing under 37 CFR 1.8 dated February 7, 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]

The application is being forwarded to Technology Center AU 2821 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* 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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30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Takahiro Moro et al | : | |
| Application No. 09/597,403 | : | DECISION GRANTING PETITION |
| Filed: June 21, 2000 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 862.C1931 | : | |

This is a decision on the petition, filed September 11, 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 August 7, 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 should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 2625 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\Sept9\597403.wpd

[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.*

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MAIL

DEC 30 2004

DIRECTOR OF
TECHNOLOGY CENTER 2800

Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester NY 14650-2201

In re Application of
Michael J. PIATT, et al.
Application No. 09/597,437
Filed: October 18, 2004
For: **COLOR TABLE LEVEL RESERVATION**

DECISION ON PETITION
TO WITHDRAW HOLDING OF
ABANDONMENT

This is in response to the Petition for Withdrawal of Abandonment filed October 18, 2004, pursuant to 37 C.F.R. § 1.181(a). No fee is required.

On February 24, 2004, a Notice of Allowance and Issue Fee Due was mailed in the subject application. A response from Applicants was not received. On August 18, 2004 a Notice of Abandonment was mailed.

Petitioner alleges that the Notice of Allowance of February 24, 2004 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 application file finds no irregularity in the mailing of the Notice of Allowance since it was mailed to the address of record at that time.

Petitioner argues that an associate power of attorney and change of address was filed March 24, 2004. The power of attorney and change of address has been received and made of record in the file.

It is noted, that the submitted docket records and statements appear to be based on failure to receive the Notice of Allowance at the new correspondence address of record. It is further noted that the change of address was filed subsequent to the mailing of the Notice of Allowance.

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.

The Notice of Allowance was sent to the address of record at the time of mailing in accordance with the rule as set forth above. Petitioner has not established failure to receive the Notice of Allowance at the correspondence address of record at the time of mailing thereof.

For the above reasons, the petition is **DENIED.**

Any request for reconsideration must be filed within **TWO MONTHS** of the date of this decision and include evidence of failure to receive the Notice of Allowance at the address of record at the time of mailing. Alternatively, petitioner may want to consider filing a petition to revive an unintentionally abandoned application under 37 CFR 1.137(b).

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

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**PATENT LEGAL STAFF**
**EASTMAN KODAK COMPANY**
**343 STATE STREET**
**ROCHESTER, NY 14650-2201**

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Piatt et al. | : | |
| Application No. 09/597,437 | : | ON PETITION |
| Filed: June 20, 2000 | : | |
| Attorney Docket No. 87779WRZ | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 1, 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 February 24, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on May 25, 2004. A Notice of Abandonment was mailed on August 18, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

As petitioner authorized, Deposit Account No. 05-0225 was charged the $1400.00 issue fee and the $1500.00 petition fee.

A copy of the Notice of Allowance and Notice of Allowability previously mailed on February 24, 2004 is enclosed as requested in the instant petition. Accordingly, if petitioner desires to have the information found thereon printed on the patent, the Issue Fee Transmittal Form should be completed and returned to the Publishing Division within **ONE MONTH** from the mail date of this decision.

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

Enclosure: A copy of the Notice of Allowance and Notice of Allowability

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APR 26 2005
CUSTOMER SERVICE
PUBLISHING DIVISION

**DOCKET 87779WRZ**
**Customer No. 01333**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Michael J. Piatt, et al

COLOR TABLE LEVEL RESERVATION

Serial No. 09/597,437

Filed 20 June 2000

Group Art Unit: 2624
Examiner: Tommy D. Lee
Allowed: 24 February 2004
Confirmation: 6119

I hereby certify that this correspondence is being deposited today with the United States Postal Service as first class mail in an envelope addressed to Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Tracy Thomas

April 12, 2005
Date

Commissioner for Patents
P.O. Box 1450
Publishing Division
Alexandria, VA. 22313-1450

Sir:

**LETTER**

Please find enclosd a copy of the Fee Transmittal for the above-entitled application. As can be determined from the enclosed Decision of Petition having a mailing date of March 14, 2005, the issue fee has been paid.

If the Publishing Division requires additional information, it is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

William R. Zimmerli/tt
Telephone: 585-588-2758
Facsimile: 585-477-1148

Attorney for Applicants
Registration No. 45,287

Enclosures: copy of Decision of Petition mailed March 14, 2005 and
PART B - Fee Transmittal

If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Entered by mar

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EASTMAN KODAK CO.

MAR 16 2005

PATENT LEGAL STAFF

PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER, NY 14650-2201

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|---|---|---|
| In re Application of | : | |
| Piatt et al. | : | |
| Application No. 09/597,437 | : | ON PETITION |
| Filed: June 20, 2000 | : | |
| Attorney Docket No. 87779WRZ | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 1, 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 February 24, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on May 25, 2004. A Notice of Abandonment was mailed on August 18, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

As petitioner authorized, Deposit Account No. 05-0225 was charged the $1400.00 issue fee and the $1500.00 petition fee.

A copy of the Notice of Allowance and Notice of Allowability previously mailed on February 24, 2004 is enclosed as requested in the instant petition. Accordingly, if petitioner desires to have the information found thereon printed on the patent, the Issue Fee Transmittal Form should be completed and returned to the Publishing Division within **ONE MONTH** from the mail date of this decision.

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

Liana Chase
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: A copy of the Notice of Allowance and Notice of Allowability

## PART B - FEE(S) TRANSMITTAL

**Complete and send this form, together with applicable fee(s), to: Mail** **Mail Stop ISSUE FEE**
**Commissioner for Patents**
**P.O. Box 1450**
**Alexandria, Virginia 22313-1450**

**or Fax** **(703) 746-4000**

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 4 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Legibly mark-up with any corrections or use Block 1)

7590 02/24/2004

Barbara Joan Haushalter
228 Bent Pines Court
Bellefontaine, OH 43311

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 drawing, must have its own certificate of mailing or transmission.

**Certificate of Mailing or Transmission**

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO, on the date indicated below.

| |
|---|
| (Depositor's name) |
| (Signature) |
| (Date) |

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/597,437 | 06/20/2000 | Michael J. Piatt | SDP259PA | 6119 |

TITLE OF INVENTION: COLOR TABLE LEVEL RESERVATION

| APPLN. TYPE | SMALL ENTITY | ISSUE FEE | PUBLICATION FEE | TOTAL FEE(S) DUE | DATE DUE |
|---|---|---|---|---|---|
| nonprovisional | NO | $1330 | $0 | $1330 | 05/24/2004 |

| EXAMINER | ART UNIT | CLASS-SUBCLASS |
|---|---|---|
| LEE, TOMMY D | 2624 | 358-003260 |

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

2. For printing on the patent front page, list (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

1 BARBARA JOAN HAUSHALTER
2 _____
3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. Inclusion of assignee data is only appropriate when an assignment has been previously submitted to the USPTO or is being submitted under separate cover. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE: EASTMAN KODAK COMPANY (B) RESIDENCE: (CITY and STATE OR COUNTRY)

343 STATE STREET, ROCHESTER, NY 14650-2201, NEW JERSEY

Please check the appropriate assignee category or categories (will not be printed on the patent); ☐ individual ☒ corporation or other private group entity ☐ government

4a. The following fee(s) are enclosed:

☐ Issue Fee
☐ Publication Fee
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s):

☐ A check in the amount of the fee(s) is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☐ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

Director for Patents is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

(Authorized Signature) (Date)

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

This collection of information is required by 37 CFR 1.311. 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 12 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, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Alexandria, Virginia 22313-1450.

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.

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Paper No. 12

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TECHNOLOGY CENTER 2100

Anthony V. S. England
1717 West Sixth Street
Suite 230
Austin, TX 78703

In re Application of:
Rakemdra Kumar Bera
Application No. 09/597,478
Filed: June 20, 2000
For: DETERMINING THE EQUIVALENCE OF TWO SETS OF SIMULTANEOUS LINEAR ALGEBRAIC FUNCTIONS

DECISION ON PETITION UNDER 37 CFR §1.181 TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the petition filed 01 March 2004 under 37 CFR §1.181 to withdraw the holding of abandonment of the above-identified application.

This application was held abandoned for failure to respond in a timely manner to the Office Action mailed 03 April 2003 (paper no. 7). A Notice of Abandonment was mailed 10 February 2004 (paper no. 10).

It is noted that Petitioner has filed a "Petition for Revival of an Application for Patent Abandoned Unavoidably under 37 CFR 1.137(a)", however this petition is being treated as a "Petition under 37 CFR 1.181 to Withdraw a Holding of Abandonment".

In support of the petition, Petitioner provides a copy of (1) a 13 page amendment, (2) an Applicant initiated interview request form, (3) a transmittal form showing transmission of a 13 page amendment and an Applicant initiated interview request form, (4) a "transmission verification report", and (5) an "auto-reply facsimile transmission" from the United States Patent and Trademark Office showing receipt of a 15 page transmission, transmitted 24 July 2003.

Petitioner also provides a copy of (1) a Petition for Extension of Time for Reply, (2) a "transmission verification report", and (3) an "auto-reply facsimile transmission" from the United States Patent and Trademark Office showing receipt of a 1 page transmission, transmitted on 28 July 2003.

The "auto-reply facsimile transmission" from the United States Patent and Trademark Office for the responses filed 24 July 2003 and 28 July 2003 establishes that a response to the Office action of 03 April 2003 was filed on 24 July 2003 and 28 July 2003. Thus, Petitioner has established

that a response was timely filed and the Abandonment was the result of Office error in not matching the response to the application file.

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 and a one-month extension of time. Petitioner's deposit account no. 50-0629 will be charged $110 for the one month extension of time. After processing, the application will then be forwarded to the Examiner for appropriate action.

Any inquiry concerning this decision should be directed to Vincent N. Trans whose telephone number is (703) 305-9750.

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

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Paper No. 10

FLESHNER & KIM, LLP
P.O. BOX 221200
CHANTILLY VA 20153

**MAILED**

APR 09 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Jung KANG, et al. :
Application No. 09/597,553 :DECISION ON PETITION TO
Filed: June 19, 2000 :WITHDRAW HOLDING OF
For: **RADIO FREQUENCY PLASMA DISPLAY PANEL AND FABRICATING METHOD THEREOF AND DRIVING APPARATUS THEREFOR** :ABANDONMENT
:

This is a decision on the petition filed August 6, 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. No fee is required.

This application became abandoned for failure to timely respond to the Non-Final Office Action mailed January 15, 2003. A Notice of Abandonment was mailed August 7, 2003.

Petitioner alleges that the Non-Final Office Action mailed January 15, 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 records indicate that the Non-Final 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 of the Non-Final Office Action on the part of the U.S. Patent and Trademark Office.

The allegation of non-receipt is supported by a statement by the petitioner attesting that the Office Action was not received at the correspondence address of record, and that a search of the contents of the file jacket and docket records reveal no evidence of receipt. Copies of the docket records have also been included to corroborate petitioner's claim.

The showing offered complies with the requirements of a successful petition to withdraw the holding of abandonment due to non-receipt of the Non-Final Office Action as set forth above. Therefore, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Accordingly, the petition is **GRANTED.**

Due to the time lapse from the previous Office action and this decision, the file will be forwarded to the examiner for updating the search and the Office action as appropriate. The time period for response will be set to run from the mailing date of the new action.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

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Paper No. 27

FOLEY AND LARDNER
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3000 K STREET NW
WASHINGTON, DC 20007

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APR 3 0 2003

OFFICE OF PETITIONS

In re Application of
Gary L. Griffiths, et al.
Application No. 09/597,580
Filed: June 20, 2000
Attorney Docket No. 018733-0987

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed on March 24, 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 January 9, 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]

The file is being forwarded to Technology Center AU 1616 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 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 Fe (s) Due (PTOL-85).

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Paper No. 24

Date : April 29, 2003

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

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APR 30 2003
OFFICE OF PETITIONS

SUBJECT : Withdrawal from Issue of

Applicant(s) : GARY L. GRIFFITHS, et al.
Application No. : 09/597,580
Filed : June 20, 2000

The above-identified application has been assigned Patent No. 6,558,648 and an issue date of May 6, 2003.

It is hereby directed that this application be withdrawn from issue at the request of the applicant.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of May 6, 2003:

"All reference to Patent No. 6,558,648 to GARY L. GRIFFITHS, ET AL. of NEW JERSEY for TARGETED COMBINATION IMMUNOTHERAPY OF CANCER AND INFECTIOUS DISEASES appearing in the Official Gazette of May 6, 2003, should be deleted since no patent was granted."

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Geraldine Dozier, Crystal Park 3-441 (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-910 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane K.Davis, P/OCS, CM1-6A07
Tamara K. Greene, PK3-910

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MAR 24 2004

STEPHEN B. MAEBIUS
FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

| | | |
|---|---|---|
| In re Application of | : | |
| Gary L. Griffiths et al | : | |
| Serial No.: 09/597,580 | : | WITHDRAWAL OF ATTORNEY |
| Filed: June 20, 2000 | : | |
| Attorney Docket No.: 018734-0987 | : | |

This is in response to applicants' attorneys' request, filed February 26, 2004, to withdraw from representation in the above identified application.

37 CFR 10.40 Withdrawal from employment.
(b) Mandatory withdrawal . A practitioner representing a client before the Office shall withdraw from employment if:
(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;
(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;
(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or
(4) The practitioner is discharged by the client.
(c) Permissive withdrawal. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:
(1) The petitioner's client:
(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;
(ii) Personally seeks to pursue an illegal course of conduct;
(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;
(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;
(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or
(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.
(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;
(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;
(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;
(5) The practitioner's client knowingly and freely assents to termination of the employment; or

(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

Applicants' attorney has provided no reason for withdrawal, as required.

The request to withdraw is **DISMISSED**.

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, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission at Office facsimile number.

William R. Dixon, Jr.
Special Program Examiner
Technology Center 1600

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Commissioner for Patents
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Paper No. 10

WALKER DIGITAL
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STAMFORD, CT 06905

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OFFICE OF PETITIONS

In re Application of :
Jorasch, et al. :
Application No. 09/597,801 : DECISION ON PETITION
Filed: June 20, 2000 :
Attorney Docket No. 00-032 :

This is a decision on the "Petition for Revival of an Application for Patent Abandoned Unavoidably under 37 C.F.R. §1.137(a)," filed May 23, 2002, which is properly considered as a petition to withdraw the holding of abandonment pursuant to §1.8(b)[1].

The petition under §1.181 is **GRANTED.**

The above-identified application became abandoned for failure to file a timely and proper reply to the non-final Office action mailed November 7, 2001. This Office action set a shortened statutory period for reply of three (3) months from the mailing date of the action, with extensions of time obtainable pursuant to 37 C.F.R. §1.136(a). No reply having been received and no extension of time made of record, the above-identified application became abandoned effective February 8, 2002. This decision precedes the mailing of a Notice of Abandonment.

Petitioner promptly filed the instant petition (and petition fee under §1.137(a)), asserting that a transmittal letter and response were timely filed on February 7, 2002. In support thereof, petitioner submitted a copy of the printout regularly updated and utilized in tracking actions throughout the prosecution history of applicant's patent applications, purportedly indicating that the action was timely filed; and a copy of their return receipt postcard, which was stamped by USPTO, purportedly confirming that the above-referenced documentation was received on February 25, 2002. In addition, petitioner submitted copies of the transmittal letter and

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[1] (b) 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 ..., 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.

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response as petitioner maintains they were filed on February 7, 2002.

Petitioner's evidence has been considered, and it has been determined that withdrawal of the holding of abandonment pursuant to §1.8(b) is warranted. Petitioner's evidence shows that the correspondence was timely filed pursuant to §1.8(a). The instant petition was promptly filed. The response bears a proper certificate of mailing under 37 C.F.R. §1.8(a), executed by Veronika Leliever and certifying timely mailing on February 7, 2002. On petition, attorney Downs attests to the previous timely mailing.

In view thereof, the response is considered timely filed, and the holding of abandoned is hereby **WITHDRAWN**.

Since consideration of the petition under §1.137(a) is unnecessary for the reasons cited, the petition fee will not be charged to Deposit Account No. 50-0271, as authorized.

The application file is being forwarded to Technology Center 3713 for consideration of the amendment resubmitted May 23, 2002.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0309.

Nancy Johnson
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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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
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NOV 22 2002

#15

MICHAEL L. GOLDMAN
NIXON PEABODY LLP
CLINTON SQUARE
PO BOX 31051
ROCHESTER, NY 14603

In re Application of Dewen Qiu et al.
Serial No.: 09/597,840
Filed: June 20, 2000
Attorney Docket No.: 19603/3340 (CRF D-2018B)

: PETITION DECISION

This is in response to applicants' petition, filed September 27, 2002 under 37 CFR 1.144, requesting withdrawal of the restriction requirement set forth by the examiner.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111(b) on June 20, 2000 as a divisional of application 09/013,587, filed January 26, 1998, which claimed benefit of provisional application 60/036,048, filed January 27, 1997. The application, as filed, contained claims 38-51. On September 7, 2001, the examiner mailed a restriction requirement dividing the claims into 7 groups. In the response filed January 10, 2002, applicants elected Group II, claims 38, 39, 41 and 46-50, with claims 38, 39 and 46-50 to be examined as drawn to methods utilizing a nucleic acid encoding a hypersensitive response elicitor protein from *Erwinia amylovora*. Applicants traversed the restriction requirement on essentially the same grounds presented in the instant petition, discussed below. Applicants also argued that the restriction was improper because claims 38, 39 and 46-50 were not designated as linking claims.

On March 27, 2002 the examiner mailed a first action on the merits. The examiner made the restriction final, clarifying that the claims 38, 39 and 46-50 were regarded as linking claims.

DISCUSSION

Applicants present two lines of argument in the petition. First, applicants argue that hypersensitive response elicitors are recognized in the art as a class of related compounds, and therefore restriction based on the source of the elicitor is inappropriate. This argument is not persuasive because different nucleic acid sequences are considered by the Office to be independent and distinct inventions. As stated in MPEP 803.04:

> Nucleotide sequences encoding different proteins are structurally distinct chemical

compounds and are unrelated to one another. These sequences are thus deemed to normally constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

By analogy, methods utilizing different nucleic acid sequences are also independent and distinct inventions.

Applicants further argue that the hypersensitive response elicitors share common characteristics, but stop short of stating that prior art regarding one sequence would render the others obvious. Given the unpredictability of the art, as discussed by the examiner in the Office action on the merits, it would appear that the skilled artisan would not predict that the results obtained with one elicitor protein would be obtained with all the others. Therefore a proper examination of all the claimed inventions would require a search for nucleic acids encoding all six of the specifically claimed elicitor proteins. Moreover, the claims require nucleic acids encoding elicitor proteins which "correspond to" those produced by the specified pathogens. Thus each invention encompasses an ill-defined genus of proteins and nucleic acid sequences, not a single sequence.

Applicants' second line of argument is that the methods should all be classified in the same class and subclass, and therefore restriction is not proper. This argument is not persuasive. MPEP 808.02 states, in part:

> Where the related inventions as claimed are shown to be distinct under the criteria of MPEP § 806.05(c) - § 806.05(i), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following:
>
> (C) A different field of search : Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together.

Applicants are advised that a search of the available sequence databases produces a listing of references disclosing the sequences most similar to the query sequence. This is the "place" where the examiner searches for prior art. The prior art relating to another query sequence will not be found in this "place" - a different listing of references must be generated and searched by the examiner. Thus a different field of search is shown, and restriction is proper.

DECISION

Applicants's petition is **DENIED** for the reasons set forth above.

The application will be forwarded to the examiner for consideration of the amendment and response filed September 27, 2002.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

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

#19

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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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JUN 10 2003

MICHAEL L. GOLDMAN
NIXON PEABODY LLP
CLINTON SQUARE
P.O. BOX 31051
ROCHESTER, NEW YORK 14603-1051

| | | |
|---|---|---|
| In re Application of<br>Qui et al.<br>Application Serial No. 09/597,840<br>Filed: June 20, 2000<br>Attorney Docket No. 19603-3340 (CRF D-2018B) | : | ON PETITION |

This is a revised decision by the Group Director of Technology Center 1600 on the renewed petition under 37 C.F.R. 1.144 for review of the restriction requirement and the previous decision of the Group Director of November 22, 2002, which refused to withdraw the final restriction requirement of March 27, 2002.

The renewed petition is **granted in part to the extent indicated.**

The instant application is a divisional of Application Serial No. 09/013,587, filed January 26, 1998, now U.S. Patent 6,277,814, which claims benefit of U.S. Provisional Application Serial No. 60/036,048, filed January 27, 1997. The instant application was filed on June 20, 2000 and was accompanied by a preliminary amendment canceling claims 1-37. Thus, at the time that the original restriction requirement was presented to applicant (September 7, 2001), claims 38-51 were pending.

As originally presented, claim 38 is drawn to a method of enhancing plant growth comprising providing transgenic plants or seeds that have been transformed with DNA that encodes a hypersensitive response elicitor (HRE) and growing said plant or seed under conditions effective to enhance plant growth. Dependent claims 39-45 specify the pathogenic organism from which the HRE is derived. In particular, claim 39 specifies that the hypersensitive response elicitor polypeptide or protein corresponds to that derived from a pathogen selected from the group consisting of *Erwinia*, *Pseudomonas, Xanthomonas, Phytophthora,* and mixtures thereof. Claims 40-45 specify individual pathogenic species or genera. It is noted that while claim 39 specifies "or mixtures thereof", claim 38 (from which claim 39 depends) specifies that the plants are transformed with "a" DNA. Therefore, a plain reading of claim 39

indicates that only a single DNA is introduced into the plants that are to be grown. Claims 47 and 48 specify groups of plants that are to be grown and claims 49 and 50 limit the "plants or seeds" of claim 38 to the use of *either* a plant *or* a seed. Claim 51 specifies an additional step in the method of claim 38 where in addition to the transgenic introduction of the DNA encoding the HRE, the HRE polypeptide or protein is applied to the plant.

In the restriction requirement mailed September 9, 2001, claims 38-51 were subject to an eight-way restriction requirement. In Groups I-VI, applicant was required to elect a source from which the HRE was derived. Group VII (misnumbered as Group VI, second occurrence) specified generic claims (claims 38, 39, and 46-50) that were not limited to derivation of the HRE from any particular pathogenic bacteria genus or species. Group VIII (misnumbered as Group VII) specified that the inclusion of the additional step of applying the HRE polypeptide or protein to the plant represented a patentably distinct invention.

Applicant responded to the restriction requirement on January 1, 2001 with the election of the invention of Group II, claims 38, 39, 41, and 46-51, with traverse. (Note that as originally presented, Group II did not include claim 51). Group II is drawn to a method of enhancing growth in plants by transformation with a nucleic that encodes an HRE derived form *Erwinia amylovora*. In their traversal, applicant argued, in part, that the originally presented restriction requirement did not follow linking claim practice as specified in MPEP §814 and further argued that species election practice should have been followed. In response, the Office Action mailed March 27, 2002 indicated that claims 38, 39 and 46-52 "were effectively treated as linking claims in that they were associated with multiple Groups" (see Office Action at page 2, second paragraph). This restriction requirement was made final.

In response to the final restriction requirement, a petition under 37 C.F.R. §1.144 was filed on October 1, 2002 and was accompanied by a declaration under 37 C.F.R. §1.132 by Dr. Zhong-Min Wei. In this declaration, Dr. Wei presented evidence and argument supporting that the claimed invention was operable using DNA encoding an HRE prepared from *Erwinia amylovora* and using topical application of HRE proteins prepared from *Pseudomonas syringae* and *Xanthomonas campestris*. While demonstrating the operability of several embodiments of the claimed inventions, applicant did not argue or provide evidence that the different embodiments of the claimed inventions were obvious over on another. Petitioner also argued therein that since the HREs of the instant application are widely recognized as a class or genus of related compounds, a restriction based upon the HRE elements is inappropriate. However, while some HREs were apparently known in the art at the time the application was filed, there is no indication that it was recognized that these different HREs would have been expected to have been functionally equivalent in the context of the instantly claimed methods. Petitioner also argued that one skilled in the art would have expected to have been able to isolate HREs from different species based upon cross-species hybridization methods. However, while this point is acknowledged, petitioner falls short of arguing that one skilled in the art would have expected different genes to have been functionally equivalent within the context of that which is claimed or that one would have been motivated to have substituted a HRE from one species for that of another with the expectation of achieving the same result (i.e. that the HREs from different species would have been obvious over one another). Finally, petitioner urges that in setting forth the original restriction requirement, the USPTO has failed to establish a burden

upon the Office since when appropriately classified the separate inventions would be similarly classified. However, it is noted that even if different inventions are similarly classified, a complete search and examination in non-patent literature must include specific consideration of source materials and such consideration is maintained as representing a significant examination burden.

In the renewed petition under 37 C.F.R. §1.144 filed January 27, 2003, petitioner reiterates the arguments presented in the October 1, 2002 petition and presents a Supplemental declaration by Dr. Zhong-Min Wei under 37 C.F.R. §1.132. In this supplemental declaration petitioner provides more evidence relating to the functionality of that which is claimed but again falls short of indicating that the different claimed embodiments are not patentably distinct. For reasons amply explained by the examiner in the Office Action of March 27, 2002 and discussed above, it is maintained that the use of the HREs from different species represent patentably distinct inventions.

Even though it is maintained that the fundamental basis of restriction as set forth by the examiner is sound, the restriction requirement as set forth on September 7, 2001 and made final on March 27, 2002, fails to properly treat the linking claims as presented by claims 38 and 46-51. In the March 27, 2002 Office Action, it is noted that "(c)laims 38-39 and 46-50 were effectively treated as linking claims in that they were associated with multiple groups" (see Office Action at page 2, second full paragraph, lines 1 and 2). The Office Action continues on page 3, lines 2 and 3, by stating that "(c)laims 38-39, 41 and 46-50 are examined to the extent they read on the transformation with a nucleic acid encoding a hypersensitive response elicitor from *Erwinia amylovora*." In this regard, it is noted that had proper linking claim practice been applied applicant would have been required to elected a single invention relating to the use of one of the species of HRE even while obtaining an examination of the generic linking claim to the extent necessary to determine patentability or lack thereof.

MPEP §809 states that where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction can nevertheless be required. MPEP §809.03 states that there are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) inseparable therefrom and thus linking together the inventions otherwise divisible. The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible include genus claims linking species claims. This is the situation in the instant application. Claim 38 represents a genus claim and claims 40-45 recite particular species that are encompassed by the genus recited in claim 38 and the subgenera recited in claim 39. It is noted that claim 39 recites a Markush group that includes the species recited in claims 40-45, but it is nonetheless restrictable since it is possible to enumerate the separate embodiments in such a manner that, upon filing an appropriate number of divisional applications, applicant would be able to obtain an examination of the full scope of that which is recited. It is further noted that any such restriction requirement between the species recited in claims 39-45 is subject to the nonallowance of the linking claims (claims 38 and 46-51). Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any

claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Thus, applicant is entitled to examination of the linking claims (claims 38, 39 and 46-51) to the extent necessary to determine allowability or lack thereof.

In particular regard to the invention as set forth in claim 51 it is noted that claim 51 is dependent upon claim 38 and provides for the further limitation that in addition to the use of transformation for introducing the HRE into the plant or seed, the HRE polypeptide or protein is applied to the plant being treated. As a further process step in the method of claim 38, it appears that the relationship between the invention of claim 38 and that of claim 51 is one of combination/subcombination. MPEP §806.05(c) sets forth the criteria for establishing the distinctness for a combination, subcombination, or element of a combination. In order to establish that combination and subcombination inventions are distinct, two-way distinctness must be demonstrated. To support a requirement for restriction, both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status, or field of search. See MPEP § 808.02. The inventions are distinct if it can be shown that a combination as claimed (A) does not require the particulars of the subcombination as claimed for patentability (to show novelty and unobviousness), and (B) the subcombination can be shown to have utility either by itself or in other and different relations. When these factors cannot be shown, such inventions are not distinct. In the instant case, since the particulars of the subcombination (the introduction of the DNA into the plants or seeds) is required for the combination as set forth in claim 51, the two-way distinction test is not met.

For the reasons set forth above, the renewed petition under 37 C.F.R. §1.144 is granted in part. The next Office Action will recast the restriction requirement in accordance with applicable procedures (as discussed above and outlined below), and will, *inter alia*, specifically withdraw, on the record, the restriction requirement from those claims currently listed as being common to more than one group of independent and distinct invention. Further, the examiner will identify and examine any linking claims present or indicate, as appropriate, that none are present.

Should there be any questions with regard to this letter, please contact Brian Stanton, Quality Assurance Specialist, by letter addressed to Director, Technology Center 1600, Washington, DC 20231, or by telephone at (703) 308-1123 or by facsimile transmission at (703) 305-7230.

Jasemine C. Chambers

Jasemine C. Chambers
Director, Technology Center 1600

Modified restriction requirement

Restriction to one of the following groups of inventions would be required under 35 U.S.C. 121:

Group A

I. Claim 40, drawn to a method of enhancing plant growth using a hypersensitive response elicitor derived from *Erwinia chrysanthemi.*

II. Claim 41, drawn to a method of enhancing plant growth using a hypersensitive response elicitor derived from *Erwinia amylovora.*

III. Claim 42, drawn to a method of enhancing plant growth using a hypersensitive response elicitor derived from *Pseudomonas syringae.*

IV. Claim 43, drawn to a method of enhancing plant growth using a hypersensitive response elicitor derived from *Pseudomonas solanacearum.*

V. Claim 44, drawn to a method of enhancing plant growth using a hypersensitive response elicitor derived from *Xanthomonas campestris.*

VI. Claim 45, drawn to a method of enhancing plant growth using a hypersensitive response elicitor derived from *Phythophthora.*

Linking claims

Claims 38 and 46-51 link inventions I through VI. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claims, claims 38 and 46-51. Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Applicant(s) are advised that if any such claims depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Claim 39 also links inventions I through VI and the same practice as set forth above in regard to claims 38 and 46-41 will be followed in the examination of this claim. The restriction requirement among the linked inventions would be subject to the nonallowance of the linking claims, claim 39. Note that in the multiple inventions defined in claim 39 utilize different genera of microorganisms (*Erwinia, Pseudomonas, Xanthomonas* and *Phythophthora*) each of defines a subgenus of patentably distinct inventions. Upon election of one of the inventions of

groups I-VI above, claim 39 will be examined to the extent that it encompasses the elected species of the genera set forth in claim 39 as set forth in the inventions of Groups I-VI above. For example, upon election of Group I above, claim 39 will be examined to the extent that it reads on the genus *Erwinia*. Should that scope of claim 39 be found allowable, the examination of claim 39 would be extended to include the other genera set forth in claim 39. See also MPEP §804.01.

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MAR 31 2004

Michael L Goldman
Nixon Peabody LLP
Clinton Square
PO Box 31051
Rochester NY 1460

In re application of Dewen Qiu et al. :
Serial No. : 09/597,840 : DECISION ON PETITION
Filed : June 20, 2000 :
Attorney Docket No.: 19603/3340 (CRF D-2018B) :

This is in response to applicants' renewed petition under 37 CFR 1.144, filed August 7, 2003.

DISCUSSION

In the renewed petition applicants state unequivocally that all the claimed inventions are not patentably distinct over each other, i.e., each invention would render the others obvious.

DECISION

Applicants' petition is **GRANTED** in view of the statement made on the record.

The application will be forwarded to the examiner for consideration of the response filed January 16, 2004.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

Jasemine C. Chambers

Jasemine Chambers
Director, Technology Center 1600

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JUN 06 2006

OFFICE OF PETITIONS

Michael J. Mallie
Blakely, Sokoloff, Taylor & Zafman
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025-1030

In re Application of :
GUPTA, et al. : DECISION ON PETITION
Application No.: 09/597,861 :
Filed: June 20, 2000 : UNDER 37 CFR 1.137(b)
Attorney Docket No.: 74451.P116 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 6, 2006 to revive the above-entitled application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a proper reply in a timely manner to the Final Office action mailed June 1, 2005, which set a shortened statutory period for reply of three (3) months. While a reply was filed on 06 October, 2005, that reply failed to place the application in condition for allowance as indicated in the Advisory Action mailed November 10, 2005. Accordingly, by operation of law, the above-identified application became abandoned on September 2, 2005.

The present 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 to the Office action mailed June 1, 2005; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Office action of June 1, 2005 is accepted as having been unintentionally delayed.

The application file is being referred to Technology Center AU 2624.

Telephone inquiries concerning this decision should be directed to the undersigned.

Derek A. Putonen
Attorney Advisor
(571) 272-3294

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

PROSKAUER ROSE LLP
One International Place
Boston, MA 02110

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Robert Rademacher | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7577601 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/597,881 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/20/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1366** 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.

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PROSKAUER ROSE LLP
One International Place
Boston, MA 02110

Mail Date: 05/17/2010

**Applicant** : Robert Rademacher
**Patent Number** : 7577601
**Issue Date** : 08/18/2009
**Application No**: 09/597,881
**Filed** : 06/20/2000

: NOTICE CONCERNING IMPROPER
: CALCULATION OF PATENT TERM
: ADJUSTMENT BASED UPON USPTO
: IMPROPERLY MEASURING REDUCTION
: PERIOD UNDER 37 CFR 1.704(c)(10).

The United States Patent and Trademark Office (USPTO) discovered that in processing the recent recalculation decisions mailed in response to patentee's filed Request for Recalculation of Patent Term Adjustment in view of Wyeth, the USPTO improperly measured the reduction period for reductions under 37 CFR 1.704(c)(10). Pursuant to 37 CFR 1.704(c)(10), patentee's reduction begins on the date of filing the amendment under 37 CFR 1.312 ("1.312 amendment") or other related paper and ends on the date that the Office mails a response to the filing of the 1.312 amendment or other paper. It has been discovered that during the recalculation, the calculation failed to the limit the reduction to the mail date of the response to the 1.312 amendment or other paper. Accordingly, patentee's reductions were greater than warranted.

This notice **VACATES** the previous GRANTED request for recalculation and provides patentee with a revised GRANTED recalculation.

The patent term adjustment has been determined to be **1380** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of patent term adjustment (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** from the mail date of this notice, whichever is longer, to file a request for reconsideration of this PTA calculation. See 35 U.S.C. § 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4).

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this PTA 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 PTA 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 of review of the USPTO's PTA determination in the United States District Court for the District of Columbia, patentee must ensure that the steps required under 35 U.S.C. § 154 (b)(4) are taken 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).

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Christopher C. Winslade
McAndrews, Held & Malloy, Ltd.
500 W. Madison Street
34th Floor
Chicago IL 60661

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OCT 30 2006

OFFICE OF PETITIONS

In re Application of :
Miller :
Application No. 09/597,917 : ON PETITION
Filed: June 19, 2000 :
Attorney Docket No. 14410US01 :
For: MODULAR, PORTABLE DATA PROCESSING TERMINAL FOR USE IN A RADIO FREQUENCY COMMUNICATION NETWORK

This is a decision on the petition under 37 CFR 1.137(a), filed October 9, 2006, requesting revival of the above-identified application. The petition will be treated under 37 CFR 1.181 as a petition to withdraw the holding of abandonment of the above-identified application.

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

The petition under 37 CFR 1.137(a) is **DISMISSED AS MOOT**.

As a preliminary matter, the correspondence address of record has been corrected to the above-identified address.

This application was held abandoned for failure to respond in a timely and proper manner to the Notice of Allowance and Fee(s) Due, mailed February 26, 2002, which set forth a non-extendable three (3) month period for reply. The Office contended that this application became abandoned on May 27, 2002. A Notice of Abandonment was mailed on March 20, 2006.

Petitioner asserts a Request for Continued Examination (RCE), an IDS, and a Deletion of Inventors Request were timely filed on May 28, 2002. It is noted that the last possible date to timely reply was May 28, 2002, as May 26, 2002 fell on a Sunday and May 27, 2002 was a federal holiday.

The official application file does not contain a RCE. However, an IDS with certificate of mailing date of May 28, 2002 and a Rule 48 request are present. These documents were entered into Office databases with a receipt date of June 3, 2002. In addition, a RCE fee and an IDS fee was charged on June 4, 2002. The official application file does not contain a RCE.

However, the copy of the purportedly earlier filed RCE submitted with the instant petition contains a proper certificate of mailing bearing a May 28, 2002 date of deposit.

Under 37 CFR 1.8(a)(1) correspondence is considered timely if: (1) the correspondence is mailed or transmitted prior to expiration of the set period for response by being properly addressed to the Patent and Trademark Office as set out in 37 CFR 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail or transmitted to the Patent and Trademark Office in accordance with 37 CFR 1.6(d); and (2) the correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have a reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

The RCE bears a proper certificate of mailing, dated May 28, 2002, in compliance with the requirements of 37 CFR 1.8(a)(1) as set forth above. In addition, the person signing the certificate, Attorney John H. Sherman, had reasonable basis to expect that the correspondence would be mailed on May 28, 2002.

The petition under 37 CFR 1.181 is **granted**, the holding of abandonment is withdrawn, and the March 20, 2006 Notice of Abandonment is **vacated**. No petition fee has been or will be charged in connection with this matter.

Accordingly, the application file will be forwarded to Technology Center A.U. 2876 for further processing of the RCE filed on certificate of mailing date May 28, 2002 and resubmitted on October 9, 2006.

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 PATENT AND TRADEMARK OFFICE

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Paper No. 17

Qualcomm Incorporated
Patents Department
5775 Morehouse Drive
San Diego, CA 92121-1714

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APR 3 0 2003

OFFICE OF PETITIONS

In re Application of :
Edward G. Tiedemann, et. al. :
Application No. 09/597,940 : ON PETITION
Filed: June 20, 2000 :
Attorney Docket No. QCPA 189CIPC2 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 17, 2003, 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 to the final Office action mailed February 4, 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 after midnight May 4, 2002.

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 slightly from the language required by 37 CFR 1.137(b)(3), the statement 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.

The petition is **GRANTED**.

The application is being forwarded to Technology Center 2600 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Telephone inquiries concerning this decision should be directed to Andrea Smith at (703) 308-6711.

Andrea Smith
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. 3

Jerry A. Miller
MILLER PATENT SERVICES
29 SEMINOLE DRIVE
RINGWOOD, NJ 07456

**MAIL**

JAN 3 0 2001

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Scott David Smyers
Application No.: 09/598,147
Filed: June 21, 2000
For: IEEE 1394-BASED PROTOCOL REPEATER

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed, August 17, 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 2600
Communications
(703) 305-4710

cc: HAVERSTOCK & OWENS
ATTN: TOM HAVERSTOCK, ESQ.
260 SHERIDAN AVENUE
SUITE 420
PALO ALTO, CA 94306

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

December 10, 2002

K. David Crockett
Crockett & Crockett
24012 Calle De La Plata
Suite 400
Laguna Hills, CA 92653

In re application of:
Howard Daniel Kent DECISION ON PETITION
Serial No.: 09/598,181
Filed: June 21, 2000
For: Rubber to Metal Bonding Method

This is a decision on the petition received May 22, 2002, 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 11, 2000. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned October 12, 2000. A notice of abandonment was mailed on May 7, 2002.

On May 2, 2002, the office received a communication from the attorney of record. Enclosed was an acknowledgment that all the requirements were met at the time of filing and the Notice to File Missing parts mailed August 28, 2000 was in error.

In reviewing the scan copies of the application the transmittal is missing. The attorney has sent in a copy of a transmittal from application 09/045,662. This transmittal does not pertain to the above application.

A new transmittal must be sent in using the correct application number 09/598,181 for finance purposes.

The petition is hereby GRANTED.

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

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

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Commissioner for Patents
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Paper No. 29

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

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NOV 19 2004

OFFICE OF PETITIONS

In re Application of
Toshihiro Shimizu, et al. :
Application No. 09/598,270 : ON PETITION
Filed: June 21, 2000 :
Attorney Docket No. 106558 :

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 18, 2004.

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 October 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.

After the application is received in the Office of Petitions, the file will be forwarded to Technology Center AU 3663 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).

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P.O. BOX 320850
ALEXANDRIA VA 22320-4850

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MAY 25 2010

OFFICE OF PETITIONS

In re Patent No. 7,366,595
Issued: April 29, 2008
Application No. 09/598,270
Filed: June 21, 2000
Attorney Docket No. 106558

DECISION ON PETITION

This is a decision on the petition, filed, November 18, 2009, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee's name and residence on the Letters Patent by way of a certificate of correction in the above-identified patent.

The request is GRANTED.

Petitioner states that the correct assignee's name is "Fujitsu Ten Limited, Kobe-shi (JP)" and that the incorrect assignee's name was included on the Fee(s) Transmittal form PTOL-85(b) at the time of payment of the issue fee.

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).

The request was accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect that "Fujitsu Ten Limited" is the assignee of record. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate to issue a certificate of correction.

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

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3205. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a certificate of correction after issuance of this application into a patent.

*/ALESIA M. BROWN/*

Alesia M. Brown
Petitions Attorney
Office of Petitions

#11

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 26 2003

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 SEVENTH AVENUE, 14TH FLOOR
NEW YORK, NY 10018

In re Application of
Benjamin Oshlack et al
Serial No.: 09/598,324
Filed: June 20, 2000
Attorney Docket No.: 200.94107

: WITHDRAWAL OF ABANDONMENT

This is in response to applicants' petition under 37 CFR 1.181, filed February 3, 2003, requesting revival of the above-identified application based on non-receipt of an Office action.

A review of the file history shows the Office mailed a Notice of Missing Parts to applicants at the above firm's address of "1140 Avenue of the Americas, 15th Floor, New York, NY, 10036" on September 15, 2000. A reply was filed on September 28, 2000, which included the same correspondence address. On February 26, 2001, applicants submitted an Information Disclosure Statement which contained a new correspondence address, however no indication that this was a new correspondence address was given. A first Office action was mailed to applicants on July 18, 2001, at the original correspondence address (1140 Avenue of the Americas, 15th Floor, New York, NY, 10036) to which a reply was made on December 3, 2001, which again set forth the new correspondence address. However no attention was drawn to the new address. A second Office action was mailed to applicants on March 13, 2002, to the original address of record. Applicants state that the Office action was never received. It was not until January 9, 2003, that a change of correspondence address was filed in this application giving the above address as the new correspondence address. A Notice of Abandonment was mailed to applicants at the new address on January 10, 2003. It is clear that applicants' correspondence address changed prior to the first Office action being mailed and likely in January or February, 2001, more than two years ago, and that applicants failed to inform the Office of the change until January, 2003. Thus failure to receive the last Office action appears to be based on applicants' failure to promptly inform the Office of a change in correspondence address.

Applicants' petition is **DISMISSED**.

**Any renewed petition must be filed within TWO MONTHS of the mail date of this decision in order to be considered timely. Any renewed petition must explain the effective date of the change of mail address and, if necessary, why it was not earlier provided.**

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.

John Doll
Director, Technology Center 1600

UNITED STATES
PATENT AND
TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
PO BOX 1450, ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

JUN 27 2003

#13

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 SEVENTH AVENUE, 14TH FLOOR
NEW YORK, NY 10018

In re Application of
Benjamin Oshlack et al
Serial No.: 09/598,324
Filed: June 20, 2000
Attorney Docket No.: 200.94107

: WITHDRAWAL OF ABANDONMENT

This is in response to applicants' renewed petition under 37 CFR 1.181, filed April 10, 2003, requesting revival of the above-identified application based on non-receipt of an Office action.

A review of the file history is set forth in the previous petition decision and is not repeated herein. Therein it was stated that applicants appeared not to have timely submitted a change of correspondence address to the Office prior to mailing of the last Office action dated March 13, 2002. Applicants now provide evidence and confirmation by the Office of a change of correspondence address having been submitted in November, 2000, which is prior to mailing of the first Office action. For unknown reasons the change was not effected in this application leading to the last Office action being mailed to an incorrect address. In view of the evidence presented the Notice of Abandonment mailed January 10, 2003, is vacated and the application restored to pending status with the mailing of this decision.

Applicants' petition is **DISMISSED**.

**The application will be forwarded to the examiner for remailing of the last Office action dated March 13, 2002.**

Should there be any questions regarding this decision, please contact William R. Dixon, Jr., by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.

John Doll
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
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APR 15 2005

#14

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 SEVENTH AVENUE, 14TH FLOOR
NEW YORK, NY 10018

In re Application of
Benjamin Oshlack et al
Serial No.: 09/598,324
Filed: June 20, 2000
Attorney Docket No.: 200.94107

: WITHDRAWAL OF ABANDONMENT

This is in response to applicants' renewed petition under 37 CFR 1.181, filed April 10, 2003, requesting revival of the above-identified application based on non-receipt of an Office action and applicants telephone inquiry of April 11, 2005.

A review of the file history is set forth in the previous petition decision and is not repeated herein. Therein it was stated that applicants appeared not to have timely submitted a change of correspondence address to the Office prior to mailing of the last Office action, dated March 13, 2002. Applicants now provide evidence and confirmation by the Office of a change of correspondence address having been submitted in November, 2000, which is prior to the mailing of the first Office action. For unknown reasons the change was not effected in this application leading to the last Office action being mailed to an incorrect correspondence address. In view of the evidence supplied the Notice of Abandonment mailed January 10, 2003, is withdrawn and the application restored to pending status with the mailing of this decision. This decision supercedes the decision mailed June 27, 2003, which indicated the petition was dismissed.

The petition is **GRANTED**.

**The application will be forwarded to the examiner for mailing of the Office action dated March 13, 2002, to the correct address.**

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov
AMB 02-03

Paper No. 7

CHERYL L. GASTINEAU
REED SMITH LLP
P.O. BOX 488
PITTSBURGH, PA 15230-0488

COPY MAILED

FEB 07 2003

OFFICE OF PETITIONS

In re Application of :
Lapcevic :
Application No. 09/598,506 : ON PETITION
Filed: June 21, 2000 :
Atty. Dkt. No. 02-640-US :

This is a decision on the petition under 37 CFR 1.137(b), filed January 13, 2003, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned October 23, 2000 for failure to timely file a proper response to the Notice to File Missing Parts of Nonprovisional Application ("Notice") mailed August 22, 2000. The Notice set a two (2) month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed May 20, 2002.

The power of attorney and change of correspondence address submitted herewith have been entered into the record.

This application will be forwarded to the Office of Initial Patent Examination for further processing.

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

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. 19

**STEVEN I. WEISBURD**
**DICKSTEIN SHAPIRO MORIN & OSHINSKY**
**1177 AVENUE OF THE AMERICAS**
**41ST FLOOR**
**NEW YORK NY 10036-2714**

COPY MAILED

OCT 1 0 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of
Fumihiro Shigenaga
Application No. 09/598,544
Filed: June 21, 2000
Attorney Docket No. K2580.0072/P072

This is a decision on the petition, filed by facsimile transmission on October 3, 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 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 will be forwarded to Technology Center AU 2837 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
www.uspto.gov

MAR 10 2005

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON MA 02110

In re Application of:
Barbara B. Lambl.
Serial No.: 09/598,604
Filed: June 21, 2000
Attorney Docket No.: 50172/002001

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in response to applicant's petition under 37 CFR § 1.181(a) filed on May 27, 2004, requesting withdrawal of the holding of abandonment based on the timely filing of a response to the Office action mailed October 29, 2003. The delay in responding to this petition is regretted, however, it has only just been brought to the attention of the deciding authority.

A review of the file history shows that the examiner mailed an Office action to applicant on October 29, 2003, setting a three-month statutory time period for reply. On May 18, 2004, the examiner mailed a notice of abandonment for failure to respond to the outstanding Office action.

Applicant states that a response to the Office action was filed on April 29, 2004, showing a Certificate of Mailing executed on the same date of April 29, 2004. Applicant also submits a copy of the post card identifying the various papers filed on April 29, 2004.

In view of this evidence, applicant is considered to have submitted a timely reply.

Applicant's petition is **GRANTED** retroactively as the application is no longer in abandoned status.

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 at 703-872-9306.

Marianne C. Seidel /jc

Jasemine C. Chambers
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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**BERRY & ASSOCIATES P.C.**
**9255 SUNSET BOULEVARD**
**SUITE 810**
**LOS ANGELES CA 90069**

**COPY MAILED**

MAR 2 0 2008

**OFFICE OF PETITIONS**

In re Application of :
Gavin PEACOCK :
Application No. 09/598,668 : DECISION ON PETITION
Filed: June 20, 2000 :
Attorney Docket No. **PALM-3215** :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 15, 2007, to revive the above-identified application.

The petition is **GRANTED**.

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 March 22, 2007. 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 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). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is June 25, 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) 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.

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) 272-2783.

This application is being referred to Technology Center AU 2141 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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
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BERRY & ASSOCIATES P.C.
9229 SUNSET BOULEVARD
SUITE 630
LOS ANGELES, CA 90069

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Gavin Peacock | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7587497 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/08/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/598,668 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/20/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **860** 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
P.O. Box 1450
Alexandria, VA 22313-1450
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022305

Mark J Murphy
COOK ALEX MCFARRON MANZO CUMMINGS & MEHLER LTD
200 West Adams Street
Suite 2850
Chicago IL 60606

MAR 0 9 2005

In re Application of:
Toru Takayama et al.
Serial No.: 09/598,736
Filed: June 21, 2000
Attorney Docket No.: **SEL 189**

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a decision on the petition filed August 2, 2004. The petition has been treated as a petition under 37 C.F.R. § 1.181 to withdraw the holding of abandonment in the above-identified application. No fee is required.

The petition is **GRANTED**.

The application was held abandoned for failure to timely file a response to the Office action mailed on October 17, 2003. A Notice of Abandonment was mailed on July 13, 2004.

Petitioner asserts that the Office action mailed on October 17, 2003 was not received. To support this assertion, petitioner provided a statement attesting that a search of the file jacket and docket records showed that the Office action was not received.

A review of the written record indicates that the Office action may not have been actually mailed with the United States Postal Service since both signed copies of the Office action are still in the file.

The Notice of Abandonment is hereby vacated and the holding of abandonment is withdrawn. The application file is being forwarded to the Technology Center 2800 support staff for remailing the Office action. The shortened statutory period for response set therein will be reset to run from the date the Office action is remailed. Extensions of time are available under 37 CFR § 1.136.

Petitioner also asserts that the fees for this petition should be refunded since failure to receive the Office action mailed October 17, 2003 was not due any fault by applicant.

Authorization to refund fees is set forth under 37 CFR 1.26. 37 CFR 1.26(a) states, in part, as follows:

(a) The Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for an oral hearing, will not entitle a party to a refund of such fee.

Since a petition under 37 C.F.R. § 1.181(a) requesting withdrawal of abandonment does not require a fee, this petition fee was paid by mistake.

Petitioner's request for a refund is **GRANTED**.

An inquiry regarding this decision should be directed to Clayton E. LaBalle, Special Program Examiner, at (571) 272-1594.

James L. Dwyer, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE 7/4/05 7/24/06

Paper No.: _____

TO SPE OF : ART UNIT 2622

SUBJECT : Request for Certificate of Correction for Appl. No.: 9/598767 Patent No. 6867882 B1

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:** _____

_____

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_____ 2625

SPE Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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Paper No. 11

Siemens Corporation
Intellectual Property Department
186 Wood Avenue South
Iselin, NJ 08830

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APR 2 8 2005

OFFICE OF PETITIONS

In re Application of :
Jack A. Mandelman :
Application No. 09/598,789 : ON PETITION
Filed: June 21, 2000 :
Attorney Docket No. 00P7715US :

This is a decision on the petition under 37 CFR 1.137(b), filed January 19, 2005, to revive the above-identified application.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing 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. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must so notify the Office.

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).

Since 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, 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. However, if petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent 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.

The petition is **GRANTED**.

The Office acknowledges receipt of one (1) sheet of replacement drawing, containing Figure 1, filed with the instant petition.

The application file is being forwarded to the Office of Publications for further review of the replacement drawing filed January 19, 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

cc: Ira Matsil
Slater and Matsil, LLP
17950 Preston Road, Ste. 1000
Dallas, TX 75252

UNITED STATES PATENT AND TRADEMARK OFFICE

MAIL

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

AUG 1 3 2001

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 8

CLARENCE T TEGREENE
INTELLECTUAL PROPERTY COUNSEL
MICROVISION, INC.
P O BOX 3008
19910 NORTH CREEK PARKWAY
BOTHELL , WA 98011-3008

In re Application of : P. Tarbouriech
Application No. 09/598,793
Filed: June 21, 2000
For: DIGITAL FINGERPRINT IDENTIFICATION SYSTEM

DECISION ON REQUEST TO WITHRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed July 6, 2001 under 37 C.F.R. § 1.36.

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 July 6, 2001 meets the above requirements. Accordingly, the request is **GRANTED**.

Robert A. Weinhardt
Special Program Examiner
Technology Center 2100
Computer Architecture, Software,
& Electronic Commerce
703-305-9780

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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**MICROVISION, INC.**
**6222 185TH AVENUE NE**
**REDMOND WA 98052**

COPY MAILED

JUL 29 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Philippe Tarbouriech | : | |
| Application No. 09/598,793 | : | ON PETITION |
| Filed: June 21, 2000 | : | |
| Attorney Docket No. XNT 00.03 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 15, 2008, to revive the above-identified application.

The petition is **GRANTED**.

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 June 1, 2007. 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 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). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is September 2, 2007. The Notice of Abandonment was mailed December 27, 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) and fee of $405, and the submission required by 37 CFR 1.114; (2) the petition fee of $770; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Terri Williams at (571) 272-2991.

This application is being referred to Technology Center AU 2136 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.

Chris Bottorff
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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DLA PIPER US, LLP
153 TOWNSEND STREET
SUITE 800
SAN FRANCISCO, CA 94107-1957

COPY MAILED

AUG 05 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Christopher Kershaw, et. al. | : | |
| Application No. 09/598,889 | : | ON PETITION |
| Filed: June 21, 2000 | : | |
| Attorney Docket No. SCHW-800-(US) | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed on December 21, 2007, to revive the above-identified application.

The application became abandoned for failure to respond to the non-final Office action mailed January 3, 2007. A Notice of Abandonment was mailed on July 27, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,540; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application file is being referred to Technology Center Art Unit 2179 for review of the amendment filed with the instant petition.

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
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ALEXANDRIA, VA 22313-1450
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AUG 15 2003

Mailed :

PJR
Paper Number 22

| | | | |
|---|---|---|---|
| In re Application of | | : | DECISION |
| Manfred Berndt | | : | ON PETITION |
| Serial No.: | 09/598,890 | : | |
| Filed : | June 22, 2000 | : | |
| For: | Supply Element for a | : | |
| | Laboratory Microchip | : | |

This is a decision on a petition under 37 CFR 1.144 filed June 6, 2003 requesting a review of a restriction requirement as set forth in the Office action mailed September 13, 2002.
That restriction requirement involved two groups as follows: Group I, claims 17-31 and 47-50, drawn to an apparatus; Group II, claims 32-46 and 51-55, drawn to a method. The basis for the restriction was election by original presentation with respect to the distinction between Groups I and II as well as the method claims not being commensurate in scope with the previously examined apparatus claims.
With respect to the restriction between Groups I and II, the applicants' argument is that in an amendment after final the method claims were limited to the same scope as the apparatus and as such the claims do not require divergent searches and should be examined together.
Given the above, the applicants' argument is unpersuasive because (a) the examiner properly applied the standard for restriction via election by original presentation when the claims were first added to the application and, (b) because it was only in an after final amendment that the claims were made commensurate in scope with the originally filed apparatus claims and entry of any amendment after final is not a matter of right but is at the discretion of the examiner. A review of the prosecution history indicates that the examiner properly refused entry of the amendment.

The petition is **Denied**.

JMStone

Jacqueline Stone
Director, Technology Center 1700
Chemical and Materials Engineering

Lowe, Hauptman, Gilman and Berner, LLP
1700 Diagonal Road
Alexandria, VA 22314

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Mailed: 5/18/05

spg

#14

In re application of
Heinz Focke et al.
Serial No. 09/598,995
Filed: June 21, 2000
For: PROCESS AND APPARATUS FOR PRODUCING AND/OR PACKAGING CIGARETTES

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE ORIGINAL NOTICE OF ALLOWANCE AND ISSUE FEE(S) DUE, PURSUANT TO MPEP § 711.03(c(II) originally filed February 18, 2004 and resubmitted June 21, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of September 23, 2002, 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 petitioner asserts that the Notice of Allowance 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 August 15, 2002. The evidence provided includes a statement by the petitioner that the Notice of Allowance, mailed August 15, 2002 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 technical support staff for prompt remailing of the Notice of Allowance and restarting of the statutory period of response from the remail date thereof.

It is further noted that the petitioner contends that the USPTO made an unauthorized change in the correspondence address of the instant application but a review of the USPTO application file reveals that the ASSOCIATE POWER OF ATTORNEY filed May 1, 2002 states that "All correspondence in connection with this application should be directed to Anthony J. Natoli at the address indicated hereinbelow" thus the address indicated on the Notice of Allowance, mailed

August 15, 2002, was correct as it directed the correspondence to Anthony J. Natoli as stated in the ASSOCIATE POWER OF ATTORNEY filed May 1, 2002.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

ABELMAN, FRAYNE & SCHWAB
150 East 42nd Street
New York NY 10017-5612

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.**: _____

**DATE** : 07/28/09

**TO SPE OF** : ART UNIT 2432

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 09599015 Patent No.: 6981281 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 (C of C)**
**Randolph Square 9D40-D**
**Palm Location 7580**

You can fax the Directors/SPE response to 571-270-9990

*Lamonte Newsome*

**Certificates of Correction Branch**

**703-756-1574**

**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:**

APPROVED
By gbarron at 8:39 am, Aug 10, 2009

/Gilberto Barron Jr./ — **SPE**

2432 — **Art Unit**

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DIGITAL VIDEO EXPRESS
DAVID GROSSMAN
518 WOODLAND CT. NW
VIENNA VA 22180

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NOV 0 8 2005

OFFICE OF PETITIONS

In re Application of :
Eye, et al. :
Application No. 09/599,124 :
Filed: June 22, 2000 :
Attorney Docket No. 1999-31 :
For: HIERARCHICAL KEY MANAGEMENT

DECISION
ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 25, 2005, to revive the above-identified application.

This application became abandoned for failure to timely pay the issue fee within three (3) months of the mailing of the April 21, 2005 Notice of Allowance and Fee(s) Due. Accordingly, this application became abandoned on July 22, 2005. The filing of the instant petition precedes the mailing of A Notice of Abandonment.

Petitioners have submitted a reply in the form of the issue fee and the PTOL-85, an acceptable statement of the unintentional nature of the delay in responding to the April 21, 2005 Notice of Allowance and Fee(s) Due, and the petition fee.

The petition is **granted**.

It is noted that the address on the petition differs from the address of record, that of customer number 23823. 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.

This application is being forwarded to Publishing Division for processing into a patent.

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

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

cc: DAVID G. GROSSMAN
1408 BAYSHIRE LANE
HERNDON, VA 20170

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**FOLEY & LARDNER LLP**
**321 NORTH CLARK STREET**
**SUITE 2800**
**CHICAGO IL 60610-4764**

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JUL 05 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Wang et al. | : | |
| Application No. 09/599,138 | : | ON PETITION |
| Filed: June 22, 2000 | : | |
| Attorney Docket No. 061602-1850 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed May 9, 2006, 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 corrected formal drawings; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

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

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OCT 25 2005

TERESA J. BOWLES
600 CONGRESS AVENUE, SUITE 2400
AUSTIN, TX 78701

| | |
|---|---|
| In re Application of | : |
| David J. Yang et al | : |
| Serial No.: 09/599,152 | : PETITION DECISION |
| Filed: June 21, 2000 | : |
| Attorney Docket No.: UTXC:664 | : |

This is in response to the petition under 37 CFR 1.144, filed September 6, 2005, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 on June 11, 2000, and contained claims 1-51. In a first Office action, mailed September 27, 2001, the examiner set forth a 4 way restriction requirement, summarized as follows:

Group I – Claims 1-32, drawn to a composition and kit comprising a radionucleotide, ethylene cysteine and a ligand;
Group II – Claims 33-41, drawn to a method of synthesizing ethylene dicysteine for imaging;
Group III – Claims 42-50, drawn to a reagent and kit comprising a ligand linked to a Tc-99 moiety;
Group VI – Claim drawn to a method of determining drug effectiveness on a tumor.

The examiner provided appropriate reasoning for restriction and further required an election of species within whichever group was elected..

Applicants replied on October 26, 2001, canceling claims 1 and 42-51 and amending claims 2-32. Applicants then elected the method of Group II and made all claims dependent on the Group II invention. No traversal of the requirement was made.

The examiner mailed a new Office action to applicants on April 24, 2002, acknowledging the election of Group II and the species and acted on all of the claims. Rejections under 35 U.S.C. 112, second paragraph, and under 35 U.S.C. 103(a) over various references were made.

Applicants replied on July 30, 2002, amending claims 9 and 22 and adding claims 52-55. The rejections were appropriately argued.

The examiner mailed a Final Office action to applicants on October 28, 2002, withdrawing the rejection under 35 U.S.C. 112, second paragraph, and some of the rejections under 35 U.S.C. 103(a). Claims 6-32, 39-41 and 52-55 were indicated as allowable if placed in independent form including all limitations of the claims from which they were dependent.

Applicants replied on January 7, 2003, canceling claim 33 and proposing amendments to claims 2-3, 5 and 34, and presenting arguments for patentability. Following an Advisory Action mailed January 29, 2003, RCE papers were filed on March 24, 2003, with an additional amendment and argument.

The examiner mailed a new non-Final Office action to applicants on September 29, 2003, withdrawing all previous rejections and setting forth a new rejection under 35 U.S.C. 112, first paragraph, for lack of enablement. The claims were also rejected under 35 U.S.C. 112, second paragraph, as indefinite. Claims 7, 11-14, 6(sic 16)-19, 21-22, 24-29 and 52-55 were objected to as allowable if rewritten in independent form including all limitations of the claims from which they depend.

Applicants replied on April 8, 2004 (COM dated March 29, 2004), amending claims 2, 7, 9, 20, 32 and 35 and adding claims 56-61. The rejections were argued in an appropriate manner.

The examiner mailed a Final Office action to applicants on June 25, 2004, setting a three month shortened statutory period for reply, withdrawing in part the rejections under 35 U.S.C. 112, first and second paragraphs, but maintaining other parts. Claims 7, 11-14, 16-22, 24-29 and 52-55 were indicated allowable if placed in independent form. Claims 56-61 were held non-elected as being directed to an invention independent and distinct from that elected.

Applicants replied on December 30, 2004 (COM dated December 23, 2004), by filing a Notice of Appeal and a reply to the Office action. The reply amended claims 7, 11, 16, 24, 52-53 and 55, and canceled claim 54. The reply addressed the rejections again and traversed the restriction requirement holding claims non-elected by original presentation.

The examiner mailed an Advisory Action to applicants on January 28, 2005, denying entry of the amendment and setting forth reasons therefore. Applicants then filed a second set of RCE papers on February 25, 2005, and requested that the amendment be entered.

The examiner then mailed a non-Final Office action to applicants on May 20, 2005, setting a three month shortened statutory period for reply. The examiner maintained the previously set forth rejections under 35 U.S.C. 112, first and second paragraph. The examiner also replied to the traversal of the restriction requirement and maintained it for the reasons set forth in the previous Office action. The requirement was not made Final.

This petition was filed on September 6, 2005, and traverses the maintaining of the restriction requirement as improper. Although the requirement was not made Final in the last Office action, the requirement was repeated by the examiner and is therefore ripe for supervisory review.

DISCUSSION

Applicants, as noted, did not traverse the original restriction requirement and proceeded with prosecution of the elected group, all claims being amended to fall within the group in response to the requirement. During prosecution claims have been added. The examiner had no objection to the addition of claims 52-55 and included them in further proceedings. The examiner, however, did object to the addition of claims 56-61, holding them to be non-elected by original prosecution.

Applicants argue that newly presented claim 56 is identical to claim 33 as originally set forth prior to restriction and was unamended prior to the first action on the merits. Claim 58 is identified as the same as claim 35 and claim 60 corresponds to original claim 38. A review of the claims shows applicants assertions to be correct. Claims 57, 59 and 61 depend from their immediately preceding claims and are thus more limited.

The only reason given by the examiner for holding claims 56-61 as non-elected is that they are broader than the claims previously examined (page 6, Office action dated 6/25/2004); specifically that they read on any and all tissue specific ligands. No additional explanation is given in the subsequent Office action in response to applicants traverse.

It is clear from the above review that the added claims are directed to the same invention as originally elected and currently under examination since they are identical to and no broader than original claims 33, 35 and 38 of elected Group II. Than they may be broader than the amended claims examined in the last Office action is immaterial since they fall within the invention elected in response to the original restriction requirement. The claims have been improperly withdrawn from consideration.

DECISION

The petition is **GRANTED**.

**The Office action of May 20, 2005, is withdrawn as incomplete. The application is returned to the examiner for preparation of a new Office action in which claims 56-61 are considered on their merits.**

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 25, 2006

TO SPE OF : ART UNIT 1618

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/599152 patent No.: 7,06,7111

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:** The changes are acceptable. There is no new matter introduced, nor has the scope been changed.

MICHAEL G. HARTLEY
SUPERVISORY PATENT EXAMINER

SPE

1618
Art Unit

SPE T. Meeks

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 09/599,174

Paper No.: _____

DATE : 5/12/05

TO SPE OF : ART UNIT 1762

SUBJECT : Request for Certificate of Correction on Patent No.: 6723376

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 3-915**
Palm location **7580** - Tel. No. 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.

Lamonte Newsome

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

BEST AVAILABLE COPY

**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:**

TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER

SPE — 1762 Art Unit

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Owen L Lamb
P O Box 386
PAESCOTT AZ 86302-0386

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SEP 22 2008

**OFFICE OF PETITIONS**

In re Patent No. 6,634,084
Issued: October 21, 2003
Application No. 09/599,203
Filed: June 22, 2000
Attorney Docket No. D-1530

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

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**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

There is no indication that the person signing the request 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 documents 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.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

CC: Albin H. Gess
600 Anton Boulevard
Suite 1400 Costa
Mesa, California 92626-7689

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 8-3-05

TO SPE OF : ART UNIT 2141

SUBJECT : Request for Certificate of Correction on Patent No.: 6880001

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.

Should this be Approved

**Thank You For Your Assistance**

Ennis Young
**Certificates of Correction Branch**
***Tel. No. 703-305-8309***

**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:**

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER

SPE

2141
Art Unit

# UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 6628833
Issue Date: September 30,2003
Application No. 09599509
Filed: June 23,2000
Attorney Docket No. 009683-359

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

This is a decision on the electronic petition, filed April 28,2008 ,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 April 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 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.

# 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) |
|---|---|---|---|---|
| 6628833 | 2003-09-30 | 09599509 | 2000-06-23 | ID 016208 |

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

| | Fee | Code |
|---|---|---|
| ◉ | 3 ½ year | (1551) |
| ○ | 7 ½ year | (1552) |
| ○ | 11 ½ year | (1553) |

Small Entity

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (2552) |
| ○ | 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 | /DJCushing/ | Date (YYYY-MM-DD) | 2008-04-28 |
| Name | David J. Cushing | Registration Number | 28703 |

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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**BENTON S. DUFFETT JR.**
**BURNS DOANE SWECKER & MATHIS LLP**
**P O BOX 1404**
**ALEXANDRIA, VA 22313-1404**

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**JAN 28 2005**

**OFFICE OF PETITIONS**

In re Application of :
Eva Ingegerd Ejerhed et al :
Application No. 09/599,563 : NOTICE
Filed: June 23, 2000 :
Attorney Docket No. 003300-650 :

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.**

This file no longer qualifies for small entity status. Accordingly, all future fees must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3218.

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
www.uspto.gov

BENTON S. DUFFETT JR.
BURNS DOANE SWECKER & MATHIS LLP
P O BOX 1404
ALEXANDRIA, VA 22313-1404

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JAN 28 2005

OFFICE OF PETITIONS

| | |
|---|---|
| In re Application of | : |
| Eva Ingegerd Ejerhed et al | :DECISION ON REQUEST FOR |
| Application No. 09/599,563 | :LATE CLAIM FOR PRIORITY |
| Filed: June 23, 2000 | :UNDER 37 CFR 1.55(a) |
| Attorney Docket No. 003300-650 | : |

This is a decision on the request under 37 CFR 1.55(a), filed January 10, 2005, for entry of priority papers submitted after the date the issue fee was paid.

The request is **granted**.

Receipt is acknowledged of papers submitted under 35 U.S.C. § 119.

The priority papers are accepted as timely filed and have been placed of record in the file.

Since the instant application issued into a patent on January 11, 2005, the priority data could not be printed on the patent. Accordingly, petitioner may request a certificate of correction under 35 U.S.C. § 255 and 37 CFR 1.323 and pay the $100 fee therefor.

Any questions concerning this decision should be directed to the undersigned at (571) 272-3218.

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

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POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kagumi Moriwaki | : | |
| Application No. 09/599,598 | : | DECISION GRANTING PETITION |
| Filed: June 23, 2000 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 018775-794 | : | |

This is a decision on the petition, filed May 30, 2007, 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 14, 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 should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 2624 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
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 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.*

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. 14

MEDLEN & CARROLL, LLP
101 HOWARD STREET, SUITE 350
SAN FRANCISCO, CA 94105

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DEC 2 0 2002

OFFICE OF PETITIONS

In re Application of :
Anita K. Hopper et al :
Application No. 09/599,662 : ON PETITION
Filed: June 22, 2000 :
Attorney Docket No. PSU-04423 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 16, 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 December 3, 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 March 4, 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 1600 for further processing.

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

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FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

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MAR 17 2008

**OFFICE OF PETITIONS**

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| In re Application of | : | |
| Mark Herrmann et al. | : | |
| Application No. 09/599,675 | : | |
| Filed: June 22, 2000 | : | DECISION ON PETITION |
| Attorney Docket Number: 10984-287001 | : | PURSUANT TO 37 C.F.R. § 1.181(A) |
| Title: CAPTURING ADVERTISING REQUESTS FROM A USER | : | |

This is a decision on the petition pursuant to 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment, filed on January 24, 2008.

The petition is **DISMISSED**.

## Background

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 (notice), mailed October 5, 2007, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees[1]. Accordingly, the above-identified application became abandoned on January 6, 2008.

With this petition, Petitioner has asserted that the notice was not received, and has included the issue and publication[2] fees, a declaration of facts from the Docketing Supervisor/Senior Docketing Specialist, and a copy of an electronic log.

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1 See M.P.E.P. § 710.02(e).
2 The publication fee is not required. This fee will be refunded to Petitioner's Deposit Account in due course.

## RELEVANT PORTION OF THE M.P.E.P.

M.P.E.P. § 711.03(c) sets forth, *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.

## Analysis

The showing in this petition is not sufficient to withdraw the holding of abandonment.

Petitioner has set forth that the notice was not received. Petitioner has attested to the fact that a search of the file jacket and docket records indicates that the Office communication was not received, and has included *a portion of* the docket record where the nonreceived Office communication would have been entered had it been received and docketed.

First, the notice was mailed to the address of record, which is Fish & Richardson's Minneapolis office. Petitioner is located in Boston[3], and as such, it does not appear that Petitioner's file jacket, docket printout, and electronic log can establish that this communication was not received from the Office, since the Office did not mail the notice to Petitioner.

Secondly, *assuming arguendo* that these items could establish that his communication was not received from the Office, Petitioner's showing is incomplete. The declaration of facts makes reference to the inclusion of an electronic log (Exhibit A) and a docket printout (Exhibit B). The electronic log has been located in the electronic file, but the docket printout has not.

## 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 pursuant to 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[4], hand-delivery[5], or facsimile[6].

Alternatively, Petitioner may wish to consider the submission of a petition pursuant to 37 C.F.R. §§ 1.137(a) and/or (b).

As set forth above, the address listed on the petition differs from the address of record. The application file does not

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3 The address that appears below the signature of the Docketing Supervisor/Senior Docketing Specialist makes it clear that she is also located in Boston.

4 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

5 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

6 (571) 273-8300- please note this is a central facsimile number.

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[7]. 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

cc: FISH & RICHARDSON PC
225 Franklin Street
Boston, Massachusetts 02110-2804

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 Petitioner's further action(s).

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P.O. BOX 1022
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JUN 0 3 2008

OFFICE OF PETITIONS

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|---|---|---|
| In re Application of | : | |
| Mark Herrmann et al. | : | |
| Application No. 09/599,675 | : | |
| Filed: June 22, 2000 | : | DECISION ON RENEWED |
| Attorney Docket Number: 10984-287001 | : | PETITION PURSUANT TO 37 C.F.R. § 1.181(A) |
| Title: CAPTURING ADVERTISING REQUESTS FROM A USER | : | |

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment, filed on April 29, 2008.

The renewed petition is **GRANTED**.

## Background

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 (notice), mailed October 5, 2007, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue fees[1]. Accordingly, the above-identified application became abandoned on January 6, 2008.

1 See M.P.E.P. § 710.02(e).

An original petition pursuant to Rule 1.181(a) was filed on January 24, 2008, and was dismissed via the mailing of a decision on March 17, 2008.

## Relevant Portion of the M.P.E.P.

Section 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 describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.
>
> Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.
>
> A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master 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. If no such master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

> 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

Petitioner has included the issue fee, a declaration of facts, and an assertion that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. Petitioner has further included a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO, along with a copy of the master docket for the firm, where the non-received Office action would have been entered had it been received.

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 holding of abandonment is **WITHDRAWN**.

## Conclusion

Pursuant to this decision, the Office of Patent Publication will be notified of this decision so that the present application can be processed into a patent.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[2]. All other inquiries

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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.

concerning the status of the application should be directed to the Office of Patent Publication at 571-272-4200.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No. ____

**STEVEN I. WEISBURD**
**DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP**
**1177 AVENUE OF THE AMERICAS, 41ST FLOOR**
**NEW YORK, NY 10036-2714**

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SEP 16 2003

OFFICE OF PETITIONS

In re Application of :
Yuko Lida :
Application No. 09/599,708 : DECISION GRANTING PETITION
Filed: June 22, 2000 : UNDER 37 CFR 313(c)(2)
Attorney Docket No. P/2041-49 :

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.

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 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) 305-8680.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2835 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).

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Paper No. 14

MAR 1 8 2004

Technology Center 2100

LEE & HAYES PLLC
421 W RIVERSIDE AVENUE SUITE 500
SPOKANE WA 99201

In re Application of: SCOTT L. RUTHFIELD, ET AL.
Application No.: 09/599,806
Filed: June 21, 2000
For: **METHOD AND SYSTEMS OF PROVIDING INFORMATION TO COMPUTER USERS**

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

This is in reply to Petitioner's petition to Withdraw the Holding of Abandonment under 37 CFR 1.181 filed in the United States Patent and Trademark Office on February 23, 2004. No fee is required.

The Petition is **GRANTED**.

A review of the file record reveals that the application was held abandoned on February 12, 2004 for failure to respond to the Office Letter dated March 12, 2003, within the Shortened Statutory Period of three months set therein.

Petitioner submitted a correspondence which included a certificate referring to each piece of the correspondence stating the transmission date of June 12, 2003. The correspondence contained a copy of the response to the Office letter dated March 12, 2003, a copy of the Facsimile Confirmation Report, and a copy of the USPTO Auto-Reply Facsimile Transmission. As a result, the correspondence is deemed as timely filed.

Since a timely response to the Office Letter dated March 12, 2003 was filed, the holding of abandonment dated February 12, 2004 is hereby withdrawn, and the application is restored to pending status. The application will be forwarded to the Examiner of Record for prompt action on the merits of the application.

BEST AVAILABLE COPY

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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LEE & HAYES PLLC
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SPOKANE WA 99201

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JUN 16 2005

**OFFICE OF PETITIONS**

In re Application of:
ARDELEANU et al.
Application No. 09/599,813
Filed: June 21, 2000
Docket No.: MSI-583US

: ON PETITION

The above-identified application has been referred to this office to treat the petition to expunge under 37 CFR 1.59 filed May 2, 2005, which under the circumstances of this case is more properly treated as a petition under 37 CFR 1.182 to disregard the reply filed April 11, 2005, in favor of the reply filed May 2, 2005.

The petition is **granted** to the extent indicated below.

A final office action was mailed February 8, 2005, which set an extendible 3 month period for reply and contained *inter alia*, a rejection of all claims which relied upon a certain U.S. patent application publication ("publication").

On April 11, 2005, applicant filed a RCE and a submission which, in essence, relied upon a declaration under 37 CFR 1.131 to antedate the publication as a means of replying to the rejection.

On May 2, 2005, which is still within the original period for reply to the outstanding Office action, in addition to the instant petition, applicant also filed a reply which traversed the rejection on the merits as opposed to relying on the aforementioned declaration as the means of replying to the rejection.

Petitioner wishes to have the USPTO consider the later reply to the exclusion of the previous reply, while reserving his option of later relying upon antedation, if necessary, to overcome the rejection. Petitioner also requests that the previous reply containing the declaration under 37 CFR 1.131 be expunged and returned.

As to the rule governing this case, 37 CFR 1.59 provides that, upon a showing satisfactory to the Director, information, other than that forming part of the original disclosure may be expunged from an application. However, as indicated in MPEP 724.05 subsection II, this is more properly directed to information that was unintentionally submitted in a file. Inspection of the communication in question reveals

that it clearly was intentionally submitted in this file. Moreover, the USPTO has a long policy, which predates and continues beyond the current amendment of 37 CFR 1.59, of treating requests, as here, to disregard a communication such as e.g., a now unwanted or flawed terminal disclaimer (see MPEP § 1490(A)), or not further process a communication such as e.g., an unwanted CPA (see MPEP 201.06(d) subsection(II)(A)),as a petition under 37 CFR 1.182.

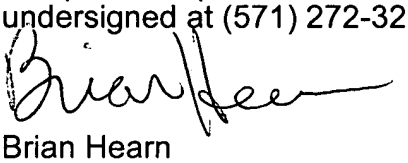
Since the reply filed April 11, 2005, will no longer be utilized, and the reply filed May 2, 2005, that will be utilized were both filed within the period for response, there is no question of abandonment if the former reply is withdrawn. Further, the examiner has not yet issued an Office action based on either reply. Accordingly, the request relief can be favorably considered to the extent that the later reply will be accepted and used for further examination.

In a paper file the former reply could, but not necessarily would, have been physically removed from the file wrapper and returned to applicant; in the IFW realm the corresponding action(s) is to close the document and also remove such from the listing of "Public[ly available] Documents." It is agreed that it would be appropriate in this instance to close the reply filed April 11, 2005, and also remove such from the listing of publicly available documents for this Image File Wrapper (IFW).

As a condition of this favorable treatment petitioner is required to maintain the material in question during the enforceable life of any patent arising from this application, or any patent claiming benefit of this application.

This application is being referred to the TC to consider the RCE and the reply filed May 2, 2005, in due course.

Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217.



Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner for
Patent Examination Policy

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United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 17

DUPONT PHARMACEUTICALS COMPANY
E I DUPONT DE NEMOURS AND COMPANY
LEGAL PATENTS
1007 MARKET STREET
WILMINGTON DE 19898

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APR 0 2 2002

OFFICE OF PETITIONS

In re Application of
Rajopadhye, et al.
Application No. 09/599,890
Filed: June 21, 2000
Attorney Docket No. DM-6999-A

DECISION ON PETITION

This is a decision on the petition filed on February 8, 2002, pursuant to 37 CFR 1.137(b), 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)."

The above-identified application became abandoned for failure to timely file a proper response to the non-final Office action, mailed April 4, 2001, which set a shortened statutory period for reply of one (1) month. On September 7, 2001, petitioner filed a Continued Prosecution Application (CPA). However, petitioner did not obtain an extension of time, so the CPA could not be entered. Regardless, petitioner was mailed a Notice of Improper CPA on September 27, 2001. CPA practice is only available for applications filed before May 29, 2000.[1] Moreover, the CPA could not be treated as an RCE because prosecution in the application had not yet closed. Petitioner obtained the necessary five (5) month extension of time on October 1, 2001 to maintain pendency of the application for purposes of the CPA. However, as explained above, the application is not eligible for CPA practice, nor could the CPA be treated as a constructive RCE. Accordingly, the above-identified application became abandoned on October 5, 2001. A Notice of Abandonment was mailed on October 17, 2001.

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). The instant petition lacks item (1), the required reply.

With the instant petition, petitioner has submitted a CPA. The above-identified application, being filed after May 29, 2000, is not eligible for CPA practice. Moreover, because an RCE can only be filed once prosecution in the application is closed, the CPA can not be treated as a constructive RCE.

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[1] See 37 CFR 1.53(d)(1)(I)(A).

In order for the application to be revived, petitioner must submit a required reply within the meaning of 37 CFR 1.137(b)(1). **Any renewed petition should be accompanied by a proper reply in the form of an Amendment (Election) in response to the non-final Office action (a Restriction Requirement) mailed April 4, 2001, or a continuing application under 37 CFR 1.53(b), not a CPA under 37 CFR 1.53(d).** If petitioner fails to reply in this manner, it may be construed as an intentional delay in presenting a grantable petition, which may adversely affect petitioner's ability to revive the abandoned application.

With the instant petition, petitioner has submitted a Terminal Disclaimer. As the above-identified application was not filed before June 8, 1995, no Terminal Disclaimer is required to revive the abandoned application.[2] Accordingly, the Terminal Disclaimer has not been entered and the $110 Terminal Disclaimer fee has been refunded to petitioner's Deposit Account No. 02-3850

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 $1,960 extension of time fee submitted with the petition on February 8, 2002 was subsequent to the maximum period obtainable for reply (October 4, 2001), this fee has been refunded to petitioner's Deposit Account No. 02-3850.

Furthermore, since the CPA filed on September 7, 2001 was not a proper reply, the CPA fee at that time of $710, plus the $468 submitted for claims in excess of twenty, has been refunded to petitioner's Deposit Account 02-3850. Likewise, the fee of $740 for the CPA submitted with the instant petition (plus the $468 for claims in excess of twenty) has been refunded to petitioner's deposit account.

In total, $4456 has been refunded to Deposit Account No. 02-3850.

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 the undersigned at (703)305-0272.

Cliff Congo
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Bristol-Myers Squibb Pharma Company
Patent Department
P.O. Box 4000
Princeton, New Jersey 08543-4000

---

[2] See 37 CFR 1.137(d).

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

BRISTOL-MYERS SQUIBB PHARMA COMPANY
PATENT DEPARTMENT
PO BOX 4000
PRINCETON NJ 08543-4000

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JUN 12 2002

OFFICE OF PETITIONS

In re Application of
Rajopadhye, et al.
Application No. 09/599,890
Filed: June 21, 2000
Attorney Docket No. DM-6999-A

ON RENEWED PETITION

This is a decision on the renewed petition filed on May 31, 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 file a proper response to the non-final Office action, mailed April 4, 2001, which set a shortened statutory period for reply of one (1) month. On September 7, 2001, petitioner filed a Continued Prosecution Application (CPA). However, petitioner did not obtain an extension of time, so the CPA could not be entered. Regardless, petitioner was mailed a Notice of Improper CPA on September 27, 2001. CPA practice is only available for applications filed before May 29, 2000.[1] Moreover, the CPA could not be treated as an RCE because prosecution in the application had not yet closed. Petitioner obtained the necessary five (5) month extension of time on October 1, 2001 to maintain pendency of the application for purposes of the CPA. However, as explained above, the application is not eligible for CPA practice, nor could the CPA be treated as a constructive RCE. Accordingly, the above-identified application became abandoned on October 5, 2001. A Notice of Abandonment was mailed on October 17, 2001. Petitioner filed a petition to revive under 37 CFR 1.137(b) on February 8, 2002. However, this petition was dismissed in a decision mailed on April 2, 2002.

With the instant petition, petitioner has submitted an election in response to the April 4, 2001 Restriction Requirement and made the proper statement of unintentional delay. The petition fee was previously submitted with the earlier petition on February 8, 2002.

The application file is being forwarded to Technology Center 1600 for consideration of petitioner's amendment (election), filed May 31, 2002.

Telephone inquiries concerning 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

---

[1] See 37 CFR 1.53(d)(1)(I)(A).

JPT
JQB

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

OIPE JC10 DEC 17 2003 PATENT & TRADEMARK OFFICE

Paper No.

FISH & RICHARDSON P.C.
225 FRANKLIN STREET
BOSTON, MASSACHUSETTS 02110-2804

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FISH & RICHARDSON, P.C.
BOSTON OFFICE

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OCT 11 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of
Toner et al
Application No. 09/599,891
Filed: June 21, 2000
Attorney Docket No. 10937-002003

This is a decision on the petition, filed by facsimile transmission on October 11, 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 19, 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 1651 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

NO DOCKETING REQUIRED
Reviewed By Practice Systems
Initials PEC On _____

[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 paym nt of any balance due will result in the abandonment of the application.**

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

**Norris M Eades**
**Kirby Eades Gale Baker**
**PO Box 3432**
**Station D**
**Ottawa K1P 6N9 CA CANADA**

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MAY 17 2007

OFFICE OF PETITIONS

In re Patent No. 6,486,126 :
Issue Date: November 26, 2002 :
Application No. 09/599,958 : NOTICE OF FEE DEFICIENCY
Filed: June 23, 2000 :
Attorney Docket No. 44894 :

This is in response to your petition, filed August 1, 2006, for acceptance of a fee deficiency submission under 37 CFR 1.28(c).

The petition is dismissed.

The petition was accompanied by a $400 credit card authorization to cover the initial filing fee of $345 and $55 terminal disclaimer fee. However, as the current filing fee is $790, the $345 filing fee was insufficient, since the fee that should have been submitted was $445. Additionally, as the current terminal disclaimer fee is $130, the $55 fee submitted was insufficient by $65. The Office adjusted the fees by applying one of the two $55 terminal disclaimer fees received on October 5, 2001 towards the filing fee, leaving one $55 terminal disclaimer fee. The Office applied the $400 credit card payment towards the $790 filing fee and $45 from one of the terminal disclaimer fees, leaving a balance of $10.

In sum, a balance of $65 is due for the large entity terminal disclaimer fee ($10+$55+$65=$130).

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 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.**

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

Paper No. 19

PULSE-LINK, INC.
1969 KELLOGG AVENUE
CARLSBAD, CA 92008

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SEP 14 2004

**OFFICE OF PETITIONS**

In re Application of
Roberto Aiello et al
Application No. 09/599,968
Filed: June 21, 2000
Attorney Docket No. FANT-00-013

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.137(b) AND
:NOTICE RESETTING PERIOD FOR
:REPLY TO NONFINAL OFFICE
:ACTION

This is a decision on the petition, filed August 23, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark Office (USPTO) of the filing of an application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on June 21, 2001. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the USPTO of the filing of a counterpart application in a foreign country or under a multinational treaty that requires publication of applications eighteen months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the Office of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been previously rescinded.

**There is no indication that a reply to the non-final Office action of June 16, 2004 has been filed. Accordingly, a shortened statutory period of three (3) months for reply to the non-final Office action of June 16, 2004 is restarted with the mailing date of this decision. Extensions of time pursuant to the provisions of 37 CFR 1.136(a) are permitted. Failure to timely reply within the period restarted by this decision will result in the abandonment of this application.**

Any inquiries concerning this decision may be directed to the undersigned at (703) 306-5685.[1]

This application is being forwarded to Technology Center Art Unit 2631 to await a reply to the non-final Office action, the period of which is restarted to run from the mailing date of this decision on petition as noted above.

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

[1] Effective September 27, 2004, the phone number will be 571-272-3220.

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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**PULSE-LINK, INC.**
**1969 KELLOGG AVENUE**
**CARLSBAD, CA 92008**

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**NOV 02 2004**

**OFFICE OF PETITIONS**

In re Application of
Roberto Aiello et al
Application No. 09/599,969
Filed: June 21, 2000
Attorney Docket No. FAN-00-012

: DECISION ON PETITION
: UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(f), filed September 20, 2004, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark Office (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is dismissed as **MOOT**.

The record disclosed that, on June 21, 2000, the date of filing of the instant application, there is no indication that applicants had submitted a nonpublication request under 35 U.S.C. § 122 (b)(2)(B)(i) certifying that "the invention disclosed in the attached **application has not and will not** be the subject of an application filed in another country, or under a multilateral international agreement, that requires publication at eighteen months after filing."

In the instant application, since the record fails to disclose that a Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was present on filing the application, the filing of a petition to revive is unnecessary and is dismissed as involving a moot issue.

in view of the above, the petition fee of $665.00 is being credited to Deposit Account No. 50-3143 as authorized.

This matter is being referred to Technology Center 2637.

Any inquiries concerning this decision may be directed to Wan Laymon at (571) 272-3220.

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

12 OCT 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

Aldo J. Test
FLEHT HOHBACH TEST
ALBRITTON & HERBERT LLP
Suite 3400, Four Embarcadero Center
San Francisco, CA 94111-4187

| | | |
|---|---|---|
| In re Application of | : | |
| Philippe J. GOIX | : | |
| Application No.: 09/600,021 | : | DECISION ON |
| PCT No.: PCT/US98/11958 | : | |
| Int. Filing Date: 09 June 1998 | : | PETITION UNDER |
| Priority Date: 09 June 1997 | : | |
| Attorney's Docket No.: A-69293/AJT | : | 37 CFR 1.137(b) |
| For: Method and Apparatus for Detecting | : | |
| Microparticles in Fluid Samples | : | |

This is in response to the "Petition tor Revive Unintentionally Abandoned Patent Application 37 CFR § 1.137(b)" filed on 07 July 2000.

## BACKGROUND

On 09 June 1998, this international application was filed, claiming an earliest priority date of 09 June 1997.

On 31 December 1998, a Demand electing the United States was filed in this international application. Accordingly, the deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 09 December 2000. This international application became abandoned with respect to the United States at midnight on 09 December 2000 for failure to pay the required basic national fee.

On 07 July 2000, applicant filed in the United States Patent and Trademark Office (PTO) the instant petition and a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, *inter alia*, a U.S. basic national fee, the copy of the international application, and oath or declaration. The U.S. basic national fee of $48.00 (small entity status), however, is deficient because the claims did not meet PCT Article 33(1)-(4). Accordingly the proper basic national fee is $335.00 and the difference, $287.00, has been charged to applicant's Deposit Account No. 06-1300 as authorized on the transmittal letter date 07 July 2000.

## DISCUSSION

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. 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(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.

Applicant's statement that "Abandonment of this application was unintentional, and the necessary responses are being submitted with this petition " is being construed as 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. Petitioner must notify the Patent and Trademark Office if such an interpretation of the statement in the petition is not correct. Thus, the statement in the petition is being accepted in satisfaction of 37 CFR 1.137(b)(3).

Moreover, petitioner has provided: (1) the proper reply by submitting the basic national filing fee, and (2) the petition fee set forth in §1.17(m). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3) and (4) under 37 CFR 1.137(b).

## DECISION

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

This application is being returned 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 **07 July 2000.**.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

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. 21

AUDLEY A CIAMPORCERO JR
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

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**FEB 03 2004**

**OFFICE OF PETITIONS**

In re Application of :
Larkin et al. :
Application No. 09/600,025 : ON PETITION
Filed: 29 August, 2000 :
For: METHODS FOR PLANT :
TRANSFORMATION AND REGENERATION

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on 21 January, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on 6 June, 2003, for failure to file a proper reply to the final Office action mailed on 5 March,

---

[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)).

2003, which set a three (3) month shortened statutory period for reply. No extensions of the time in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 22 October, 2003.

On 21 January, 2004, the present petition was filed, accompanied by a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

The application will be forwarded to Technology Center 1600 for consideration of the RCE and amendment.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

JUN 2 0 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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William S. Frommer
Frommer, Lawrence & Haug, LLP
745 Fifth Avenue
New York, NY 10151

| | | |
|---|---|---|
| In re Application of | : | |
| SUMIDA | : | DECISION ON |
| Application No.: 09/600,047 | : | |
| PCT No.: PCT/JP99/06332 | : | PETITION UNDER |
| Int. Filing Date: 12 November 1999 | : | |
| Priority Date: 12 November 1998 | : | 37 CFR 1.181 |
| Attorney Docket No.: 450119-2169 | : | |
| For: DATA MULTIPLEXING APPARATUS AND DATA MULTIPLEXING METHOD AND DATA TRANSMITTING APPARATUS | : | |

This is a decision on applicant's "Petition Under 37 C.F.R. § 1.181 to Remove Notice of Abandonment and Request Remailing of Notification of Missing Requirements" filed on 30 March 2001 in the United States Patent and Trademark Office (USPTO) and supplemented on 11 April 2001.

## BACKGROUND

On 12 November 1999, applicant filed international application PCT/JP99/06332, which claimed priority of an earlier application filed 12 November 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 25 May 2000. A Demand for international preliminary examination, in which the United States was elected, was not 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 12 July 2000.

On 11 July 2000, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); an English translation of the international application; an Information Disclosure Statement and a first preliminary amendment. An oath or declaration as required by 35 U.S.C. 371 (c)(4) was not included.

On 09 August 2000, applicant was mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date. Applicant was also notified of the need to pay the $130.00 surcharge for providing the oath or

declaration later than 30 months from the earliest claimed priority date. Applicant was given one month to respond and advised that this time period could be extended with a proper petition and payment of fees.

On 08 March 2001, applicant was mailed a Notification of Abandonment (Form PCT/DO/EO/909) for having failed to respond to the Notification of Missing Requirements (Form PCT/DO/EO/905) within the time required.

On 30 March 2001, applicant filed the present petition requesting withdrawal of the holding of abandonment. On 11 April 2001 applicant supplemented the petition applicant by filing a "Response to Notification of Missing Requirements" which included an executed declaration of the inventor and authorization to charge the $130.00 surcharge for providing an oath or declaration later than twenty months from the priority date.

## DISCUSSION

The Official Gazette, at 1156 OG 53, provides that a petition requesting relief based on the grounds that an Office action was not received must be accompanied by a statement that (1) the Office action was not received, (2) attests that a search of the file jacket indicates the Office action was not received, (3) attests that a search of counsel's docket records indicates the Office action was not received and (4) the Petition must also be accompanied by copies of the docket records where the non-received Office action would have been entered. (See also, Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

Applicant's petition and accompanying papers filed 30 March 2001 satisfy the items above. In addition, applicant has now provided an executed declaration and payment of the relevant surcharge which were the subject of the Notification of Missing Requirements. With the filing of the executed declaration, all of the requirements of 35 U.S.C. 371 for entry into the national stage in the United States have been satisfied.

## CONCLUSION

Applicant's Petition Under 37 CFR 1.181 is **GRANTED**.

As authorized, $130.00 will be deducted from Deposit Account 50-0320 for payment of the appropriate surcharge for providing the declaration later than twenty months from the priority date.

The Notification of Abandonment mailed 08 March 2001 is hereby **VACATED**.

The application has an international filing date of **12 November 1999** under 35 U.S.C. 363 and a date of **11 April 2001** under 35 U.S.C. 371(c).

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for treatment in accordance with this decision.

Leonard Smith
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

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

JJGJR.: 09-07

Paper No: __

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OFFICE OF PETITIONS

FROMMER
LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK NY 10151

In re Application of :
Sumida :
Application No.: 09/600,047 :
Filing Date: 11 April, 2001 :
Attorney Docket No. 450119-02169 :

DECISION

This is a decision on the paper viewed as a petition filed on 1 September, 2006, to withdraw the holding of abandonment and considered 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]

For the reasons set forth below the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**.

## BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to then Notice to File Corrected Papers

[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.**

mailed on 27 October, 2005, with reply due under a non-extendable 30-day deadline on or before 26 November, 2005;

- the application went abandoned by operation of law after midnight on 26 November, 2005;
- the Office mailed the Notice of Abandonment on15 August, 2006;
- on 1 September, 2006, the Office of Publications rescinded (without specification of date) sui sponte the Abandonment
- on 1 September, 2006, Petitioner filed the instant petition, and averred therein, *inter alia*, timely reply and evidenced the reply with supporting documentation
- the instant application issued as Patent No. 7,130,265 on 31 October, 2006.

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 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]

---

[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,

## 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]

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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]

[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).

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

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:

* * *

> **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

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[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.

[9] See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

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 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.

* * *

Moreover, the regulation places upon Petitioner a diligence requirement to seek relief within two (2) months of the act complained of.

It appears that the instant matter is moot as a result of the Office action of 1 September, 2006.

## CONCLUSION

The petition as considered under 37 C.F.R. §1.181 is **dismissed as moot**.

The instant application is released to IFW storage.

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

[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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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JAN 0 7 2008

**OFFICE OF PETITIONS**

In re Application of :
Ades et al. :
Application No. 09/600,057 : ON PETITION
Filed: October 5, 2000 :
Attorney Docket No. 14114.0381U2 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 7, 2007, to revive the above-identified application.

The petition is **GRANTED**.

This above-identified application became abandoned for failure to timely file an appeal brief and submit the accompanying fee. Applicant filed a Notice of Appeal on November 23, 2005 (certificate of mailing November 21, 2005) . Pursuant to 37 CFR 41.37(a) applicant was required to file an Appeal brief two months from November 23, 2005. No extensions of time pursuant to 37 CFR 1.136 were obtained. Accordingly, this application became abandoned on January 23, 2006. A Notice of Abandonment was mailed on July 28, 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 Request for Continued Examination (RCE) and fee of $790.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $1500.00; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 1645 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.

Charlema Grant

Charlema Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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PORTLAND, OR 97204

Mail Date: 04/22/2010

| | | |
|---|---|---|
| **Applicant** | : Edwin W. Ades | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7635486 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/22/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/600,057 | : OF WYETH |
| **Filed** | : 10/05/2000 | : |
| | | : |

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.

JUN 12 2001

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In re Application of SAIED et al.
Application No.: 09/600,073
PCT No.: PCT/FR99/00040
Int. Filing: 12 January 1999
Priority Date: 12 January 1998
Attorney Docket No.: 1029/00205
For: METHOD FOR EXPLORING AND DISPLAYING TISSUE OF HUMAN OR ANIMAL ORIGIN FROM A HIGH FREQUENCY ULTRASOUND PROBE

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 05 February 2001. Applicants requested a five month extension of time, which was granted.

## BACKGROUND

On 12 January 1999, applicants filed international application No. PCT/FR99/00040 which claimed priority of an earlier U.S. application filed 12 January 1998. A copy of the international application had been communicated earlier to the United States Patent and Trademark Office from the International Bureau on 15 July 1999.

On 19 July 1999, 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 12 July 2000.

On 11 July 2000, applicants filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee and an English translation of the international application.

On 03 August 2000, 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(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required. The notification set a one month time limit in which to respond.

On 05 February 2001, applicants, in response to 03 August 2000 Notification of Missing Requirements, filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Michel Puech on the grounds that the non-signing inventor refused to execute the declaration.

## DISCUSSION

The petition included the requisite petition fee and a verified statement of someone having first hand knowledge whose name was not identified in the declaration and whose signature was illegible, regarding Mr. Puech's refusal to sign . The signatory of the declaration apparently is an employee of the France Invention Scientific Transfery (FIST), agent for the alleged assignee.

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 non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3), and (4) have been submitted and satisfy the requirements of 37 CFR 1.47(a).

With respect to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor....
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the

document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

[Emphasis added]

Here, Petitioner submitted a statement of facts under 37 CFR § 1.47(a)(2) executed by person claiming first hand knowledge, however, the person's name is illegible. Paragraphs two (2) and six (6) of the statement states that the *declaration* was sent to Mr. Puech on July 10, 2000 and October 24, 2000. Nor is it clear that the person signing the statement is the one who sent the papers to the inventor. This is insufficient evidence to conclude that applicant/inventor Michel Puech has refused to sign the *application*. What is required is that Mr. Puech be presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application as identified above.

Petitioner has not demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/600,073 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address and (2) Mr. Puech's refusal to sign, either in writing or by telephone, these documents.

In sum, the evidence submitted does not support a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

## CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED** without prejudice.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) 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(a)." No additional petition fee is required.

A proper response must include either a declaration executed by all inventors or a proper showing that Mr. Puech has been presented with a copy of the application papers for U.S. application 09/600,073 (specification, including claims, drawings, and declaration) and that subsequently, he has refused to execute the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Richard R. Cole
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Petitions Attorney
PCT Legal Office

CMK/RRC:cmk

Telephone: (703) 306-5467

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FEB 04 2002

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In re Application of SAIED et al.
Application No.: 09/600,073
PCT No.: PCT/FR99/00040
Int. Filing: 12 January 1999
Priority Date: 12 January 1998
Attorney Docket No.: 1029/00205
For: METHOD FOR EXPLORING AND DISPLAYING TISSUE OF HUMAN OR ANIMAL ORIGIN FROM A HIGH FREQUENCY ULTRASOUND PROBE

DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicant's renewed petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 12 September 2001. Applicants requested a one month extension of time, which is granted.

## BACKGROUND

On 03 August 2000, 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(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required. The notification set a one month time limit in which to respond.

On 05 February 2001, applicants, in response to 03 August 2000 Notification of Missing Requirements, filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Michel Puech, on the grounds that the non-signing inventor refused to execute the declaration.

On 12 June 2001, a decision dismissing applicants' petition under 37 CFR 1.47(a) was mailed to applicants indicating that applicants had not demonstrated that a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/600,073 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address and had not demonstrated Mr. Puech's refusal to sign, either in writing or

by telephone, these documents.

On 12 September 2001, applicants filed a renewed petition under 37 CFR 1.47(a) including a statement of the efforts to reach the non-signing inventor by Chantal Peaucelle, having first-hand knowledge of the refusal.

## 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 non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Items (1), (3), and (4) have been submitted, satisfing the requirements of 37 CFR 1.47(a).

With respect to item (2), where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers, and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. *See* Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.

Here, Petitioner submitted a statement of facts under 37 CFR § 1.47(a)(2) executed by Chantal Peaucelle, the person claiming first hand knowledge of the refusal. The statement indicates that on 23 July 2001, Chantal Peaucelle sent a copy of the application by registered mail to Michel Puech, the non-signing inventor. A copy of the cover letter and an English translation were provided. On 27 July 2001, Ms. Peaucelle phoned Mr. Puech and spoke with his secretary. Thereafter Mr. Puech "returned the phone call and indicated that he had received the mentioned patent application papers but has been repeatedly told by his attorney, Mr. Francis Ahner, of the French patent law firm Cabinet Regimbeau, to refuse to sign. The reason for the refusal is the fact that Mr. Puech filed a separate application in the U.S. on his own behalf."

Mr. Puech was presented with a copy of all of the national stage application papers (oath and declaration, specification, including claims and drawings) for this application. The statement that Mr. Puech was advised by his attorney not to sign the application papers and has not, in fact, the returned the papers with his signature is sufficient evidence to conclude that applicant/inventor Michel Puech has refused to sign the application.

Petitioner has demonstrated that: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 09/600,073 (specification, including claims, drawings, and declaration) to the nonsigning inventor for his signature, sent to his last known address and (2) Mr. Puech's oral refusal to sign these documents.

In sum, the evidence submitted supports a finding that the nonsigning inventor refuses to sign the application for the reasons set forth above. Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

**CONCLUSION**

The petition under 37 CFR §1.47(a) is **GRANTED**.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 05 February 2001 and to mail a filing receipt. The application has an international filing date of 12 January 1999 under 35 U.S.C. 363, and a date of 05 February 2001 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.

Boris Milef
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
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FEB 04 2002

MICHEL PUECH
14 AVENUE DE BRETEUIL
75007 PARIS FRANCE

| | | |
|---|---|---|
| In re Application of SAIED et al. | : | |
| Application No.: 09/600,073 | : | NOTIFICATION |
| PCT No.: PCT/FR99/00040 | : | |
| Int. Filing: 12 January 1999 | : | UNDER |
| Priority Date: 12 January 1998 | : | |
| Attorney Docket No.: 1029/00205 | : | 37 CFR 1.47(a) |
| For: METHOD FOR EXPLORING AND DISPLAYING TISSUE OF HUMAN OR ANIMAL ORIGIN FROM A HIGH FREQUENCY ULTRASOUND PROBE | : | |

Dear Mr. Puech:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an 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 to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you care to join in 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.

Boris Milef
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Attorney Advisor
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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

FEB 04 2002

# OFFICIAL GAZETTE NOTICE

## 37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of a national stage 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 inventor whose signature is missing (Michel Puech) 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/FR99/00040 and was filed on 12 January 1999 in the names of Amena Saied, Genevieve Berger, Pascal Laugier and Michel Puech for the invention entitled Method for Exploring and Displaying Tissues of Human or Animal Origin From a High Frequency Ultrasound Probe. The national stage application is assigned number 09/600,073 and has a 35 U.S.C. 371(c) date of 05 February 2001.

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Micheline Gravelle
BERESKIN & PARR
Box 401, 40 King Street West
Toronto, Ontario
Canada M5H 3Y2

In re Application of
WARRINGTON, R. C. *et al*
Application No.: 09/600,125
PCT No.: PCT/CA99/00005
Int. Filing Date: 13 January 1999
Priority Date: 13 January 1998
Attorney Docket No.: 10242-32
For: COMPOSITION CONTAINING PROPARGYLAMINE FOR ENHANCING CANCER THERAPY

DECISION

This is a decision on applicants' "Renewed Request Under 37 CFR 1.42" filed 30 April 2001.

## BACKGROUND

On 28 February 2001, a decision dismissing applicants' request under 37 CFR 1.42 was mailed. The request was dismissed because applicants did not provide the name, citizenship, residence, and last known post office address of the deceased inventor as required. In addition, there was a question as to the names of the persons signing as the legal representatives of I. Alick Paterson and their authority to sign for Canada Trust.

On 30 April 2001, applicants submitted the instant renewed response which was accompanied by, *inter alia*, three notarized statements attesting to the identity, title and authority of the legal representatives, and another executed declaration with an added page listing the name, citizenship, residence, and last known post office address of the deceased inventor.

## DISCUSSION

In the renewed petition, applicants submitted three notarized "Statements" attesting to the identity, position and authority of Brenda Kennedy and Kevin Rogers as authorized representatives of Canada Trust, legal representative of I. Alick Paterson. This evidence is sufficient to meet the objections detailed in the prior decision.

Applicants also filed another declaration with an "added page" to the Declaration. This "added page" lists the name, citizenship, residence, and last post office address of the deceased inventor, I. Alick Paterson. The declaration also indicates that Brenda

Kennedy and Kevin Rogers are the legal representatives of I. Alick Paterson as required.

However, the declaration does not list the residences and mailing addresses of the legal representatives as required by 37 CFR 1.497(b)(2). Therefore, the declaration is still not acceptable under 37 CFR 1.42.

It is also noted that the declaration does not provide the mailing addresses and residences of co-inventors, R.C. Warrington and Alan A. Boulton. 37 CFR 1.497 does not require this information. However, 37 CFR 1.63 does require this information unless such information is supplied on an application data sheet in accordance with 37 CFR 1.76.

## CONCLUSION

For the reasons listed above, applicants' renewed request under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration of this decision 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 Request Under 37 CFR 1.42". Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Richard Cole
PCT Legal Examiner
PCT Legal Office

James Thomson
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Tel.: (703) 308-6457

FEB 2 8 2001

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In re Application of :
WARRINGTON, R. C. *et al* :
Application No.: 09/600,125 :
PCT No.: PCT/CA99/00005 :
Int. Filing Date: 13 January 1999 :
Priority Date: 13 January 1998 : DECISION
Attorney Docket No.: 10242-32 :
For: COMPOSITION CONTAINING :
PROPARGYLAMINE FOR ENHANCING :
CANCER THERAPY :

This is a decision on the papers filed 02 January 2001 requesting the United States Patent and Trademark Office (PTO) accept the declaration signed by the legal representative of a deceased co-inventor.

## BACKGROUND

On 13 January 1999, applicants filed international application PCT/CA99/00005 claiming priority to a Canadian patent application filed 13 January 1998. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office on 22 July 1999.

On 13 August 1999, 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.*, 13 July 2000.

On 12 July 2000, 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 check of $910.00 to pay the basic national fee; and authorization to charge Counsel's Deposit Account No. 02-2095 for any additional fees as required.

On 26 October 2000, a NOTIFICATION OF MISSING REQUIREMENTS (Form PCT/DO/EO/905) was mailed indicating that a declaration in compliance with 37 CFR 1.497(a) & (b) and a surcharge pursuant to 37 CFR 1.492(e) was required. A one month time limit was set for response.

On 02 January 2001, applicants submitted the instant response which was accompanied by, *inter alia*, a one-month extension and fee, the required surcharge fee, a copy of the "Letters Probate," and a copy of the "Last Will" of Ian Alick Paterson.

## DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

> 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 the patent.

In the instant petition, applicants have furnished a declaration signed by two of the three co-inventors, R.C. Warrington and Alan A. Boulton, and by "Canada Trust" as legal representative of I. Alick Paterson. However, applicants have not provided the name, citizenship, residence, and last post office address of the deceased inventor as required pursuant to 37 CFR 1.497.

Also, it appears that two persons signed for the legal representative, Canada Trust, however, the names of these persons are not listed and their signatures are illegible. In addition, the position of "Senior Trust Officer" and "Estate Counsellor," are positions not normally associated with having the authority to sign for a corporation and there is no statement claiming that these persons have the requisite authority to sign for Canada Trust. Such an express declaration by each agent is required.

Accordingly, the declaration is not acceptable under 37 CFR 1.42.

Applicants also included a copy of the "Letters Probate," and a copy of the "Last Will" of Ian Alick Paterson" presumably as the proof of the authority under 37 CFR 1.44 of Canada Trust to sign as the legal representative of the deceased inventor. It is noted that proof of the authority of the legal representative in compliance with 37 CFR 1.44 is no longer required in the USPTO as of 08 September 2000.

## CONCLUSION

Applicants' request Under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration of this decision 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 Request Under 37 CFR 1.42". Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

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PCT Legal Office

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In re Application of :
WARRINGTON, R. C. *et al* :
Application No.: 09/600,125 :
PCT No.: PCT/CA99/00005 :
Int. Filing Date: 13 January 1999 :
Priority Date: 13 January 1998 : DECISION
Attorney Docket No.: 10242-32 :
For: COMPOSITION CONTAINING :
PROPARGYLAMINE FOR :
ENHANCING CANCER THERAPY :

This is a decision on applicants' "Renewed Request Under 37 CFR 1.42" filed 16 October 2001.

## BACKGROUND

On 10 July 2001, a decision dismissing applicants' request under 37 CFR 1.42 was mailed because the declaration did not list the residences and mailing addresses of the legal representatives of deceased co-inventor, I. Alick Paterson as required by 37 CFR 1.497(b)(2).

On 16 October 2001, applicants submitted the instant renewed request which was accompanied by, *inter alia*, an executed declaration and a two-month extension and a $400.00 extension fee.

## DISCUSSION

The decision dated 10 July 2001 stated that the declaration submitted 30 April 2001 was not in compliance with 37 CFR 1.497 because the residences and mailing addresses of the legal representatives, Brenda Kennedy and Kevin Rogers were not listed. After further consideration, this statement has been determined to be erroneous.

The legal representative in this case is the Canada Trust Company. Therefore, the citizenship, residence and mailing address of the Canada Trust Company is required on the declaration, not that of Ms. Kennedy or Mr. Rogers. *See* 37 CFR 1.497(b)(2).

However, a further review of the declaration filed 30 April 2000 shows that it was still not in compliance with 37 CFR 1.497. The declaration did not denote the citizenship of the Canada Trust Company. The statement "that it is a Canadian Company" listed on the top portion of the "Added Page to Combined Declaration . . ." is not sufficient. 37 CFR 1.497(b)(2) specifically requires that the citizenship of the legal representative be on the declaration. Further, section 605.01 of the Manual of Patent Examining Procedure states that "[w]here an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement." No such statement was filed.

Moreover, the residence of the legal representative was listed, but the declaration did not indicate whether that was also the mailing address of the Canada Trust Company. Both the residence and mailing address of the legal representative must be listed pursuant to 37 CFR 1.497(b)(2).

The declaration filed with the instant petition is also not in compliance with 37 CFR 1.497 due largely to counsel's attempt to follow the instructions contained in the decision dated 10 July 2001. We regret any inconvenience this may have caused.

It is also noted that the citizenship of the deceased co-inventor, I. Alick Paterson is listed as the United Kingdom on the 30 April 2001 declaration, while the citizenship of the deceased co-inventor is listed as Canadian in the declaration submitted in the instant response. Please verify whether the citizenship of the deceased co-inventor is Canadian or British.

## CONCLUSION

Applicants' request Under 37 CFR 1.42 is **DISMISSED** without prejudice.

If reconsideration of this decision 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 Request Under 37 CFR 1.42". Extensions of time may be obtained under 37 CFR 1.136(a).

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Boris Milef
PCT Legal Examiner
PCT Legal Office

James Thomson
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APR 26 2002

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In re Application of :
WARRINGTON, R. C. *et al* :
Application No.: 09/600,125 :
PCT No.: PCT/CA99/00005 :
Int. Filing Date: 13 January 1999 :
Priority Date: 13 January 1998 : DECISION
Attorney Docket No.: 10242-32 :
For: COMPOSITION CONTAINING :
PROPARGYLAMINE FOR :
ENHANCING CANCER THERAPY :

This is a decision on applicants' "Renewed Request Under 37 CFR 1.42" filed 10 April 2002.

## BACKGROUND

On 11 January 2002, a decision dismissing applicants' request under 37 CFR 1.42 was mailed because the declaration submitted on 16 October 2001 did not comply with the requirements of 37 CFR 1.497.

On 10 April 2002, applicants submitted the instant renewed request which was accompanied by, *inter alia*, an executed declaration and a one-month extension with accompanying $110.00 extension fee.

## DISCUSSION

As stated in the 11 January 2002 decision, the legal representative of the deceased co-inventor is the Canada Trust Company. Therefore, the citizenship, residence and mailing address of the Canada Trust Company are required on the declaration pursuant to 37 CFR 1.497(b)(2). In addition, section 605.01 of the Manual of Patent Examining Procedure states that "[w]here an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement."

It was also noted in the prior decision that the citizenship of the deceased co-inventor, I. Alick Paterson is listed as the United Kingdom on the 30 April 2001 declaration, while the citizenship of the deceased co-inventor is listed as Canadian in the declaration submitted on 16 October 2001.

In the instant renewed petition, applicants have submitted a new declaration complying with all of the requirements of 37 CFR 1.497(a) and (b). The citizenship of the legal representative, the Canada Trust Company is indicated as "no citizenship" which meets the requirements of the MPEP. Both the residence and mailing address of the Canada Trust Company are listed on the declaration. Finally, the citizenship of I. Alick Paterson is listed as the United Kingdom.

This declaration complies with 37 CFR 1.497(a) and (b).

## CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 13 January 1999 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of 10 April 2002.

This application is being forwarded to the United States Designated/Elected Office for further processing in accordance with this decision.

Boris Milef
PCT Legal Examiner
PCT Legal Office

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

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191 Peachtree Street N.E. 45th Floor
Atlanta GA 30303

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OFFICE OF PETITIONS

In re Application of :
Keith H.S. Campbell :
Application No. 09/600,130 : DECISION ON PETITION
Filed: 05/14/2001 :
Attorney Docket No. 105434.105001 :

This is decision on the petition under 37 CFR 1.181, filed July 28, 2006, to withdraw the holding of abandonment in the above-identified application.

On April 13, 2005, the Office mailed a nonfinal Office action, which set a three month shortened statutory period for reply. In the apparent absence of a timely filed response, the Office mailed a Notice of Abandonment on March 23, 2006.

In the present petition, petitioner asserted that the Office issued the Notice of Abandonment in error because petitioner submitted a timely response, a request for an extension of time for response within the second month, and a certificate of mailing dated September 13, 2005. Petitioner provided the Office a copy of these documents, as well as a return, itemized postcard receipt with a USPTO date-stamp of September 15, 2005.

Unfortunately, the response, the request for an extension of time, and the certificate of mailing dated September 13, 2005, were not located in the official file. Therefore, petitioner is relying on the certificate of mailing as evidence of the timely filing of these documents on September 13, 2005.

Pursuant to Section 711.03(c)(I)(B) of the Manual of Patent Examining Procedure:

> Where a certificate of mailing under 37 CFR 1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 CFR 1.8(b) and MPEP § 512. As stated in 37 CFR 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).

In the present petition, petitioner did not provide a statement under 37 CFR 1.8(b)(3), attesting to a personal knowledge of the mailing of the original response on the date indicated on the certificate by the person who signed the certificate (*i.e.,* Stephanie Adams). Additionally, Rebecca J. Kaufman did not explain how she had firsthand knowledge of the previous timely mailing.

Accordingly, the petition to withdraw the holding of abandonment is **dismissed**. Before the Office can withdraw the holding of abandonment, petitioner must submit a request for reconsideration and a statement in compliance with 37 CFR 1.8(b)(3). A request for reconsideration of this decision must be submitted with TWO (2) MONTHS of the mailing date of this decision. Extensions of this time period may be granted under 37 CFR 1.136. The request for reconsideration should include a cover sheet entitled "Renewed Petition Under 37 CFR 1.181." No additional fee is due for filing a renewed petition.

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
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Application of :
Keith H.S. Campbell :
Application No. 09/600,130 : DECISION ON PETITION
Filed: 05/14/2001 :
Attorney Docket No. 105434.105001 :

This is decision on the renewed petition under 37 CFR 1.181, filed November, 2006, to withdraw the holding of abandonment in the above-identified application.

On April 13, 2005, the Office mailed a nonfinal Office action, which set a three month shortened statutory period for reply. In the apparent absence of a timely filed response, the Office mailed a Notice of Abandonment on March 23, 2006. On July 28, 2006, petitioner filed the original petition under 37 CFR 1.181, in which petitioner asserted that the Office issued the Notice of Abandonment in error because petitioner submitted a timely response, a request for an extension of time for response within the second month, and a certificate of mailing dated September 13, 2005. Copies of these documents accompanied the petition. Nevertheless, the petition was dismissed by the decision of November 15, 2006, for failure to submit a statement under 37 CFR 1.8(b)(3).

On November 28, 2006, petitioner filed the present renewed petition. In addition, petitioner submitted the Statement of Stephanie Adams, the person who signed the certificate of mailing under 37 CFR 1.8(b), attesting to her personal knowledge of the mailing of the original response on September 13, 2005, in response to the Office action of April 13, 2005. The Office notes that the certificate of mailing of September 13, 2005, would have rendered the reply and the request for an extension of time for response in the second month as timely filed if received in the USPTO; however, the application file does not include the original reply, the request of an extension of time, or the certificate of mailing.

Pursuant to 37 CFR 1.8(b):

> 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 U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is 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 Director 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.

The present petition satisfies the requirements of 37 CFR 1.8(b). Accordingly, the holding of abandonment for failure to file a timely reply to the nonfinal Office action of April 13, 2005, is withdrawn and the application is restored to pending status. The Office will accept the copy of the reply and the request for an extension of time submitted on July 28, 2006, in place of the reply mailed on September 13, 2005.

This application is being referred to Technology Center AU 1632 for appropriate action on the amendment submitted on July 28, 2006 (certificate of mailing dated September 13, 2005).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211. All other questions regarding the status of the application or the examination process should be directed to the Technology Center.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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| | | |
|---|---|---|
| In re Application of | : | |
| Campbell | : | |
| Application No. 09/600,130 | : | DECISION ON PETITION |
| Filed: 05/14/2001 | : | |
| Attorney Docket No. 105434.105001 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 23, 2008, 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 April 16, 2007, 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 July 17, 2007. On March 17, 2008, the Office mailed a Notice of Abandonment.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee, and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3211.

This application is being referred to Technology Center AU 1632 for appropriate action by the Examiner in the normal course of business on the reply received on October 23, 2008.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

- AUG 03 200[redacted]

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Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

In re Application of MEIER et al
U.S. Application No.: 09/600,180
Int. Application No.: PCT/EP99/00635
Int. Filing Date: 01 February 1999
Priority Date: 05 February 1998
Attorney Docket No.: 194070US0 PCT
For: DEVICE FOR PRODUCING POLYMER SUPPORT MATERIALS IN THE FORM OF POROUS POLYMER BEADS

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This is in response to applicant's "Request for Reconsideration of Decision on Request Under 37 CFR 1.497(a)" filed 30 March 2001, which is being treated as a renewed request under 37 CFR 1.497(d).

## BACKGROUND

On 01 February 1999, applicants filed international application PCT/EP99/00635, which claimed priority of an earlier Germany application filed 05 February 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 12 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 August 1999, 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 05 August 2000.

On 04 August 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 22 August 2000, 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 must be filed.

On 21 December 2000, applicants filed a request under 37 CFR 1.497(d) accompanied by an executed declaration and an assignment document. The declaration is executed by the inventors identified in the international application as well as one additional inventor, i.e. Thomas Boller.

On 05 March 2001, the PCT Legal Office of the USPTO mailed a decision dismissing the 21 December 2000 request on grounds that written consent of the assignee had not been provided.

On 30 March 2001, applicants filed the present renewed request. The renewed request states that it is accompanied by an executed "Consent for Assignee to Change of Inventorship".

## DISCUSSION

37 CFR 1.497(d) (effective 07 November 2000) states,

> If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) 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).

With regard to item (1) above, applicant has provided the requisite statement.

With regard to item (2) above, the requisite fee has been provided.

With regard to item (3) above, ownership of the application must be established when an assignee consents to a correction of inventorship. MPEP 324.

According to 37 CFR 3.73(b), ownership of the application may be established by: (A) submitting documentary evidence of a chain of title from the original owner to the assignee; or (B) specifying by reel and frame number where such evidence is recorded in the USPTO. In the present case, the assignment document filed 21 December 2000 sufficiently establishes a chain of title from the inventors to the assignee.

37 CFR 3.73(b) further provides that a submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. MPEP 324 states,

> The submission under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):

> (A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. An officer (president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. A person having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney from the inventors in an organization to a practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.
>
> (B) The submission may be signed by any person, if the submission sets forth that the person signing is empowered to sign the submission on behalf of the assignee.
>
> (C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.
>
> Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required.

In the present case, item (B) applies. Although the "Consent for Assignee to Change of Inventorship" filed with the renewed request states that Drs. Rainer Teubner and Michael Gottschalk are "duly authorized representatives of the Assignee for this application", the submission does not specifically set forth that Drs. Teubner and Gottschalk are empowered to sign the submission on behalf of the assignee. As applicants have not complied with any of items (A), (B), or (C) above, evidence of Dr. Teubner's and Dr. Gottschalk's authority to sign is required.

## CONCLUSION

Because applicants have failed to satisfy item (3) above, the renewed request under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)." No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Richard Cole
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

MAR 0 5 2001

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

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT
4th Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

In re Application of
MEIER et al
Application No.: 09/600,180
PCT No.: PCT/EP99/00635
Int. Filing Date: 01 February 1999
Priority Date: 05 February 1998
Attorney Docket No.: 194070USOPCT
For: APPARATUS AND SYNTHESIS OF SUPPORT POLYMER MATERIALS IN THE FORM OF POROUS POLYMER BEADS

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This is a decision on the "Request for Change of Inventorship under 37 CFR 1.48(a)" filed 21 December 2000, which has been treated as a request under 37 CFR 1.497(d), as the present application has not yet completed the requirements for entry into U.S. national stage.

## BACKGROUND

On 01 February 1999, applicants filed international application No. PCT/EP99/00635 designating the United States and claiming a priority date of 05 February 1998. A Demand electing, *inter alia*, the United States, was filed prior to the expiration of 19 months from the priority date. Consequently, the deadline for entry into the national stage in the U.S. expired as of midnight of 05 August 2000.

On 04 August 2000, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, payment of the full U.S. basic national fee and surcharge fee under 37 CFR 1.492(e). A declaration was not filed.

On 22 August 2000, a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905) was mailed to applicants requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b). The notice set a one-month extendable period for reply.

On 21 December 2000, applicants filed the present request under 37 CFR 1.497(d)

accompanied by a three-month extension of time and an executed declaration. The declaration is executed by the inventors identified in the international application, as well as one additional inventor, i.e., Thomas Boller.

## DISCUSSION

A request under 37 CFR 1.497(d) to accept an oath or declaration changing inventorship must include: 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) the fee set forth in § 1.17(i); and 3) written consent of the assignee, if an assignment has been executed by any of the original named inventors.

Applicants have satisfied items (1)-(2) above.

With regard to item (3), it is not clear that consent of the assignee has been given. The first sentence of the "Consent for Assignee" indicates that "**Röhm** GmbH" is the "authorized representative" of the "Assignee, **Roehm** GmbH." It is unclear under what authority **Röhm** GmbH is permitted to sign the submission on behalf of **Roehm** GmbH. Is **Röhm** GmbH a holding company and thus a subsequent assignee? Proof of authority must be provided. Moreover, the "Consent" is signed by Drs. Teubner and Gottschalk as "authorized agents" of "Röhm GmbH." These signatories do not have apparent authority to sign the submission on behalf of **Röhm** GmbH, nor do they clearly state that they have been empowered to sign the submission on behalf of the corporate entity. See MPEP 324.

## CONCLUSION

For the reasons above, the request under 37 CFR 1.497(d) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)". Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file the proper reply will result in **ABANDONMENT** of the application

A proper reply must include written consent of the assignee as discussed above.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, DC 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Boris Milef
Legal Examiner
PCT Legal Office

Telephone: (703) 308-3659
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DEC 11 2001

Oblon, Spivak, McClelland, Maier & Neustadt, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

In re Application of MEIER et al
U.S. Application No.: 09/600,180
Int. Application No.: PCT/EP99/00635
Int. Filing Date: 01 February 1999
Priority Date: 05 February 1998
Attorney Docket No.: 194070US0 PCT
For: DEVICE FOR PRODUCING POLYMER SUPPORT MATERIALS IN THE FORM OF POROUS POLYMER BEADS

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This is in response to applicant's "Request for Reconsideration of Decision on Request Under 37 CFR 1.497(d)" filed 27 November 2001.

## BACKGROUND

On 01 February 1999, applicants filed international application PCT/EP99/00635, which claimed priority of an earlier Germany application filed 05 February 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 12 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 August 1999, 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 05 August 2000.

On 04 August 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 22 August 2000, 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 must be filed.

On 21 December 2000, applicants filed a request under 37 CFR 1.497(d) accompanied by an executed declaration and an assignment document. The declaration is executed by the inventors identified in the international application as well as one additional inventor, i.e. Thomas Boller.

On 05 March 2001, this Office mailed a decision dismissing the 21 December 2000 request on grounds that written consent of the assignee had not been provided.

On 30 March 2001, applicants filed a renewed request.

On 03 August 2001, this Office mailed a decision dismissing the 30 March 2001 renewed request on grounds that written consent of the assignee had not been established.

On 27 November 2001, applicants filed the present renewed request. A fee of $400.00 for a two month extension of time will be charged to Deposit Account No.15-0030 as authorized in the renewed request.

## DISCUSSION

37 CFR 1.497(d) (effective 07 November 2000) states,

> If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) 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).

Applicants have previously satisfied items (1) and (2) above.

With regard to item (3) above, ownership of the application must be established when an assignee consents to a correction of inventorship. MPEP 324. Applicants have previously established a chain of title from the inventors to the assignee.

37 CFR 3.73(b) further provides that a submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. MPEP 324 states,

> The submission under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):
>
> (A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. An officer (president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. A person

> having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney from the inventors in an organization to a practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.
>
> (B) The submission may be signed by any person, if the submission sets forth that the person signing is empowered to sign the submission on behalf of the assignee.
>
> (C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.
>
> Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required.

In the present case, item (B) applies. The "Consent for Assignee to Change of Inventorship" filed with the present renewed request states that the persons signing are empowered to sign the submission on behalf of the assignee.

Therefore, having established ownership of the application, the assignee has provided written consent to the change of inventorship.

## CONCLUSION

For the reasons above, the renewed request under 37 CFR 1.497(d) is GRANTED.

The application has an International Filing Date of 01 February 1999 and a date under 35 U.S.C. 371 of 21 December 2000.

The application will be forwarded to the DO/EO/US for processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 0 9 2004

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Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

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OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.

In re Application of MEIER et al
U.S. Application No.: 09/600,180
Int. Application No.: PCT/EP99/00635
Int. Filing Date: 01 February 1999
Priority Date: 05 February 1998
Attorney Docket No.: 194070US0 PCT
For: DEVICE FOR PRODUCING POLYMER SUPPORT MATERIALS IN THE FORM OF POROUS POLYMER BEADS

DECISION ON REQUEST

UNDER 37 CFR 1.497(d)

This is in response to applicant's "Request for Reconsideration of Decision on Request Under 37 CFR 1.497(d)" filed 27 November 2001.

## BACKGROUND

On 01 February 1999, applicants filed international application PCT/EP99/00635, which claimed priority of an earlier Germany application filed 05 February 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 12 August 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 August 1999, 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 05 August 2000.

On 04 August 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 22 August 2000, 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 must be filed.

On 21 December 2000, applicants filed a request under 37 CFR 1.497(d) accompanied by an executed declaration and an assignment document. The declaration is executed by the inventors identified in the international application as well as one additional inventor, i.e. Thomas Boller.

On 05 March 2001, this Office mailed a decision dismissing the 21 December 2000 request on grounds that written consent of the assignee had not been provided.

On 30 March 2001, applicants filed a renewed request.

On 03 August 2001, this Office mailed a decision dismissing the 30 March 2001 renewed request on grounds that written consent of the assignee had not been established.

On 27 November 2001, applicants filed the present renewed request. A fee of $400.00 for a two month extension of time will be charged to Deposit Account No.15-0030 as authorized in the renewed request.

## DISCUSSION

37 CFR 1.497(d) (effective 07 November 2000) states,

> If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in § 1.17(i); and (3) 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).

Applicants have previously satisfied items (1) and (2) above.

With regard to item (3) above, ownership of the application must be established when an assignee consents to a correction of inventorship. MPEP 324. Applicants have previously established a chain of title from the inventors to the assignee.

37 CFR 3.73(b) further provides that a submission establishing ownership must be signed by a party authorized to act on behalf of the assignee. MPEP 324 states,

> The submission under 37 CFR 3.73(b) may be signed on behalf of the assignee in the following manner if the assignee is an organization (e.g., corporation, partnership, university, government agency, etc.):
>
> (A) The submission may be signed by a person in the organization having apparent authority to sign on behalf of the organization. An officer (president, vice-president, secretary, or treasurer) is presumed to have authority to sign on behalf of the organization. The signature of the chairman of the board of directors is acceptable, but not the signature of an individual director. Modifications of these basic titles are acceptable, such as vice-president for sales, executive vice-president, assistant treasurer, vice-chairman of the board of directors. A person

having a title (manager, director, administrator, general counsel) that does not clearly set forth that person as an officer of the assignee is not presumed to have authority to sign the submission on behalf of the assignee. A power of attorney from the inventors in an organization to a practitioner to prosecute a patent application does not make the practitioner an official of an assignee or empower the practitioner to sign the submission on behalf of the assignee.

(B) The submission may be signed by any person, if the submission sets forth that the person signing is empowered to sign the submission on behalf of the assignee.

(C) The submission may be signed by a person empowered by an organizational resolution (e.g., corporate resolution, partnership resolution) to sign the submission on behalf of the assignee, if a copy of the resolution is, or was previously, submitted in the record.

Where a submission does not comply with (A), (B), or (C) above, evidence of the person's authority to sign will be required.

In the present case, item (B) applies. The "Consent for Assignee to Change of Inventorship" filed with the present renewed request states that the persons signing are empowered to sign the submission on behalf of the assignee.

Therefore, having established ownership of the application, the assignee has provided written consent to the change of inventorship.

## CONCLUSION

For the reasons above, the renewed request under 37 CFR 1.497(d) is GRANTED.

The application has an International Filing Date of 01 February 1999 and a date under 35 U.S.C. 371 of 21 December 2000.

The application will be forwarded to the DO/EO/US for processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
www.uspto.gov

JAN 12 2001

John Peter Gahan
P.O. Box 3500
Parramatta, NSW 2124
AUSTRALIA

| | | |
|---|---|---|
| In re Application of | : | |
| John Peter GAHAN | : | |
| Application No.: 09/600,320 | : | DECISION ON |
| PCT No.: PCT/AU98/00767 | : | PETITION |
| Int. Filing Date: 17 September 1998 | : | UNDER 37 CFR 1.137(b) |
| Priority Date: 06 October 1997 | : | |
| Attorney Docket No.: None | : | |
| For: ROTARY TWO-STROKE ENGINE | : | |

The petition to revive under 37 CFR 1.137(b) filed 16 July 2000 in the above-captioned application is hereby **GRANTED** as follows:

The appropriate petition fee for a small entity as required by 37 CFR 1.17(m) has been submitted.

All of the requirements of 37 CFR 1.137(b) for revival have been submitted. Applicant's statement that "the 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" meets the requirement of 37 CFR 1.137(b)(3).

A review of the declaration of the inventor filed with the petition reveals that it is in compliance with 37 CFR 1.497. However, it should be noted that the declaration did not contain the claim for priority under 35 U.S.C. 119 to Australian patent application 9721155.1 filed 06 October 1997, as indicated in the publication. Applicant is also notified that the money submitted in this application is short of $15. The Office only received $1,140 rather than $1,155 as indicated in the fee calculation sheet.

Applicant's claim for priority is acknowledged. The application has an international filing date of **17 September 1998** under 35 U.S.C. 363 and a date of **16 July 2000** under 35 U.S.C. 371(c).

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.

The application is being forwarded to the United States Designated/Elected Office for further processing.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

NNH/RC:hn

Tel: (703) 308-6508

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.go

Paper No. 14

John Peter Gahan
PO Box 3500
Parramatta, 2124
Australia

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MAY 15 2003

OFFICE OF PETITIONS

In re application of :
John P. Gahan :
Application No. 09/600,320 :
Filing Date: July 16, 2000 :
Attorney Docket No. 1223-001 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed May 5, 2003, to revive the above-identified application.

The petition is Dismissed.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the Notice of Non-Compliant Amendment filed July 17, 2002, which set a period for reply of (1) month or (30) days from the mailing date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 18, 2002.

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 petition indicates that a response to the first Office action has been previously submitted on February 7, 2003; however, the Notice of Abandonment mailed February 27, 2003 sets forth that the reply received February 7, 2003 does not constitute a proper reply to the non-final Office action mailed July 17, 2002. The petition cannot be granted until a proper reply is submitted. Accordingly, a copy of the Notice mailed July 17, 2002 will be re-mailed with this decision.

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. However, in accordance with 37 CFR 1.34(a), the signature of Michael S. Hargis appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. However, if Michael S. Hargis desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent 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.

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

| | |
|---|---|
| By mail: | Mail Stop PETITION<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Crystal Plaza Four, Suite 3C23<br>2201 South Clark Place<br>Arlington, VA 22202 |
| By Fax: | (703) 308-6916<br>ATTN: Office of Petitions |

Any questions concerning this matter may be directed to the undersigned at (703) 308-6911.

Latrice Bond

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

Attachment: Notice of Non-Compliant Amendment 37 CFR 1.121

Cc: Michael S. Hargis
247 North Broadway
Lexington, KY 40507

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. 19

King & Schickli
247 North Broadway
Lexington, Kentucky 40507-1058

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SEP 2 6 2003

OFFICE OF PETITIONS

In re Application of :
John P. Gahan :
Application No. 09/600,320 : ON PETITION
Filed: July 16, 2000 :
Attorney Docket No. 1223-001 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed September 17, 2003, to revive the above-identified application.

The petition is Granted.

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 3748 for further processing.

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. 070105

Townsend and Townsend and Crew LLP
Two Embaracdero Center, 8th Floor
San Francisco, CA 94111-3834

| | | |
|---|---|---|
| In re Application of: | : | |
| Steven A. Sunshine | : | DECISION ON REQUEST TO WITHDRAW |
| Serial No.: 09/600,346 | : | FROM RECORD |
| Filed: July 14, 2000 | : | |
| Attorney Docket No.: **018564-002410US** | : | |

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed March 08, 2004.

The request is **DISMISSED** as moot.

A review of the application file record reveals a proper revocation and power of attorney to Joseph R. Snyder was filed on March 08, 2004. As such, the power of attorney for the attorneys and agents requesting withdrawal has already been revoked. Accordingly, the present request is moot, and must be dismissed.

All future communications form the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Inquiries related to this decision should be directed to Clayton Laballe at (571) 272-1594.

Clayton Laballe, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Joseph R. Snyder
Foley & Lardner
3000 K Street, N.W.
Washington, DC 20007

OCT 04 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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BEST AVAILABLE COPY

Roger T. Barrett
Townsend and Townsend and Crew LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

| | | |
|---|---|---|
| In re Application of VARDI et al | : | |
| U.S. Application No.: 09/600,348 | : | DECISION ON PETITION |
| Int. Application No.: PCT/US99/00835 | : | |
| Int. Filing Date: 13 January 1999 | : | UNDER 37 CFR 1.47(a) |
| Priority Date: 14 January 1998 | : | |
| Attorney Docket No.: 19601-000120US | : | |
| For: EXTENDIBLE STENT APPARATUS | : | |

This is in response to applicants' "Petition Under §1.47(a) 'Filing When an Inventor Cannot be Reached'" filed 16 January 2001, requesting that the present application be accepted for United States national stage processing without the signature of one of the four joint inventors.

## BACKGROUND

On 13 January 1999, applicants filed international application PCT/US99/00835, which claimed priority of an earlier United States application filed 14 January 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 August 1999, 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 14 July 2000.

On 14 July 2000, applicants filed national stage papers in the United States. The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 10 August 2000, 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) along with a Notification of a Defective Oath or Declaration (Form PCT/DO/EO/917) indicating that a properly executed oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 16 January 2001, applicants filed the present petition along with the appropriate extension of time fee. The petition states that inventor Eric Elam cannot be reached after diligent effort.

## DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

With regard to item (1) above, applicants have submitted a declaration signed by three of the joint inventors on their own behalf and on behalf of the nonsigning inventor Elam.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, an affidavit or declaration of facts should be submitted which fully describes the exact facts which are relied on to establish that a diligent effort was made. . . . The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

In the present case, applicants have provided an affidavit from Rosalinda Rafael, who states in the affidavit that she attempted to contact Elam by mail on 23 October 2000, by telephone in January 2001, and by electronic mail (see Rafael's affidavit, page 2). Rafael also states that she made inquiries to the three other joint inventors, Elam's former co-workers, and other associates of Elam. While Rafael's attempts demonstrate a diligent effort to locate Elam, applicant is required to provide additional documentary evidence concerning the 23 October 2000 letter. Specifically, applicant should more specifically detail the contents of the 23 October 2000 correspondence and provide a copy of the cover letter of instructions. Such additional evidence should indicate that Elam was requested to respond to the 23 October 2000 communication in a timely manner.

With regard to item (3) above, applicants have provided the requisite petition fee.

With regard to item (4) above, the petition states the last known address of the nonsigning inventor.

BEST AVAILABLE COPY

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) 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. Failure to timely file a proper response will result in abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

JC14 Rec'd PCT/PTO 07 JAN 2002

Please type a plus sign (+) inside this box → [+]

PTO/SB/21 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
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.

# TRANSMITTAL FORM

*(to be used for all correspondence after initial filing)*

| | |
|---|---|
| **Application Number** | 09/600,348 |
| **Filing Date** | July 14, 2000 |
| **First Named Inventor** | Vardi, Gil M. et al. |
| Group Art Unit | Unassigned |
| Examiner Name | Unassigned |
| Total Number of Pages in This Submission: 1 | Attorney Docket Number: 19601-000120 |

ENCLOSURES *(check all that apply)*

- ☐ Fee Transmittal Form
  - ☐ Fee Attached
- ☒ Communication in Response to Decision on Petition Under 37 CFR 1.47(a)
- ☐ After Final
- ☐ Affidavits/declaration(s)
- ☐ Extension of Time Request
- ☐ Express Abandonment Request
- ☐ Information Disclosure Statement
- ☐ Certified Copy of Priority Document(s)
- ☐ Response to Missing Parts/ Incomplete Application
  - ☐ Response to Missing Parts under 37 CFR 1.52 or 1.53
- ☐ Assignment Papers *(for an Application)*
- ☐ Drawing(s)
- ☐ Licensing-related Papers
- ☐ Petition Routing Slip (PTO/SB/69) and Accompanying Petition
- ☐ Petition to Convert to a Provisional Application
- ☐ Power of Attorney, Revocation Change of Correspondence Address
- ☐ Terminal Disclaimer
- ☐ Request for Refund
- ☐ CD, Number of CD(s)
- ☐ After Allowance Communication to Group
- ☐ Appeal Communication to Board of Appeals and Interferences
- ☐ Appeal Communication to Group *(Appeal Notice, Brief, Reply Brief)*
- ☐ Proprietary Information
- ☐ Status Letter
- ☒ Other Enclosure(s) *(please identify below)*:
  1. Return Postcard
  2. Executed Delcaration

RECEIVED
18 JAN 2002
Legal Staff
International Division

**Remarks**

The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.

No fee transmittal is submitted herewith as this Communication is being timely filed and no fee is believed owing.

## SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | |
|---|---|
| Firm and Individual name | Townsend and Townsend and Crew LLP<br>Roger T. Barrett Reg. No. 41,599 |
| Signature | |
| Date | December 4, 2001 |

## CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date:

December 4, 2001

| | | | |
|---|---|---|---|
| Typed or printed name | Sara B. McPeak | | |
| Signature | | Date | December 4, 2001 |

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be send to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

DE 7056742 v1

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Box PCT
Commissioner for Patents
U. S. Patent and Trademark Office
Washington, D.C. 20231
Attn: PCT Legal Office

on December 4, 2001

TOWNSEND and TOWNSEND and CREW LLP

By Sara B. McPeak
Sara B. McPeak

PATENT
Attorney Docket No.:19601-000120

BEST AVAILABLE COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

**Gil M. Vardi et al.**

Serial No.: 09/600,348

Filed: July 14, 2000

For: **EXTENDIBLE STENT APPARATUS**

Examiner: Unassigned

Art Unit: Unassigned

COMMUNICATION IN RESPONSE TO DECISION ON PETITION UNDER 37 CFR 1.47(a)

Box PCT
Commissioner for Patents
U. S. Patent and Trademark Office
Washington, D.C. 20231
Attn: PCT Legal Office

Sir:

On October 4, 2001, a Decision on Applicants' Petition Under 37 CFR 1.47(a) was issued dismissing, without prejudice, Applicants' Petition. A two-month period of time was granted to respond to the Petition Decision.

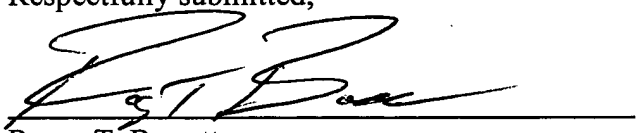
In response, Applicants submit herewith a signed Declaration executed by Mr. Eric Elam, the previously missing inventor. In the period of time subsequent to Applicants' Petition Under

37 CFR 1.47(a) and the present, Applicants reacquired contact with the missing inventor, Mr. Eric Elam. Thus, Applicants respectfully believe the submission of the enclosed Declaration is an appropriate response to the Petition Decision, and further request consideration of the present application.

If prosecution may be advanced by a telephone conversation with the undersigned attorney, he may be reached at (303) 571-4000.

It is believed no fees are due for this submission, however, the Commissioner is authorized to charge any fees owing or credit any amount to Deposit Account Number 20-1430.

Respectfully submitted,



Roger T. Barrett
Reg. No. 41,599

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111
Phone (303) 571-4000
Fax (303) 571-4321
RTB/sm

DE 7056741 v1

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. 19

Basell USA Inc.
912 Appleton road
Elkton, MD 21921

**COPY MAILED**

**DEC 2 2 2003**

**OFFICE OF PETITIONS**

In re Application of :
Gary Peeters et al. :
Application No. 09/600,363 : ON PETITION
Filed: July 14, 2000 :
Attorney Docket No. US17017 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 3, 2003, to revive the above-identified application.

The petition is granted.

The above-identified application became abandoned for failure to timely pay the issue fee. 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. See MPEP 711.03(c)(III)(A)(1). Therefore, the filing of a continuing application is not a proper reply under 37 CFR 1.137(a)(1) or (b)(1). In view of the authorization contained in the petition to charge any additional fees due, the $1330 issue fee will be charged to Deposit Account No. 08-2336.

**Petitioner is advised that the issue fee paid 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**

The application file is being forwarded to Technology Center AU 1713 for processing the Request for Continued Examination filed September 4, 2003.

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

Latrice Bond
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. The request and pertinent attachments should be addressed to **Mail Stop Issue Fee**. Additionally, if the issue fee has increased from the previously paid issue fee, the balance due must be submitted. **Failure to 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.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 6/29/05

Paper No.: —

TO SPE OF : ART UNIT 1653

SUBJECT : Request for Certificate of Correction on Patent No.: 6849712 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 ext113***

**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 changes are o.k.

– D. Lukton 7/6/05

Bruce Campbell — **SPE**

1654 — **Art Unit**

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. 27

CROWELL & MORING L.L.P.
Intellectual Property Group
P.O. Box 14300
Washington, D.C. 20044-4300

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**FEB 0 2 2004**

**OFFICE OF PETITIONS**

In re Application of

Christian Lutz

Application No. 09/600,593

: DECISION ON PETITION

Filed: July 19, 2000

:

Attorney Docket No. 1959/49027

This is a decision on the petition under 37 CFR 1.137(b), filed January 22, 2004, 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 January 24, 2003, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on April 25, 2003. A Notice of Abandonment was mailed on September 5, 2003.

The amendment filed January 22, 2004, is noted and made of record.

The address as cited on the instant petition differs from the address of record. Although a courtesy copy of this decision is being mailed to the address as cited on the petition, petitioner is advised that all future correspondence will be mailed to the address of record until appropriate written instructions to the contrary are received.

The application is being forwarded to Technology Center 3600 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-0010.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc:
Song Zhu, Ph.D.
Crowell & Moring, LLP
Intellectual Property Group
PO Box 14300
Washington, DC 20044-4300

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SEP 27 2001

Bernhard D. Saxe
Foley & Lardner
Washington Harbour
3000 K Street, N.W., Suite 500
Washington, D.C. 20007-5109

In re Application of
ADAMS, David Reginald et al.
US Application No.: 09/600,631
PCT Application No.: PCT/GB99/00223
Int. Filing Date: 22 January 1999
Priority Date: 23 January 1998
Attorney's File Reference: 040283/0182
For: AZETIDINECARBOXAMIDE DERIVATIVES FOR TREATING CNS DISORDERS

: NOTIFICATION OF ACCEPTANCE OF DECLARATION

This notification responds to applicants' "SUBMISSION FO SUBSTITUTE EXECTUED DECLARATION", filed 18 September 2001, which was accompanied by, inter alia, a "REQUEST TO WITHDRAW PETITION FILED UNDER 37 CFR 1.47".

## BACKGROUND

On 22 January 1999, applicants filed international application number PCT/GB99/00223, which claimed priority to a prior GB application filed 23 January 1998. The applicant filed a Demand for international preliminary examination on 09 July 1999. Accordingly, the thirty-month period for paying the basic national fee in the United States of America expired at midnight on 24 July 2000 since 23 July 2000 was a Sunday.

On 20 July 2000, applicants filed a transmittal letter for entry into the national stage in the United States of America, which was accompanied by, inter alia, the basic national fee.

On 10 August 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements indicating that the applicants must file an oath/declaration along with the surcharge for filing the oath/declaration later than 30 months from the priority date within one month from the mailing date of the Notification in order to avoid abandonment of the US national stage application. The notification also indicated that extensions of time were available under 37 CFR 1.136(a).

On 12 February 2001, the applicants filed, inter alia, a petition under 37 CFR 1.47 along with the requisite petition fee, a combined declaration and power of attorney (declaration), the surcharge for filing the declaration later than 30 months from the priority date, and a request for a 5 month extension of time. The declaration did not include the signature of Joy Miriam Shepherd, the legal representative of deceased inventor Robin Gerald Shepherd.

On 18 September 2001, applicants filed, inter alia, the present request to withdraw the petition under 37 CFR 1.47 along with a substitute declaration. The substitute declaration includes the names and signatures of all of the living inventors and includes the name and signature of Joy Miriam Shepherd, the legal representative of deceased inventor Robin Gerald Shepherd. The declaration also indicates that Joy Miriam Shepherd is the legal representative of deceased inventor Robin Gerald Shepherd.

## DISCUSSION

The declaration filed 18 September 2001 is acceptable under 37 CFR 1.42 and 1.497. Accordingly, the petition under 37 CFR 1.47 filed 12 February 2001 is moot.

It is noted that the declaration contains alterations concerning Robin Shepherd and Joy Shepherd. It is assumed that these alterations were inserted before Joy Shepherd signed the declaration. If this is not the case, applicants are required to immediately notify this Office and submit a new declaration.

## CONCLUSION

The petition under 37 CFR 1.47 filed 12 February 2001 is **DISMISSED** as moot.

The declaration filed 18 September 2001 is acceptable under 37 CFR 1.42.

This application has a date under 35 USC 371 of 18 September 2001.

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office

This application is being forwarded to the US Designated/Elected Office for further processing in accordance with this decision and for issuance and mailing of a Notification of Acceptance Under 35 USC 371.

Diana L. Oleksa
Special Programs Examiner
PCT Special Programs Office
Telephone: 703-308-0890

Conferee: Richard Cole
PCT Legal Examiner
PCT Legal Office

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

18 OCT 2000

#3

Robert J. Smith
Myers, Bigel, Sibley & Sajovec
P.O. Box 37428
Raleigh, NC 27627

In re Application of :
SHAW, et al. : DECISION ON PETITION
Application No.: 09/600,837 :
PCT No.: PCT/GB99/00018 :
Int. Filing Date: 05 January 1999 : UNDER 37 CFR 1.137(b)
Priority Date: 06 January 1998 :
Attorney Docket No.: 9052-61 :
For: METHOD OF FORMING INTERCONNECTIONS :
BETWEEN CHANNELS AND CHAMBERS :

This is a decision on applicant's "PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 21 July 2000. The required petition fee of $1210.00 (37 CFR 1.17(m)) has been included.

## BACKGROUND

On 05 January 1999, applicant filed international application PCT/GB99/00018, which claimed priority of an earlier British application filed 06 January 1998. A Demand for preliminary examination, in which the United States was elected, was filed on 26 July 1999, prior to the expiration of nineteen months from the earliest claimed priority date. Accordingly, payment of the basic national fee was due 06 July 2000.

On 06 July 2000, the application became abandoned for failure to pay the basic national fee for a U.S. national stage entry application.

On 21 July 2000, applicant filed the present petition along with a TRANSMITTAL LETTER TO THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US) CONCERNING A FILING UNDER 35 U.S.C. 371. An oath or declaration of the inventors as required under 35 U.S.C. 371(c)(4) was not included.

## DISCUSSION

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 required reply is the payment of the Basic National Fee under 37 CFR 1.492(a) and filing of the U.S. national stage entry application. Applicant has included this payment along with Form PTO 1390 and specification including claims.

As to Item (2) the appropriate petition fee of $1210.00 as required by 37 CFR 1.17(m) was submitted.

With regard to Item (3), applicant's statement that, "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 due to an inadvertent delay in transmittal of the required documentation of four (4) business days." 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.

## CONCLUSION

For the reasons above, the petition for revival is **GRANTED**.

This application is being returned to the DO/EO/US for processing in accordance with this decision, namely, the mailing of a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905).

Richard Cole
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 0602

**In re Application of**
**Seiji Shirai et al.**
**Application Number: 09/600890**
**Filed: August 16, 2000**
**For: Multilayer Printed Wiring Board with Filled Viahole Structure**

**DECISION ON PETITION**

**JUN 10 2003**

This is a decision on the petition under 37 C.F.R. § 1.181, filed May 6, 2003, requesting that the finality of the Office action of January 8, 2003, be withdrawn.

The petition is GRANTED.

Petitioner asserts that making the office action of January 8, 2003, final is premature. Petitioner asserts that the final office action changed the grounds of rejection in section 3 from rejected under section 103(a) as obvious over Kinoshita to rejected under section 103(a) as being obvious over Kinoshita in view of Matsuyama. Petitioner states this change was not necessitated by amendment. Therefore, petitioner argues that the finality of the rejection is improper.

Review of the record reveals that the first rejection under 103(a) as obvious over Kinoshita was set forth in the office action mailed May 24, 2002, in section 21. In response to this rejection, petitioner filed a response on October 24, 2002, and argued at page 9, lines 8-13, that the rejection was improper because one of the claim limitations was not taught in Kinoshita as alleged by the office action. In particular, petitioner argued that Kinoshita does not disclose the dimension of the viahole diameter to be less than 25 micrometers as stated in section 21 of the office action. Subsequent to petitioners response of October 24, 2002, a final office action was issued on January 8, 2003. In this final office action, in section 3, the 103(a) rejection over Kinoshita was changed to a 103(a) rejection over Kinoshita in view of Matsuyama. Examiner withdrew the statement that Kinoshita teaches the dimension to be less than 25 micrometers and cited the Matsuyama reference to

establish the dimensional requirements of the claim. The portion of the claim including these dimensional requirements was not amended.

As such, the change in the grounds (citing Matsuyama to disclose the claimed dimensional requirements) was neither necessitated by amendment or based on filing of an IDS.

The finality of the office action of January 8, 2003, is hereby withdrawn and the application if forwarded to the examiner for examination.

Arthur Grimley, Acting Director
Technology Center 2800

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

GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

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SEP 0 9 2005

OFFICE OF PETITIONS

In re Application of :
Seiji Shirai, et al. :
Application No. 09/600,890 : ON PETITION
Filed: August 16, 2000 :
Attorney Docket No.: P19797 :
:

This is a decision on the petition, filed September 8, 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 21, 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 2841 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).

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 : September 9, 2005

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Seiji Shirai, et al.
Application No. : 09/600,890
Filed : August 16, 2000

The above-identified application has been assigned Patent No. 6,943,303 and an issue date of September 13, 2005.

It is hereby directed that this application be withdrawn from issue at the request of the applicant.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of September 13, 2005:

> "All reference to Patent No. 6,943,303 to SEIJI SHIRAI, ET AL. of JAPAN for MULTILAYER PRINTED WIRING BOARD HAVING FILLED-VIA STRUCTURE appearing in the Official Gazette of September 13, 2005, should be deleted since no patent was granted."

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Paul Harrison, Crystal Park 3-44l (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-9l0 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane K.Davis, P/OCS, CM1-6A07
Tamara K. Greene, PK3-910

FEB 02 2001

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

Ira J. Schultz
DENNISON, SCHEINER, SCHULTZ & WAKEMAN
612 Crystal Square 4
1745 Jefferson Davis Highway
Arlington, VA 22202

In re Application of :
BRU-MAGNIEZ, Nicole *et al* :
Application No.: 09/600,895 :
PCT No.: PCT/FR99/00185 :
Int. Filing Date: 29 January 1999 : DECISION ON PETITION
Priority Date: 29 January 1998 : UNDER 37 CFR 1.181
Attorney's Docket No.: 00156 :
For: NOVEL SURFACTANT COPOLYMERS :
BASED ON METHYLIDENE :
MALONATE :

The decision is in response to applicants' "Request to Withdraw Holding of Abandonment" filed on 18 September 2000. This is treated as a petition under 37 CFR 1.181. No petition fee is required.

## BACKGROUND

On 29 January 1999, applicants filed international application PCT/FR99/00185 claiming priority to a French patent filed 29 January 1998. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office ("PTO") on 05 April 1999.

On 17 April 1999, 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.*, 29 July 2000.

On 26 July 2000, applicant 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*, an English translation; a preliminary amendment; and authorization to charge the basic national fee to a credit card. Applicants also claim that a Credit Card Payment Form (PTO-2038) was also submitted.

On 14 September, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) because of failure to provide the full U.S. Basic National Fee by 20 months *[sic]* from the earliest claimed

priority date.

On 18 September 2000, applicants submitted the instant petition which was accompanied by, *inter alia*, copies of documents submitted 26 July 2000 including the aforementioned Credit Card Payment Form and a stamped postcard receipt of the documents filed 26 July 2000.

On 19 September 2000, applicants submitted an executed declaration.

## DISCUSSION

A Credit Card Payment Form required to charge the basic national fee was not located in the above-captioned file. Therefore, the PTO was unable to charge the basic national fee in the above-captioned application.

Nevertheless, MPEP § 503 lists procedures to ensure receipt of any paper filed in the PTO. Applicants must enclose a self-addressed postcard identifying all of the papers filed. The PTO will stamp the receipt date on the card and place it on the outgoing mail. The identifying data on the card must clearly identify the paper for which receipt is requested. 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.

In this case, applicants have provided a copy of the date-stamped filing receipt for the documents submitted 26 July 2000. The receipt clearly identifies the application by the name of the applicants, attorney docket number, and international application number. The filing receipt declares in a box labeled "Fee(s)" that $970.00 was received in the PTO and annotated next to the box are the words "Filing fee - Credit Card billing." The postcard receipt is stamped "90 Rec'd PCT/PTO 26 JUL 2000" across its face. This description is sufficient to prove that a Credit Card Payment Form was included with the documents.

Accordingly, applicants have provided *prima facie* evidence that the Credit Card Payment Form was received on 26 July 2000.

## CONCLUSION

For the reason listed above, applicants' request to withdraw the holding of abandonment is **GRANTED**.

Accordingly, the Notification of Abandonment mailed 14 September 2000 is hereby **VACATED**.

On the new transmittal form (PTO-1390) located on the PTO website, is a box

for credit card authorizations.

Applicants have completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 29 January 1999, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **19 September 2000.**

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Boris Milef
PCT Legal Examiner
PCT Legal Office

James Thomson
PCT Attorney
PCT Legal Office

Tel.: (703) 308-6457

05 JAN 2004

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

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Jay H. Maioli
COOPER & DUNHAM LLP
1185 Avenue of the Americas
New York, NY 10036

In re Application of :
TANAKA, Izuru :
U.S. Application No.: 09/600, 925 : **DECISION ON PETITION**
PCT No.: PCT/JP99/06589 :
Int. Filing Date: 25 November 1999 : **TO WITHDRAW HOLDING**
Priority Date: 25 November 1998 :
Attorney Docket No.: 6715/60196 : **OF ABANDONMENT**
For: ELECTRONIC EQUIPMENT AND :
OPERATION CONTROL METHOD :
THEREOF :

This decision is in response to applicant's "Petition for Revival . . . " ("Pet.") filed 22 September 2003. This is treated as a petition to withdraw the holding of abandonment. No fee is required.

## BACKGROUND

On 08 August 2000, 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(a) and (b) and a surcharge fee pursuant to 37 CFR 1.492(e) was required. A one-month time limit in which to respond was set with extensions of time available.

On 13 November 2002, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) for failing to respond to the Form PCT/DO/EO/905 within the time period set therein.

On 22 September 2003, applicant filed the instant petition which was accompanied by, *inter alia*, a copy of a computer generated docket record; a declaration signed by the sole inventor; a check of $110.00 for the petition to revive fee; a check of $130.00 for the surcharge fee; and authorization to charge any additional fees to Deposit Account No. 03-3125.

## DISCUSSION

Applicant filed the instant petition to revive the above-captioned application pursuant to 37 CFR 1.137(a) based on nonreceipt of an Office communication. Accordingly, this petition is being treated as a petition to withdraw the holding of abandonment. *See* § 711.03(c) Manual of Patent Examining Procedure (MPEP).

The $110.00 petition fee will be credited to Deposit Account No. 03-3125.

**Petition to Withdraw Holding of Abandonment**

Petitioner claims that an incomplete address was most likely the reason that the Office communications were not received. This may be the case. Nevertheless, the petitioner must show that they did not receive these communications.

The showing required to establish the failure to receive an Office communication consists of: (1) a statement from the practitioner declaring that the Office communication was not received by the practitioner; (2) 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, (3) 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 practitioners' statement.

In the petition, counsel states that "he did not receive the above-noted Notification of Missing Requirements or the Notice of Abandonment. A search of the file jacket and docket records confirms this fact." Pet. at ¶ 2.

These statements satisfy items (1) and (2) above.

Petitioner also submitted a copy of a computer docket sheet containing information on Docket Number 60196 only. A review of this docket record does not indicate that the Notification of Missing Requirements mailed 08 August 2000 or the Notification of Abandonment mailed 13 November 2002 was received. However, petitioner provided no explanation concerning this docket record in the instant petition. Moreover, this docket record does not satisfy the requirement outlined in § 711.03(c) of the MPEP which states, in part:

> 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.** (Emphasis added).

A single document containing only docket information on the U.S. application in question shows no other corroborating information to add weight and credibility to the information contained therein and can be too easily manipulated. In order to satisfy the docket record requirement to prove nonreceipt of an Office communication, applicant

must provide a copy of counsel's docket records for the date upon which a response to the Notification of Missing Requirements was due (*i.e.*, 08 September 2002). An example of such a record would be a daily "tickler" report or a daily log showing all applications for which a response is due on that date. The docket report showing only the subject application does not satisfy this requirement.

Therefore, item (3) is not yet satisfied. Applicant has not met all of the requirements required to establish nonreceipt of an Office action.

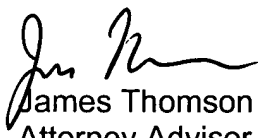
## CONCLUSION

Applicants' petition to withdraw the holding of abandonment is **DISMISSED** without prejudice.

The subject application 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 for Withdrawing the Holding of Abandonment." No fee is required.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (703) 308-645

25 MAR 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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Jay H. Maioli
COOPER & DUNHAM LLP
1185 Avenue of the Americas
New York, NY 10036

In re Application of :
TANAKA, Izuru :
U.S. Application No.: 09/600, 925 :
PCT No.: PCT/JP99/06589 :
Int. Filing Date: 25 November 1999 : **DECISION**
Priority Date: 25 November 1998 :
Attorney Docket No.: 6715/60196 :
For: ELECTRONIC EQUIPMENT AND :
OPERATION CONTROL METHOD :
THEREOF :

This decision is in response to applicant's "Renewed Petition for Withdrawing the Holding of Abandonment" filed 08 March 2004. No fee is required.

## BACKGROUND

On 05 January 2004, a decision dismissing applicant's petition to withdraw the holding of abandonment was mailed due to applicants' failure to provide a copy of counsel's docket records for the date upon which a response to the Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (Form PCT/DO/EO/905) mailed 08 August 2000 was due.

On 08 March 2004, applicant submitted the instant petition which was accompanied by a copy of the daily log of counsel's law firm for 08 September 2000.

## DISCUSSION

To establish the failure to receive an Office communication applicant must provide (1) a statement from the practitioner declaring that the Office communication was not received by the practitioner; (2) 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 (3) 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.

Applicant satisfied items (1) and (2) in the original petition.

The decision mailed 05 January 2004 noted that in order to satisfy the docket record requirement to prove nonreceipt of an Office communication, applicant must

provide a copy of counsel's docket records for the date upon which a response to the Notification of Missing Requirements was due. In this case the due date was 08 September 2000 (the prior decision erroneously indicated a year date of 2002).

In the renewed petition, applicant submitted the master file report for 08 September 2000. A review of this log verifies that the Form PCT/DO/EO/905 was not received in the above-captioned application. This satisfies item (3) above.

Accordingly, applicants have now met the requirements required to establish nonreceipt of an Office action.

## CONCLUSION

In view of the above, the renewed petition to withdraw the holding of abandonment is **GRANTED**.

The Notification of Abandonment mailed 13 November 2002 is hereby **VACATED**.

Applicant has completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 25 November 1999, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **22 September 2003**.

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) 308-645

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Paper No. 17

John F. Hoffman
Baker & Daniels
111 East Wayne Street, Suite 800
Fort Wayne, IN 46802

COPY MAILED

MAY 2 8 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Harald Hoffeld, et al. :
Application No. 09/600,941 :
Filed: September 13, 2000 :
Attorney Docket No. VOI0219 :

This is a decision on the petition under 37 CFR 1.137(b), filed May 12, 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 October 10, 2002, which set a shortened statutory period for reply of three(3) months. A three(3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on April 11, 2003.

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111, or in her absence, Sherry D. Brinkley at (703)305-9220.

The application file is being forwarded to Technology Center 3700, Art Unit 3745 for processing the Request for Continued Examination under 37 CFR 1.114, filed on May 12, 2003.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry D. Brinkley
Petitions Examiner

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) |
|---|---|---|---|---|
| 6870888 | 2005-03-22 | 09/600,971 | 2000-07-20 | 5550-25 |

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

| | Fee | Code |
|---|---|---|
| ◉ | 3 ½ year | (1551) |
| ○ | 7 ½ year | (1552) |
| ○ | 11 ½ year | (1553) |

Small Entity

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (2552) |
| ○ | 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 | /Jason H. Vick/ | Date (YYYY-MM-DD) | 2009-03-24 |
| Name | Jason H. Vick | Registration Number | 45285 |

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. 6870888
Issue Date: March 22,2005
Application No. 09600971
Filed: July 20,2000
Attorney Docket No. AWR-007(457/

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

This is a decision on the electronic petition, filed March 24,2009 ,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 March 24,2009 . 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 DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address:Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

OCT 03 2000

Thomas Fitting
THE SCRIPPS RESEARCH INSTITUTE
10550 North Torrey Pines Road, TPC-8
La Jolla, CA 92037

| | | |
|---|---|---|
| In re Application of | : | |
| MADISON, Edwin L. | : | |
| U.S. Application No.: 09/600,985 | : | |
| PCT No.: PCT/US97/20226 | : | |
| Int. Filing Date: 12 November 1997 | : | DECISION |
| Priority Date: 12 November 1996 | : | |
| Attorney Docket No.: TSRI 568.1 | : | |
| For: TISSUE TYPE PLASMINOGEN ACTIVATOR . . . | : | |

The petition to revive pursuant to 37 CFR 1.137(b) filed on 25 July 2000 in the above-captioned application is hereby **GRANTED** as follows:

Applicant states that "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" as required by 37 CFR 1.137(b)(3). The petition fee and basic national fee have been paid. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

The declaration submitted was not signed. Accordingly, the application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements (Form PCT/DO/EO/905) for failing to provide a declaration in compliance with 37 CFR 1.497 (a) and (b) and a surcharge fee of $130.00 pursuant to 37 CFR 1.492(e).

James Thomson
PCT Attorney
PCT Legal Office

Tel.: (703) 308-6457

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 10

Jacobson Holman
400 Seventh Street, NW
Washington, DC 20004-2201

COPY MAILED

OCT 1 0 2002

OFFICE OF PETITIONS

In re Application of :
Alex Podgornik et al. :
Application No. 09/601,037 : ON PETITION
Filed: July 26, 2000 :
Attorney Docket No. P65728US0 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 1, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within a timely manner to the non-final Office action mailed December 26, 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. However, a petition to reset the reply period was submitted on January 31, 2002 and a Notice granting the petition was mailed (not dated) setting a reply period of three months from the January 31, 2002 receipt date of the petition. Accordingly, the application became abandoned on May 1, 2002.

The application file is being forwarded to Technology Center AU 1723 for further processing.

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

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. 8

In re Application of
Podgornik et al.
Application No. 09/601,037
Filed: 7/26/00
Attorney Docket No. P65728USO

DECISION GRANTING PETITION
TO RESET PERIOD FOR REPLY

This is a decision on the petition filed on January 31, 2002, requesting that the shortened statutory period for reply set forth in the Office communication mailed on December 26, 2001 be reset to run from the date on which the Office communication was actually received at the correspondence address of record.

The petition is granted.

Petitioner provided a statement that the Office communication in question was received at the correspondence address of record on January 23, 2002. The petition was filed within two weeks of receipt of the Office communication. A substantial portion of the set reply period had elapsed on the date of receipt. Furthermore, the Office communication was mailed between October 13, 2001 and January 2, 2002, when delivery of mail from the Office to certain regions of the country was delayed.

Accordingly, the shortened statutory period that was originally set forth in the Office communication originally mailed on December 26, 2001 is hereby reset to run FROM THE RECEIPT DATE OF January 23, 2002.

William Krynski, Special Program Examiner,
Technology Center 1700
(703) 308-2376

JUN 2 3 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
www.uspto.gov

AKIN GUMP STRAUSS HAUER & FELD
1333 NEW HAMPSHIRE AVENUE NW
WASHINGTON, DC 20036

In re Application of :
THOMAS EXNER :
Application No.: 09/601,073 :
PCT No.: PCT/AU99/00069 :
Int. Filing Date: 01 February 1999 : DECISION ON PETITION
Priority Date: 02 February 1998 :
Attorney Docket No.: 071550.0017 :
For: IMPROVED BLOOD COAGULATION TEST:

This is a decision on applicant's 'Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office (USPTO) via facsimile on 06 June 2001.

## BACKGROUND

On 01 February 1999, applicant filed international application No. PCT/AU99/00069 which claimed a priority date of 02 February 1998. A copy of the international application had been communicated earlier to the United States Patent and Trademark Office from the International Bureau on 05 August 1999.

On 05 August 1999, 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 02 August 2000.

On 26 July 2000 applicant filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the basic national fee.

On 21 August 2000, the DO/EO/US mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration executed by the inventor and the surcharge for filing the oath or declaration after the thirty month period was required.

On 06 June 2001, applicant filed a petition to revive with authorization to charge their deposit account the petition fee of $605 for a small entity. Applicant, in effect, requests the withdrawal of the holding of abandonment.

## DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay must be accompanied by (1) a proper 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 to the filing of a grantable petition pursuant to this paragraph was unintentional", and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Applicant has submitted the proper reply with the submission of the declaration, satisfying item (1). With regard to item (2), the required petition fee of $605 has been charged to applicant's deposit account. As for item (4), since the application was filed after 08 June 1995, no terminal disclaimer is necessary in this application.

With regard to item (3), applicant's statement that "the entire delay in filing the required reply from the date 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 "[t]he entire delay in filing the 35 U.S.C. 371(c) requirements from their due date until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals all of the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, 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 is **GRANTED**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing. The 35 U.S.C. 371(c) and 102(e) date is **06 June 2001.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK:cmk
Telephone: (703) 306-5467

JAN 1 1 2001

#5

UNITED STATES PATENT AND TRADEMARK OFFICE

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

James A. Henricks
HENRICKS, SLAVIN & HOLMES
840 Aollo Street, Suite 200
El Segundo, CA 90245-4737

In re Application of :
MURDOCH :
Application No.: 09/602,122 : DECISION ON PETITION
PCT No.: PCT/AU99/00059 : UNDER 37 CFR 1.182
Int. Filing Date: 29 January 1999 :
Priority Date: 29 January 1998 :
Attorney Docket No.: 010100-104 :
For: A TRANSCEIVER

This decision is in response to applicants' "PETITION TO CORRECT NAMED APPLICANT" filed on 15 September 2000 which is being treated as a petition to change an inventor's name under 37 CFR 1.182. Applicant is requesting to change the name of the inventor from Graham Murdoch to Graham Alexander Munro Murdoch. The petition fee under 37 CFR 1.17(h) has been charged to Deposit Account No. 50-0655, as authorized.

## BACKGROUND

On 27 July 2000, 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 preliminary amendment.

On 14 August 2000, the United States/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indication an oath or declaration and the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) must be furnished. The notification set a one month time limit in which to respond.

On 15 September 2000, applicants filed the present papers which was accompanied by, inter alia: executed declaration and a verified statement claiming small entity staus.

## DISCUSSION

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The Manual of Patent Examining Procedure at § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include the appropriate petition fee and an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or certified copy of the court order.As noted above, the $130 petition fee has been charged to counsel's Deposit Account No. 50-0655, and thus item (1) has been satisfied.

With regards to item (2), applicants have not provided an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order. Therefore, item (2) has not been satisfied, and thus the petition may not be properly granted at this time.

## CONCLUSION

For the reasons above, 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 1.182." No additional petition fee is required.

A proper response must include an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

Failure to file a proper response within the period for response as set forth above will result in the abandonment of the application.

Please direct further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Anthony Smith
Petitions Attorney
PCT Legal Office
Tel: (703) 308-6314
Fax: (703) 308-6459

AUG 3 0 2001

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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James A. Henricks
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840 Apollo Street, Suite 200
El Segundo, CA 90245-4737

| | | |
|---|---|---|
| In re Application of | : | |
| MURDOCH | : | DECISION ON PETITION |
| Application No.: 09/602,122 | : | UNDER 37 CFR 1.182 |
| PCT No.: PCT/AU99/00059 | : | |
| Int. Filing Date: 29 January 1999 | : | |
| Priority Date: 29 January 1998 | : | |
| Attorney Docket No.: 010100-104 | : | |
| For: A TRANSCEIVER | | |

This decision is in response to applicants' "Response to Decision on Petition under 37 CFR 1.182 to Correct Named Applicant and Transmittal of Corrected Declaration" filed on 23 February 2001 which is being treated as a renewed petition under 37 CFR 1.182.

## BACKGROUND

On 29 January 1999, applicants filed the above-captioned international application, which claimed a priority date of 29 January 1998 and designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 05 August 1999. The international application named Graham Murdoch as the sole inventor. A Demand for international preliminary examination was filed prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 29 July 2000.

On 27 July 2000, 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 preliminary amendment.

On 14 August 2000, the United States/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indication an oath or declaration and the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) must be furnished. The notification set a one month time limit in which to respond.

On 15 September 2000, applicants filed "Petition to Correct Named Applicant" accompanied by: an executed declaration and a verified statement claiming small entity status. The declaration listed the inventor as Graham Alexander Munro Murdoch. The request was dismissed in a decision dated 11 January 2001.

On 23 February 2001, applicant filed the present petition and declaration.

## DISCUSSION

The Manual of Patent Examining Procedure at § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. Applicant states in the present petition, "[i]n response to the Decision on Petition under 37 CFR 1.182 to Correct Named applicant date January 11, 2001, . . . , please accept for filing the new Declaration and Petition signed by Applicant Graham Munro." The Declaration submitted has been executed by Graham Munro, the name listed on the international application, and is accepted. A review of the application papers reveals that applicant completed all the requirements of 35 U.S.C. 371 for entry into the national stage.

## CONCLUSION

The petition under 37 CFR 1.182 is **DISMISSED** as moot.

The application has an international filing date of 29 January 1999 under 35 U.S.C. 363 and a date of **23 February 2001** under 35 U.S.C. 371(c).

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Anthony Smith
Petitions Attorney
PCT Legal Office
Tel: (703) 308-6314
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

Mail Date: 04/23/2010

| | | |
|---|---|---|
| **Applicant** | : Tatsushi Nashida | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7610599 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/601,126 | : OF WYETH |
| **Filed** | : 09/22/2000 | : |
| | | : |

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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NEW YORK, NY 10151

Mail Date: 04/23/2010

| | | |
|---|---|---|
| **Applicant** | : Motoki Kobayashi | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7607150 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/20/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/601,150 | : OF WYETH |
| **Filed** | : 09/05/2000 | : |
| | | : |

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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OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA VA 22320

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OFFICE OF PETITIONS

In re Patent No. 6,825,889
Issue Date: November 30, 2004
Application No. 09/601,195
Filed: July 28, 2000
Attorney Docket Number: 106387

ON PETITION

This is a decision on the petition, filed on April 13, 2005, requesting the issuance of a duplicate Letters Patent for the above-identified application.

The petition is **Granted**.

The USPTO record indicates the patent was issued and mailed on March 23, 1999. The instant petition is granted in view of the assertion contained therein that the letters patent is lost. Receipt of the $200.00 petition fee is acknowledged. However, the current petition fee is $400.00. Accordingly, deposit account no. 15-0461 will be charged an additional $200.00.

A copy of this decision is being forwarded to the Office of Patent Publication for issuance of a duplicate letters patent for patent 6,825,889 to attorney of record:

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA VA 22320

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3215.

Charlema R. Grant
Petitions Attorney
Office of Petitions

cc: **Krystal Paige, South Tower, 8th Floor**
**Room C-32**
**Fax - (703) 746-4642**
**Phone - (703) 308-9250 x 139**

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Paper No.

Tarek N. Fahmi
BLAKELY, SOKOLOFF, TAYLOR &
ZAFMAN LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025-1026

MAILED

MAR 11 2005

Technology Center 2100

In re Application of:
Andrew A. Wajs
Application No. 09/601,233
Filed: July 31, 2000
For: SYSTEM FOR PROCESSING AN INFORMATION SIGNAL

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed November 12, 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 November 12, 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

JRM

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

cc: Andre L. Marais
SCHWEGMAN, LUNDBERG, WOESSNER &
KLUTH, P.A.
1600 TCF TOWER
121 South Eighth Street
Minneapolis, MN 55402

10 FEB 2004

#10

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Michael S. Huppert
Wenderoth, Lind & Ponack
Suite 800
2033 K Street NW
Washington, D.C. 20006

| | | |
|---|---|---|
| In re Application of | : | |
| Tanaka | : | |
| Application No.: 09/601,241 | : | DECISION ON |
| PCT No.: PCT/JP99/06645 | : | |
| Int. Filing Date: 29 November 1999 | : | PETITION |
| Priority Date: 01 December 1998 | : | |
| Attorney's Docket No.: 2000-0893 A | : | UNDER 37 CFR 1.182 |
| For: SPEAKER APPARATUS | : | |

This is a decision in response to the request to correct the international application number filed on 11 September 2000, which is being treated as a petition to correct the international application number. Accordingly, the $130 petition fee has been charged to applicant's deposit account.

## BACKGROUND

On 29 November 1999, applicant filed international application PCT/JP99/06645 that claimed priority of an earlier Japanese application filed 01 December 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 June 2000. No Demand for international preliminary examination was filed. Accordingly, the twenty-month period for paying the basic national fee for the national stage in the United States expired at midnight on 01 August 2000.

On 31 July 2000, applicant filed a letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a translation of the international application, a preliminary amendment, and the basic national fee of $840 as required by 35 U.S.C. 371(c). These papers were assigned application number 09/601,241.

On 11 August 2000, the United States Designated/Elected Office mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/EO/EO905), indicating that an oath or declaration and the surcharge for filing the oath or declaration later that 30 months from the priority date as required by 37 CFR 1.492(e) needed to be filed, along with the paper copy of the sequence listing and the CRF. The notification set a two-month time period in which to respond.

On 17 January 2002, applicant filed a declaration and the surcharge along with a request to correct the international application number. Applicant stated that the international application number was incorrectly identified on the original transmittal letter filed 31 July 2000.

## DISCUSSION

37 CFR § 1.417 states, in part:

> The submission of the international publication or an English language translation of an international application pursuant to 35 U.S.C. 154(d)(4) must clearly identify the international application to which it pertains (§ 1.5(a)) and, unless it is being submitted pursuant to § 1.495, be clearly identified as a submission pursuant to 35 U.S.C. 154(d)(4).

Although, the national stage application did not clearly identify the application to which it pertains on filing, applicant has provided the correct international application number.

## CONCLUSION

The petition is **GRANTED**.

The **$130** petition fee has been **charged** to applicant's **deposit account #23-0975**.

The "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) dated 25 September 2000 is hereby **VACATED**.

This application is being forwarded to the United States Designated Office for preparation of a corrected "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) indicating a corrected intenational application number of **PCT/JP99/06645**.

Debra S. Brittingham
PCT Special Programs Examiner
PCT Legal Office

Leonard Smith
PCT Legal Examiner
PCT Legal Office

DSB/LS:dsb
Telephone: (703) 308-3401
Facsimile: (703) 308-6459

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745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

Mail Date: 04/23/2010

| | | |
|---|---|---|
| **Applicant** | : Takeshi Hashimoto | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7600192 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/06/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/601,255 | : OF WYETH |
| **Filed** | : 09/25/2000 | : |
| | | : |

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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SEP - 7 2004

MYERS, BIGEL, SIBLEY & SAJOVEC
P. O. BOX 37428
RALEIGH, NC 27627

#18

| | |
|---|---|
| In re Application of | : |
| William N. Keith | : |
| Serial No.: 09/601,627 | : PETITION DECISION |
| Filed: August 25, 2000 | : |
| Attorney Docket No.: 9013-18 | : |

This is in response to the petition under 37 CFR 1.181, filed June 1, 2004, requesting withdrawal of abandonment based on timely filing of a reply.

A review of the file history shows that the examiner mailed an Office action to applicant on February 12, 2003, setting a three month shortened statutory period for reply. On January 28, 2004, the Office mailed a Notice of Abandonment to applicants for failure to file a reply to the Office action. Applicant states that a reply was filed on July 14, 2003, with a request for extension of time and fee therefore, and provides a copy thereof with a properly executed Certificate of Mailing and an Office date stamped postcard indicating Office receipt thereof. The original reply has not been located and the copy provided with the petition will be utilized in lieu thereof. In view of the timely reply, the Notice of Abandonment was mailed in error and is withdrawn and the application 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

Jasemine C. Chambers
Director, Technology Center 1600

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DANN, DORFMAN, HERRELL & SKILLMAN
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SUITE 2400
PHILADELPHIA PA 19103-2307

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| William Nicol Keith | : | |
| Application No. 09/601,267 | : | DECISION ON PETITION |
| Filed: August 25, 2000 | : | |
| Patent No. 7,084,267 | : | |
| Issued: August 1, 2006 | : | |
| Attorney Docket No. 9013-18 | : | |

This is a decision on the Request for Certificate of Correction under 37 CFR 1.323 filed November 20, 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 requests that a certificate of correction be issued to reflect the correct assignee on the front page of the Letters Patent in the patent to be issued from the application.

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.

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

The request was accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect that The University Court of The University of Glasgow is the assignee of record, which assignment was submitted for recordation as set forth in § 3.11 before issuance of the patent. Also, the request authorizes the charging of additional fees to deposit account number 04-1406, and the fee set forth in § 1.17(i) ($130.00) has been charged to said account. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to be processed after issuance of this application into a patent.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6692. 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.

David Bucci
Petitions Examiner
Office of Petitions

10 DEC 2004

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Mark S. Bicks
Roylance, Abrams, Berdo & Goodman LLP
1300 19th Street, Suite 600
Washington, DC 20036

| | | |
|---|---|---|
| In re Application of | : | |
| SCHULTE | : | DECISION ON |
| Application No.: 09/601,280 | : | |
| PCT No.: PCT/EP98/06930 | : | PETITION |
| Int. Filing Date: 02 November 1998 | : | |
| Priority Date: 22 September 1998 | : | UNDER 37 CFR 1.181 |
| Attorney's Docket No.: 40098 | : | |
| For: FLOOR CARPET INSTALLING SYSTEM | : | |

This application is before the PCT Legal Staff for consideration of matters arising under 35 U.S.C. 371.

## BACKGROUND

On 02 November 1998, applicant filed international application PCT/EP98/06930, which claimed priority of an earlier international application filed 22 September 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 March 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 July 1999, 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 22 March 2001.

On 31 July 2000, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a executed declaration as required by 35 U.S.C. 371(c)(4); a purported translation of the annexes to the IPER and a preliminary amendment.

On 11 September 2001, the United States Designated/Elected Office mailed a Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) indicating a 35 U.S.C. 102(e) date of 31 July 2000.

The application has received a final rejection and applicant has filed a notice of appeal and brief in the file. On 24 September 2004, applicant filed a petition under 35 U.S.C. 181 for entry of a substitute specification. Applicant's petition is being held in abeyance pending the outcome of the following matter.

## DISCUSSION

A review of the international application reveals that a translation of the international application as required by 35 U.S.C. 371(c)(2) was not filed. It is noted that the published international application has 10 claims and the brief description of the drawings list 3 figures. None of the purported translations filed contains a claim set containing claims 1-10. Nor do any of the purported translations of the description have a brief description of the drawings 1-3, other than a marked-up specification filed on 31 July 2000. However these sheets are indicated as having been modified. In the petition filed 24 September 2004, applicant states (pg 2) that he filed translations of both the international application and the annexes. However, it is noted that the transmittal letter of 31 July 200 does not indicate that a translation of the international application was filed. Furthermore, it does not appear that applicant later filed an English translation of the international application. It appears that what applicant filed, may have been a translation of the international application with the amendments made during international preliminary examination (Chapter II) proceedings during the international stage of the application. This is not proper under 37 CFR 1.495, which requires that a translaton of the international application and a separate translation of the annexes to the international application be filed.

If applicant has a post card showing that he filed a translation of the international application, he could submit the postcard and copy of translation and a statement from the attorney that these are true copies and what was filed.

## CONCLUSION

The Notification of Acceptance mailed on 11 September 2001 is hereby VACATED.

Applicant is requried to file an English translation of the international application as required by 35 U.S.C. 371(c)(2) and the processing fee for filing the English translation of the international application later than 30 months from the priority date as required by 37 CFR 1.492(f).

Applicant has TWO (2) MONTHS from the mail date of this decision to file the translation and processing fee. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to comply will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration

LES:ls

Telephone: (571) 272-3297
Facsimile: (571) 273-0459

UNITED STATES PATENT AND TRADEMARK OFFICE

15 APR 2005

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1300 19th Street, Suite 600
Washington, DC 20036

| | | |
|---|---|---|
| In re Application of | : | |
| SCHULTE | : | DECISION |
| Application No.: 09/601,280 | : | |
| PCT No.: PCT/EP98/06930 | : | |
| Int. Filing Date: 02 November 1998 | : | RE: TRANSLATION |
| Priority Date: 22 September 1998 | : | |
| Attorney's Docket No.: 40098 | : | |
| For: FLOOR CARPET INSTALLING SYSTEM | : | |

This application is in response to applicant's response filed March 18, 2005.

## BACKGROUND

On 02 November 1998, applicant filed international application PCT/EP98/06930, which claimed priority of an earlier international application filed 22 September 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 30 March 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 July 1999, 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 22 March 2001.

On 31 July 2000, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a executed declaration as required by 35 U.S.C. 371(c)(4); a purported translation of the annexes to the IPER and a preliminary amendment.

On 11 September 2001, the United States Designated/Elected Office mailed a Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) indicating a 35 U.S.C. 102(e) date of 31 July 2000.

The application has received a final rejection and applicant has filed a notice of appeal and brief in the file. On 24 September 2004, applicant filed a petition under 35 U.S.C. 181 for entry of a substitute specification. Applicant's petition is being held in abeyance pending the outcome of the following matter.

In a decision dated 10 December 2004, it was noted that applicant had not filed a translation of the international application as required by 35 U.S.C. 371(c)(2). The following was stated:

> A review of the international application reveals that a translation of the international application as required by 35 U.S.C. 371(c)(2) was not filed. It is noted that the published international application has 10 claims and the brief description of the drawings list 3 figures. None of the purported translations filed contains a claim set containing claims 1-10. Nor do any of the purported translations of the description have a brief description of the drawings 1-3, other than a marked-up specification filed on 31 July 2000. However these sheets are indicated as having been modified. In the petition filed 24 September 2004, applicant states (pg 2) that he filed translations of both the international application and the annexes. However, it is noted that the transmittal letter of 31 July 200 does not indicate that a translation of the international application was filed. Furthermore, it does not appear that applicant later filed an English translation of the international application. It appears that what applicant filed, may have been a translation of the international application with the amendments made during international preliminary examination (Chapter II) proceedings during the international stage of the application. This is not proper under 37 CFR 1.495, which requires that a translation of the international application and a separate translation of the annexes to the international application be filed.

The Notification of Acceptance mailed on 11 September 2001 was vacated and applicant was required to file an English translation of the international application as required by 35 U.S.C. 371(c)(2) and the processing fee for filing the English translation of the international application later than 30 months from the priority date as required by 37 CFR 1.492(f) within two months from the mail date of the decision.

## DISCUSSION

With the 18 March 2005 response, applicant has filed an acceptable English translation of the international application as required by 35 U.S.C. 371(c)(2) and the processing fee for filing the English translation of the international application later than 30 months from the priority date. Furthermore, applicant has submitted an English translation of the annexes to the international preliminary examination report (identified as AMENDED SHEETS/IPEA/EP) consisting of four sheets of description and two sheets of description. These translated amended sheets should be replace the translated sheets of the original international application. Therefore, any further amendments to the applications would have to amend the international application with the translated annexes entered. Accordingly, a new Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) indicating a 35 U.S.C. 102(e) date of 18 March 2005 will be mailed to applicant.

## CONCLUSION

The filing of the acceptable English translation of the international application satisfied the requirement of by 35 U.S.C. 371(c)(2). This application is being return to the National Stage Processing Division for issuance of a new Notification of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.495 (Form PCT/DO/EO/903) indicating a 35 U.S.C. 102(e) date of 18 March 2005.

Afterwards, the application will be returned to the Technology Center 1770 for consideration of the entry of the substitute specification.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration

LES:ls

Telephone: (571) 272-3297
Facsimile: (571) 273-0459

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Michael Molins
Molins & Co.
Suite S, Level 6
139 Macquarie Street
Sydney NSW, 2000 Australia

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**OFFICE OF PETITIONS**

In re Patent No. 6,755,966 :
Issue Date: June 29, 2004 :
Application No. 09/601,375 : ON PETITION
Filed: September 21, 2000 :
Attorney Docket No. 1367-4 :

This is a decision on the communications filed March 23, 2005, June 22, 2005, and July 28, 2005, which is being treated as a petition under 37 CFR 1.182, requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is **DISMISSED**.

Petitioner alleges that the Letters Patent (hereinafter "Patent") had not been received. A review of the written record indicates no irregularity in the mailing of the Patent, and in the absence of any irregularity there is a strong presumption that the Patent was properly mailed to the petitioner at the address of record.

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. However, 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). *See* MPEP 711.03(c). In view of the above, petitioner must provide documentation to support the allegation that the Patent was not received. While this section of the Manual refers to Office communications, i.e., Office actions, the same standards apply to show nonreceipt of any communication.

The fee required for filing a petition under 37 CFR 1.182 is $400. Petitioner has not provided the required $400 petition fee. If petitioner can provide an adequate showing (as noted above) to the Office, the petition fee will be refunded. However, if petitioner is unable to provide the aforementioned showing, the Office will retain the $400 petition fee. Upon the filing of a Request for Reconsideration of

Petition under 37 CFR 1.182 and the requisite fee and/or adequate showing, the Office will mail a duplicate Letters Patent.

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**
Attn: Office of Petitions

By hand:
U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

Marianne E. Jenkins
Petitions Examiner
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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Fenster & Company Intellectual Property 2002 LTD.
c/o Reed Smith, LLP
599 Lexington Avenue, 29th Floor
New York, NY 10022-7650

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JUN 20 2005

**OFFICE OF PETITIONS**

In re Application of :
Aviv Refuah, et. al. :
Application No. 09/601,385 : ON PETITION
Filed: July 28, 2000 :
Attorney Docket No. 092/01664 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 16, 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, to the final Office action mailed July 8, 2004, which set a shortened statutory period for reply of three (3) months. A three (3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned after midnight January 8, 2005.

In response to the final Office action, petitioner submitted with the instant petition $750 for the petition to revive fee, $395 for the filing of a Request for Continued Examination (RCE), an amendment as the submission required under 37 CFR 1.114 and the statement of unintentional delay as required by 37 CFR 1.137(b).

Petitioner should note that the above fees were charged, as authorized, to the Deposit Account listed in the instant petition.

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 2151, for processing the Request for Continued Examination under 37 CFR 1.114, and for further review of the amendment filed with the instant petition.

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

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

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United States Patent and Trademark Office
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WOLF, BLOCK, SCHORR & SOLISCOHEN LLP
250 Park Avenue
New York, NY 10177

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JAN 04 2007

Technology Center 2100

In re Application of: Refuah, et al.
Application No.: 09/601,385
Filed: July 28, 2000
Attorney Docket No.: 092/01664
For: PERSONALIZED INTERNET INTERACTION

**DECISION ON PETITION *UNDER 37 CFR §1.181***

This is a decision on the petition filed February 16, 2006, under 37 CFR §1.181(a), for withdrawal of the final rejection of December 30, 2005 as premature. The delay in response to the petition(s) is regretted.

A review of the file record indicates that prosecution will be reopened as a result of the panel decision from pre-appeal brief review (see Notice of Panel Decision from Pre-Appeal Brief Review, mailed November 20, 2006).

Accordingly, in view of the above stated reason, the instant petition, filed under 37 CFR §1.181(a) to invoke supervisory authority to withdraw the final rejection mailed on December 30, 2004, is rendered moot.

Accordingly, the petition is **DISMISSED as MOOT**.

The application is being forwarded to the Examiner to reopen prosecution of the instant application, consistent with the panel decision from pre-appeal brief. Telephone inquiries should be directed to the undersigned at 571-272-3595.

Brian L. Johnson
Workgroup Quality Assurance Specialist
Technology Center 2100
Computer Architecture, Software, and Information Security

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**OSTRAGER CHONG FLAHERTY & BROITMAN PC**
**570 LEXINGTON AVENUE, FLOOR 17**
**NEW YORK, NY 10022-6894**

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OCT 09 2009

OFFICE OF PETITIONS

In re Application of :
**Aviv REFUAH**, et *al.* :
Application No. 09/601,385 :
Filed: July 28, 2000 :
Attorney Docket No. **NETEX-P2-US** :

DECISION GRANTING PETITION
UNDER 37 CFR 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.313(c)(2), filed October 7, 2009, 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 10, 2009 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) 272-7253.

This application is being referred to Technology Center AU 2451 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/Monica A. Graves/
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 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
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Mailed: MAY 15 2002

MC
Paper Number 10

In re application of
WAKAYAMA et al.
Serial No.: 09/601,390
Filed: July 31, 2000
For: FILTER MEDIUM FOR AIR FILTER AND PROCESS FOR PRODUCING THE SAME

: **DECISION ON**
: **PETITION**

This is a decision on the petition under 37 CFR 1.144 filed April 18, 2002, in Paper No. 9, to review the restriction requirement as set forth in the action mailed on September 28, 2001, in Paper No. 5.

## BACKGROUND

The present application was filed on the national stage under the provisions of 35 USC 371. In reviewing the propriety of a restriction requirement, i.e. the presence or absence of "Unity of Invention," in such an application it is understood that unity of invention is to be evaluated by the criteria described in PCT Rules 13.1-13.2 or 37 CFR 1.475. According to PCT Rule 13.2:

> Where a group of inventions is claimed in an 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.

Furthermore, 37 CFR 1.475 (b) or Annex B to the "PCT Administrative Instructions" in Appendix AI of the *MPEP* describes different combinations of categories of inventions that may be held to have unity of invention due to their possession of such a technical relationship.

The examiner imposed a three way restriction under 35 USC 121, relying in part, on the argument that the three Groups of Invention, i.e., Group I, claims 1-8, and 17 directed to a filter medium and method for manufacturing a filter medium; Group II, claims 12-13 directed to a method for manufacturing semiconductors; and Group III, claims 9-11 and 14-16 directed to a clean room. The examiner further expands his explanation in that "Group I is directed to a filter medium having a special technical feature of a binder not shared by any of the remaining groups. Group II is directed to a method of manufacturing semiconductors having a special feature of a silicon wafer not shared by any of the remaining groups. Group III is directed to a clear room having the special feature of a clean bench, clean booth, wafer stocker, wafer transfer space, and semiconductor fabrication equipment not shared by any of the remaining groups".

Petitioner argues that the claims of Group III, namely, 9-11 and 14-16 are dependent claims, ultimately depending upon independent claim 1. Similarly, the claims of Group II, namely, 12-13 are also dependent

claims, ultimately depending upon independent claim 1. In addition, Petitioner contends that the special technical feature common to all of the claims is the air filter comprising a filter medium. The petitioner, then goes on to set forth example 13 found in Annex B to the "PCT Administrative Instructions" in Appendix AI of the *MPEP* as being analogous to claims 1-18.

**DECISION**

Upon review of the arguments above, the claims as filed, including the claims added in the preliminary amendment filed July 31, 2000, revealed that claims 9-11 are dependent upon claim 8 which in turn depends on claim 1. Claims 14, 15, and 16 were drafted to depend on claims 10, 12 and 13 respectively. Claims 12 and 13 also depending on claim 8.

According to *MPEP* 1850 under the subtitle, "*Independent and Dependent Claims*" it is stated:

> 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. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed, for example, product, process, use or apparatus or means, etc.).

In this case, the imposed restriction was considered in relation to the dependent claims 9-16 for Unity of invention. Due to their dependency, claims 9-16 contain all the features, the special technical feature, of claim 8 and consequently, of claim 1. Since the standard for restriction for application filed under 35 USC 371 has not been met, it is evident that the restriction is improper.

In view of the above discussion, the petition is **GRANTED**.

The application will be forwarded to the examiner for examination of all of the restricted claims present in the application, namely, Claims 9-16.

Richard V. Fisher

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

Darlene P. Condra
YOUNG & BASILE, P.C.
3001 West Big Beaver Rd., Suite 624
Troy, Michigan 48084-3107

05 APR 2005

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STRIKER, STRIKER & STENBY
103 East Neck Road
Huntington, New York 11743

| | | |
|---|---|---|
| In re Application of | : | DECISION ON |
| KUNZ et al | : | |
| Application No.: 09/601,431 | : | |
| PCT No.: PCT/EP99/09005 | : | PETITION UNDER |
| Int. Filing Date: 23 November 1999 | : | |
| Priority Date: 07 December 1998 | : | |
| Attorney Docket No.: 1222 | : | 37 CFR 1.182 |
| For: COMPOSITION FOR DYEING HAIR | : | |

This decision is in response to petitioner's "RESPONSE TO NOTIFICATION DATED MARCH 26, 2003" filed on 26 June 2003, which is being treated as a petition under 37 CFR 1.182. The petition fee of $130.00 has been charged to Deposit Account No. 19-4675 as indicated in the petition.

## BACKGROUND

In a notification from Office on 26 March 2003, the declaration of the inventors was not accepted at that time since the name of the second named inventor, Manuela Kunz JAVET, did not correspond the set forth in the international application, Manuela Kunz. The notification indicated where an inventor's name has changed after the international application was filed to submit a petition under 37 CFR 1.182.

On 26 June 2003, petitioner submitted the instant petition, which included an affidavit in support of the name change of the inventor from Manuela Kunz to Manuela Javet.

## DISCUSSION

MPEP § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

With respect to item (1), the petition fee has been charged to petitioner's deposit account.

With respect to item (2), an affidavit has been provided signed under both names- Manuela Kunz (maiden name), and Manuela Javet (married named), and setting forth the procedure whereby the change of name was effected. Therefore, item (2) has been satisfied.

For the reasons above, the application may enter into national stage processing at this time.

## CONCLUSION

The petition under 37 CFR §1.182 for change of name of inventor is **GRANTED**. This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **02 August 2000.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Telephone: (571) 272-3276
Facsimile: (571) 273-0459

Richard Cole
PCT Legal Examiner
PCT Legal Office

05 APR 2005

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Huntington, New York 11743

| | | |
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| In re Application of | : | DECISION ON |
| KUNZ et al | : | |
| Application No.: 09/601,43. | : | |
| PCT No.: PCT/EP99/09005 | : | PETITION UNDER |
| Int. Filing Date: 23 November 1999 | : | |
| Priority Date: 07 December 1998 | : | |
| Attorney Docket No.: 1222 | : | 37 CFR 1.182 |
| For: COMPOSITION FOR DYEING HAIR | : | |

This decision is in response to petitioner's "RESPONSE TO NOTIFICATION DATED MARCH 26, 2003" filed on 26 June 2003, which is being treated as a petition under 37 CFR 1.182. The petition fee of $130.00 has been charged to Deposit Account No. 19-4675 as indicated in the petition.

## BACKGROUND

In a notification from Office on 26 March 2003, the declaration of the inventors was not accepted at that time since the name of the second named inventor, Manuela Kunz JAVET, did not correspond the set forth in the international application, Manuela Kunz. The notification indicated where an inventor's name has changed after the international application was filed to submit a petition under 37 CFR 1.182.

On 26 June 2003, petitioner submitted the instant petition, which included an affidavit in support of the name change of the inventor from Manuela Kunz to Manuela Javet.

## DISCUSSION

MPEP § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

With respect to item (1), the petition fee has been charged to petitioner's deposit account.

With respect to item (2), an affidavit has been provided signed under both names- Manuela Kunz (maiden name), and Manuela Javet (married named), and setting forth the procedure whereby the change of name was effected. Therefore, item (2) has been satisfied.

For the reasons above, the application may enter into national stage processing at this time.

## CONCLUSION

The petition under 37 CFR §1.182 for change of name of inventor is **GRANTED**. This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **02 August 2000.**

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Telephone: (571) 272-3276
Facsimile: (571) 273-0459

Richard Cole
PCT Legal Examiner
PCT Legal Office

05 APR 2005

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| In re Application of | : | DECISION ON |
| KUNZ et al | : | |
| Application No.: 09/601,431 | : | |
| PCT No.: PCT/EP99/09005 | : | PETITION UNDER |
| Int. Filing Date: 23 November 1999 | : | |
| Priority Date: 07 December 1998 | : | |
| Attorney Docket No.: 1222 | : | 37 CFR 1.182 |
| For: COMPOSITION FOR DYEING HAIR | : | |

This decision is in response to petitioner's "RESPONSE TO NOTIFICATION DATED MARCH 26, 2003" filed on 26 June 2003, which is being treated as a petition under 37 CFR 1.182. The petition fee of $130.00 has been charged to Deposit Account No. 19-4675 as indicated in the petition.

## BACKGROUND

In a notification from Office on 26 March 2003, the declaration of the inventors was not accepted at that time since the name of the second named inventor, Manuela Kunz JAVET, did not correspond the set forth in the international application, Manuela Kunz. The notification indicated where an inventor's name has changed after the international application was filed to submit a petition under 37 CFR 1.182.

On 26 June 2003, petitioner submitted the instant petition, which included an affidavit in support of the name change of the inventor from Manuela Kunz to Manuela Javet.

## DISCUSSION

MPEP § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include (1) the appropriate petition fee and (2) an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or a certified copy of the court order.

With respect to item (1), the petition fee has been charged to petitioner's deposit account.

With respect to item (2), an affidavit has been provided signed under both names-Manuela Kunz (maiden name), and Manuela Javet (married named), and setting forth the procedure whereby the change of name was effected. Therefore, item (2) has been satisfied.

For the reasons above, the application may enter into national stage processing at this time.

## CONCLUSION

The petition under 37 CFR §1.182 for change of name of inventor is **GRANTED**. This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing under 35 U.S.C. 371. The 35 USC 371(c)(1), (c)(2), and (c)(4) date of this application is **02 August 2000.**

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PCT Legal Office

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Richard Cole
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PCT Legal Office

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Patent and Trademark Office

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In re Application of :
CHANG, Esther, H., et al. :
U.S. Application No.: 09/601,444 :
PCT No.: PCT/US98/24657 :
International Filing Date: 19 November 1998 :
Priority Date: 19 November 1997 :
Attorney's Docket No.: 2444-101 :
For: TARGETED LIPOSOME GENE DELIVERY :

DECISION ON PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

This decision is issued in response to applicants' "Petition To Revive Unintentionally Abandoned Application Under 37 CFR 1.137(b)" filed on 02 August 2000. Applicants have paid the small entity petition fee.

## BACKGROUND

On 19 November 1998, applicants filed international application PCT/US98/24657 which claimed a priority date of 19 November 1997 and which designated the United States.

On 18 June 1999, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. 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 thirty months from the priority date, i.e., 19 May 2000.

On 02 August 2000, applicants filed the Petition To Revive considered herein, with accompanying materials.

## DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (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 required pursuant to 37 CFR 1.137(c).

Regarding item (1), the "required reply," section 711.03(c) of the Manual of Patent Examining Procedures states that:

> [g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.

Here, a copy of the international application was not required because the international application was filed in the United States Receiving Office. The "required reply" was therefore payment of the basic national fee. The Petition To Revive filed on 02 August 2000 included an authorization to charge Deposit Account No. 02-2135 for the small entity basic national fee and was accompanied by a small entity statement. Thus, applicants have made a submission which would have been "sufficient to have avoided abandonment" had it been made in a timely manner, that is, on or before 19 May 2000. Accordingly, applicants have submitted the "required reply." Item (1) is satisfied.

Item (2) is the petition fee required under 37 CFR 1.17(m). The Petition To Revive provided authorization to charge Deposit Account No. 02-2135 $605 for the small entity petition fee. Item (2) is satisfied.

As for item (3), the Petition For Revival expressly states that:

> the entire delay in filing the necessary papers to begin the U.S. national stage of this PCT application until the lack of a U.S. national stage filing was noticed on 26 July 2000 was unintentional. On that date the process of preparing the necessary papers for prosecution of the U.S. national stage and the obtaining of necessary signatures was begun. The filing of this petition and the accompanying papers was accomplished as rapidly as possible following discovery on 26 July 2000 that the necessary papers for entering the U.S. national stage for this application had not been filed with the U.S. Patent and Trademark Office.

The statements in the Petition To Revive are construed as being the statement required by 37 CFR 1.137(b)(3), that is, 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." Applicants **must** notify this Office if this is **not** a correct interpretation. Based on this interpretation, item (3) under 37 CFR 1.137(b) is satisfied.

Under the terms of 37 CFR 1.137(c), the terminal disclaimer listed as item (4) above is not required for this application. Applicants have therefore satisfied all the requirements for a grantable petition under 37 CFR 1.137(b). The Petition To Revive is granted.

The Petition To Revive was also accompanied by an executed declaration. However, review of this declaration reveals that it is not in compliance with 37 CFR 1.497(a) and (b). Specifically, the first two pages of the declaration are an original document, while the third page is a copy. Accordingly, the first two originalpages could not have been attached to the signature page at the time of execution, and therefore, execution is not proper. In addition, the third page of the declaration is illegible (note, e.g., the second inventor's typewritten name)

## CONCLUSION

Applicants' Petition To Revive is **GRANTED**.

The application has an international filing date of 19 November 1998 under 35 U.S.C. 363 and a date of 02 August 2000 under 35 U.S.C. 371(c) and 102(e).

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accord with this decision including mailing of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring a properly executed oath or declaration.

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PCT Legal Examiner
PCT Legal Office

RMR/BM:rmr

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
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Mailed: MAR 1 2004

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Paper Number 14

| | | |
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| In re application of | : | |
| Hiroaki Okamoto et al. | : | DECISION ON |
| Serial No. 09/601,474 | : | PETITION |
| Filed: October 17, 2000 | : | |
| For: METHOD OF FORMING PROTECTIVE COATING ON CELL SAFETY VALVE ELEMENT, CELL SAFETY VALVE ELEMENT COATED WITH PROTECTIVE FILM, CELL SEALING PLATE USING THE ELEMENT, AND ENCLOSED CELL USING THE PLATE | : | |

This is a response to the PETITION TO VACATE HOLDING OF ABANDONMENT, filed September 26, 2003. The petition asks that the abandonment, as set forth in the Notice of Abandonment of August 25, 2003, be withdrawn since the applicant did timely file a response on June 12, 2003.

**DECISION**

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the USPTO application file reveals that applicant's response, the REQUEST FOR CONTINUED EXAMINATION (RCE) and INFORMATION DISCLOSURE STATEMENT, were properly filed on June 12, 2003 in view of the fact that the originally filed papers having a Patent and Trademark Office date stamp of June 12, 2003 thereon have been located in the USPTO application file. Accordingly, any holding of abandonment is hereby vacated, and the application has been returned to pending status.

The application shall be forwarded to the examiner for processing and consideration of the papers filed June 12, 2003.

The Petition is **GRANTED**.

JStone

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#9

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Benoit Castel
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| | |
|---|---|
| In re Application of | |
| PARTINGTON, et al. | DECISION ON |
| Application No.: 09/601,477 | |
| PCT No.: PCT/GB99/00194 | PETITION |
| Int. Filing Date: 20 January 1999 | |
| Priority Date: 04 February 1998 | UNDER 37 CFR 1.182 |
| Attorney Docket No.: CILB 10858US | |
| For: BATTERY | |

This decision is in response to applicants' "PETITION UNDER 37 C.F.R. 1.182" filed 14 February 2001.

## BACKGROUND

On 20 January 1999, applicant filed international application PCT/GB99/00194, which claimed priority of an earlier application filed 04 February 1998. 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 04 August 2000.

On 03 August 2000, applicant filed a Transmittal Letter for entry into the national stage in the United States, which was accompanied by, inter alia: the basic national fee; a copy of the international application; an International Preliminary Examination report; an International Search Report and a first preliminary amendment. An executed oath or declaration was not filed.

On 22 August 2000, 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 executed by the inventor and the $130.00 surcharge for filing after the thirty-month period were required. The notification set a ONE (1) MONTH period for response.

On 23 October 2000, applicant responded with an executed combined declaration and power of attorney; a petition for a one month extension of time. With the filing of the one-month extension of time, the response was considered timely filed.

On 01 November 2000, applicant was mailed a NOTIFICATION OF A DEFECTIVE RESPONSE (Form PCT/DO/EO/916) and a NOTIFICATION OF A DEFECTIVE OATH OR

DECLARATION (Form PCT/DO/EO/917) as the executed combined declaration and power of attorney identified the second joint inventor as David Colin BROWN whereas the international application identifies the second joint inventor as David Colin SMITH.

On 14 February 2001, applicant responded with the present petition under 37 CFR 1.182.

## DISCUSSION

The Manual of Patent Examining Procedure at § 605.04(c) requires in instances where an inventor has changed his or her name after the application has been filed to submit a petition under 37 CFR 1.182. The petition must include the appropriate petition fee and an affidavit signed with both names setting forth the procedure whereby the change of name was effected, or certified copy of the court order.

The papers have been reviewed and the papers are accepted.

The declaration submitted on 23 October 2000 and executed by Kenneth Michael Partington and David Colin Brown is accepted.

## CONCLUSION

The petition under 37 CFR 1.182 to change the inventor's name from David Colin SMITH to David Colin BROWN is **GRANTED**.

The application has an international filing date of 20 January 1999 under 35 U.S.C. 363 and a date of **23 October 2000** under 35 U.S.C. 371(c).

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

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Paper No. 18

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OFFICE OF PETITIONS

In re Application of :
Kenneth M. Partington et al. :
Application No. 09/601,477 : ON PETITION
Filed: October 23, 2000 :
Attorney Docket No. CIBL 10858 US :

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 reply in a timely manner in reply to the non-final Office action mailed July 25, 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 26, 2002.

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

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

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

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| | |
|---|---|
| In re Application of | : |
| Danette Andrea Dudley et al. | : |
| Serial No. 09/601,479 | : WITHDRAWAL OF ABANDONMENT |
| Filed: August 3, 2000 | : |
| Attorney Docket No.: 5712-01-CA | : |

This is in response to applicants' petition under 37 CFR 1.137(b) to revive an application abandoned unintentionally, filed October 4, 2001. Since the application was never abandoned in fact, the petition is being treated as a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment (MPEP 711.03(c)(I)). No petition fee is required.

A review of the file history shows that the examiner mailed an Office action (restriction requirement) to applicant on February 14, 2001, setting a one month shortened statutory time period for reply. On September 20, 2001, the examiner mailed a Notice of Abandonment to applicant indicating no response to the Office action had been received.

Applicant states that a reply to the Office action was filed on March 12, 2001, as evidenced by the properly executed Certificate of Facsimile Transmission on the reply. Applicant provides a copy of the submitted reply with the petition. In view of this evidence, 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 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.

Bruce Kisliuk
Director, Technology Center 1600

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In re Application of :
BREYNAERT, François :
U.S. Application No.: 09/601,545 :
PCT No.: PCT/FR99/00193 : DECISION
Int. Filing Date: 29 January 1999 :
Priority Date: 03 February 1998 :
Attorney's Docket No.: 60130-865 :
For: MERITOR LIGHT VEHICLE SYSTEMS :

This decision is in response to applicant's "Petition to Withdraw From Abandonment/Revive Application" ("Pet.") filed 16 November 2000. The "Petition to Withdraw From Abandonment" is being treated as a petition under 37 CFR 1.181 which requires no petition fee.

## BACKGROUND

On 29 January 1999, applicant filed international application PCT/FR99/00193 claiming priority to a French patent filed 03 February 1998. A copy of the international application was communicated from the International Bureau to the United States Patent and Trademark Office ("PTO") on 12 April 1999.

On 30 April 1999, 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.*, 03 August 2000.

On 03 August 2000, applicant 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*, an English translation and authorization to charge the basic national fee to Deposit Account No. 18-1720. The transmittal letter was signed by Ms. Kerrie A. Laba who was not listed on the Deposit Account authorization list.

On 12 October 2000, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) because of failure to provide the full U.S. Basic National Fee by 30 months from the claimed priority date.

On 16 November 2000, applicant submitted the instant petition.

On 08 February 2000, applicant submitted via facsimile a letter verifying that the instant petition is for the above-captioned application.

## DISCUSSION

### Withdraw Holding of Abandonment

Counsel requests that the Notification of Abandonment be withdrawn in the above-captioned application. Counsel contends that the failure to pay the full U.S. basic national fee was due to a clerical mistake in using the wrong Deposit Account on the transmittal letter. Nonetheless, counsel argues that "applicant did make a bona fide attempt to pay the filing fee within the required period of time." Pet. ¶ 1. This argument is unpersuasive.

37 CFR 1.495 *Entering the national stage in the United States of America as an Elected Office,* states in part:

> Where the United States of America has been elected by the expiration of 19 months from the priority date, the applicant must fulfill the requirements of 35 U.S.C. 371 within the time periods set forth in paragraphs (b) and (c) of this section in order to prevent the abandonment of the international application as to the Unites States of America . . .
>
> > (b) To avoid abandonment of the application, the applicant shall furnish to the United States Patent and Trademark Office not later than the expiration of 30 months from the priority date: . . .
> >
> > > (2) The basic national fee (see § 1.492(a)). The 30-month time limit may not be extended.

In the instant petition to withdraw the holding of abandonment, applicant does not dispute that Ms. Kerrie A. Laba was not authorized to charge fees on Deposit Account No. 18-1720. Rather, counsel argues that the failure was due to not using the Deposit Account of Meritor Automotive "For which applicant's primary attorney contact was authorized" on the transmittal letter. Nevertheless, a "bona fide attempt" was made. Id.

Whether applicant made a bona fide attempt to pay the filing fee within the required time period is not the applicable standard in this situation. The rules clearly state that applicant must pay the basic national fee prior to the expiration of the 30-month deadline and that an extension of the 30-month time limit will not occur. Applicant failed to pay the basic national fee in time, therefore, the above-captioned application was properly abandoned.

**Petition to Revive**

Applicant alternatively requests to revive the unintentionally abandoned application. A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay must be accompanied by (1) a proper reply, unless previously filed, (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 to the filing of a grantable petition pursuant to this paragraph was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

The statement that "[a]ny delay form [*sic*] the point of receiving the Notification of Abandonment mailed 12 October 2000 and today's date was also unintentional" has been interpreted as meaning that the "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). If this is an incorrect interpretation, applicant is requested to notify this office.

The petition fee, basic national fee and surcharge fee for furnishing the declaration late pursuant to 37 CFR 1.492(e) have been charged to Deposit Account No. 50-1482 as authorized. A terminal disclaimer is not required in this application.

Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

**DECISION**

In view of the discussion mentioned above, applicant's petition under 37 CFR 1.181 is **DISMISSED** without prejudice. However, the petition to revive pursuant to 37 CFR 1.137(b) is **GRANTED**.

A review of the declaration submitted with the instant petition reveals that the declaration was for the national stage of PCT/FR98/01318.

The application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements (Form PCT/DO/EO/905) for failing to provide an oath or declaration in compliance with 37 CFR 1.497(a) & (b).

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#15

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| | |
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| In re Application of | : |
| Michael W. Dahm et al. | : |
| Serial No.:09/601,645 | :PETITION DECISION |
| Filed: August 4, 2000 | : |
| Attorney Docket No.: 24741-1509US | : |

This is in response to applicant's petition, filed December 26, 2001 under 37 CFR 1.144, requesting removal of the restriction requirement set forth by the examiner. The delay in responding to this petition is regretted.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 as the National Stage of PCT/EP99/00716, filed February 3, 1999, which claims priority to German application 198 04 372.4, filed February 4, 1998. The application, as filed, contains claims 1-51 and 52-68 presented in a preliminary amendment. In a first Office action mailed May 1, 2001, the examiner set forth a restriction / lack of unity requirement under 35 U.S.C. 121 and 372 dividing the claims into 2 groups, as follows:

> Group I, claims 1-38 and 52-67, drawn to a nucleic acid amplification method.
> Group II, claims 39-51 and 68, drawn to an oligonucleotide and a kit containing said oligonucleotide.

The examiner presented reasons for the requirement, indicating that the cDNA sequence of human telomerase was known in the art and that methods of quantifying tumor cells in body fluid by measuring specific mRNAs in cells were also known in the art. Applicant replied by electing, with traverse, Group I, claims 1-38 and 52-67. Applicant argued that the inventions of both groups are not taught or suggested by the prior art, and therefore they are linked by a special technical feature.

In the next Office action, mailed July 3, 2001, the examiner modified the restriction requirement by dividing the claims into 3 groups, as follows:

> Group I, claims 1-19, 35-38 and 52-61, drawn to a nucleic acid amplification method.

Group II, claims 20-34 and 62-67, drawn to a method and apparatus for concentrating tumor cells.
Group III, claims 39-51 and 68, drawn to an oligonucleotide and a kit containing said oligonucleotide.

The examiner presented reasons for the requirement, indicating that the cDNA sequence of human telomerase was known in the art and that methods of quantifying tumor cells in body fluid by measuring specific mRNAs in cells were also known in the art, citing an additional reference. The examiner did not respond to Applicant's arguments.

Applicant replied by electing, with traverse, Group II, claims 20-34 and 62-67. Applicant again argued that the inventions of all groups are not taught or suggested by the prior art, and therefore they are linked by a special technical feature. Applicant further argued that the restriction requirement could result in applicant being granted two patents on essentially the same method (Groups I and II) without a double patenting rejection being made.

In the next Office action, mailed October 24, 2001, the examiner again modified the restriction requirement, stating that claim 67 should have been included in Group I because it depends on claim 1. The examiner made the restriction requirement final, responding to Applicant's arguments as follows. The examiner stated that none of the particulars of amplifying and quantifying RNA are found in Group II, while none of the particulars of concentrating tumor cells are found in Group I. Therefore, the examiner reasoned, the special technical feature is the human telomerase sequence, which was known in the art.

DISCUSSION

In the petition, Applicant disputes the examiner's assertion that the telomerase sequence is the general inventive feature of groups I and II. Applicant does not suggest an alternative special technical feature, but points out that the claims of Groups I and II are all drawn to a methods for quantitation of tumor cells and that all the claims of Group II are dependent on claims of Group I. Applicant also argues that the primers of Group III are specified in some dependent claims of group I.

Annex B of the PCT Administrative Instructions gives guidance on Unity of Invention as follows:

> (c) 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. By "dependent" claim is meant a claim which contains all the features of another claim and is in the same category of claim as that other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed, for example, product, process, use or apparatus or means, etc.).

There are 4 independent claims pending in the instant application: claims 1 and 39-41. Claim 1 is drawn to a method for quantification of tumor cells in a body fluid, comprising specifically amplifying mRNA coding for the catalytic subunit of telomerase. Claim 41 is drawn to a kit comprising an oligonucleotide primer pair for amplifying the catalytic subunit of telomerase. Claims 39 and 40 are drawn to oligonucleotide primers having specific sequences. Claim 1 does not require the specific sequence of claims 39 and 40. Neither claim 1 nor claim 41 recite a

specific sequence, and the specification states that any sequence section of the cDNA encoding the catalytic subunit of telomerase may be used in the invention (p. 7, lines 35-38). Therefore it is concluded that there is no common structure uniting the compositions of claims 39-41 with the method of claim 1, and restriction of claims 39-51 and 68 (Group III) from the other claims is proper.

Claim 20, which depends on claim 1, was rejected by the examiner under 35 U.S.C. 103. Therefore claim 1 is not free of the prior art. Annex B part (c)(ii) states, in part:

> 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 that claim needs to be carefully considered.

In this case, all the claims of group II ultimately depend on claim 1. The claims of Group II may contain a technical feature not found in claim 1, but the technical feature of claim 1 is included in each of the Group II claims. Therefore there is still an inventive link between claims 1-38 and 52-67 and further restriction of these claims is deemed improper.

DECISION

Applicant's petition with respect to withdrawal of the restriction / lack of unity requirement is **GRANTED-IN-PART** for the reasons set forth above.

**The application will be forwarded to the examiner for consideration of claims 1-38 and 52-67, in light of Applicant's response filed February 25, 2002, following mailing of this decision.**

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

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

14 JAN 2003

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| In re Application of | : |
| FOLLESTAD et al. | : |
| Application No. 09/601,652 | : |
| PCT No.: PCT/NO99/00043 | : DECISION ON PETITION |
| Int. Filing Date: 09 February 1999 | : |
| Priority Date: 09 February 1998 | : |
| Attorney Docket No.: 09100.017 | : |
| For: METHOD FOR PREPARATION THEREOF | : |

This is a response to applicants' "Completion of Filing Requirements" filed 22 January 2001 which is being treated as Petition under 37 CFR 1.42 and "Petition to Reinstate Application" filed 27 November 2002, which is being treated as a Petition to Withdraw Holding of Abandonment under 37 CFR 1.181.

## BACKGROUND

On 09 February 1999, applicants filed international application no. PCT/NO99/00043 which claimed a priority date of 09 February 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 August 1999. A proper Demand was filed with for International Preliminary Examination prior to the 19th month from the earliest claimed priority date. Accordingly, the thirty-month time period for submitting the requisite basic national fee in the United States of America was extended to expire 30 months from the priority date, i.e. 09 August 2000.

On 04 August 2000, applicants filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. 371. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee of $840, a copy of the international application, and a preliminary amendment.

On 23 August 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge under 37 CFR 1.492(e). The notification set a one-month time limit in which to respond.

On 22 January 2001, applicants filed "Completion of Filing Requirements" which included a declaration and power of attorney executed by: Arild Follestad; Vidar Almquist; Harri Hokkanen and Marit Palmqvist on behalf of deceased inventor, Ulf Palmqvist.

On 27 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 23 August 2000 within the time period set therein.

On 27 November 2002, applicants filed "Petition to Reinstate Application."

## DISCUSSION

A. Petition to Withdraw Holding of Abandonment

A proper response to the Notice of Missing Requirements mailed 23 August 2000 was due by 23 September 2000. On 22 January 2001, applicants filed "Completion of Filing Requirements" which was accompanied by an executed declaration. A review of the application file reveals that the declaration originally filed 22 January 2001 is located therein, therefore, the Notification of Abandonment (PCT/DO/EO/909) dated 27 March 2001 was mailed in error.

Applicant's Deposit Account No. 50-0548 has been charged a four-month extension of time fee ($1390), as authorized.

B. Petition under 37 CFR 1.42.

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

> 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 the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by "all of the heirs" of the deceased inventor, where no legal representative has been appointed.

The declaration submitted on 22 January 2001 was executed by Marit Palmqvist for deceased inventor, Ulf Palmqvist. However, the declaration does not state that the relationship of Marit Palmqvist to the deceased inventor. Absent a statement that the signing heir is the sole heir or legal representative (executor) of the deceased inventor, the declaration cannot be accepted under 37 CFR 1.42.

In addition, it is noted that revised 37 CFR 1.497(b)(2) states the following:

> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall

also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the residence, citizenship, and post office address of the deceased inventor, the declaration must also provide this information (residence, citizenship, and post office address) for the signing heir. The declaration filed on 22 January 2001 provides the residence, citizenship, and post office address for only one individual and it is unclear whether this information is for the heir or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

## CONCLUSION

The petition to withdraw holding of abandonment under 37 CFR 1.181 is **GRANTED**, and the Notification of Abandonment (PCT/DO/EO/909) dated 01 August 2001 is hereby **VACATED**.

The request for status under 37 CFR 1.42 is REFUSED.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and 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
Office of PCT Legal Administration

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone 703-308-6314
Fax: 703-308-6459

22 MAY 2003
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#8

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

Karen Lee Orzechoski
Liniak, Barento, Longacre & White
6550 Rock Spring Drive, Ste. 240
Bethesda, Maryland 20817

In re Application of :
FOLLESTAD et al. :
Application No. 09/601,652 :
PCT No.: PCT/NO99/00043 : DECISION ON PETITION
Int. Filing Date: 09 February 1999 :
Priority Date: 09 February 1998 :
Attorney Docket No.: 09100.017 :
For: METHOD FOR PREPARATION :
THEREOF

This is a response to applicants' "Renewed Submission under 37 CFR 1.42" filed 13 May 2003.

## BACKGROUND

On 09 February 1999, applicants filed international application PCT/NO99/00043 which claimed a priority date of 09 February 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 12 August 1999. A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. Accordingly, the thirty-month time period for submitting the requisite basic national fee in the United States of America was extended to expire 30 months from the priority date, 09 August 2000.

On 04 August 2000, applicants filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. 371. Filed with the Transmittal Letter were, *inter alia*, the requisite basic national fee of $840, a copy of the international application, and a preliminary amendment.

On 23 August 2000, the United States Designated/Elected Office mailed a Notification of Missing Requirements (PCT/DO/EO/905) requiring submission of an oath or declaration in compliance with 37 CFR 1.497 and the surcharge under 37 CFR 1.492(e). The notification set a one-month time limit in which to respond.

On 22 January 2001, applicants filed "Completion of Filing Requirements" which included a declaration and power of attorney executed by: Arild Follestad; Vidar Almquist; Harri Hokkanen and Marit Palmqvist on behalf of deceased inventor, Ulf Palmqvist.

On 27 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/909) indicating that the

application was abandoned for failure to file a complete response to the Notification of Missing Requirements mailed 23 August 2000 within the time period set therein.

On 27 November 2002, applicants filed "Petition to Reinstate Application." In a decision dated 14 January 2003, applicants' petition to withdraw of holding of abandonment was granted. Applicants' request under 37 CFR 1.42 was dismissed without prejudice because the declaration was defective pursuant to 37 CFR 1.497.

On 13 May 2003, applicants filed the present renewed request under 37 CFR 1.42 and a petition for a two-month extension of time.

## DISCUSSION

Request under 37 CFR 1.42.

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

> 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 the patent.

The substitute declaration filed 13 May 2003 is executed by Marit Palmqvist as the "sole heir and legal representative" of the deceased inventor, Ulf Palmqvist. The declaration is acceptable under 37 CFR 1.42 and complies with 37 CFR 1.497(a)-(b). Accordingly, the requirements for entry into national stage under 35 U.S.C. 371(c) were completed as of 13 May 2003.

## CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

The application has an international filing date of 09 February 1999, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **13 May 2003**.

Deposit Account No. 50-0548 will be charged $400 for the two-month extension of time fee and a $130.00 surcharge fee under 37 CFR 1.492(e) for supplying an oath or declaration later than 30 months from the earliest claimed priority date.

The application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone 703-308-6314
Fax: 703-308-6459

05/27/2003 GFREY1 00000001 500548 09601652
01 FC:1617 130.00 CH
02 FC:1252 400.00 CH

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APR 8 2004

Paper No. 16

| | | |
|---|---|---|
| In re Application of | : | |
| Russell Gordon Speight | : | |
| Serial Number : 09/601,955 | : | WITHDRAWAL FROM ISSUE |
| Filed : November 13, 2000 | : | *37 CFR 1.313(b)* |
| For: AUTOMATED MOLDING | : | |
| TECHNOLOGY FOR THERMOPLASTIC | : | |
| INJECTION MOLDING | : | |

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue after payment of the issue fee due to unpatentability of one or more claims. *See* 37 CFR 1.313(b).

The application is being withdrawn to permit reopening of prosecution. The reasons therefore will be communicated to you by the examiner. The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. The request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to Michael Colaianni at 571-272-1196.

The application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Khaled Shami
Burns Doane Swecker & Mathis
PO Box 1404
Alexandria, VA 22313-1404

cc:Allowed Files, Pk3-910

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APR 8 2004

Paper No. 16

RECEIVED
APR 14 2004
TC 1700

In re Application of :
Russell Gordon Speight :
Serial Number : 09/601,955 :
Filed : November 13, 2000 :
For: AUTOMATED MOLDING :
TECHNOLOGY FOR THERMOPLASTIC :
INJECTION MOLDING :

WITHDRAWAL FROM ISSUE
*37 CFR 1.313(b)*

The purpose of this communication is to inform you that the above-identified application is being withdrawn from issue after payment of the issue fee due to unpatentability of one or more claims. *See* 37 CFR 1.313(b).

The application is being withdrawn to permit reopening of prosecution. The reasons therefore will be communicated to you by the examiner. The above-identified application is hereby withdrawn from issue.

The issue fee is refundable upon written request. If, however, the application is again found allowable, the issue fee can be applied toward payment of the issue fee in the amount identified on the new Notice of Allowance and Issue Fee Due upon written request. The request and any balance due must be received on or before the due date noted in the new Notice of Allowance in order to prevent abandonment of the application.

Telephone inquiries should be directed to Michael Colaianni at 571-272-1196.

The application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Khaled Shami
Burns Doane Swecker & Mathis
PO Box 1404
Alexandria, VA 22313-1404

cc:Allowed Files, Pk3-910

#13

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NOV 26 2003

**Henry E. Bartony, Jr., Esq.**
**Bartony & Hare, LLP**
**Law & Finance Building**
**Suite 1801**
**429 Forth Avenue**
**Pittsburgh, Pennsylvania 15219**

In re Application of
Dennis P. Curran et al
Serial No.: 09/602,105
Filed: June 22, 2000
Attorney Docket No.: 00-012

: Decision on Petition

This is in response to applicants' "Petition to Withdraw Erroneous Notice of Abandonment or in the Alternative Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b)" filed September 9, 2003.

On February 25, 2003, a Notice of Allowance was mailed to applicant. On July 9, 2003, a Notice of Abandonment was mailed for failure to timely pay the issue fee. On September 9, 2003, the present petition was filed. Applicants assert that a Request for Continued Examination (RCE) was timely filed on May 27, 2003. The petition was accompanied with copies of RCE, PTO/SB/08A & B, and Copies of listed references, Receipt Acknowledgement Postcard.

Applicant's statement and file history have been carefully reviewed. The evidence filed show that the Request for Continued Examination was timely filed. Accordingly, the petition is Granted.

The application has been returned to pending status and the RCA will be processed after mailing of this letter.

Should there be any questions with respect to this decision, please contact Cecilia sang, by mail addressed to: Director, Technology Center 1600, Alexandria, VA 22313-1450, or by telephone at (703) 308-0254 or by facsimile transmission at (703) 305-7230.

Cecilia Tsang for
Bruce Kisliuk
Director, Technology Center 1600

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Paper No. 11

**MERCHANT & GOULD**
**P.O. BOX 2903**
**MINNEAPOLIS, MN 55402-0903**

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OFFICE OF PETITIONS

In re Application of :
Kirk A. Glerum et al :
Application No. 09/602,252 : ON PETITION
Filed: June 23, 2000 :
Attorney Docket No. 50037.86US01/150526.1 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 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 December 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 March 13, 2003.

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 2122.

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

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P O BOX 51418
PALO ALTO CA 94303

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NOV 07 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Brunheroto et al. | : | DECISION ON PETITION |
| Application No. 09/602,278 | : | |
| Filed: 23 June, 2000 | : | |
| Atty Docket BC999047/1455P | : | |

This is a decision on the petition filed on 18 August, 2006, under 37 CFR 1.137(b), [1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 29 June, 2006, for failure to timely and properly reply to the Decision on Appeal mailed on 28 April, 2006, which affirmed the examiner's rejection, which set a two (2) month period for reply. Notice of Abandonment was mailed on 10 July, 2006.

Petitioner has filed a Request for Continued Examination (RCE) and an amendment as the required reply under 37 CFR 1.114.

---

[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)).

The application is being referred to Technology Center Art Unit 2623 for further processing.

Any inquiries concerning this decision may be directed to the undersigned at 571.272.3231.

/D Wood/
Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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IBM CORP.
c/o SAWYER LAW GROUP, P.C.
2465 E. Bayshore Road, Suite No. 406
PALO ALTO, CA 94303

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Jose R. Brunheroto | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7617509 | : RECALCULATION of PATENT |
| **Issue Date** | : 11/10/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/602,278 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/23/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1567** 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.

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HUFFMAN LAW GROUP, P.C.
1900 MESA AVE.
COLORADO SPRINGS, CO 80906

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**OFFICE OF PETITIONS**

In re Application of :
Mario Nemirovsky et al :
Application No. 09/602,279 : ON PETITION
Filed: June 23, 2000 :
Attorney Docket No. MIPS.0168-00-US

This is a decision on the petition, filed January 15, 2008 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 October 31, 2007 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 Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2182 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
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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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 200057

**MAILED**

MAR 10 2009

OFFICE OF PETITIONS

In re Application of :
Mario Nemirovsky, et al. :
Application No. 09/602,279 : DECISION DISMISSING PETITION
Filed: June 23, 2000 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 1778.3120000 (0168.00US) :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 9, 2009, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **DISMISSED AS MOOT**.

Unfortunately, the petition was not referred to the appropriate deciding official for decision until after the issuance of this application into a patent. However, petitioner's attention is directed to 37 CFR 1.313(d), which states:

> 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**. (Emphasis added)

In this case, the petition was not received in the Office of Petitions for consideration until March 9, 2009, the date upon which the above-identified application issued as U.S. Patent No. 7,502,876. Since the case has now issued, the petition to withdraw from issue cannot be granted.

The request for continued examination (RCE) filed concurrently with the petition is improper in view of the issuance of this application into a patent and will not be processed. Accordingly, the $810 filing fee and the $130 petition fee submitted are unnecessary and will be refunded in due course.

The Information Disclosure Statement has been made of record in the file of the above-identified application without further consideration. *See* 37 CFR 1.97(i).

Telephone inquiries should be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | |
|---|---|
| In re application of: | Confirmation No. 9147 |
| NEMIROVSKY *et al.* | Art Unit: 2182 |
| Appl. No. 09/602,279 | Examiner: Peyton, Tammara R. |
| Filed: June 23, 2000 | Atty. Docket: 1778.3120000 (0168.00US) |
| For: **Background Memory Manager That Determines If Data Structures Fit in Memory With Memory State Transactions Map** | |

## Petition to Withdraw From Issue Under 37 C.F.R. § 1.313(c)(2) for Consideration of a Request for Continued Examination

**Mail Stop Issue Fee**

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Madam:

It is hereby petitioned under 37 C.F.R. § 1.313(c)(2) that the above-captioned application be withdrawn from issue for consideration of the accompanying request for continued examination in compliance with 37 C.F.R. § 1.114.

It is believed that no extensions of time are necessary, other than those that are otherwise provided for herewith. However, if extensions of time under 37 C.F.R. § 1.136 other than those provided herewith are required to prevent abandonment of the above-captioned application, then such extensions of time are hereby petitioned.

Adjustment date: 03/12/2009 CKHLOK
03/10/2009 INTEFSW 00002516 09602279
01 FC:1464 -130.00 OP
02 FC:1801 -810.00 OP

Refund Ref:
03/12/2009 0030067626

Credit Card Refund Total: $940.00

Am Exp..: XXXXXXXXXXX1005

This petition is accompanied by our Online Credit Card Payment Authorization in the amount of $130.00 in payment of the required fee (37 C.F.R. § 1.17(h)). The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

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

Timothy A. Doyle
Attorney for Applicants
Registration No. 51,262

Date 9 MAR 09

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

PTO/SB/30 (12-08)
Approved for use through 01/31/2009. OMB 0651-0031
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 contains a valid OMB control number.

# Request for Continued Examination (RCE) Transmittal

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

| | |
|---|---|
| Application Number | 09/602,279 |
| Filing Date | June 23, 2000 |
| First Named Inventor | Mario NEMIROVSKY |
| Art Unit | 2182 |
| Examiner Name | Peyton, Tammara R. |
| Attorney Docket Number | 1778.3120000 (0168.00US) |

**This is a Request for Continued Examination (RCE) under 37 CFR 1.114 of the above-identified application.**
Request for Continued Examination (RCE) practice under 37 CFR 1.114 does not apply to any utility or plant application filed prior to June 8, 1995, or to any design application. See Instruction Sheet for RCEs (not to be submitted to the USPTO) on page 2.

1. Submission required under 37 CFR 1.114 Note: If the RCE is proper, any previously filed unentered amendments and amendments enclosed with the RCE will be entered in the order in which they were filed unless applicant instructs otherwise. If applicant does not wish to have any previously filed unentered amendment(s) entered, applicant must request non-entry of such amendment(s).

   a. ☐ Previously submitted. If a final Office action is outstanding, any amendments filed after the final Office action may be considered as a submission even if this box is not checked.

      i. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed on _____

      ii. ☐ Other _____

   b. ☒ Enclosed

      i. ☒ Amendment/Reply

      ii. ☐ Affidavit(s)/ Declaration(s)

      iii. ☒ Information Disclosure Statement (IDS)

      iv. ☒ Other Petition to Withdraw from Issue

2. Miscellaneous

   a. ☐ Suspension of action on the above-identified application is requested under 37 CFR 1.103(c) for a period of _____ months. (Period of suspension shall not exceed 3 months; Fee under 37 CFR 1.17(i) required)

   b. ☐ Other _____

3. Fees The RCE fee under 37 CFR 1.17(e) is required by 37 CFR 1.114 when the RCE is filed.

   a. ☒ The Director is hereby authorized to charge the following fees, any underpayment of fees, or credit any overpayments, to Deposit Account No. 19-0036.

      i. ☒ RCE fee required under 37 CFR 1.17(e)

      ii. ☐ Extension of time fee (37 CFR 1.136 and 1.17)

      iii. ☐ Other _____

   b. ☐ Check in the amount of $ _____ enclosed

   c. ☒ Payment by credit card (XXXXXXXXXXXXXXXX)

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

***SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED***

| | | | |
|---|---|---|---|
| Signature | /Timothy A. Doyle/ | Date | March 9, 2009 |
| Name (Print/Type) | Timothy A. Doyle | Registration No. | 51,262 |

***CERTIFICATE OF MAILING OR TRANSMISSION***

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop RCE, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450 or facsimile transmitted to the U.S. Patent and Trademark Office on the date shown below.

| | | | |
|---|---|---|---|
| Signature | | | |
| Name (Print/Type) | | Date | |

This collection of information is required by 37 CFR 1.114. 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 12 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 FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop RCE, 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 & TRADEMARK OFFICE
Washington, D.C. 20231

# REQUEST FOR PATENT FEE REFUND

1 Date of Request: 3/10/09

2 Serial/Patent # 09/602219

| 3 Please refund the following fee(s): | | 4 PAPER NUMBER | 5 DATE FILED | 6 AMOUNT |
|---|---|---|---|---|
| X | Filing RCE | wfee | 3/9/09 | $ 810 |
| | Amendment | | | $ |
| | Extension of Time | | | $ |
| | Notice of Appeal/Appeal | | | $ |
| X | Petition | wfee | 3/9/09 | $ 130 |
| | Issue | | | $ |
| | Cert of Correction/Terminal Disc. | | | $ |
| | Maintenance | | | $ |
| | Assignment | | | $ |
| | Other | | | $ |

7 TOTAL AMOUNT OF REFUND $ 940

8 TO BE REFUNDED BY: Credit card

10 REASON:

| | |
|---|---|
| | Overpayment |
| | Duplicate Payment |
| X | No Fee Due (Explanation): |

Application issued.

Treasury Check

Credit Deposit A/C #:

9 [ ][ ]--[ ][ ][ ][ ]

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Sherry D. Brinkley TITLE: Petitions Examiner

SIGNATURE: Sherry D. Brinkley PHONE: 2-3204

OFFICE: Petitions

**********

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APPROVED: CKelly DATE: 3/12/09

*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:*

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**Refund Branch**
**Crystal Park One, Room 802B**

FORM PTO 1577
(01/90)

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United States Patent and Trademark Office
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CHICAGO IL 60610

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APR 2 0 2006
OFFICE OF PETITIONS

| | |
|---|---|
| In re | : DECISION ON APPLICATION |
| Peder J. Jungck | : FOR PATENT TERM ADJUSTMENT |
| Application No. 09/602,286 | : AND |
| Filed: June 23, 2000 | : NOTICE OF INTENT TO ISSUE |
| Patent No. 7,003,555 | : CERTIFICATE OF CORRECTION |
| Issued: February 21, 2006 | : |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. 1.705(d)", filed February 22, 2006. Patentee requests that the determination of patent term adjustment under 35 U.S.C. 154(b) be corrected and reviewed for accuracy.

The application for patent term adjustment is **GRANTED**.

The Patent Term Adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **seven hundred eight (708) days**.

On November 14, 2005, applicant submitted an application for patent term adjustment pursuant to his duty of candor and good faith, alerting the Office to an error in applicants' favor with respect to the number of days of patent term adjustment. The "candor letter" was not acted upon, and on February 21, 2006 the application issued into patent No. 7,003,555 with a patent term adjustment of six hundred fifty (650) days.

The Office determined a patent term adjustment of six hundred fifty (650) days based on an adjustment for PTO delay of seven hundred twenty-two (722) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), and thirty-eight (38) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. 1.703(a)(2), reduced by Applicant's

delay of one hundred (100) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8) and ten (10) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. 1.704(b). The adjustment of 100 days is at issue.

Patentee points out that he was improperly assessed applicant delay of one hundred (100) days for filing the application for patent term adjustment on November 14, 2005.

Pursuant to 37 C.F.R. § 1.704(e), the submission of an application for patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution of the application.

Furthermore, as pointed out by patentee, he should have been assessed additional delay. A review of the file reveals that patentee filed an RCE on July 6, 2005. On August 17, 2005, patentee filed an IDS. Accordingly, pursuant to 37 C.F.R. §1.704(c)(8), patentee should have been assessed applicant delay of forty-two (42) days for the filing of this supplemental reply.

In view thereof, the correct determination of patent term adjustment at the time of issuance of the patent is **seven hundred eight (708) days** (760 (722+38) days of PTO delay, reduced by 52 (42+10) days of applicant delay).

Given the basis for granting this petition, the $200.00 fee set forth in 37 C.F.R. §1.18(e) was not required, and has not been charged.

The application file is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction, indicating a Patent Term Adjustment **seven hundred (708) days.**

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,003,555 B1

DATED : February 21, 2006

INVENTOR(S) : Peder J. Jungck

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,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (650) days

Delete the phrase "by 650 days" and insert – by 708 days—

Day : Wednesday

PALM INTRANET

Date: 4/19/2006
Time: 11:31:58

| PTA Calculations for Application: 09/602286 | | | |
|---|---|---|---|
| Application Filing Date: | 06/23/2000 | PTO Delay (PTO): | 760 |
| Issue Date of Patent: | 02/21/2006 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 110 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 708 |
| PTO Delay Adjustment: | 58 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 81 | 04/19/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | 58 | | |
| 77.5 | 02/01/2006 | PTA 36 MONTHS | | | |
| 77 | 02/21/2006 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 76 | 01/24/2006 | EXPORT TO FINAL DATA CAPTURE | | | |
| 75 | 01/21/2006 | DISPATCH TO FDC | | | |
| 74 | 01/21/2006 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 72 | 11/14/2005 | MISCELLANEOUS INCOMING LETTER | | 100 | |
| 71 | 12/27/2005 | TC RETURN TO PUBS | | | |
| 70 | 12/15/2005 | FINISHED INITIAL DATA CAPTURE | | | |
| 69 | 11/23/2005 | PUBS CASE REMAND TO TC | | | |
| 68 | 11/14/2005 | ISSUE FEE PAYMENT VERIFIED | | | |
| 67 | 11/14/2005 | ISSUE FEE PAYMENT RECEIVED | | | |
| 66 | 11/09/2005 | MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT | | | |
| 65 | 11/08/2005 | MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT | | | |
| 64 | 10/17/2005 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 63 | 10/06/2005 | MAIL NOTICE OF ALLOWANCE | | | |
| 62 | 10/04/2005 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 61 | 10/04/2005 | ISSUE REVISION COMPLETED | | | |
| 60 | 09/29/2003 | REFERENCE CAPTURE ON IDS | | | |
| 59 | 09/16/2005 | NOTICE OF ALLOWABILITY | | | |
| 58 | 08/17/2005 | REFERENCE CAPTURE ON IDS | | | |
| 57 | 08/17/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 56 | 07/14/2005 | DATE FORWARDED TO EXAMINER | | | |
| 55 | 07/06/2005 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 54 | 07/14/2005 | DATE FORWARDED TO EXAMINER | | | |
| 53 | 07/06/2005 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 52 | 07/14/2005 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 51 | 07/06/2005 | REFERENCE CAPTURE ON IDS | | | |
| 50 | 07/06/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 49 | 07/06/2005 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 48 | 04/06/2005 | MAIL FINAL REJECTION (PTOL - 326) | 38 | | 44 |
| 47 | 04/04/2005 | FINAL REJECTION | | | |
| 46 | 02/01/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 45 | 02/01/2005 | DATE FORWARDED TO EXAMINER | | | |
| 44 | 10/27/2004 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 43 | 10/27/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 42 | 07/30/2004 | MAIL NON-FINAL REJECTION | | | |
| 41 | 07/26/2004 | NON-FINAL REJECTION | | | |
| 40 | 06/04/2004 | DATE FORWARDED TO EXAMINER | | | |
| 39 | 05/21/2004 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 38 | 06/04/2004 | DATE FORWARDED TO EXAMINER | | | |
| 37 | 05/21/2004 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 10 | 26 |
| 36 | 06/04/2004 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 35 | 05/21/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 34 | 05/21/2004 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 33 | 05/06/2004 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 32 | 05/06/2004 | ADVISORY ACTION (PTOL-303) | | | |
| 31 | 05/01/2004 | DATE FORWARDED TO EXAMINER | | | |
| 30 | 04/09/2004 | AMENDMENT AFTER FINAL REJECTION | | | |
| 29 | 04/09/2004 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 28 | 04/08/2004 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 27 | 04/07/2004 | EXAMINER INTERVIEW SUMMARY RECORD | | | |

| | | | | | |
|---|---|---|---|---|---|
| | | (PTOL - 413) | | | |
| 26 | 02/11/2004 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 25 | 02/06/2004 | FINAL REJECTION | | | |
| 24 | 10/03/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 23 | 12/01/2003 | DATE FORWARDED TO EXAMINER | | | |
| 22 | 11/12/2003 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 21 | 09/29/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 20 | 08/15/2003 | MAIL NON-FINAL REJECTION | 722 | | -1 |
| 19 | 08/11/2003 | NON-FINAL REJECTION | | | |
| 18 | 07/21/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 17 | 05/06/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 16 | 03/26/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 15 | 09/25/2000 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 14 | 11/30/2000 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 13 | 05/02/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 12 | 04/02/2001 | APPLICATION DISPATCHED FROM OIPE | | | |
| 11 | 03/29/2001 | APPLICATION IS NOW COMPLETE | | | |
| 10 | 03/29/2001 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 9 | 03/19/2001 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 8 | 03/19/2001 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 7 | 03/19/2001 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 6 | 09/28/2000 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 5 | 08/16/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 4 | 08/16/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 3 | 08/16/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 2 | 07/17/2000 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 06/23/2000 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Washington, D.C. 20231
www.uspto.gov

**Paper No. 9**

**Fulbright & Jaworski**
**666 Fifth Avenue**
**New York, NY 10103-3198**

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OCT 1 6 2002

OFFICE OF PETITIONS

**In re Application of** :
**Jager et al.** :
**Application No. 09/602,362** : **ON PETITION**
**Filed: June 22, 2000** :
**Attorney Docket No. LUD 5615.1 CIP** :

**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 file a complete reply to the Notice to File Missing Parts of Application (Notice) mailed August 24, 2000, which set a period for reply 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, the above-identified application became abandoned on October 25, 2000.**

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

**The application file is being forwarded to the Office of Initial Patent Examination for further processing.**

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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SOFER & HAROUN, L.L.P
317 MADISON AVENUE
SUITE 910
NEW YORK, NY 10017

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JUN 26 2007

OFFICE OF PETITIONS

In re Application of Urano et al. :
Application No. 09/602,409 : Decision on Petition
Filing Date: June 23, 2000 :
Attorney Docket No. 773-008 :

This is a decision on the petition filed August 21, 2003, under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application. The Office regrets the delay in the issuance of the instant decision.

The petition is **dismissed.**

Facts:

The original address of record was:

> Sofer & Haroun, LLP
> Suite 1921
> 342 Madison Avenue
> New York, NY 10173

A Notice of Allowance and Notice of Allowability were properly mailed to the original address or record on March 14, 2003.

A "Change of Address" was filed May 21, 2003. The paper stated,

> Applicants wish to notify the Examiner that as of March 4, 2002 all communications directed to the Applicants should be mailed to:
>
> > SOFER & HAROUN, L.L.P
> > 317 Madison Avenue
> > Suite 910
> > New York, NY 10017
> > Phone (212) 697-2800
> > Facsimile (212) 697-3004

The Office updated the address of record.

The issue fee was due on or before Monday, June 16, 2003. The Office did not receive the issue fee. As a result, the application became abandoned as of midnight on June 16, 2003.

The Office mailed a Notice of Abandonment to the new address of record on July 24, 2003.

Petitioner received the Notice of Abandonment.

The instant petition was filed August 21, 2003, and requests withdrawal of the holding of abandonment based on non-receipt of the Notice of Allowance.

Discussion:

Petitioner's failure to timely change the address of record precludes the Office from granting the relief requested.

The change of address filed May 21, 2003, indicated the new address had been in use since March 4, 2002. However, petitioner did not request the address of record be changed prior to the mailing of the Notice of Allowance on March 14, 2003.

Petitioner has not shown the Notice of Allowance would not have been received if petitioner had filed a request to change the address or record prior to the mailing of the Notice of Allowance. In other words, the failure to receive the Notice of Allowance appears to be the result of a failure to keep the Office informed of a current mailing address rather than error by the USPTO or USPS.

For the reasons above, the holding of abandonment will not be withdrawn.

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by the required reply (the issue fee and issue fee transmittal form), the required petition fee ($1,500 for a large entity), 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 pursuant to 37 CFR 1.137(b) was unintentional. A copy of a blank petition form is enclosed for petitioner's convenience.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted.

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
Attn: Office of Petitions

By hand: U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

Attachments: Form PTO/SB/64
Privacy Act Statement
Copy of papers originally mailed March 14, 2003

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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317 MADISON AVENUE
SUITE 910
NEW YORK, NY 10017

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OCT 21 2009

**OFFICE OF PETITIONS**

In re Application of Urano et al. :
Application No. 09/602,409 : Decision on Petition
Filing Date: June 23, 2000 :
Attorney Docket No. 773-008 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 2, 2009, and supplemented October 15, 2009, to revive the above-identified application.

The petition is **granted**.

Facts

A Notice of Allowance and Notice of Allowability were mailed March 14, 2003. The Notice of Allowance required payment of the issue fee and set a statutory period for reply of three (3) months. The Office did not receive the issue fee. As a result, the application became abandoned as of midnight on June 16, 2003. The Office mailed a Notice of Abandonment to the new address of record on July 24, 2003.

Petitioner filed a petition under 37 CFR 1.181 to withdraw the holding of abandonment on August 21, 2003, based on non-receipt of the Notice of Allowance.

A decision dismissing the petition was mailed June 26, 2007. Petitioner states the decision on petition was never received.

The instant petition requests revival of the application pursuant to 37 CFR 1.137(b).

Discussion

A grantable petition under 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,
(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.

Petitioner has submitted a reply to the Notice of Allowance in the form of payment of the issue fee and petitioner has submitted the required petition fee.

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." To the extent any statement of delay in the petition varies from this exact language, the statement will be construed as the equivalent of the statement above. If the entire delay from the date of abandonment, until the date the petition was filed, was not unintentional, petitioner must notify the Office.

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 petition was accompanied by a payment of $300 for the publication fee. However, a publication fee is unnecessary because the application was filed June 23, 2000. Therefore, the Office has scheduled a refund of the $300.

Technology Center Art Unit 2171 will be informed of the instant decision in order to permit the examiner to review the Information Disclosure Statement filed April 2, 2009. After the examiner reviews the matter, the examiner will refer the instant case to the Office of Data Management, Patent Publication Branch.

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

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. 8

Francis I. Gray
Tekronix Inc.
MS 50 LAW
P.O. Box 500
Beaverton, OR 97077

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JUL 2 4 2002

OFFICE OF PETITIONS

In re Application of :
Marek Musial :
Application No. 09/602,418 : ON PETITION
Filed: June 23, 2000 :
Attorney Docket No. 6963 US :

This is a decision on the petition under 37 CFR 1.137(b), filed May 28, 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 To File Missing Parts Of Non-Provisional Application mailed September 20, 2000. The Notice set a period for reply 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, the above-identified application became abandoned on November 21, 2000.

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 extension of time submitted with the petition on May 28, 2002 was subsequent to the maximum extendable period for reply, no extension of time is necessary.

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 Office of Initial Patent Examination for further processing.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry Brinkley
Petitions Examiner

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of: | : | DECISION ON REQUEST |
| Ellingsen et al. | : | FOR REVIEW OF |
| Patent No. 7,048,870 | : | PATENT TERM ADJUSTMENT |
| Application No. 09/602528 | : | and |
| Filing or 371(c) Date: 06/23/2000 | : | NOTICE OF INTENT TO ISSUE |
| Atty Docket No. 06275-199001 | : | CERTIFICATE OF CORRECTION |

This letter is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT," filed July 28, 2006. Pursuant to patentee's duty of good faith and candor to the Office, patentee requests confirmation of the issuance of a patent term adjustment of 322 days.

The request for review of the determination of patent term adjustment (PTA) is **granted**.

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 **zero (0) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 23, 2006, the above-identified application matured into U.S. Patent No. 7,048,870, with a revised patent term adjustment of 322 days. On July 28, 2006, patentee submitted the instant comment. Patentee states no basis for the request for review of the patent term adjustment.

Nonetheless, a review of the application history confirms that an incorrect number of days were determined for Applicant and PTO delay.

Applicant delay

A review of the application history reveals that Applicant should have been assessed an additional delay of ninety-six (96) days pursuant to 37 C.F.R. § 1.704(b). 37 CFR 1.704(b) provides, in pertinent part, that:

> With respect to the grounds for adjustment set forth in §§ 1.702(a) through (e), and in particular the ground of adjustment set forth in § 1.702(b), an applicant shall be deemed to have failed to engage in reasonable efforts to conclude

> processing or examination of an application for the cumulative total of any periods of time in excess of three months that are taken to reply to any notice or action by the Office making any rejection, objection, argument, or other request, measuring such three-month period from the date the notice or action was mailed or given to the applicant, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the day after the date that is three months after the date of mailing or transmission of the Office communication notifying the applicant of the rejection, objection, argument, or other request and ending on the date the reply was filed. The period, or shortened statutory period, for reply that is set in the Office action or notice has no effect on the three-month period set forth in this paragraph.

In this instance, the Office mailed a non-final Office action on October 9, 2002. Applicant filed an Amendment in response to the Office action on April 14, 2003. Pursuant to 37 CFR § 1.704(b), the patent term adjustment should have been reduced by ninety-five (95) days for applicant delay, from the date in excess of three months to reply to the Office action, January 10, 2003, to April 14, 2003, in filing a proper reply to the non-final Office action.

A further review of the application history reveals that Applicant should have been assessed an additional delay of three-hundred and one (301) days pursuant to 37 C.F.R. § 1.704(c)(7). 37 CFR 1.704(c) provides, in pertinent part, that:

> Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
>
> > (7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

In this instance, Applicant filed a Request for Continued Examination ("RCE") and Amendment on August 25, 2003. However, the Amendment was non-compliant. Applicant was notified in a Notice of Non-Compliant Amendment mailed May 20, 2004. Applicant filed a supplemental reply in the form of an Amendment in response to the Notice of Non-Compliant Amendment, on June 21, 2006. Pursuant to 37 CFR § 1.704(c)(7) the patent term adjustment should have been reduced by three-hundred one (301) days for applicant delay, from August 25, 2003, to June 21, 2004, in filing a proper reply to the final rejection.

PTO delay

A further review of the application history confirms that an incorrect number of days were determined for PTO delay. The entry of a period of adjustment of 222 days was entered in error. Specifically, a period of adjustment of 222 days was entered for Office delay in taking action in response to applicant's Request for Continued Examination ("RCE") and Amendment filed August 25, 2003. However, and as noted supra, the Office mailed a Notice of Non-Compliant Amendment on May 20, 2004. The mailing of the Notice of Non-Compliant Amendment was a response to a reply under 35 U.S.C. § 132. Pursuant to 37 CFR § 1.704(a)(2), the patent term adjustment should have been adjusted by one-hundred forty-seven (147) days for PTO delay, from August 25, 2003, to May 20, 2004, the date of the mailing of the Notice of Non-Compliant Amendment.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **zero (0) days** (488 days of PTO delay, reduced by 637 days of applicant delay), subject to any terminal disclaimer.

As this letter was submitted as an advisement to the Office of an error in Patentees' favor, the Office will not assess the $200.00 application fee under 37 CFR 1.705(b). The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **ZERO (0)** days.

Telephone inquiries specific to this matter should be directed to Attorney Derek L. Woods, at (571) 272-3232.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 7,048,870 B1

DATED : May 23, 2006

INVENTOR(S) : Ellingsen et al.

DRAFT

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,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (322) days

Delete the phrase "by 322 days" and insert – by 0 days--

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20100222

**DATE** : February 23, 2010

**TO SPE OF** : ART UNIT 2164

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,654,757

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:** /Charles Rones/ **Art Unit** 2164

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. 22

**ERIC B. MEYERTONS**
**CONLEY ROSE & TAYON PC**
**P O BOX 398**
**AUSTIN, TX 78767-0398**

COPY MAILED

APR 15 2004

OFFICE OF PETITIONS

In re Application of
Allen B. Childress
Application No. 09/602,691
Filed: June 23, 2000
Attorney Docket No. 5053-35800

: DECISION GRANTING PETITION
: UNDER 37 CFR 313(c)(2)

This is a decision on the petition, filed April 12, 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 October 31, 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) 305-8680.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2174 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
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 23

Eric B Meyertons
Conley Rose & Tayon PC
P O Box 398
Austin TX 78767-0398

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**DEC 0 8 2004**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application | : | |
| Allen Childress | : | |
| Application No. 09/602,691 | : | DECISION ON APPLICATION |
| Filed: June 23, 2000 | : | FOR PATENT TERM ADJUSTMENT |
| Atty Docket No. 5053-35800 | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND, APPLICATION FOR PATENT TERM ADJUSTMENT," filed October 31, 2003. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from five hundred twenty-six (526) days to five hundred seventy-nine (579) days.

The application for patent term adjustment is **GRANTED**.

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 seventy-nine **(579)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 25, 2003, 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 526 days. On October 31, 2003, applicant timely[1] submitted an application for patent term adjustment (with required fee). In effect, applicant disputes the reduction of 53 days attributed to applicant for failing to respond within three months to the Notice to File Missing Parts of Application mailed October 2, 2000.

Applicant specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The reduction of 53 days has been found to be incorrect. A review of the application file reveals that applicant's response

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[1] PALM records indicate that the Issue Fee was also received in the Office on October 31, 2003. It is noted that payment of the Issue Fee was timely. During the statutory period for reply to the notice of allowance, on June 12, 2003, applicant filed a request for continued examination. A new notice of allowance was mailed on July 28, 2003.

to the Notice to File Missing Parts of Application mailed October 2, 2000, is of record in the application with a date of receipt by the Office of November 24, 2000. Furthermore, the response included a complete reply to the Notice. Thus, the Office should not have assessed applicant a delay of fifty-three (53) days. The response was filed within the three-month period under 37 CFR 1.704(b) and accordingly, applicant's delay should have been assessed as zero (0) days. Applicant did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance on March 25, 2003 is five hundred seventy-nine (579) days.

It is noted that subsequent to the mailing of this notice of allowance, applicant filed several Information Disclosure Statements, as well as, Requests for Continued Examination (RCE) on June 9, 2003 and April 12, 2004. The revised determination of patent term adjustment indicated in any patent issued will include additional periods of reduction based on these additional filings.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Pursuant to the decision granting petition under 37 CFR 313(c)(2), the application is being forwarded to Technology Center AU 2174 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

/Karin Ferriter/
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen

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

**BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP**
**12400 WILSHIRE BOULEVARD**
**SEVENTH FLOOR**
**LOS ANGELES, CA 90025-1026**

**COPY MAILED**

JAN 19 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Laracey et al. | : | DECISION ON PETITION |
| Application No. 09/602,697 | : | TO WITHDRAW |
| Filed: June 24, 2000 | : | FROM RECORD |
| Attorney Docket No. OIC0055US | : | |

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 15, 2006.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to the attorneys associated with Customer Number 08791 has been revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Liana Walsh
Petitions Examiner
Office of Petitions

cc:

CSA LLP
4807 SPICEWOOD SPRINGS RD.
BLDG. 4, SUITE 201
AUSTIN TX 78759

UNITED STATES PATENT AND TRADEMARK OFFICE

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CAMPBELL STEPHENSON LLP
11401 CENTURY OAKS TERRACE
BLDG. H, SUITE 250
AUSTIN TX 78758

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AUG 2 8 2008

**OFFICE OF PETITIONS**

In re Application of :
Kevin E. Laracey et al. :
Application No. 09/602,697 : ON PETITION
Filed: June 24, 2000 :
Attorney Docket No.: **OIC0055US** :

This is a decision on the petition filed June 2, 2008 under 37 CFR 1.181 to withdraw the holding of abandonment for the above-identified application.

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. 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," or, as explained in more detail below, "...under 37 CFR 1.137(a)" or (b). This is not a final agency decision.

Petitioner asserts that the Restriction Requirement mailed October 18, 2007 and which set the longer of one month or thirty days as the period for reply, should not have been sent by virtue of an election made to a prior requirement and by virtue of a prior filed amendment which cancelled the claims cited in the Restriction Requirement mailed October 18, 2007.

No response to the October 18, 2007 Restriction Requirement having been timely filed, the application became abandoned November 20, 2007. Accordingly, a Notice of Abandonment was mailed May 1, 2008.

Unfortunately however, the requirement for responding to communications mailed from the USPTO must be in writing as is required by 37 CFR 1.2. Petitioners are advised that in the absence of the Restriction Requirement being withdrawn by the USPTO, then by law a response was required. The failure to file a response causes the application to become abandoned, even if the communication mailed from the USPTO was sent in error.

According to the Examiner of Record, there is no evidence that the applicants filed a written response or query as is required by 37 CFR 1.2. Therefore, applicants are not

afforded an opportunity then to withhold a response based on a perceived error on the part of the USPTO. If applicants perceived an error with the Restriction Requirement, petitioners had an affirmative obligation to file a response that no such Election or response should have been required.

In view thereof, the holding of abandonment will not be withdrawn.

**ALTERNATIVE VENUES**

Petitioner may wish to consider filing a renewed petition under 37 CFR 1.137(a)[1] or 37 CFR 1.137(b),[2] which now provides 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).

The filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should 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

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[1]A grantable petition 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 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 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.

(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 as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

[2]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)).

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 FAX: (571) 273-8300

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

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

CAMPBELL STEPHENSON LLP
11401 CENTURY OAKS TERRACE
BLDG. H, SUITE 250
AUSTIN TX 78758

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OCT 21 2008

OFFICE OF PETITIONS

In re Application of :
Kevin E. Laracey et al. :
Application No. 09/602,697 : ON PETITION
Filed: June 24, 2000 :
Attorney Docket No.: **OIC0055US** :

This is a decision on the petition filed September 17, 2008, under 37 CFR 1.137(b)[1], to revive the above-identified application.

The petition is **GRANTED**.

A Restriction Requirement mailed October 18, 2007 set the longer of one month or thirty days as the period for reply. No response to the October 18, 2007 Restriction Requirement having been timely filed, the application became abandoned November 20, 2007. Accordingly, a Notice of Abandonment was mailed May 1, 2008.

The petition fee in the amount of $1540.00 has been applied to the finance records for the instant patent application.

The response to the Restriction Requirement filed September 17, 2008 will be referred to Technology Center 3693 for further 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

---

[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 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 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)).

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

James David Jacobs, Esq.
BAKER & MCKENZIE
805 Third Avenue
New York, NY 10022

MAILED

JUN 1 4 2002

Technology Center 2100

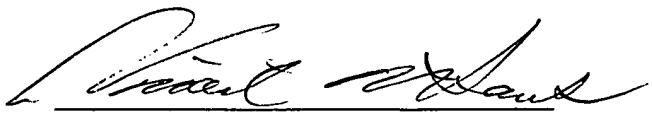
In re Application of )
Richard A. ROSS )
Application No. 09/602,713 ) **DECISION ON REQUEST FOR**
Filed: June 26, 2000 ) **WITHDRAWAL AS ATTORNEY**
For: SYSTEM AND METHOD FOR )
COMPRESSING SOFTWARE CODE )

This is a decision on the Request To Withdraw from Representation filed April 12, 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 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.



Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and
Electronic Commerce
(703) 305-9750

cc: Hewlett-Packard Company
Legal Department
Mail Stop 79,
3404 E. Harmony Road
Fort Collins, CO 80528-9599

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : November 27, 2007

**TO SPE OF** : ART UNIT 1652

**SUBJECT** : Request for Certificate of Correction for Appl. No. 09/602740 patent no. 7270984

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:** _____

_____

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_____

_____

_____ **SPE**

1652 **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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www.uspto.gov

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

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SEP 13 2004

OFFICE OF PETITIONS

In re Application of :
Neil R. Cashman, et al. :
Application No. 09/602,775 : ON PETITION
Filed: June 23, 2000 :
Attorney Docket No. 50111/002002 :

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 (703) 306-5594.

The application matter is being referred to Technology Center 1600, Art Unit 1648.

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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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NOV 22 2006

OFFICE OF PETITIONS

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON, MA 02110

In re Patent No. 7,041,807 :
Issued: May 9, 2006 : DECISION ON APPLICATION FOR
Application No. 09/602,775 : PTA and NOTICE OF INTENT
Filed: June 23, 2000 : TO ISSUE CERTIFICATE OF
Atty. Dkt. No.: 50111/002002 : CORRECTION

This decision is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed July 13, 2006 (certificate of mailing date of July 10, 2006).

The request for reconsideration of patent term adjustment (PTA) is **GRANTED**.

The above-identified application matured into U.S. Patent No. 7,041,807 on May 9, 2006. The instant request for reconsideration was timely filed July 13, 2006 in accordance with 37 CFR 1.705(d). The patent issued with a PTA of 342 days. Patentees argue that the adjustment accorded the patent was improperly reduced 62 days in connection with the "Reply to Notice of Allowance" filed March 9, 2006.

A review of the application history reveals that the adjustment was improperly reduced 62 days, as argued by patentees, in connection with the "Reply to Notice of Allowance" filed March 9, 2006. The Office has found that papers related to comments on the examiner's statement of reasons for allowance do not constitute failures to engage in reasonable efforts to conclude prosecution. *See*, MPEP 2732. *See, also*, 1247 Off. Gaz. Pat. Off. 111 (June 26, 2001).

In view thereof, at the time of issuance, the patent was entitled to an adjustment of 404 days, as argued by patentees.

This application file will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 404 days.

Receipt is hereby acknowledged of the required application fee of $200.00.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery A. Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

CC: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

| | | |
|---|---|---|
| PATENT | : | 7,041, 807 B1 |
| DATED | : | May 9, 2006 |
| INVENTOR(S) | : | Cashman, 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,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 342 days

Delete the phrase "by 342 days" and insert – by 404 days--

Day : Tuesday
Date: 11/21/2006

PALM INTRANET

Time: 15:19:39

| PTA Calculations for Application: 09/602775 | | | |
|---|---|---|---|
| Application Filing Date: | 06/23/2000 | PTO Delay (PTO): | 778 |
| Issue Date of Patent: | 05/09/2006 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 436 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 404 |
| PTO Delay Adjustment: | 62 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 84 | 11/21/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | 62 | | |
| 79.5 | 04/19/2006 | PTA 36 MONTHS | 108 | | |
| 79 | 05/09/2006 | PATENT ISSUE DATE USED IN PTA CALCULATION | | | |
| 78 | 03/21/2006 | EXPORT TO FINAL DATA CAPTURE | | | |
| 77 | 03/20/2006 | DISPATCH TO FDC | | | |
| 76 | 03/09/2006 | MISCELLANEOUS INCOMING LETTER | | 62 | |
| 75 | 03/16/2006 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 74 | 03/09/2006 | ISSUE FEE PAYMENT VERIFIED | | 2 | 67 |
| 73 | 03/07/2006 | FINISHED INITIAL DATA CAPTURE | | | |
| 72 | 03/09/2006 | ISSUE FEE PAYMENT RECEIVED | | | |
| 71 | 03/01/2006 | MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT | | | |
| 70 | 02/27/2006 | MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT | | | |
| 69 | 12/22/2005 | SEQUENCE FORWARDED TO PUBS ON TAPE | | | |
| 68 | 12/12/2005 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 67 | 12/07/2005 | MAIL NOTICE OF ALLOWANCE | 166 | | 58 |
| 66 | 12/01/2005 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 65 | 11/14/2005 | NOTICE OF ALLOWABILITY | | | |
| 64 | 02/24/2005 | INFORMATION DISCLOSURE STATEMENT CONSIDERED | | | |
| 63 | 09/22/2005 | REQUEST FOR REFUND | | | |
| 62 | 02/24/2005 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 61 | 02/24/2005 | REFERENCE CAPTURE ON IDS | | | |

| | | | | | |
|---|---|---|---|---|---|
| 60 | 02/24/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 59 | 10/14/2005 | DATE FORWARDED TO EXAMINER | | | |
| 58 | 02/24/2005 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 57 | 10/14/2005 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 56 | 02/24/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 55 | 04/11/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 46 | 58 |
| 54 | 02/24/2005 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 53 | 09/21/2004 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 52 | 09/17/2004 | ADVISORY ACTION (PTOL-303) | | | |
| 51 | 09/13/2004 | PETITION DECISION - GRANTED | | | |
| 50 | 08/04/2004 | DATE FORWARDED TO EXAMINER | | | |
| 49 | 07/22/2004 | AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL | | | |
| 48 | 07/22/2004 | NOTICE OF APPEAL FILED | | 93 | 39 |
| 47 | 07/22/2004 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 43 | 07/22/2004 | PETITION ENTERED | | | |
| 42 | 07/22/2004 | WORKFLOW INCOMING PETITION IFW | | | |
| 41 | 05/27/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 40 | 05/20/2004 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 39 | 01/20/2004 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 38 | 01/12/2004 | FINAL REJECTION | | | |
| 37 | 10/10/2002 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 36 | 10/10/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 34 |
| 35 | 10/29/2003 | DATE FORWARDED TO EXAMINER | | | |
| 34 | 10/10/2003 | RESPONSE AFTER NON-FINAL ACTION | | 93 | 32 |
| 33 | 10/10/2003 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 32 | 04/09/2003 | MAIL NON-FINAL REJECTION | | | |
| 31 | 04/07/2003 | NON-FINAL REJECTION | | | |
| 30 | 02/10/2003 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 0 | 28 |
| | | | | | |

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|---|---|---|---|---|---|
| 29 | 02/20/2003 | DATE FORWARDED TO EXAMINER | | | |
| 28 | 02/10/2003 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 27 | 01/09/2003 | MAIL RESTRICTION REQUIREMENT | 504 | | -1 |
| 26 | 01/08/2003 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 25 | 11/03/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 24 | 05/07/2002 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 23 | 05/02/2002 | DATE FORWARDED TO EXAMINER | | | |
| 22 | 04/16/2002 | RESPONSE TO A LETTER TO COMPLY WITH THE SEQUENCE RULES | | 82 | 18 |
| 21 | 03/12/2002 | MAIL INCOMPLETE RESPONSE TO SEQUENCE RULE REQUEST | | | |
| 20 | 03/11/2002 | INCOMPLETE RESPONSE TO SEQUENCE RULE REQUEST | | | |
| 19 | 02/28/2002 | DATE FORWARDED TO EXAMINER | | | |
| 18 | 01/24/2002 | RESPONSE TO A LETTER TO COMPLY WITH THE SEQUENCE RULES | | 58 | 15 |
| 17 | 01/24/2002 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 16 | 02/19/2002 | CRF DOES NOT MATCH APPLICATION SPECIFICATION -- APPLICANT MUST CORRECT | | | |
| 15 | 08/27/2001 | MAIL LETTER REQUIRING CRF (UNREADABLE, NON-COMPLIANT, NOT SUBMITTED) | | | |
| 14 | 08/27/2001 | CRF DISKETTE UNREADABLE / DID NOT COMPLY / REQUIRED BUT NOT SUBMITTED | | | |
| 13 | 03/21/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 12 | 01/08/2001 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 11 | 01/05/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 10 | 11/27/2000 | APPLICANT HAS FILED A VERIFIED STATEMENT OF SMALL ENTITY STATUS IN COMPLIANCE WITH 37 CFR 1.27 | | | |
| 9 | 11/27/2000 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 8 | 12/05/2000 | APPLICATION DISPATCHED FROM OIPE | | | |
| 7 | 12/05/2000 | APPLICATION IS NOW COMPLETE | | | |
| 6 | 08/21/2000 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 5 | 08/18/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 4 | 07/24/2000 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 3 | 07/18/2000 | CRF IS GOOD TECHNICALLY / ENTERED INTO | | | |

| | | | | | |
|---|---|---|---|---|---|
| | | DATABASE | | | |
| 2 | 06/23/2000 | CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE | | | |
| 1 | 06/23/2000 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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FEB 0 6 2006

**OFFICE OF PETITIONS**

In re Application of :
Edward A. Hubbard :
Application No. 09/602,789 : ON PETITION
Filed: June 23, 2000 :
Attorney Docket No. UNTD:010 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 9, 2005, to revive the above-identified application.

This application became abandoned for failure to respond to the Notice Regarding Drawings mailed March 31, 2005. A Notice of Abandonment was mailed on August 4, 2005.

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 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.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of twenty-nine (29) sheets of formal drawings containing Figures 1a-15; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application is being referred to the Office of Publications for further processing into a patent.

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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Genentech Inc
Attn Wendy Lee
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San Francisco, CA 94080-4990

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**AUG 18 2005**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Mark Sliwkowski | : | DECISION ON |
| Application No. 09/602,812 | : | PETITION UNDER 1.183 |
| Filed: June 23, 2000 | : | and |
| Attorney Docket No. P1467R2 | : | DECISION ON APPLICATION |
| | : | FOR PATENT TERM ADJUSTMENT |
| | : | |

This is in response to the "PETITION UNDER 37 C.F.R. § 1.183," and the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," both filed April 12, 2005. Applicant requests wavier of the requirement under § 1.705(b) that any request for reconsideration of the patent term adjustment indicated in the notice of allowance be filed no later than the payment of the issue fee. Applicant requests that the initial determination of patent term adjustment be corrected from zero (0) days to three hundred twenty-nine (329) days plus the number of days from the date of the Notice of Allowance until the date that a patent is granted.

The petition under § 1.183 is **DISMISSED**.

**RELEVANT STATUTES and RULES**

§ 1.183 Suspension of rules.

> 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(f).

35 U.S.C. 154(b)(3)(B) provides that

Under the procedures established under subparagraph (A), the Director shall—

(i) make a determination of the period of any patent term adjustment under this subsection, and shall transmit a notice of that determination with the written notice of allowance of the application under section 151; and

(ii) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director.

37 C.F.R. § 1.705 provides, in pertinent part, that:

(a) The notice of allowance will include notification of any patent term adjustment under 35 U.S.C. 154(b).

(b) Any request for reconsideration of the patent term adjustment indicated in the notice of allowance, except as provided in paragraph (d) of this section, and any request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) must be by way of an application for patent term adjustment. An application for patent term adjustment under this section must be filed no later than the payment of the issue fee but may not be filed earlier than the date of mailing of the notice of allowance.

**OPINION**

Pursuant to 35 U.S.C. 154(b)(3)(B) and implementing regulation 37 C.F.R. § 1.705, an applicant shall receive an initial determination of patent term adjustment with the mailing of the Notice of Allowance and shall be given one opportunity to request reconsideration of that determination by way of filing

of an application for patent term adjustment prior to the payment of the issue fee.

On January 12, 2005, the Office mailed the initial 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 0 days. The issue fee payment was received in the Office on April 8, 2005. No filing of an application for patent term adjustment preceded the payment of the issue fee. The period for filing an application for patent term adjustment requesting reconsideration of the initial determination of patent term adjustment at the time of mailing of the notice of allowance ended upon payment of the issue fee on April 8, 2005.

On April 12, 2005, applicant filed an application for patent term adjustment. In addition, applicant filed the petition requesting waiver of the requirement that the application for patent term adjustment be filed prior to payment of the issue fee. Applicant acknowledges that the issue fee payment was made prior to filing of the application for patent term adjustment. Applicant offers the following facts, as a basis for waiving the timeliness requirement of § 1.705(b):

- Shortly after receiving the Notice of Allowance, outside counsel was asked to review the determination of PTA, but as of April 8, 2005, outside counsel had not completed that review;
- Due to their travel and meeting schedule, applicant's agent was concerned it might be difficult to file the payment of the issue fee during the first part of the week of April 11 and by the 3-month due date. Further, believing in error that the Rules permitted the submission of an application for patent term adjustment after the payment of the issue fee, applicant's agent faxed in payment of the issue fee on April 8, 2005;
- However, counsel completed the review on April 11, 2005, and advised agent that an application for patent term adjustment be filed no later than the payment of the issue fee; and
- The error of failing to submit an application for patent term adjustment before or on the same day as the payment of the issue fee occurred without deceptive intent on the part of applicant's agent or outside counsel.

Having considered applicant's explanation, it is concluded that in this instance waiver of the requirement that the application for patent term adjustment be filed prior to payment of the issue fee is not appropriate. Applicant has not shown that the circumstance of the failure to comply with the time period for filing an application for patent term adjustment set forth in § 1.705(b) is an extraordinary situation for which justice requires waiver.

It is well established that a party's inadvertent failure to comply with the requirements of a rule is not deemed to be an extraordinary situation that would warrant waiver of a rule under 37 CFR 1.183, nor is such an inadvertent omission considered "unavoidable," within the meaning of 15 U.S.C. 1062(b), 35 U.S.C. 133, 37 CFR 1.137(a) or 37 CFR 2.66(a). See Honigsbaum v. Lehman, 903 F. Supp. 8, 37 USPQ2d 1799 (D.D.C. 1995) (Commissioner did not abuse his discretion in refusing to waive requirements of 37 CFR 1.10(c) in order to grant filing date to patent application, where applicant failed to produce "Express Mail" customer receipt or any other evidence that application was actually deposited with USPS as "Express Mail."), aff 'd without opinion, 95 F.3d 1166 (Fed. Cir. 1996); Nitto Chemical Industry. Co., Ltd. v. Comer, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (Commissioner's refusal to waive requirements of 37 CFR 1.10 in order to grant priority filing date to patent application not arbitrary and capricious, because failure to comply with the requirements of 37 CFR 1.10 is an "avoidable" oversight that could have been prevented by the exercise of ordinary care or diligence, and thus not an extraordinary situation under 37 CFR 1.183.); Vincent v. Mossinghoff, 230 USPQ 621 (D.D.C. 1985) (misunderstanding of 37 CFR 1.8 not unavoidable delay in responding to Office Action); Gustafson v. Strange, 227 USPQ 174 (Comm'r Pat. 1985) (counsel's unawareness of 37 CFR 1.8 not extraordinary situation warranting waiver of a rule); In re Chicago Historical Antique Automobile Museum, Inc., 197 USPQ 289 (Comm'r Pat. 1978) (since certificate of mailing procedure under 37 CFR 1.8 was available to petitioner, lateness due to mail delay not deemed to be extraordinary situation).

Petitioner has not set forth any other circumstance for violation of the timeliness requirement than believing in error that the rules permitted the submission of an application for patent term adjustment after the payment of the issue fee. Whether, as applicant states, the failure was without deceptive intent is irrelevant. The requirement that the application for

patent term adjustment be filed prior to payment of the issue fee is clearly set forth in the rule. Thus, applicant was expected to be aware of this requirement and to act accordingly. This situation is not distinguishable from those, cited above, in which lack of awareness of a rule was not found to meet the requirements for waiver under § 1.183. Likewise, applicant's lack of awareness of the timeliness requirement of § 1.705(b) is not an extraordinary situation, warranting waiver of the requirement that the application for patent term adjustment be filed prior to payment of the issue fee.

As there is no dispute that this application for PTA was filed after payment of the issue fee and it has been concluded that waiver of the requirement is not warranted, it is appropriate to dismiss this application for patent term adjustment as untimely filed.

In view thereof, it is concluded that the initial determination of Patent Term Adjustment of zero (0) days will not be reconsidered.

The Office acknowledges submission of the $400.00 fee set forth in 37 CFR 1.17(f) and the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,949,245 | : | DECISION ON REQUEST FOR |
| Mark Sliwkowski | : | RECONSIDERATION OF |
| Issue Date: September 27, 2005 | : | PATENT TERM ADJUSTMENT |
| Application No. 09/602,812 | : | and |
| Filed: June 23, 2000 | : | NOTICE OF INTENT TO ISSUE |
| Attorney Docket No. P1467R2 | : | CERTIFICATE OF CORRECTION |
| | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF REVISION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed December 5, 2005, with a certificate of mailing dated November 28, 2005. Patentee requests that the patent term adjustment indicated on the patent be corrected from two hundred fifteen (215) days to three hundred thirty-five (335) days.

The request for reconsideration of patent term adjustment is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **THREE HUNDRED THIRTY-FIVE (335)** days.

On September 27, 2005, the application matured into U.S. Patent No. 6,949,245, with a revised patent term adjustment of 215 days. By virtue of the certificate of mailing dated Monday, November 28, 2005, patentee timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 335 days. Patentee asserts that the 120-day applicant delay associated with the "miscellaneous paper" filed on April 12, 2005, was recorded in error. Patentee states that

the only papers filed on April 12, 2005 were an application for patent term adjustment including an exhibit containing a copy of an earlier filed Information Disclosure Statement and a petition under § 1.183 requesting waiver of the requirement that the application for patent term adjustment be filed before the payment of the issue fee.

37 C.F.R. § 1.704(e) provides that:

> Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

A review of the record confirms that the reduction of 120 days is based on the filing of the application for patent term adjustment, which included an exhibit and a petition for waiver of the timeliness requirement. In view thereof, the reduction of 120 days was not warranted.

The patent should have issued with a revised patent term adjustment of three hundred thirty-five (335) 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 Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **THREE HUNDRED THIRTY-FIVE (335)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 6,949,245 B1

DATED : September 27, 2005

INVENTOR(S) : Sliwkowski

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,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (215) days

Delete the phrase "by 215" and insert – by 335 days--

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OFFICE OF PETITIONS

In re Application of: :
Takeuchi et al. :
Application No. 09/602,814 : DECISION ON
Filed: March 4, 1999 : PETITION
Title of Invention: :
BALL LOADING APPARATUS AND BALL :
LOADING METHOD :

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

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action, mailed February 20, 2003. The Notice set a shortened statutory period for reply of three (3) months from the mail date of the Notice, and also provided for extensions of time under 37 CFR 1.136(a).

Applicant filed an Amendment in response to the Office action on July 18, 2003; however, the Amendment failed to place the application in condition for allowance. Applicant was so notified in an Advisory action mailed on July 29, 2003.

A Notice of Abandonment was mailed on September 9, 2003.

With the instant petition, Petitioner paid the petition fee; submitted a Request for Continued Examination ("RCE"), and fee, and a submission in the form of an Amendment. Accordingly, the petition is granted.

Having found that all of the requirements for a grantable petition under 37 CFR 1.137(b) have been met, **this petition is hereby granted.**

This application is being returned to Technology Center 1725 for processing of the RCE and Amendment.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Application of :
Tacheuchi et al. :
Application No. 09/602,814 :
Filed: June 23, 2000 : ON PETITION
Attorney Docket No. 82493.0002 :

This is a decision on the Petition for Corrected Filing Date, filed April 18, 2005. The Petition is properly treated as a petition under 37 CFR 1.53 to accord a filing date of June 23, 2000, to the application.

The application was filed on June 23, 2000 in a language other than English. In response, the the Office of Initial Patent Examination mailed a Notice to File Missing Parts of Nonprovisional Application ("Notice") noting, *inter alia*, that a filing date had been accorded the application, and requiring an English language translation in accordance with 37 CFR 1.52. Applicant timely filed a response to the Notice on November 20, 2000, which included the English language translation of the application1. In response to this filing, the Office of Initial Patent Examination mailed an Updated Filing Receipt on May 29, 2001, wherein the filing date of the application was changed to the date of receipt of the response to the Notice - November 20, 2000.

Petitioner files the instant Petition to correct the filing date of the application to June 23, 2000. In support of the petition, Applicant files a copy of his return-receipt postcard.

A review of the return-receipt postcard reveals that Applicant is correct. The postcard acknowledges receipt of, *inter alia*, 26 pages of specification, 13 claims, and 10 sheets of drawings in the above-identified application by this on June 23, 2000.

"A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of

1 The response to the Notice included a one month extension of time request and a Certificate of Mailing date November 16, 2000.

receipt in the PTO of all items listed thereon by the PTO." MPEP § 503.

Accordingly, the petition is granted.

No fee has been charged and none is due.

The application will be referred to the Office of Initial Patent Examination for correction of the filing date to June 23, 2000.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Petitions Attorney
Office of Petitions

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**Eighth Floor**
**Toledo, OH 43604**

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FEB 12 2004

**OFFICE OF PETITIONS**

In re Application of
Haas, Andrew M.
Application No. 09/602,883
Filed: June 26, 2000
Attorney Docket No. 1-14915

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 20, 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.

This application became abandoned for failure to timely reply to the non-final Office action mailed June 20, 2001. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on September 21, 2001. A Notice of Abandonment was mailed January 28, 2002.

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 under 37 CFR 1.137 was unintentional, the Commissioner may require additional information.[2]

---

[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.

[2] See MPEP 711.03(c)(III)(C) and (D).

The instant petition appears to be on behalf of the assignee; however, the petition does not comply with 37 CFR 3.73(b). 37 CFR 3.73(b) provides that: (1) when an assignee seeks to take action in a matter before the Office, the assignee must establish its ownership of the property to the satisfaction of the Commissioner; (2) ownership is established by submitting to the Office, in the Office file related to the matter in which action is sought to be taken, documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment submitted for recording) or by specifying (*e.g.*, reel and frame number) where such evidence is recorded in the Office; (3) the submission establishing ownership must be signed by a party authorized to act on behalf of the assignee; and (4) documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office. A 37 CFR 3.73(b) statement is enclosed with this requirement for information.

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.

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

Enclosure: PTO/SB/96 - Statement under 37 CFR 3.73(b)

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

**MARSHALL & MELHORN**
**FOUR SEAGATE**
**EIGHTH FLOOR**
**TOLEDO, OH 43604**

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MAR 2 6 2004

OFFICE OF PETITIONS

In re Application of
Haas, Andrew M.
Application No. 09/602,883
Filed: June 26, 2000
Attorney Docket No. 1-14915

ON PETITION

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed March 18, 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 June 20, 2001. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on September 21, 2001. A Notice of Abandonment was mailed on January 28, 2002.

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

SEE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE 7.6.09 Paper No.:

TO SPE OF : ART UNIT 2145

SUBJECT : Request for Certificate of Correction for Appl. No. 09/602985 Patent No.: 6460897

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

**FOR IFW FILES:** Should Fig. 6e Approved

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 (C of C)**
**Randolph Square 9C62-D**
**Palm Location 7580**

Ennis Young
Certificates of Correction Branch
703-756-1542

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: Please process the certificate of correction.
Thank you.
Thomas Duong

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER

Art Unit

PTOL-368 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. ..... 6,963,897
Confirmation No. ..... 1376
Issue Date ..... November 8, 2005
Inventorship ..... Edward Hubbard
Applicant ..... Niration Network Group L.L.C.
Group Art Unit ..... 2145
Examiner ..... Thomas Duong
Attorney's Docket No. ..... NING0011
Title: Customer Services and Advertising based upon Device Attributes and Associated Distributed Processing System

## REQUEST FOR CERTIFICATE OF CORRECTION

## UNDER 37 CFR 1.322

To: Honorable Commissioner of Patents
Office of Patent Publications
Attention: Certificate of Correction Branch
P.O. Box 1450
Alexandria, VA 22313-1450

From: Lance R. Sadler (Tel. 509-755-7251; Fax 509-755-7252)
Sadler, Breen, Morasch & Colby, p.s.
422 W. Riverside Avenue, Suite 424
Spokane, WA 99201

**Customer No. 75671**

Sir:

We respectfully request that a Certificate of Correction be issued under 37 CFR 1.322 for U.S. Patent 6,963,897.

Applicant submits that the subject patent was issued without Figure 16 as illustratcd in form PTO/SB/44.

Specifically, in the Office Action dated May 14, 2004, the Office objected to the drawings because they allegedly did not show the features of Claim 1. On November 12, 2004, the Applicant submitted Figure 16 in response to the Office's objection. On November 5, 2008, the subject patent issued without Figure 16.

The errors listed in form PTO/SB/44 are believed to be Patent Office errors and as such no fee is enclosed for this Request for a Certificate of Correction. If fees are due, however, the Commissioner is hereby authorized to charge any fee or credit any overpayments to Deposit Account No. 50-4143 of Sadler, Breen, Morasch & Colby.

We respectfully submit that a significant error is present in the printed patent and that correction thereof in accord with enclosed form PTO/SB/44 is required to prevent any misunderstanding.

Respectfully Submitted,

Date: 6/23/2009

By: /Lance R. Sadler/

Lance R. Sadler
Attorney for Applicant
Reg. No. 38,605

Sadler, Breen, Morasch & Colby, PS
422 W. Riverside Avenue, Suite 424
Spokane, Washington 99201
Telephone: (509) 755-7251
Facsimile: (509) 755-7252

PTO/SB/44 (09-07)
Approved for use through 08/31/2010. 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. : 6,963,897

APPLICATION NO.: 09/602,983

ISSUE DATE : November 8, 2005

INVENTOR(S) : Edward Hubbard

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:

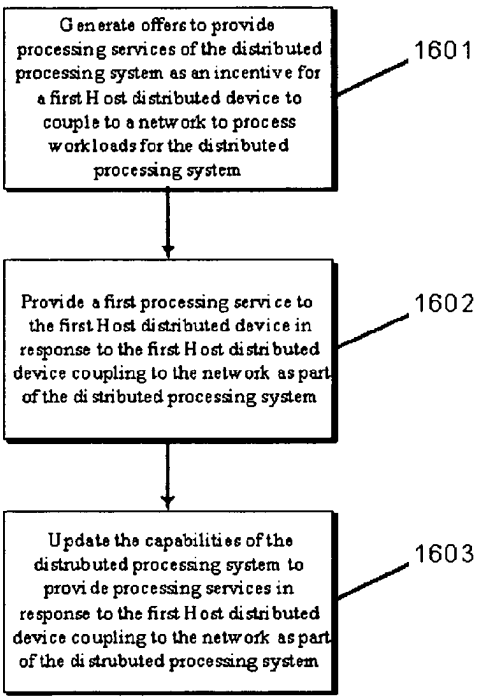


FIG. 16

MAILING ADDRESS OF SENDER (Please do not use customer number below):

Sadler, Breen, Morasch, & Colby
422 West Riverside Avenue, Suite 424
Spokane, Washington 99201

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.*

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE 11/19/09 Paper No.:

TO SPE OF ART UNIT 2445

SUBJECT Request for Certificate of Correction for Appl. No.: 09/602983 Patent No.: 6963897

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**

Application Data sheet is omitted as required.

Eva James
Certificates of Correction Branch
703-756-1583

**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: Please process the Certificate of Correction
Thank you
Thomas Dung

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER

PTO/SB/44 (09-07)
Approved for use through 08/31/2010. 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. : 6,963,897 B1

APPLICATION NO.: 09/602,983

ISSUE DATE : November 8, 2005

INVENTOR(S) : Edward A. Hubbard

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:

On the cover page, please replace the priority information paragraph with the following paragraph:

--Related U.S. Application Data

This application is a continuation-in-part of application No. 09/538,543, filed on Mar. 30, 2000, now U.S. Patent No. 7,003,547, and a continuation-in-part of application No. 09/539,023, filed on Mar. 30, 2000, now abandoned, and a continuation-in-part of application No. 09/539,448, filed on Mar. 30, 2000, now abandoned, and a continuation-in-part of application No. 09/539,428, filed on Mar. 30, 2000, now abandoned, and a continuation-in-part of application No. 09/539,106, filed on Mar. 30, 2000, now U.S. Patent No. 6,891,802, and a continuation-in-part of application No. 09/538,542, filed on Mar. 30, 2000, now U.S. Patent No. 6,654,783, and a continuation-in-part of application No. 09/539,107, filed on Mar. 30, 2000, now abandoned.--

MAILING ADDRESS OF SENDER (Please do not use customer number below):

James F. Goedken
Bell Boyd & Lloyd LLP
P.O. Box 1135
Chicago, IL 60690

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.*

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

| | |
|---|---|
| Patentee(s): | Edward A. Hubbard |
| Patent No.: | US 6,963,897 B1 |
| Issue Date: | November 8, 2005 |
| Title: | CUSTOMER SERVICES AND ADVERTISING BASED UPON DEVICE ATTRIBUTES AND ASSOCIATED DISTRIBUTED PROCESSING SYSTEM |
| Examiner: | Duong, Thomas |
| Docket No.: | 118927-009 |

Commissioner for Patents
P.O. Box 1135
Alexandria, VA 22313-1450

**REQUEST FOR CERTIFICATE OF CORRECTION UNDER 37 CFR SECTION 1.323**

Dear Sir:

On the cover page please replace the priority information paragraph with the following paragraph:

**Related U.S. Application Data**

This application is a continuation-in-part of application No. 09/538,543, filed on Mar. 30, 2000, now U.S. Pat. No. 7,003,547, and a continuation-in-part of application No. 09/539,023, filed on Mar. 30, 2000, now abandoned, and a continuation-in-part of application No. 09/539,448, filed on Mar. 30, 2000, now abandoned, and a continuation-in-part of application No. 09/539,428, filed on Mar. 30, 2000, now abandoned, and a continuation-in-part of application No. 09/539,106, filed on Mar. 30, 2000, now U.S. Pat. No. 6,891,802, and a continuation-in-part of application No. 09/538,542, filed on Mar. 30, 2000, now U.S. Pat. No. 6,654,783, and a continuation-in-part of application No. 09/539,107, filed on Mar. 30, 2000, now abandoned.

## REMARKS

Upon careful review of issued U.S. Patent No. 6,963,897 B1 that issued November 8, 2005, errors were noted with regard to the chain of priority, as the application should have been a continuation-in-part of each of the listed applications. A copy of the executed Declaration that includes the priority claim is enclosed herewith as Exhibit A. Further, the priority information was correctly stated in the specification in Column 1, lines 6-26.

Accordingly, Applicants respectfully request that this request for a certificate of correction be granted and thus a certificate of correction be issued that identifies the corrected related U.S. applications on the face of the above-identified issued patent based on at least the reasons as discussed above.

Patentee is hereby requesting the issuance of a Certificate of Correction pursuant to 37 CFR §1.323. A proposed Certificate of Correction is also submitted herewith. Patentee requests that Deposit Account No. 02-1818 be charged for the requisite fee pursuant to 37 CFR §1.20(a).

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY _____

James F. Goedken
Reg. No. 44,715
Customer No.: 24573

Dated: March 11, 2007

EXHIBIT A

# DECLARATION FOR PATENT APPLICATION AND POWER OF ATTORNEY

As an undersigned inventor, I hereby declare that:

My residence, post office address and country of citizenship are as stated directly below my name.

I believe (check one) [ X ] I am the original, first and sole inventor
[ ] I am a joint inventor and the below named inventors are the original and first inventors

of the subject matter which is claimed and for which a patent is sought on the invention entitled

**CUSTOMER SERVICES AND ADVERTISING BASED UPON DEVICE ATTRIBUTES AND ASSOCIATED DISTRIBUTED PROCESSING SYSTEM**

the specification of which

(check one) [ X ] is attached hereto.
[ ] was filed on _____,
as Application Serial No. _____,
and was amended on _____.
(if applicable)

I further declare that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office (hereinafter "the Office") all information known to me to be material to patentability of the subject matter which is claimed as defined in 37 C.F.R. §1.56.

I hereby claim foreign priority benefits under 35 U.S.C. § 119 of any foreign application(s) for patent or inventor's certificate indicated below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

| Prior Foreign Application(s) Number | Country | Day/Month/Year Filed | Priority Claimed Yes | No |
|---|---|---|---|---|
| None | | | | |

I hereby claim the benefit under 35 U.S. C. §119(e) of any United States provisional application listed below:

| Provisional Application Serial No. | Filing Date |
|---|---|
| None | |

I hereby claim the benefit under 35 U.S.C. § 120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of 35 U.S.C. § 112, I acknowledge the duty to disclose to the Office all information known to me to be material to patentability as defined in 37 C.F.R. § 1.56, which became available between the filing date of the prior application and the national or PCT international filing date of this application:

| Application Serial No. | Filing Date | Status (patented, pending, abandoned) |
|---|---|---|
| 09/538,543 | March 30, 2000 | Pending |
| 09/539,023 | March 30, 2000 | Pending |
| 09/539,448 | March 30, 2000 | Pending |
| 09/539,428 | March 30, 2000 | Pending |
| 09/539,106 | March 30, 2000 | Pending |
| 09/538,542 | March 30, 2000 | Pending |
| 09/539,107 | March 30, 2000 | Pending |

I hereby appoint: Robert M. O'Keefe (Reg. No. 35,630), Richard D. Egan (Reg. No. 36,788), Brian W. Peterman (Reg. No. 37,908), and William W. Enders (Reg. No. 41,735), each an attorney of the firm of O'KEEFE, EGAN & PETERMAN, as its attorneys for so long as they remain with such firm, with full power of substitution and revocation, to prosecute the application, to make alterations and amendments therein, to transact all business in the Patent and Trademark Office in connection therewith, and to receive any Letters Patent, and for one year after issuance of such Letters Patent to file any request for a certificate of correction that may be deemed appropriate.

Address all telephone calls to Brian W. Peterman at telephone number (512) 347-1611.

Address all correspondence to:

Brian W. Peterman
O'KEEFE, EGAN & PETERMAN
1101 Capital of Texas Highway South

Building C, Suite 200
Austin, TX 78746
(512) 347-1611
(512) 347-1615 (Fax)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further, that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and may jeopardize the validity of the application or any patent issued thereon.

Full name of sole inventor: Edward A. Hubbard

Inventor's Signature [signature] Date 6/23/00

Residence Address: 3105 SCARLET OAK COVE ROUND ROCK TX 78664
**(Including Postal Code)**

Citizenship: USA

Post Office Address: SAME
**(Including Postal Code)**

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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JUN 05 2007

OFFICE OF PETITIONS

**ERIC B. MEYERTONS**
**CONLEY ROSE & TAYON PC**
**PO BOX 398**
**AUSTIN TX 78767-0398**

| | | |
|---|---|---|
| In re Application of | : | |
| Gregory Jones et al | : | |
| Application No. 09/603,144 | : | DECISION ON PETITION |
| Filed: June 23, 2000 | : | |
| Attorney Docket No. 5053-28000 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 6, 2007, to revive the above-identified application.

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 March 10, 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). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is June 11, 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 Notice of Appeal; (2) the petition fee of 1,500; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 3627 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

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
www.uspto.gov

ERIC B. MEYERTONS, ESQ.
CONLEY, ROSE & TAYON, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

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AUG 18 2005

OFFICE OF PETITIONS

In re Application of :
Lorenz : DECISION ON PETITION
Application No. 09/603,303 :
Filed: June 23, 2000 :
Atty. Dkt. No.: 5053-36000 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 22, 2005, to revive the above-identified application.

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

This application became abandoned November 19, 2004 for failure to timely reply to the final Office action mailed June 18, 2004. The final Office action set a three (3) month shortened statutory period of time for reply. A two month extension of time was timely procured. Notice of Abandonment was mailed April 6, 2005.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply; (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 of the reply until the filing of a grantable petition 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.

The instant petition has been reviewed and found in compliance with the provisions of 37 CFR 1.137(b). Accordingly, the failure to timely submit a proper reply to the final Office action mailed June 18, 2004 is accepted as having been unintentionally delayed.

This application file is being forwarded to Technology Center 3600 for processing of the Notice of Appeal submitted herewith submitted herewith.

Application No. 09/603,303

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
www.uspto.gov

Eric B Meyertons
Conley Rose & Tayon PC
PO Box 398
Austin, TX 78767-0398

MAILED

MAR 01 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re Application of
Brian Wolfe, et al.
Application No. 09/603,308
Filed: June 23, 2000
For: SYSTEM AND METHOD FOR EXTERNALIZATION OF FORMULAS FOR ASSESSING DAMAGES

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in reply applicant's Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181 filed in the United States Patent and Trademark Office on December 30, 2003.

The petition is **GRANTED**.

A review of the file record indicates that the application was held abandoned for failure to timely file a proper response to the Office action dated April 18, 2003 and a Notice to that effect was mailed on December 2, 2003.

Petitioner states that a Request for Continued Examination (RCE) and a submission as required under 37 C.F.R. 1.114 were filed as a response to the above noted Office action on August 18, 2003, August 19, 2003 and August 20, 2003. This response has been received. The information disclosure statements filed with the Request for Continued Examination constitute a proper submission under 37 C.F.R. 1.114.

This application is being forwarded to the Supervisory Legal Instruments Examiner to charge the appropriate extension of time fees. Thereafter, it will be forwarded to the examiner for prompt action on the response.

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866

KJD/cps: 2/18/04

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

PULSE-LINK, INC.
1969 KELLOGG AVENUE
CARLSBAD CA 92008

COPY MAILED

OCT 2 1 2004

OFFICE OF PETITIONS

In re Application of
Carlton Sparrell et al.
Application No. 09/603,310
Filed: June 21, 2000
Attorney Docket No. FAN-00-010
Title: WIRELESS TDMA SYSTEM AND METHOD FOR NETWORK COMMUNICATIONS

DECISION ON PETITION
UNDER 37 C.F.R. §1.137(f)

This is a decision on the petition filed September 13, 2004, pursuant to 37 C.F.R. §1.137(f), to revive the above-identified application.

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

(1) Notification of the filing of an application in a foreign country or under a multinational treaty that requires 18 month publication[1];
(2) The petition fee as set forth in 37 C.F.R. § 1.17(m), and;
(3) A statement that the entire delay in filing the notice from the date that the notice was due under 35 U.S.C. §122(b)(2)(B)(iii) until the date the notice was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

Petitioner states that the instant nonprovisional application is the subject of an application filed in either a foreign or an international application on June 21, 2001. However, the United States Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in either an international application or a foreign country.

On June 25, 2001, a Notice of Rescission of Nonpublication Request was filed with the Office or with the instant petition. Unfortunately, notification of the filing of the international or foreign application did not accompany this filing.

1 See PTO/SB/36 and paragraph on PTO/SB/64a for further information. Both may be downloaded at http://www.uspto.gov/web/forms/index.html.

In view of the above, this application became abandoned pursuant to 35 U.S.C. §1.22(b)(2)(B)(iii) and 37 C.F.R. §1.213(c) for failure to timely notify the Office of the filing of either a foreign application or an application under a multilateral international agreement that requires publication of applications 18 months after filing.

The petition under 37 C.F.R. §1.137(f) is **GRANTED**.

Petitioner has submitted the notification of either a foreign or an international filing, paid the petition fee, and has made the proper statement of unintentional delay.

The instant petition has been found to be in compliance with 37 C.F.R. §1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. §122(b)(2)(B)(iii) and 37 C.F.R. §1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. §122(b)(2)(B)(i), filed with the original application papers, has been rescinded. Unfortunately, due to a software problem the Office is currently experiencing, the Office cannot determine the projected publication date at this time.

It is noted that on the petition, Petitioner has listed the first named inventor as being "John Santhoff." The Office will presume that this is a typographical error, as this individual does not appear on the declaration.

After this decision is mailed, the application will be forwarded to Technology Center 2600.

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.

**Paul Shanoski**
**Senior Attorney**
**Office of Petitions**
**United States 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

**FISH & RICHARDSON PC**
**P.O. BOX 1022**
**MINNEAPOLIS MN 55440-1022**

MAILED

AUG 24 2009

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,972,775 | : | |
| Issue Date: December 6, 2005 | : | |
| Application No. 09/603,422 | : | DECISION ON PETITION |
| Filed: June 26, 2000 | : | |
| Attorney Docket No. 11328-006001 | : | |

This is a decision on the petition under 37 CFR 1.181 (no fee), filed June 26, 2009, requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is **DISMISSED**.

Petitioner states that the original Letters Patent was never received.

The Office follows the guidelines set forth in MPEP § 711.03(c) (*see also* "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 Official Gazette 53 (November 16, 1993), which sets forth that, in the absence of any irregularity in the mailing of an Office action (in this case, the Letters Patent), there is a strong presumption that the Office action (Letters Patent) was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Letters Patent was not in fact received. In this regard, the showing required to establish the failure to receive the Letters Patent must consist of the following:

1. a statement from practitioner stating that the Letters Patent 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 Letters Patent was not received; and
3. a copy of the docket record where the nonreceived Letters Patent would have been entered had it been received must be attached to and referenced in the practitioner's statement.

The petition is not accompanied by the evidence required to establish nonreceipt of the original Letters Patent. In this regard, petitioner has not provided items 2 or 3 above. Office records reflect that the Letters Patent was mailed to the address of record at the time; namely, FISH & RICHARDSON PC. The evidence submitted does not establish nonreceipt of the Letters Patent at that address.

In view of the above, the petition fails to provide the necessary evidence to establish nonreceipt of the Letters Patent. Accordingly, the petition for issuance of a duplicate Letters Patent under 37 CFR 1.181 cannot be granted at this time. .

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 PETITION
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

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

By hand: U. S. Patent and Trademark Office
Customer Service Window, Mail Stop Petitions
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries concerning this decision should be directed to Terri Williams at (571) 272-2991.

Chris Bottorff
Petitions Examiner
Office of Petitions

cc: **FISH & RICHARSON P.C.**
**225 FRANK STREET**
**BOSTON, MA 02110**

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. 6148029
Issue Date: November 14,2000
Application No. 09603495
Filed: June 10,1997
Attorney Docket No. PHF 93-584A

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

This is a decision on the electronic petition, filed May 27,2009 ,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 27,2009 . 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) |
|---|---|---|---|---|
| 6148029 | 2000-11-14 | 09603495 | 1997-06-10 | |

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

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (1551) |
| ◉ | 7 ½ year | (1552) |
| ○ | 11 ½ year | (1553) |

Small Entity

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (2552) |
| ○ | 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 | /Michael E Marion/ | Date (YYYY-MM-DD) | 2009-05-18 |
| Name | Michael E. Marion | Registration Number | 32266 |

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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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN TX 78701

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JUL 0 7 2009

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Arthur Dale Burns | : | |
| Application No. 09/603,510 | : | NOTICE |
| Filed: 06/26/2000 | : | |
| Docket No. UHGC:1104US/10813341 | : | |

This is a Notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed January 26, 2009.

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**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

The fee deficiency of $1,255.00 will be charged to the Deposit Account as requested.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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United States Patent and Trademark Office
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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN TX 78701

In re Application of
Arthur Dale Burns
Application No. 09/603,510
Filed: 06/26/2000
Docket No. UHGC:1104US/10813341

DECISION ON PETITION

This is decision on the petition under 37 CFR 1.137(b), filed January 26, 2009, to revive the above-identified application.

On June 1, 2007, the Office mailed a Notice of Allowability, which set a statutory period of three months to submit corrected drawings. In the absence of a timely and proper response, the application became abandoned on September 2, 2007. On October 11, 2007, the Office mailed a Notice of Abandonment.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of replacement drawings (2) the petition fee, and (3) a proper statement of unintentional delay. Accordingly, the failure to timely submit drawings in response to the Notice of Allowability is accepted as being unintentionally delayed.

The application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
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
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OCT 21 2009

OFFICE OF PETITIONS

**Fulbright & Jaworski, L.L.P.**
**600 Congress Avenue**
**Suite 2400**
**Austin, TX 78701**

In re Patent No. 7,574,401 :
Issue Date: August 11, 2009 :
Application No. 09/603,510 : ON PETITION
Filed: June 26, 2000 :
Attorney Docket No. UHGC: 1104US/10813341 :

This is a decision on the petition filed September 23, 2009, under 37 CFR 3.81(b) 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 correct assignee's name is "UnitedHealth Group Incorporated, Minnetonka, MN (US)" and that the incorrect assignee's name was included on the Fee(s) Transmittal form PTOL-85(b) at the time of payment of the issue fee. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct assignee on the front page of the Letters Patent in the patent to be issued from the application.

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.

The request was accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect that "UnitedHealth Group Incorporated, Minnetonka, MN (US)" is the assignee of record. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to be processed after issuance of this application into a patent.

Inquiries concerning this decision should be directed to the Kimberly Inabinet at (571) 272-4618. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a certificate of correction after issuance of this application into a patent.

Carl Friedman
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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FULBRIGHT & JAWORSKI L.L.P.
600 CONGRESS AVE.
SUITE 2400
AUSTIN, TX 78701

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Arthur Dale Burns | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7574401 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/11/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/603,510 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/26/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1327** 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.

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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STEVEN I. WEISBURD
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP
1177 AVENUE OF THE AMERICAS
41st FLOOR
NEW YORK, NY 10036-2714

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| | | |
|---|---|---|
| In re Patent No. 7,024,386 | : | |
| Issued: April 4, 2006 | : | DECISION ON APPLICATION FOR |
| Application No. 09/603,514 | : | PTA and NOTICE OF INTENT |
| Filed: June 23, 2000 | : | TO ISSUE CERTIFICATE OF |
| Atty. Dkt. No.: P/3331-138 | : | CORRECTION |

This decision is in response to the "REQUEST FOR RECONSIDERATION UNDER 37 C.F.R. § 1.705(d) OF PATENT TERM ADJUSTMENT DETERMINATION," filed April 27, 2006.

The request for reconsideration of patent term adjustment (PTA) is **GRANTED**.

The above-identified application matured into U.S. Patent No. 7,024,386 on April 4, 2006. The instant request for reconsideration was timely filed April 27, 2006 in accordance with 37 C.F.R. § 1.705(d). The patent issued with a PTA of 559 days. Patentees argue that the adjustment of 582 days that was indicated in the Determination of Patent Term Adjustment under 35 USC 154(b) mailed October 11, 2005 was improperly reduced 23 days in connection with a submission received December 27, 2005.

A review of the application history reveals that the adjustment of 582 days indicated in the Determination of Patent Term Adjustment was in fact improperly reduced 23 days, as argued by patentees. The submission received December 27, 2005 was a request for a corrected Notice of Allowability that was acknowledged as such in the Acknowledgement of Request mailed January 18, 2006. A request for corrected Notice of Allowability is in not a failure to engage in reasonable efforts to conclude prosecution within the meaning 37 CFR 1.704(b).

In view thereof, the patent is entitled to an adjustment of 582 days as argued by applicants.

This application file will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction

to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 582 days.

The required application fee of $200.00 has been charged to applicants' deposit account as authorized.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery A. Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

CC: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

| | | |
|---|---|---|
| PATENT | : | 7,024,386 B1 |
| DATED | : | April 4, 2006 |
| INVENTOR(S) | : | Mills, 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,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by 559 days

Delete the phrase "by 559 days" and insert – by 582 days--

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Pet. Dec.

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

Mailed: JUL 14 2005

Paper Number

In re application of :
Horst Farber : DECISION ON
Serial No. 09/603,528 : PETITION
Filed: June 23, 2000 :
For: SAMPLING TUBE AND METHOD OF MAKING SAME :

This is a response to the REQUEST TO WITHDRAW NOTICE OF ABANDONMENT originally filed March 19, 2005. The request asks that the abandonment, as set forth in the Notice of Abandonment of March 11, 2005, for failure to timely respond to the Final Office Action of January 15, 2004 be withdrawn. The requester asserts that a timely response in the form of a REQUEST FOR CONTINUED EXAMINATION was filed on July 09, 2004 along with a an Amendment after Final, Petition for Extension of Time, and Request for Continued Examination all filed on July 08, 2004 as evidenced by copy of the stamped postcard receipts.

**DECISION**

The instant request has been accepted as a petition to withdraw the holding of abandonment under the provisions of 37 CFR 1.181 (no fee) - no abandonment-in-fact. A review of the USPTO application file reveals that applicant's response, REQUEST FOR CONTINUED EXAMINATION, was properly filed on July 09, 2004 in view of the fact that the originally filed papers having a Patent and Trademark Office receipt stamp of July 09, 2004 and July 08,2004 thereon have been located in the USPTO electronic application file. Also it is noted that a review of the financial records associated with the application file indicate a fee was charged on July 14, 2004 for the Request for Continued Examination. Accordingly, any holding of abandonment is hereby vacated, and the application has been returned to pending status.

The application shall be forwarded to the examiner for processing and consideration of the papers filed July 09, 2004 and July 08, 2004.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

HERBERT DUBNO
THE FIRM OF KARL F. ROSS, P.C.
5676 RIVERDALE AVENUE BOX 900
BRONX, NY 10471-0900

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Charles J. Kulas
TOWNSEND and TOWNSEND and CREW LLP
8th Floor
Two Embarcadero Center
San Francisco, CA 94111-3834

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OFFICE OF PETITIONS

In re Application of :
Xu et al. :
Application No. 09/603,575 : ON PETITION
Filed: June 21, 2000 :
Attorney Docket Number: 20481-3 :

This is a decision on the Petition for Revival of Abandoned Application under 37 CFR 1.137(b), filed March 20, 2006.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due, mailed November 29, 2005. The Notice set a non-extendable three (3) month period for reply. No reply having been received, the application became abandoned on March 1, 2006. The mailing of this Decision precedes the mailing of a Notice of Abandonment.

With the instant petition, Applicant has satisfied the requirements of a grantable petition under 37 CFR 1.137(a). The issue fee is filed with the instant petition. Accordingly, the petition is granted.

This application is being referred to Publishing Division for processing into a patent.

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

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

DARBY & DARBY P.C.
P.O. BOX 770
Church Street Station
New York, NY 10008-0770

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : James D. Marks | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7596578 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/603,601 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/26/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1051** 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
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Alexandria, VA 22313-1450
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FEB 08 2008

Technology Center 2100

FISH & RICHARDSON PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

In re Application of: Karl Haakonsen et al
Patent No. :TBA
Application No.: 09/603,604
Filed: June 26, 2000

: RESPONSE TO REQUEST TO
; CORRECT INVENTORSHIP
: UNDER 37 C.F.R. § 1.48 (a)

For: **WEB SIMULATOR**

Applicants' request to correct the inventorship of the above-referenced application filed under 37 C.F.R. § 1.48(a) has been received. This petition is GRANTED.

A proper petition under this code section requires the following items. 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). 5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee. Applicant's have complied with each requirement.

Paul Rodriguez
Supervisory Patent Examiner
Art Unit 2123
(571)272-3753

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

DATE : 02/28/07

TO SPE OF : ART UNIT 2132

SUBJECT : Request for Certificate of Correction for Appl. No.: **09/603636** Patent No.: **7092522**

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:** No new matter; no change in scope or meaning of claim.

GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

**SPE**

2132
**Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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DIW Dec-06

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2 HIGH RIDGE PARK
STAMFORD CT 06905

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DEC 0 6 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Mueller et al. | : | |
| Application No. 09/603,677 | : | DECISION ON PETITION |
| Filed: 26 June, 2000 | : | |
| Atty Docket No. 00-004 | : | |

This is a decision on the petition filed on 12 September, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 15 August, 2005, for failure to timely submit an Appeal Brief in response to the Notice of Appeal filed on 14 June, 2005, which set a two (2) month shortened period for reply. No extensions of the time for reply

---

[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)).

were obtained. Notice of Abandonment was mailed on 28 April, 2006.

Petitioners have filed a Request for Continued Examination (RCE) and arguments as the submission under 37 CFR 1.114.

This application is being referred to Technology Center Art Unit 3627 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

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

Paper No. 11

ANTHONY C. MURABITO
WAGNER MURABITO & HAO
TWO NORTH MARKET STREET, 3RD FLOOR
SAN JOSE, CA 95113

COPY MAILED

APR 0 9 2004

OFFICE OF PETITIONS

In re Application of :
Guillermo Rozas et al :
Application No. 09/603,743 : NOTICE
Filed: June 26, 2000 :
Attorney Docket No. TRANS19

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 2111.

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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Paper No. 15

FAY KAPLUN & MARCIN, LLP
150 BROADWAY , STE 702
NEW YORK, NY 10038

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JAN 2 3 2004

OFFICE OF PETITIONS

In re Application of :
Roy Sullivan :
Application No. 09/603,886 :
Filed: June 26, 2000 :
Attorney Docket No. 10546/56701 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) filed January 2, 2004, to revive the above-identified application.

The petition is GRANTED.

The Office acknowledges receipt of the Notice of Appeal filed January 2, 2004.

**The 2-month period for filing the Appeal Brief, in triplicate, accompanied by the fee required by law, runs from the date of this decision.**

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9282.

This application is being forwarded to Technology Center AU 3737.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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

Grossman, Tucker, Perreault & Pfleger, PLLC
c/o Intellevate
P.O. Box 52050
Minneapolis, MN 55402

Mail Date: 07/16/2010

| | | |
|---|---|---|
| **Applicant** | : David L. Graumann | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7664274 | : RECALCULATION of PATENT |
| **Issue Date** | : 02/16/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 09/603,939 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/27/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **3197** 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
PO Box 1450
Arlington, VA 22313-1450
www.uspto.gov

Paper No. 14

Glen E. Books, ESQ
Lowenstein Sandler PC
65 Livingston Avenue
Roseland, NJ 07068

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OFFICE OF PETITIONS

In re Application of
Zhenan Bao et al.
Application No. 09/603,941
Filed: June 27, 2000
Attorney Docket No. BAO 16-25-12

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed May 16, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

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 July 22, 2002. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on October 23, 2002.

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 July 22, 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 $930 extension of time submitted with the petition on May 16, 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>Arlington, VA 22313-1450 |
| By facsimile: | (703) 308-6916<br>Attn: Office of Petitions |
| By hand: | Office of Petitions<br>2201 South Clark Place<br>Crystal Plaza 4, Suite 3C23<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: "Courtesy Copy of Advisory Action"

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patent
United States Patent and Trademark Offic
Washington, D.C. 2023
www.uspto.go

Paper No. 18

Glen E. Books
Lowenstein Sandler PC
65 Livingston Avenue
Roseland, NJ 07068

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JUL 0 1 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of
Zhenan Bao et al.
Application No. 09/603,941
Filed: June 27, 2000
Attorney Docket No. BAO 16-25-12

This is a decision on the renewed petition under 37 CFR 1.137(b), filed June 16, 2003, to revive the above-identified application.

The petition is **GRANTED**.

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 2815 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6397771
Issue Date: June 4,2002
Application No. 09604015
Filed: June 26,2000
Attorney Docket No. LEVI-02

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

This is a decision on the electronic petition, filed June 29,2007 ,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 29,2007 . 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.

# 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) |
|---|---|---|---|---|
| 6,397,771 | 2002-06-04 | 09604015 | 2000-06-26 | LEVI-01 |

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 | /Austin Bonderer/ | Date (YYYY-MM-DD) | 2007-06-29 |
| Name | Austin Bonderer | Registration Number | 56850 |

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
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Alexandria, VA 22313-1450
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**BAKER BOTTS L.L.P.**
**THE WARNER, SUITE 1300**
**1299 PENNSYLVANIA AVENUE, N.W.**
**WASHINGTON DC 20004-2400**

MAILED

MAR 2 9 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Patent No. 6,821,295 | : | |
| Issue Date: November 23, 2004 | : | |
| Application No. 09/604,114 | : | NOTICE UNDER 37 CFR. 1.28(c) |
| Filed: June 26, 2000 | : | |
| Attorney Docket No. | : | |

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue patent 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**.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

Inquiries related to this communication should be directed to Michelle R. Eason at (571) 272-4231.

Thurman K. Page
Petitions Examiner
Office of Petitions

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

**Paper No**.:20080306

**DATE** : May 14, 2008

**TO SPE OF** : ART UNIT 1655

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,887,899

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:** /Terry McKelvey/ **Art Unit** 1655

UNITED STATES PATENT AND TRADEMARK OFFICE

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**SCHWEGMAN, LUNDBERG & WOESSNER, P.A.**
**P.O. BOX 2938**
**MINNEAPOLIS, MN 55402**

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MAY 13 2008

| | | |
|---|---|---|
| In re Application of | : | |
| Robert H. Joyce et al. | : | |
| Application No. 09/604,199 | : | DECISION ON PETITION |
| Filed: June 27, 2000 | : | TO WITHFRAW |
| Attorney Docket No. 002950.P053 | : | FROM RECORD |
| | : | |

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR 1.36(b) filed April 7, 2006.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Schwegman, Lundberg & Woessner, P.A. has been revoked by the assignee of the patent application on July 21, 2006. Accordingly, the request to withdraw under 37 CFR 1.36(b) is moot.

All future communications from the Office will continue to be directed to the below-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to Carl Friedman at 571-272-6842.

Carl Friedman
Petitions Examiner
Office of Petitions

Cc: WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO IL 60606

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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Paper No. 13

Ivor R. Elrifi
Mintz, Levin, Cohn, Ferris,
Glovsky and Popeo, P.C.
One Financial Center
Boston, MA 02111

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SEP 12 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of
Nick W. Warne, et al.
Application No. 09/604,378
Filed: June 27, 2000
Attorney Docket No.22058-522CON(GI-5238BA)

This is a decision on the petition under 37 CFR 1.137(b), filed February 7, 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 Restriction mailed July 19, 2001, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 20, 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). Since the $1960.00 extension of time submitted with the petition on March 7, 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 1600, Art Unit 1647.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry Brinkley
Petitions Examiner

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Paper No. 24

Date : June 2, 2004

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) :Elvin R. Lukenbach et al
Application No. :09/604,563
Filed :June 27, 2000

The above-identified application has been assigned Patent No. 6,753,302 and an issue date of June 22, 2004.

It is hereby directed that this application be withdrawn from issue at the request of the applicant.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of June 22, 2004:

"All reference to Patent No. 6,753,302 to Elvin R. Lukenbach et al of New Jersey for CLEANSING COMPOSITIONS in the Official Gazette of June 22, 2004 should be deleted since no patent was granted."

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

cc: Geraldine Dozier, Crystal Park 3-441 (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-910 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane Davis (CDS), CM1-6A07
Tamara Greene, Crystal Park 3-908

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Paper No. 23

AUDLEY A. CIAMPORCERO JR.
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK NJ 08933-7003

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JUN 0 2 2004

OFFICE OF PETITIONS
ON PETITION

In re Application of :
Elvin R. Lukenbach et al :
Application No. 09/604,563 :
Filed: June 27, 2000 :
Attorney Docket No. JBP-506 :

This is a decision on the petition, filed May 28, 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 4, 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 1751 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).

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www.uspto.gov

Paper No. 14

William S. Frommer
Frommer Lawrence & Haug LLP
745 Fifth Avenue – 10th Floor
New York, NY 10151

In re Application of: Nagasawa
Application No.: 09/604,632
Filed: June 27, 2000
Attorney Docket No.: 450100-02579
For: SIGNAL INPUT AND OUTPUT APPARATUS THAT DISCRIMINATES BETWEEN PLURALITY OF DIFFERENT DEVICES EACH ISSUING UNIQUE CONTROL SIGNALS SUBSTANTIALLY SIMULTANEOUSLY THROUGH SINGLE TRANSMISSION PATH

**DECISION GRANTING PETITION TO ACCEPT CORRESPONDENCE AS TIMELY FILED UNDER 37 CFR §1.8**

This decision is in response to the request for withdrawal of holding of abandonment of this application filed on September 11, 2003. The request is being considered a petition to accept papers as timely filed under 37 CFR §1.8. This application was abandoned for failure to the issue fee that was due July 22, 2003 in response to the Notice of Allowance mailed April 22, 2003 (Paper No. 9).

In support of the petition, petitioner has provided (1) a copy of the the post card receipt with a date of June 9, 2003 listing a preliminary amendment, a check and RCE request, (2) a copy of the Request for Continued Examination, (3) a copy of the check, and (4) a copy of the preliminary amendment responding to the examiner's amendment dated April 22, 2003. In a telephone conversation on October 28, 2003, Mr. Kessler confirmed the preliminary amendment inadvertently indicated the response was to an Advisory Action rather than to the Examiner's Amendment and Notice of Allowance.

"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 items listed thereon on the date stamped thereon" (see MPEP § 503). In addition, a review of the file wrapper and the fee records reveals the RCE and amendment filed June 9, 2003 have now been matched to the file. Therefore, the evidence establishes that a timely response was, in fact, filed on June 9, 2003. The abandonment was the result of the Office failing to timely match the response to the application file.

The petition is **GRANTED**. The application was not abandoned, in fact. The Office regrets any inconvenience caused by this error.

The application file is being forwarded to the Technology Center support staff for processing of the RCE and amendment. Thereafter, the file will be forwarded to the examiner for consideration of applicant's response.

Josie A. Ballato
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 308-0269

UNITED STATES PATENT AND TRADEMARK OFFICE

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE, 10TH FLOOR
NEW YORK, NY 10151

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Hirokazu NAGASAWA ET AL | : | |
| Application No. 09/604,632 | : | DECISION GRANTING PETITION |
| Filed: June 27, 2000 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. 450100-02579 | : | |

This is a decision on the petition, filed June 1, 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**, *nunc pro tunc*.

It is noted that, although the petition to withdraw from issue had not been acted upon by the appropriate deciding official of the U.S. Patent and Trademark Office, the Technology Center processed the request for continued examination (RCE) under 37 CFR 1.114 and subsequently issued a new Notice of Allowance and Fee(s) Due and Notice of Allowability on August 16, 2005. Where an issue fee has been paid and an RCE is subsequently filed, the RCE is not a proper filing unless a petition to withdraw from issue has been granted. Therefore, the examiner was without authority to act further in the case absent a grantable petition withdrawing the application from issue. Nevertheless, in view of this decision on petition, the RCE is now considered a proper filing and the actions of the examiner taken thereafter are hereby ratified.

The issue fee in reply to the second Notice of Allowance and Fee(s) Due mailed August 16, 2005 was received on September 8, 2005. Accordingly, this matter is being referred to Publishing Division for processing into a patent.

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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MILES & STOCKBRIDGE PC
1751 PINNACLE DRIVE
SUITE 500
MCLEAN, VA 22102-3833

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Olivier Miakinen | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7653709 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/604,919 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/28/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **2638** 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.

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Paper No.

FITZPATRICK CELLA HARPER &
SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,862,106 | : | |
| Hiroshi Matsushima | : | |
| Issue Date: March 1, 2005 | : | DECISION ON |
| Application No. 09/604,980 | : | PETITION |
| Filed: June 28, 2000 | : | |
| Attorney Docket No. 35.G2609 | : | |
| | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)" filed April 29, 2005. Patentee requests that the patent term adjustment under 35 U.S.C. 154(b) indicated in the patent be corrected from eight hundred sixty-one (861) days to nine hundred thirty-nine (939) days.

The request for reconsideration of patent term adjustment is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of nine hundred thirty-nine **(939)** days.

On March 1, 2005, the application matured into U.S. Patent No. 6,862,106, with a revised patent term adjustment of 861 days. On April 29, 2005, patentee timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 939 days. Patentee disputes the reduction of 78 days associated with the filing of a supplemental oath or declaration after the mailing of the notice of allowance.

Patentee states that at the request of the Office they re-supplied a copy of the executed declaration, previously submitted on November 6, 2000 (before the mailing of the Notice of Allowance and within 3 months of the mailing of the Notice to File Missing Parts of Application).

Patentee's arguments and evidence have been considered, in light of the record, and found persuasive. Under the circumstances, it is concluded that the re-supplying of the executed declaration on December 14, 2004, did not constitute a failure to engage in reasonable efforts to conclude prosecution within the meaning of 37 CFR 1.704(c)(10).

In view thereof, the patent should have issued with a revised patent term adjustment of nine hundred thirty-nine (939) 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 file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by NINE HUNDRED THIRTY-NINE (939) days.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

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THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS, MO 63101

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OFFICE OF PETITIONS

In re Application of :
Cory O. Nykoluk :
Application No. 09/604,995 : ON PETITION
Filed: June 28, 2000 :
Attorney Docket No. 16513-2424 :

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.

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. However, in accordance with 37 CFR 1.34, the signature of Kirk Damman 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. If Mr. Damman desires to receive future correspondence regarding this application, an appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence will be directed solely to the address of record until otherwise instructed.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Telephone inquiries concerning this matter may be directed to Retta Williams at (703) 306-5594 or in my absence, Frances Hicks at (703) 305-8680.

This matter is being referred to Technology Center 3700, Art Unit 3727 for consideration of the Notice of Appeal and the Amendment after final.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Frances Hicks

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

cc: KIRK DAMMAN
LEWIS, RICE AND FINGERSH, L.C.
ATTN: BOX IP DEPT.
500 N. BROADWAY, SUITE 2000
ST. LOUIS, MO 63102-2147

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OIPE JC48 JAN 12 2004 PATENT & TRADEMARK OFFICE

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COOK, ALEX, McFARRON, MANZO, CUMMINGS & MEHLER

Paper No. 17

Mark J Murphy
Cook Alex Mcfarron Manzo
Cummings & Mehler LTD
200 West Adams St Suite 2850
Chicago, IL 60606

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In re Application of :
Takayama et al. :
Application No. 09/604,997 :
Filed: June 28, 2000 : DECISION ON PETITION
Attorney Docket No. SEL 193 :

This is a decision on the petition filed November 21, 2000 (and resubmitted on October 6, 2003), requesting that the above-identified application be accorded a filing date of June 28, 2000, rather than the presently accorded filing date of November 21, 2000.

Application papers in the above-identified application were deposited on June 28, 2000. However, on February 28, 2001, the Office of Initial Patent Examination mailed a "Notice of Incomplete Nonprovisional Application," for the purposes of this decision, notifying applicant that the application papers had not been accorded a filing date because the application was deposited without a specification including at least one claim as prescribed by 35 U.S.C. 112[1].

Petitioner maintains that the application-as-filed on June 28, 2000, included a specification with at least one claim. In support, the petition is accompanied by a copy of applicants' postcard receipt. On petition, petitioner submits the English translation, verification of translation and fee under §1.52(d); and an executed declaration.

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the Office of all items listed thereon on the date stamped thereon by the Office. See MPEP 503. A review of petitioner's postcard receipt reveals that the postcard does not contain the Office stamp which acknowledges receipt of the items listed on the postcard. Accordingly the postcard provided with the petition will not act as prima facie evidence.

However, the Office will accord a filing date to an application meeting the requirements of 35 USC 111(a), even though some or all of the application papers, including the written description and the claims, are in a language other than English and hence does not comply with 37 CFR 1.52. A review of the papers filed on June 28, 2000, reveals that the specification, including at

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[1] See 35 U.S.C. 111(a)(4).

least one claim, was present in the USPTO on June 28, 2000, albeit in the copy of the priority application. Since the papers filed on June 28, 2000, included a specification with at least one claim , on petition, the papers may be accorded a filing date of **June 28, 2000**.

Accordingly, the petition is **GRANTED**.

However, the petition fee will not be refunded since special handling of this application was necessitated by the condition of the application as filed, wherein the application, as filed, was not in English. Petitioner indicates an English translation was filed with the initial disclosure, however there is evidence which suggest the translation and verification of translation were not filed prior to November 21, 2000, as the verification of translation contains the date of November 8, 2000.

The application is being forwarded to Office of Initial Patent Examination for correction of the filing date to June 28, 2000 and issuance of a Corrected Filing Receipt.

Thereafter the application will be forwarded to the Office of Publication for processing into a Patent

Telephone inquiries specific to this decision should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

OIPE JC48
JAN 12 2004
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COOK, ALEX, McFARRON,
MANZO, CUMMINGS & MEHLER

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OFFICIAL MAILROOM STAMP AFFIXED
HERETO, ACKNOWLEDGES RECEIPT OF:

ENCLOSURES:

(X) Application Patent
(X) Specification 44 pages - In Japanese (org.)
(X) Claims 4 pages
(X) Abstract 1 page(s)
(X) Drawing Sheets no. 23 (F) X (INF)
(X) Transmittal Letter: Divisional Apln.
(X) Check $ 834.00 No: 14677
(X) Declaration/Oath
( ) Assignment and Cover Sheet
(X) Information Disclosure Statement
(X) ~~Response~~/Amendment - Preliminary A + red-lined drawings
( ) Extension of Time (In Duplicate)
( ) Small Entity Status
( ) Copy of Priority Document
(X) Appointment of Associate Attorneys
(X) Substitute Specification; Marked-Up copy of Spec. & Verified Translation

PTO 03940 U.S.
10/672521
09/26/03

RE: APPLICATION ATTY/SEC: MJM/cn
File no: 0553-0193.01

Applicant: Toru TAKAYAMA et al

S.N.: Not Assigned Filing Date: Herewith

Title: Wiring Material, Semiconductor Device Provided with a Wiring Using the Wiring Material and Method of Manufacturing Thereof

Due date: ~~Date Sent~~: 9/26/2003

SEL
0553-0193.01
EDM/MJM

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Paper No. 8

DAVINCI-ONLINE(TM) BY THE PERSON OF
Y.F RAGOS
37 POSIDONOS ST VOULA
ATHENS, GR 16673
GREECE

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OFFICE OF PETITIONS

In re Application of :
Constantine N. Maris et al :
Application No. 09/605,066 : ON PETITION
Filed: June 28, 2000 :
Attorney Docket No. 102362-003 US B4 :

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MAY 20 2003
TECHNOLOGY CENTER 2800

This is a decision on the petition under 37 CFR 1.137(b), filed October 21, 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 to File Missing Parts of Application (Notice) mailed August 22, 2000. The Notice set a period for reply 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, the above-identified application became abandoned on October 23, 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

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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.

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

The application file is being forwarded to the Office of Initial Patent Examination.

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

cc: DAVY E. ZONERAICH
NORRIS MCLAUGHLIN AND MARCUS
P.O. BOX 1018
SOMERVILLE, NJ 08876

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 8

DAVINCI-ONLINE(TM) BY THE PERSON OF
Y.F RAGOS
37 POSIDONOS ST VOULA
ATHENS, GR 16673
GREECE

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FEB 14 2003

OFFICE OF PETITIONS

In re Application of :
Constantine N. Maris et al :
Application No. 09/605,066 : ON PETITION
Filed: June 28, 2000 :
Attorney Docket No. 102362-003 US B4 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 21, 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 to File Missing Parts of Application (Notice) mailed August 22, 2000. The Notice set a period for reply 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, the above-identified application became abandoned on October 23, 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.

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

The application file is being forwarded to the Office of Initial Patent Examination.

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

cc: DAVY E. ZONERAICH
NORRIS MCLAUGHLIN AND MARCUS
P.O. BOX 1018
SOMERVILLE, NJ 08876

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 9

KNOBBE MARTENS OLSON & BEAR LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH, CA 92660

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DEC 17 2001

OFFICE OF PETITIONS

In re Application :
R.C. Quijano et al. :
Application No. 09/605,118 : LETTER
Filed: June 28, 2000 :
Attorney Docket No. P-10220.01 :

This is in response to the paper filed November 2, 2001 under 37 CFR 1.28(b) requesting that status as a Small Entity be removed.

In accordance with the November 2, 2001 request, status as a Small Entity has been removed.

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 file is being forwarded to Technology Center 3700.

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

cc:

Mueting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458-1415

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Paper No. 10

KNOBBE MARTENS OLSON & BEAR LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH, CA 92660

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DEC 17 2001

OFFICE OF PETITIONS

ON PETITION

In re Application of :
R.C. Quijano et al. :
Application No. 09/605,115 :
Filed: June 28, 2000 :
Attorney Docket No. P-10220.01 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 2, 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 January 23, 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 April 24, 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.

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

cc:

Mueting, Raasch & Gebhardt, P.A.
P.O. Box 581415
Minneapolis, MN 55458-1415

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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OIW Jun-05

MEDTRONIC, INC.
710 MEDTRONIC PARKWAY NE
MS-LC340
MINNEAPOLIS MN 55432-5604

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**JUN 0 6 2005**

**OFFICE OF PETITIONS**

In re Application of :
Quijano et al. :
Application No. 09/605,118 : DECISION ON PETITION
Filed: 28 June, 2000 :
Atty Docket No. P-10220.01 :

This is a decision on the petition filed on 4 May, 2005, under 37 CFR 1.137(b)[1], to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 19 November, 2004, for failure to file a proper reply to the final Office action mailed on 18 August, 2004, which set a three (3) month shortened statutory period for reply. On 18 November, 2004, petitioners filed an amendment after final rejection. The amendment did not place the case in *prima facie* condition for allowance, however,

[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 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 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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and petitioners were so notified in the Notice of Abandonment mailed on 4 March, 2005.

Petitioners have filed a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

The statement contained in the instant petition does not set forth that the entire delay from the due date of the required reply to the date of the filing of a grantable petition was unintentional as required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition is being so construed. Petitioner **must** notify the Office if this is not a correct interpretation.

As the three (3) month extension of time received on 4 May, 2005, was filed outside of the extendable period for reply to the Notice mailed on 18 August, 2004, this extension of time is unnecessary and will be credited to counsel's deposit account, No. 13-2546, as authorized on the fee transmittal sheet filed with the present petition.

This application is being referred to Technology Center Art Unit 3738 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

Copied from 10605118 on 06/08/2005

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TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

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SEP 0 7 2004

OFFICE OF PETITIONS

In re Application of
Jung et al.
Application No. 09/605,206
Filed: June 27, 2000
Attorney Docket No. 000939-046610US

LETTER REGARDING
PATENT TERM ADJUSTMENT

This letter is in response to the "COMMENT ON PATENT TERM ADJUSTMENT DETERMINATION," filed March 1, 2003, notifying the Office of an error in Applicants' favor in the initial determination of patent term adjustment under 35 U.S.C. § 154(b). Applicants state that the patent term adjustment to date is zero (0) days, not thirty-six (36) days.

The request for correction of the initial determination of patent term adjustment (PTA) is **granted**. The determination of PTA at the time of the mailing of the Notice of Allowance is ZERO (0) days.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment determination at the time of the mailing of the Notice of Allowance was ZERO (0) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On December 10, 2003, 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 to date is thirty-six (36) days.

The Office initially determined a patent term adjustment of 36 days based on an adjustment for PTO delay of fifty-nine (59) days and sixteen (16) days (for a total PTO delay of seventy-five (75) days), both pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. 1.703(a)(2), reduced by Applicants' delay of thirty-nine (39) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b).

The PTO delay of 75 days has been found to be incorrect.

Furthermore, a review of the application file reveals that Applicants incurred additional delay.

The PTO delay of 59 days for the mailing of a non-final Office action on December 5, 2002 has been found to be incorrect. The application file reveals that a Request for Continued Examination (RCE) was filed on September 20, 2002. As the December 5, 2002 Office action was timely mailed pursuant to 37 C.F.R. §1.702(a)(2), no PTO delay should have been assessed.

The PTO delay of 16 days for the mailing of a Notice of Allowance on December 10, 2003 has also been found to be incorrect. The application file reveals that an Amendment was filed on October 3, 2003. As the December 10, 2003 Notice of Allowance was timely mailed pursuant to 37 C.F.R. §1.702(a)(2), no PTO delay should have been assessed.

In addition to Applicants' delay of 39 days, a review of the application file reveals additional delay of one hundred forty-nine (149) days. A final Office action was mailed on March 22, 2002. On September 20, 2002, Applicants filed an RCE. As this reply was not filed within the three-month period under 37 C.F.R. § 1.704(b), Applicants should have been assessed a delay of ninety (90) days.

Furthermore, a review of the application file reveals that a final Office action was mailed on May 6, 2003. On October 3, 2003, Applicants filed an Amendment that place the application in condition for allowance. As this Amendment was not filed within the three-month period under 37 C.F.R. § 1.704(b), Applicants should have been assessed a delay of fifty-nine (59) days.

In view thereof, the correct determination of PTA at the time of the mailing of the Notice of Allowance is ZERO (0) days (including 188 days (39 + 90 + 59) of applicant delay).

To the extent that this letter was submitted to advise the Office of an error in Applicants' favor, the Office will not assess the $200.00 application fee under 37 C.F.R. § 1.705(b). The Office thanks Applicants for their good faith and candor in bringing this matter to the attention of the Office.

The application file is being forwarded to the Office of Patent Publication for timely issuance of the patent.

Telephone inquiries specific to this letter should be directed to Cliff Congo, Petitions Attorney, at (703) 305-0272.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of adjusted PAIR calculation

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 11

KNOBBE, MARTENS, OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

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NOV 0 5 2002

OFFICE OF PETITIONS

In re Application of
Chen-Fa Hsieh
Application No. 09/605,282
Filed: June 28, 2000
Attorney Docket No. AMPCO.165A

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 29, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely respond to a non-final Office action mailed December 6, 2000. A Notice of Abandonment was mailed July 3, 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. While the statement contained in the instant petition varies from the language required by 37 CFR1.137(b)(3), the statement 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.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-9220.

The revocation and power of attorney filed October 29, 2002, has been accepted.

The application file is being forwarded to Technology Center AU 2362 for further prosecution, including treatment of the Petition to Make Special filed October 29, 2002.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Paper No. 12

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE CA 92614

MAIL

DEC 1 0 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re application of: )
Chen-Fa Hsieh )
Serial Number: 09/605,282 )
Filed: June 28, 2000 )
For: DECORATIVE ALERT SYSTEM

DECISION ON PETITION

This is a decision on the petition filed October 29, 2002 under 37 C.F.R. 1.102(d), to make the above-identified application special.

A grantable petition under 37 CFR 1.102(d) and MPEP 708.02, section II: Infringement, must be accompanied by the required fee and a statement alleging:

(1) that there is an infringing device or product actually on the market or method in use;

(2) that a rigid comparison of the alleged infringing device, product, or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and

(3) that he or she has made or caused to be made a careful and thorough search of the prior art or has a good knowledge of the pertinent prior art. Further, Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

The above requirements are met and therefore the petition is **GRANTED**.

The application will maintain its special status throughout its entire course of prosecution at the Patent and Trademark Office, including appeal, if any to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant.

The application is being forwarded to the examiner for expedited prosecution.

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

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MACPHERSON KWOK CHEN & HEID, LLP
1762 TECHNOLOGY DRIVE, SUITE 226
SAN JOSE, CA 95110

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FEB 10 2006

OFFICE OF PETITIONS

In re Application of :
Pamela R. Lipson, et. al. :
Application No. 09/605,289 : ON PETITION
Filed: June 28, 2000 :
Attorney Docket No. M-15704 US :

This is a decision on the petition under 37 CFR 1.137(b), filed February 22, 2005, to revive the above-identified application. The delay in responding is hereby regretted.

The application became abandoned for failure to reply to the non-final Office action mailed February 19, 2004.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay. Therefore, the petition is **GRANTED**.

The Revocation of Power of Attorney filed January 3, 2005, has been accepted and made of record.

The application file is being referred to Technology Center Art Unit 2625, for review of the amendment filed with the instant petition.

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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**DARBY & DARBY PC**
**805 THIRD AVENUE**
**NEW YORK, NY 10022**

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**OFFICE OF PETITIONS**

In re Patent No. 7,120,568 :
Application No. 09/605,334 :
Filed: June 27, 2000 : ON PETITION
Issued: October 10, 2006 :
Attorney Docket No. 6727/0H560 :

This is a decision on the petition filed October 26, 2006, which is being treated as a request under 37 CFR 3.81(b)[1] to include an omitted assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

The patent file is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to Petitions Examiner Liana Walsh at (571) 272-3206. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Frances Hicks
Petitions Examiner
Office of Petitions

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

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JUN 1 6 2003

Paper No. 5

**Technology Center 2100**

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, VA 22209

In re Application of: James L. Jason, JR. et al. )
Application No. 09/605,361 ) **DECISION ON REQUEST FOR**
Filed: June 29, 2000 ) **WITHDRAWAL AS ATTORNEY**
For: COMMUNICATION SYSTEM )
INCLUDING A SECURITY SYSTEM )

This is a decision on the Request To Withdraw from Representation filed June 9, 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.

Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture and Software
(703) 305-9750

cc: Blakely, Sokoloff, Taylor & Zafman LLP
c/o Grace Abercrombie
1279 Oakmead Parkway
Sunnyvale, CA 94086

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

August 20, 2002

Charles R. Watts
Wenderoth, Lind & Ponack
2033 K ST., N. W., Suite 800
Washington, DC 20006-1021

In re application of:
Jean-Francois Delmas et al DECISION ON PETITION
Serial No.: 09/605,390
Filed: June 28, 2000
For: RECTROREFLECTING METROLOGY
TARGET MARKER DEVICE

This is a decision on the petition received on May 31, 2002, 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 28, 2000. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned October 31, 2000. A notice of abandonment was mailed on May 15, 2002.

On May 31, 2002, the office received a communication from the attorney of record. Enclosed was an acknowledgment that the attorney never received the Notice to File Missing Part mailed August 28, 2000.

The evidence submitted is sufficient to establish that the petitioners never received the Notice to File Missing Parts of Application mailed August 28, 2000.

The petition is hereby GRANTED.

The application has been completed for release to Technology Center 2877

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

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination.

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Paper No. 7

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MAY 09 2005

OFFICE OF PETITIONS

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

In re Application of :
Ali, et al. : DECISION ON PETITION
Application No. 09/605,421 :
Filed: June 27, 2000 :
Docket No.: 1.054US :

This is a decision on the petition under 37 CFR 1.137(a), filed December 17, 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 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(a)." This is not a final agency decision.

This application became abandoned December 30, 2003 for failure to timely reply to the Office communication mailed October 29, 2003. The Office communication set a two (2) month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136 were timely requested. Notice of Abandonment was mailed September 27, 2004.

A grantable 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 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 as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The present petition fails to satisfy requirement (3) set forth above. 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 CFR 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 CFR 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 (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). 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 USPQ2d 1130 (N.D. Ind. 1987).

Petitioners attribute the delay in timely responding to the Office communication to non-receipt of the Office communication. Petitioners argue that upon request, they received a copy of the Office communication from the examiner of record. Petitioners argue that the copy of the Office communication that they received bears an Office receipt stamp. Petitioners argue that this is an indication that the Office communication was not received by petitioners because the Office communication was in fact returned to the Office and never delivered.

Petitioners' arguments have been considered, but are not found persuasive. The Office communication was properly mailed October 29, 2003 sent to the then correspondence address of record[1]. The Office communication, however, was returned by the United States Postal Service as **"NOT DELIVERABLE AS ADDRESSED, UNABLE TO FORWARD."**

Petitioner is advised that where an application becomes abandoned as a consequence of a change of correspondence address

[1] Paul Grandinetti, c/o Telogy Networks Inc., 20250 Century Boulevard, Germantown, MD 20874.

(the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply) an adequate showing of "unavoidable" delay will require a showing 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).

Any renewed petition must be accompanied by evidence that sufficiently establishes that the failure to timely reply to the Office communication was unavoidable.

**ALTERNATE VENUE**

Petitioners may wish 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: (703) 872-9306

By hand:

U.S. Patent and Trademark Office
Customer Window
Mail Stop Petition
Randolph Building
Dulany Street
Alexandria, VA 22314

The requested change of correspondence address submitted herewith has been entered into the record.

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

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

In re Application of :
Ali, et al. : DECISION ON PETITION
Application No.. 09/605,421 :
Filed: June 27, 2000 :
Docket No.: 1.054US :

This is a decision on the petition renewed under 37 CFR 1.137(b), filed July 11, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned December 30, 2003 for failure to timely reply to the Office communication mailed October 29, 2003. The Office communication set a two (2) month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136 were timely requested. Notice of Abandonment was mailed September 27, 2004. A petition under 37 CFR 1.137(a) was filed December 17, 2004 and dismissed May 9, 2005.

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 Office communication mailed October 29, 2003 is accepted as having been unintentionally delayed.

This application is being forwarded to Technology Center 2100 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
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Alexandria, VA 22313-1450
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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

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OFFICE OF PETITIONS

In re Application of :
Ali et al. :
Application No. 09/605,421 : ON PETITION
Filed: June 27, 2000 :
Attorney Docket Number: 1.054US :

This is a decision on the Petition for Revival of Abandoned Application under 37 CFR 1.137(b), filed March 14, 2006.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due, mailed December 7, 2005. The Notice set a non-extendable three (3) month period for reply. No reply having been received, the application became abandoned on March 8, 2006. The mailing of this Decision precedes the mailing of a Notice of Abandonment.

With the instant petition, Applicant has satisfied the requirements of a grantable petition under 37 CFR 1.137(a). The issue fee is filed with the instant petition. Accordingly, the petition is granted.

This application is being referred to Publishing Division for processing into a patent.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

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OFFICE OF PETITIONS

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

In re Application of :
Dowdal : DECISION ON PETITION
Application No. 09/605,422 :
For: June 27, 2000 :
Atty. Dkt. No.: 1.046US :

This is a decision on the "PETITION TO WITHDRAW ABANDONMENT," filed June 12, 2006.

This matter is being treated under 37 CFR 1.137(b) as a petition to revive for unintentional abandonment[1].

The petition under 37 CFR 1.137(b) 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 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 January 3, 2004 for failure to timely reply to the non-final Office action mailed October 2, 2004. The non-final Office action set a three month shortened statutory period of time for reply. No petition for extension of time was timely submitted. Notice of Abandonment was mailed December 13, 2004.

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

[1] The petition is not being treated under 37 CFR 1.181 (petition to withdraw the holding of abandonment) or 37 CFR 1.137(a) (petition to revive unavoidably abandoned application) as the petition is accompanied by no documentary evidence. The petition, however, does include a statement of unintentional abandonment. Therefore, the matter is being treated pursuant to 37 CFR 1.137(b), required fee having been charged to petitioner's deposit account.

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 fails to satisfy requirement (1) set forth above. A proper reply to the non-final Office action has not been submitted. The request for continued examination submitted herewith is improper as the instant application is not under final rejection. Any renewed petition must be accompanied by an appropriate reply.

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 in 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).

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.

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: U.S. Patent and Trademark Office
Customer Window
Mail Stop Petition
Randolph Building
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
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OFFICE OF PETITIONS

TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

In re Application of :
Dowdal : DECISION ON PETITION
Application No. 09/605,422 :
For: June 27, 2000 :
Atty. Dkt. No.: 1.046US :

This is a decision on the renewed petition under 37 CFR 1.137(b) filed July 24, 2006.

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

This application became abandoned January 3, 2004 for failure to timely reply to the non-final Office action mailed October 2, 2004. The non-final Office action set a three month shortened statutory period of time for reply. No petition for extension of time was timely submitted. Notice of Abandonment was mailed December 13, 2004. A petition under 37 CFR 1.137(b) was filed June 12, 2006 and dismissed July 6, 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 non-final Office action is accepted as having been unintentionally delayed.

This application is being directed to Technology Center 2600 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

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**SONNENSCHEIN NATH & ROSENTHAL LLP**
**P.O. BOX 061080**
**WACKER DRIVE STATION, SEARS TOWER**
**CHICAGO IL 60606-1080**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Yamagishi et al. | : | |
| Application No. 09/605,461 | : | DECISION ON PETITION |
| Filed: June 28, 2000 | : | |
| Patent No.7,328,402 | : | |
| Issued: February 5, 2008 | : | |
| Attorney Docket No. SUGI-T0730 | : | |

This is a decision on the request under 37 CFR 3.81(b)[1] filed March 4, 2008 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 indicates that the correct assignees are Sony Corporation, Tokyo, Japan and Matsushita Electric Industrial Co., Ltd., Osaka, Japan, rather than Sony Corporation, Tokyo, Japan and Information Broadcasting Laboratories, Inc., Tokyo, Japan as is printed on the front page of the patent. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct assignees on the front page of the Letters Patent in the patent to be issued from the application.

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.

---

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

The request was accompanied by a certificate of correction (and fee) as required by 3.81(b). Further, Office assignment records reflect that Sony Corporation and Matsushita Electric Industrial Co., Ltd. are the assignees of record, which assignments were submitted for recordation as set forth in § 3.11 before issuance of the patent. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to be processed after issuance of this application into a patent.

Also, the processing fee set forth in § 1.17(i) ($130.00) has been charged to Deposit Account No. 19-3140 as authorized in the petition.

Telephone inquiries concerning this decision should be directed to Christopher Bottorff at (571) 272-6692. 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.

Christopher Bottorff
Petitions Examiner
Office of Petitions

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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

In re Application of :
Timothy M. Schmidl et al. :
Application No. 09/605,610 : DECISION ON PETITION UNDER
Filed: June 28, 2000 : 37 C.F.R. §1.137(B)
Attorney Docket Number: TI-29425 :
Title: WIRELESS COMMUNICATIONS SYSTEM WITH CYCLING OF UNIQUE CELL BIT SEQUENCES IN STATION COMMUNICATIONS :

This is a decision on the petition filed August 25, 2006, 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 February 8, 2006, which set a shortened statutory period for reply of three months. An after-final amendment was received on July 13, 2006, along with a three-month extension of time, and an advisory action was mailed on July 28, 2006. No further extensions of time under the

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.

provisions of 37 C.F.R §1.136(a) were available, and no further responses were received. Accordingly, the above-identified application became abandoned on August 9, 2006.

With the present petition, Petitioner has submitted a second after-final amendment, the petition fee, and the proper statement of unintentional delay.

Petitioner has met requirements (2) and (3) of 37 C.F.R. §1.137(b). A terminal disclaimer is not required.

Regarding the first requirement, Petitioner must submit the required reply to the Office action. The required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed[2]. In order for the application to be revived, petitioner must submit a reply which satisfies 37 C.F.R. §1.137(b)(1) (i.e., a Notice of Appeal and fee required by law; an amendment that prima facie places the application in condition for allowance; a continuing application under 37 C.F.R. §1.53(b); a request for continuing examination under 37 C.F.R. §1.114, if applicable; or a 37 C.F.R. §1.129(a) submission, if applicable). An amendment was received along with the instant petition. This amendment was considered by the Examiner, but it failed to place the application in condition for allowance. A copy of the Examiner's Advisory Action has been enclosed.

Therefore, the petition must be **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(b)," and should include an acceptable submission. 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[3], hand-delivery[4], or facsimile[5].

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2 See M.P.E.P. 711.03(c).

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.

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

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

Encl. Examiner's Advisory Action

| **Advisory Action Before the Filing of an Appeal Brief** | **Application No.** 09/605,610 | **Applicant(s)** SCHMIDL ET AL. | |
|---|---|---|---|
| | **Examiner** Anh-Vu H. Ly | **Art Unit** 2616 | |

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

THE REPLY FILED 25 August 2006 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 Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: *5,10,25 and 30*.
   Claim(s) rejected: *1-4,6-9,11-24,26-29 and 31-56*.
   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: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE: does NOT place the application in condition for allowance because: The amendment after final dated August 25, 2006 does not place the application in condition for allowance. Claims 5, 10-16, 25, 33-36 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claims. However, claims 39-56 are rejected under 35 USC 102 (b) as being anticipated by SIlventoinen, M. et al (WO 98/07291). Applicant argues in pages 9 and 10 that Silventoinen does not disclose the training sequence uniquely distinguishes a first cell from a second cell adjacent to the first cell as required by claims 39 and 48. Examiner respectfully disagrees. First of all, the after final amendment dated July 13, 2006 did not get enter. Therefore, applicant's argument is not directed to the set of claims as currently examined.

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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

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JUL 13 2007

**OFFICE OF PETITIONS**

In re Application of :
Timothy M. Schmidl et al. :
Application No. 09/605,610 : DECISION ON RENEWED PETITION
Filed: June 28, 2000 : UNDER 37 C.F.R. §1.137(B)
Attorney Docket Number: TI-29425 :
Title: WIRELESS COMMUNICATIONS SYSTEM WITH CYCLING OF UNIQUE CELL BIT SEQUENCES IN STATION COMMUNICATIONS :

This is a decision on the renewed petition filed February 16, 2007, 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 February 8, 2006, which set a shortened statutory period for reply of three months. An after-final amendment was received on July 13, 2006, along with a three-month extension of time, and an advisory action was mailed on July 28, 2006. No further extensions of time under the

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.

provisions of 37 C.F.R §1.136(a) were available, and no further responses were received. Accordingly, the above-identified application became abandoned on August 9, 2006.

The original petition was filed on August 25, 2006, and was dismissed via the mailing of a decision on February 2, 2007.

With this renewed petition, Petitioner has included an amendment, a Notice of Appeal, and the associated fee.

This renewed petition is **GRANTED**.

The Notice of Appeal, filed on February 16, 2007, has been entered and made of record. Accordingly, **the two-month period for filing the Appeal Brief, in triplicate, accompanied by the fee required by law, runs from the mailing date of this decision.**

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.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[2]. 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 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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Wacker Drive Station - Sears Tower
Chicago IL 60606-1080

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OFFICE OF PETITIONS

In re Application of :
Yamagishi et al. :
Application No. 09/605,733 : DECISION ON PETITION
Filed: June 28, 2000 :
Attorney Docket No. 09794353-0013 :

This is a decision on the "Petition to Rescind Holding of Abandonment Pursuant to 37 CFR 1.181," filed December 20, 2005, and supplemented on March 2, 2006.

This application was held abandoned for failure to respond timely to the nonfinal Office action, mailed on November 12, 2003, which set a three-month shortened statutory period for reply. In the apparent absence of a timely filed response, the application was held abandoned on February 13, 2004. A Notice of Abandonment was mailed on June 10, 2004.

In the petition, petitioner asserted that the practitioner did not receive the nonfinal Office action because the USPTO did not enter the revocation and appointment of power of attorney and the change of correspondence address submitted on September 24, 2001. As a result of this error, the Office erroneously mailed the nonfinal Office action to an incorrect correspondence address.[1] Accordingly, petitioner requested that the Office withdraw the holding of abandonment, remail the nonfinal Office action, and restart the period for reply.

A review of the record indicates that petitioner filed an "Revocation and Power of Attorney," on September 24, 2001, which was signed by authorized persons to act on behalf of the assignee, and contained a revocation and appointment of power of attorney and a change of correspondence address. Unfortunately, the Office did not enter the "Revocation and Power of Attorney" of September 24,

[1] The record reveals that the nonfinal Office Action and the Notice of Abandonment were returned to the USPTO as undeliverable.

2001.[2] For this reason, the USPTO mailed the nonfinal Office action to an incorrect correspondence address.

In view of the above, the petition to withdraw the holding of abandonment is **granted**. The Notice of Abandonment was mailed in error and is hereby withdrawn. The application is restored to pending status. As the practitioner did not receive the original nonfinal Office Action of November 12, 2003, **Technology Center Art Unit 2177 shall re-mail the nonfinal Office Action and restart the period for response.**

This matter is being referred to Technology Center Art Unit 2177 for further action consistent with this decision.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosures: Notice of Acceptance of Power of Attorney and a Notice Regarding Change of Power of Attorney

[2] The Office has entered the Revocation and Power of Attorney and changed the correspondence address of record. A Notice of Acceptance of Power of Attorney and a Notice Regarding Change of Power of Attorney are enclosed with this decision.

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**OFFICE OF PETITIONS**

In re Application of
Yamagashi et al.
Application No. 09/605733
Filed: 06/28/2000
Attorney Docket Number:
09794353-0013

DECISION ON APPLICATION
FOR PATENT TERM ADJUSTMENT

This is a decision on the "Petition for Reconsideration of the Patent Term Adjustment Under 37 C.F.R. § 1.705(d)", filed October 1, 2007. The petition is properly treated under 37 CFR 1.705(b).

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is hereby **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 **seven hundred five (705) days**, including 766 days of Office delay. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 29, 2007, 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 0 days.

On October 1, 2007, applicant timely submitted the instant application for patent term adjustment[1]. Applicant requests that the Determination of Patent Term Adjustment be corrected from 0 days, as indicated on the Determination of PTA mailed June 29, 2007, to an adjustment of 1667 days.

Applicant requests review of the Determination of Patent Term Adjustment for PTO delay based upon the granting of the petition to withdraw the holding of abandonment. Applicant asserts that the non-final Office action mailed November 12, 2003, was not received by Applicant. Applicant states that a petition to withdraw the holding of abandonment was granted in a Decision mailed April 27, 2006, and the Office action was re-mailed on May 22, 2006, wherein

[1] PALM records show that the Issue Fee payment was received in the Office on October 1, 2007.

this Office re-set the period of reply. Applicant asserts that a timely reply to the office action, mailed May 22, 2006, was filed on August 22, 2006. As such, Applicant asserts that the period of delay of 962 days attributed to Applicant under 37 CFR 1.704(b) is in error and should be canceled.

Applicant does not dispute the period of delay of 61 days attributed to Applicant under 37 CFR 1.704(b), nor does Applicant dispute the period of delay of 766 days attributed to the Office under 37 CFR 1.703(a).

Applicant concludes that the period of delay, based upon the foregoing, should be (766 + 962 – 61) = 1667 days.

A review of Office records confirms that a petition to withdraw the holding of abandonment was granted in a Decision mailed April 27, 2006, and the Office action was re-mailed on May 22, 2006, wherein this Office re-set the period of reply. The reply to the Office action, mailed May 22, 2007, was filed on August 22, 2006.

It is specifically noted that the petition to withdraw the holding of abandonment was filed within two months from the date that it was determined that the application was abandoned. See § 1.704(c)(4).

Applicant's delay is calculated as **sixty-one (61)** days.

On Office Delay

Applicant calculates that PTO delay should include 962 days that were incorrectly attributed to the Applicant. Applicant calculates the patent term adjustment due to Office delay to include the 962 days incorrectly attributed to Applicant. Applicant is advised that removal of the 962 days of applicant delay completes the remedy available to Applicant. Applicant does not receive an additional 962 days of patent term for Office delay. This formulation would amount to Applicant receiving 962 days twice: once when removing the delay from the delay attributed to Applicant, and a second time for adding the delay by attributing the delay to the Office.

Applicant is further advised that the patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Conclusion

The correct patent term adjustment (PTA) under 37 CFR § 1.703(a)(1), and 37 CFR § 1.704(b), at the time of the allowance is seven hundred sixty-six (766) days of Office delay, minus sixty-one (61) days of Applicant delay, or **seven hundred five (705) days**. The Office will adjust the PAIR screen to reflect that the PTA determination at the time of mailing of the present Decision

reflects an adjustment of 705 days. A copy of the updated PAIR screen showing the correct determination is enclosed.

In view thereof, at the time of allowance, the application is entitled to an adjustment of 705 days.

The petition fee of $200.00 has been submitted with the instant petition.

The application is being forwarded to the Publications Division for issuance of a patent.

Telephone inquiries specific to this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Adjustment PAIR Calculations

Day : Thursday
Date: 3/13/2008

PALM INTRANET

Time: 14:48:37

| PTA Calculations for Application: 09/605733 | | | |
|---|---|---|---|
| Application Filing Date: | 06/28/2000 | PTO Delay (PTO): | 766 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 1023 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 705 |
| PTO Delay Adjustment: | 962 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 60 | 03/13/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | 962 | | |
| 53 | 06/29/2007 | MAIL NOTICE OF ALLOWANCE | | | |
| 52 | 06/26/2007 | ISSUE REVISION COMPLETED | | | |
| 51 | 06/26/2007 | DOCUMENT VERIFICATION | | | |
| 50 | 06/26/2007 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 49 | 06/24/2007 | NOTICE OF ALLOWABILITY | | | |
| 48 | 04/10/2007 | DATE FORWARDED TO EXAMINER | | | |
| 47 | 04/09/2007 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 46 | 04/10/2007 | DATE FORWARDED TO EXAMINER | | | |
| 45 | 04/09/2007 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 61 | 35 |
| 44 | 04/10/2007 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 43 | 04/09/2007 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 42 | 04/09/2007 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 41 | 03/21/2007 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 40 | 03/14/2007 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 39 | 02/13/2007 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 38 | 02/12/2007 | ADVISORY ACTION (PTOL-303) | | | |
| 37 | 02/07/2007 | DATE FORWARDED TO EXAMINER | | | |
| 36 | 02/02/2007 | AMENDMENT AFTER FINAL REJECTION | | | |
| 35 | 11/07/2006 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 34 | 11/06/2006 | FINAL REJECTION | | | |

| | | | | | |
|---|---|---|---|---|---|
| 33 | 08/22/2006 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 32 | 08/29/2006 | DATE FORWARDED TO EXAMINER | | | |
| 31 | 08/22/2006 | RESPONSE AFTER NON-FINAL ACTION | | 962 | 14 |
| 30 | 07/08/2006 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 29 | 05/22/2006 | MAIL NOTICE OF RESTARTED RESPONSE PERIOD | | | |
| 28 | 05/19/2006 | LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES) | | | |
| 27 | 05/18/2006 | MAIL NOTICE OF RESCINDED ABANDONMENT | | | |
| 26 | 05/18/2006 | NOTICE OF RESCINDED ABANDONMENT IN TCS | | | |
| 25 | 05/18/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 24 | 05/16/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 23 | 04/27/2006 | MAIL-PETITION TO REVIVE APPLICATION - GRANTED | | | |
| 22 | 04/26/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 21 | 04/26/2006 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 20 | 12/20/2005 | PETITION ENTERED | | | |
| 19 | 06/10/2004 | MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION | | | |
| 18 | 06/10/2004 | ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION | | | |
| 17 | 11/12/2003 | MAIL NOTICE OF RESTARTED RESPONSE PERIOD | | | |
| 15 | 11/10/2003 | LETTER RESTARTING PERIOD FOR RESPONSE (I.E. LETTER RE: REFERENCES) | | | |
| 14 | 10/03/2003 | MAIL NON-FINAL REJECTION | 766 | | -1 |
| 13 | 09/29/2003 | NON-FINAL REJECTION | | | |
| 12 | 09/04/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 11 | 07/15/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 10 | 01/21/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 9 | 05/24/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 8 | 06/28/2000 | REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED) | | | |
| 7 | 01/09/2001 | APPLICATION DISPATCHED FROM OIPE | | | |
| 6 | 12/18/2000 | APPLICATION IS NOW COMPLETE | | | |
| 5 | 12/15/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 4 | 09/27/2000 | NOTICE MAILED--APPLICATION INCOMPLETE-- | | | |

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|---|---|---|---|---|---|
| | | FILING DATE ASSIGNED | | | |
| 3 | 08/16/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 2 | 07/19/2000 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 06/28/2000 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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CHICAGO IL 60606-1080

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**MAR 26 2008**

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|---|---|---|
| In re Application of | : | |
| Yamagashi et al. | : | |
| Application No. 09/605733 | : | DECISION ON APPLICATION |
| Filed: 06/28/2000 | : | FOR PATENT TERM ADJUSTMENT |
| Attorney Docket Number: | : | |
| 09794353-0013 | : | |

This is a decision correcting a prior decision, mailed March 14, 2008, on the "Petition for Reconsideration of the Patent Term Adjustment Under 37 C.F.R. § 1.705(d)," filed October 1, 2007. The petition is properly treated under 37 CFR 1.705(b).

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is hereby **CORRECTED 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 **sixteen hundred sixty-seven (1667) days**, including 1728 days of Office delay. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 29, 2007, 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 0 days.

On October 1, 2007, Applicants timely submitted the instant application for patent term adjustment[1]. Applicants maintain that the period of adjustment pursuant to 37 CFR 1.702(a)(1) should be calculated based on the date of re-mailing of the non-final Office action. Applicants state that through no fault of the applicants the non-final Office action was not received.

The application history has been reviewed and it has been determined that the initial patent term adjustment for Office delay of 766 days is incorrect. The Office mailed an Office action under s35 U.S.C. 132 on October 3, 2003, fourteen months and 766 days after the date of filing of the application. However, the Office action was not mailed to the proper correspondence address of record due to Office error. The record supports a conclusion that the Office first mailed the

[1] PALM records show that the Issue Fee payment was received in the Office on October 1, 2007.

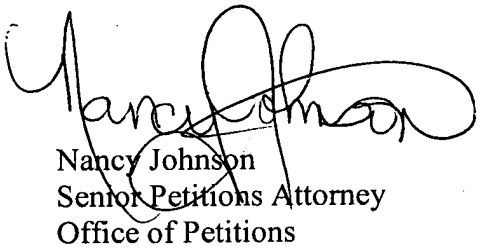
Office action by way of a letter restarting the period for reply to the correct address on May 22, 2006. (See PALM content records and applicant's response filed August 22, 2006). Accordingly, the Office's delay, pursuant to 37 CFR 1.703(a)(1), should be calculating using the May 22, 2006 date. Applicants are correct that the period of delay is 1728 days, counting the number of days in the period beginning fourteen months after the actual filing date of this application.

Submission of the $200.00 fee set forth in 37 CFR 1.18(e) on initial petition for reconsideration of patent term adjustment is acknowledged. No additional fee is required.

Applicants are reminded that any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. Further, in considering the overlap, the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). See 35 U.S.C. 154(b) (1)(B); 35 U.S.C. 154(b)(2)(A); and 37 CFR 1.703(f).

The Publishing Division has been advised of this decision. The application is, thereby, being forwarded to the Publishing Division for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Attorney Derek L. Woods at (571) 272-3232.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Adjustment PAIR Calculations

| PTA Calculations for Application: 09/605733 | | | |
|---|---|---|---|
| Application Filing Date: | 06/28/2000 | PTO Delay (PTO): | 766 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 1023 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1667 |
| PTO Delay Adjustment: | 1924 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 65 | 03/25/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | 1728 | | |
| 64 | 03/25/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | | 766 | |
| 61 | 03/14/2008 | RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE | | | |
| 60 | 03/13/2008 | ADJUSTMENT OF PTA CALCULATION BY PTO | 962 | | |
| 53 | 06/29/2007 | MAIL NOTICE OF ALLOWANCE | | | |
| 52 | 06/26/2007 | ISSUE REVISION COMPLETED | | | |
| 51 | 06/26/2007 | DOCUMENT VERIFICATION | | | |
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| 34 | 11/06/2006 | FINAL REJECTION | | | |
| 33 | 08/22/2006 | NEW OR ADDITIONAL DRAWING FILED | | | |
| 32 | 08/29/2006 | DATE FORWARDED TO EXAMINER | | | |
| 31 | 08/22/2006 | RESPONSE AFTER NON-FINAL ACTION | | 962 | 14 |
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| 25 | 05/18/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 24 | 05/16/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 23 | 04/27/2006 | MAIL-PETITION TO REVIVE APPLICATION - GRANTED | | | |
| 22 | 04/26/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
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| 10 | 01/21/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 9 | 05/24/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 8 | 06/28/2000 | REQUEST FOR FOREIGN PRIORITY (PRIORITY | | | |

| | | | | | |
|---|---|---|---|---|---|
| | | PAPERS MAY BE INCLUDED) | | | |
| 7 | 01/09/2001 | APPLICATION DISPATCHED FROM OIPE | | | |
| 6 | 12/18/2000 | APPLICATION IS NOW COMPLETE | | | |
| 5 | 12/15/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 4 | 09/27/2000 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 3 | 08/16/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 2 | 07/19/2000 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 06/28/2000 | INITIAL EXAM TEAM NN | | | |

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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JUN 3 0 2005

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Oleg B. Rashkovskiy, et al. :
Application No. 09/605,799 :
Filed: June 28, 2000 :
Attorney Docket No. INTL-0413-US (P8908) :

This is a decision on the petition under 37 CFR 1.137(b), filed March 17, 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 May 4, 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 August 5, 2004.

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 future correspondence solely to the address of record.

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; (3) the required statement of unintentional delay have been received. Accordingly, the petition filed March 17, 2005 is accepted as having been unintentionally delayed.

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 2616 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Paul A. Mendonsa
12400 Wilshire Boulevard, Seventh Floor
Los Angeles, CA 90025-1026

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JUN 15 2007

TECHNOLOGY CENTER 3600

Carson C.K. Fincham
Walker Digital Management, LLC
2 High Ridge Park
Stamford CT 06905

In re Application of
Jay S. Walker et al.
Application No. 09/605,818
Filed: June 28, 2000
For: SYSTEM FOR UTILIZING REDEMPTION INFORMATION

*On Petition to*
WITHDRAW SUPPLEMENTAL EXAMINER'S ANSWER
*under*
37 CFR 1.181

This is a decision on Appellant's Petition under 37 CFR 1.181 filed on December 18, 2006 to withdraw the Supplemental Examiner's Answer mailed November 28, 2006.

The petition is **DENIED**.

## Issues Raised on Petition and Relief Sought

The Petition alleges that the Examiner impermissibly filed the Supplemental Examiner's Answer mailed November 28, 2006 because such Supplemental Examiner's Answer was responding to "new arguments" rather than "new issues". The Petition argues that "new arguments" in a Reply Brief are insufficient to warrant the filing of a Supplemental Examiner's Answer and that the Reply Brief filed August 15, 2006 did not raise any "new issues". Petitioner cites 37 CFR 41.43(a)(1) and MPEP 1207.05(l) in support of this Petition. Petitioner seeks withdrawal of the Supplemental Examiner's Answer mailed November 28, 2006.

## History

Office action mailed September 13, 2005: The Examiner provided documentary evidence in the form of Lough, Kerch, and Broshy in support of items Officially Noticed in the Office action mailed April 6, 2005.

Appeal Brief filed March 9, 2006: Appellant alleged (at page 23) that the Examiner had misconstrued the phrase "comparable sales" in Lough (i.e. to include both properties that are for sale and properties that have already sold). To this end, Appellant argued that the term "sales" in Lough "refers to properties that are offered for sale, not those that have already sold" (emphasis added).

Examiner's Answer mailed June 15, 2006: The Examiner, in response to the Appeal Brief, responded to the allegation that he had misconstrued the phrase "comparable sales". To this end, the Examiner made statements (at page 6) which identified his own personal experience, and identified that he believed that his interpretation was consistent with what one of ordinary skill in the art would have interpreted the phrase "comparable sales" to have included.

Reply Brief filed August 15, 2006: Appellant, in response to the Examiner's Answer, alleged that the Examiner's statements had provided ambiguous rationale and had provided inadequate support in justifying that his interpretation of phrase "comparable sales" in Lough would have included both properties that are for sale and properties that have already sold. Further, Appellant questioned the source of the rationale as being derived from either or both of the Examiner's own knowledge and Official Notice of "comparable sales". In either case, Appellant requested clarification and evidence in support of such findings (by the provision of documentation and/or by Affidavit pursuant to 37 CFR. 1.04(d)(2)).

Supplemental Examiner's Answer mailed November 28, 2006: The Examiner, in response to the Reply Brief, provided clarification of his rationale and provided a definition of "comparables" from *Barrons Real Estate Guides, Dictionary or Real Estate Terms, second edition, 1987*) in support of his justification that his interpretation that the phrase "comparable sales" in Lough was consistent with what one of ordinary skill in the art would have interpreted the phrase "comparable sales" to have included.

## Authority

37 CFR 41.43 states, in part, that:

> "[T]he primary examiner...may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief" (emphasis added).

Additionally, MPEP 1207.05(I) states, in part, that:

> "The examiner cannot issue a supplemental examiner's answer if the reply brief raises no new issue" (emphasis added).

## Opinion

Although the Examiner characterized (at page 2) the filing of the Supplemental Examiner's Answer as being "compelled" due to the entry of a substantial number of "new arguments" in the Reply Brief, it is apparent that Appellant had directed such arguments to an issue first raised in the Reply Brief. That is, Appellant, in the Reply Brief has presented a new matter of dispute as to why the Board of Patent Appeals and Interferences should not sustain the Examiner's ultimate legal conclusion that the claims are unpatentable in view of Lough under 35 USC 103(a). This issue is not predicated

on the reason that the Examiner had misconstrued the meaning of the "phrase "comparable sales" in Lough (such as alleged in the Appeal Brief), but on the newly presented reasoning that the Examiner had not applied appropriate rationale in arriving at his interpretation of the phrase "comparable sales" in Lough and had not adequately justified the application of such interpretation.

Specifically, in the Reply Brief, Appellant alleged that although the Examiner had provided (in his Examiner's Answer) an indication that his interpretation of the phrase "comparable sales" included "sold properties" (at page 6), such interpretation, nonetheless, was considered inappropriate in application to the claimed subject matter because the Examiner had failed to demonstrate that he had applied an unambiguous rationale for arriving at his interpretation of such phrase and had failed to justify the application of his interpretation of the phrase "comparable sales" in Lough to the claimed subject matter.

This issue, once raised, placed into dispute whether or not the Examiner had appropriately applied his interpretation of the phrase "comparable sales" in Lough to the claimed subject matter, and, consequently, placed into dispute his ultimate legal conclusion that the claims are unpatentable in view of Lough under 35 USC 103(a).

The Examiner, in filing the Supplemental Examiner's Answer, has merely responded to this new issue by providing both his specific rationale for arriving at his interpretation of the phrase "comparable sales" in Lough and by justifying that his rationale was consistent with what one of ordinary skill in the art would have interpreted the phrase "comparable sales" in Lough to have included (citing *Barrons*, supra ).

Accordingly, the Examiner's filing of a Supplemental Examiner's Answer in this case is permissible pursuant to both to 37 CFR 41.43 (a) and MPEP 1207.05(I) inasmuch as the Reply Brief has raised a new issue and inasmuch as the Supplemental Examiner's Answer was in response to a new issue raised in the Reply Brief.

Summary

The Petition is DENIED and the application is being electronically forwarded to the Board of Patent Appeals and Interferences for consideration of the appeal.

Wynn Coggins, Director
Patent Technology Center 3600
Telephone No.: (571) 272-5350

wc/js: 05/21/2007

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

WALKER DIGITAL MANAGEMENT, LLC
2 HIGH RIDGE PARK
STAMFORD, CT 06905

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Jay S. Walker | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7627498 | : RECALCULATION of PATENT |
| **Issue Date** | : 12/01/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/605,818 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/28/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **2176** 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, D.C. 20231
www.uspto.gov

Paper No. 6

**Sughrue Mion Zinn MacPeak & Seas**
**2100 Pennsylvania Avenue, N.W.**
**Washington, D.C. 20037-3213**

COPY MAILED

OCT 25 2000

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
Christian Laroque et al. :
Application No. 09/605,881 : DECISION REFUSING STATUS
Filed: June 29, 2000 : UNDER 37 CFR 1.47(a)
For: Method of Monitoring the use of a :
Chargeable Dynamic Signaling Port of an
Inter-Exchange Trunk

This is in response to the petition under 37 CFR 1.47(a), filed September 21, 2000.

The petition is dismissed.

Rule 47 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 1.47(a)," and should only address the deficiencies noted below. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a). The reply to this decision may include an oath or declaration executed by the nonsigning inventor in compliance with 37 CFR 1.63.

The above-identified application was filed on June 29, 2000 without an oath or declaration and naming Christian Laroque and Lahcen Bennai as joint inventors.

Accordingly, on August 28, 2000, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and the $130 surcharge for its late filing.

In response, on September 21, 2000, petitioner submitted the instant petition and an authorization within the petition to charge the petition fee, a $130 surcharge, a declaration of facts in support of the petition, documented evidence in support of the petition, the last known address of the nonsigning inventor, and a declaration in compliance with 37 CFR 1.63 and 1.64 signed by joint inventor Lahcen Bennai, but not by joint inventor Christian Laroque.

The declaration of facts presented by Michèle Bruneel, an employee of Alcatel, states that she forwarded the Declaration and Power of Attorney relating to the above-identified application to Mr. Xavier De Fay of Alcatel Business Systems for execution by both inventors and the declaration was returned to her with only the signature of joint inventor Lahcen Bennai. Ms. Bruneel further states that, in an E-mail transmission forwarded to her by inventor Christian Laroque in which he referred to the above-identified application, Mr. Laroque indicated that he would not sign and return the Declaration and Power of Attorney for the instant application.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the nonsigning inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the nonsigning inventor. Applicant lacks items (1) set forth above.

Rule 47 applicant has failed to adequately show or provide proof that nonsigning inventor Christian Laroque has refused to sign the declaration after having been presented with the application papers (specification, claims and drawings). In this regard, no evidence has been presented showing that a copy of the complete application papers (specification, claims, and drawings) were in fact mailed and/or received by the nonsigning inventor prior to his statement of refusal. If in fact joint inventor Laroque was not presented with a copy of the complete application papers, then Mr. Laroque rightfully refused to execute the documents which he was requested to sign since he could not attest that he has "reviewed and understands the application papers." Petitioner should either demonstrate that a copy of the application papers was presented to Mr. Laroque but he did not respond to the request that he sign the oath or declaration or that Mr. Laroque refused to accept delivery of the application papers in order to show that he has refused to join in the application.[1] The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc. See MPEP 409.03(d).

**In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Latrice Bond.**

---

[1] The copies of Exhibits 1 and 2 supplied with the petition are not in the English language and therefore cannot serve as evidence in support of the petition to establish refusal of the nonsigning inventor to join in the application.

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 FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

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

Frances Hicks
Lead 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

COPY MAILED

FEB 12 2001

OFFICE OF PETITIONS
A/C PATENTS

Sughrue Mion Zinn MacPeak & Seas
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213

In re Application of
Christian Laroque
Application No. 09/605,881
Filed: June 29, 2000
For: Method of Monitoring the use of a Chargeable Dynamic Signaling Port of an Inter-Exchange Trunk

: DECISION ACCORDING STATUS
: UNDER 37 CFR 1.47(a)

This is in response to the renewed "Petition Under 37 CFR 1.47(a)," filed January 25, 2001, and supplemented on January 30, 2001.

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. Notice of the filing of this application will also be published in the Official Gazette.

After the mailing of this decision, the file will be forwarded to Office of Initial Patent Examination for preexamination processing.

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

Frances Hicks
Lead 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. 5

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

MAIL

JUL 11 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Dammann et al. :
Application No. 09/606,025 :
Filed: June 29, 2000 :
For: BUFFER ARRANGEMENT TO SUPPORT DIFFERENTIAL LINK DISTANCES AT FULL BANDWIDTH :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request to Withdraw as Attorney/Agent of record filed on June 23, 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.

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

All of the attorneys/agents listed in the request and those associated with Customer Number 20,457 are granted the request for withdrawal. All other attorneys remain of record. Furthermore, the Patent Office does not recognize the withdrawal of a firm.

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.

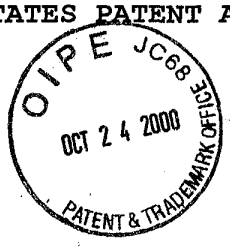
Kenneth Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: C/O ANNE RICHARDS
SCHWEGMAN, LUNDBERG, WOESSNER, & KLUTH PA
1600 TCF TOWER
121 S. 8TH STREET
MINNEAPOLIS, MN 55402

B3

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE




In re Application of

Hans SIGRIST et al.

Serial No.: 09/606,040

Filed: June 29, 2000

For: PROCESS FOR THE MODIFICATION OF SURFACES

SUBMISSION OF ORIGINAL EXECUTED DECLARATION

Commissioner for Patents
Box Missing Parts
Washington, D. C. 20231

Sir:

The above-identified application was duly filed on June 29, 2000 without an executed Declaration. Accordingly, submitted herewith are six (6) individually executed Declarations of the inventors. These six executed Declarations, taken together, constitute one document. Attached is our check for $1,080.00, which includes $130.00 to cover the payment of the fee in accordance with 37 CFR 1.16(e), $240.00 to cover the fee for recordation of the Assignment documents, and the remainder to cover the full filing fees.

Entry of these documents should complete all of the filing formalities and fully satisfy the Notice of Missing Parts mailed

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03 FC:126 240.00 OP

August 25, 2000. Accordingly examination and allowance of the application in due course are respectfully solicited.

All correspondence should be sent to applicants' representative at the address indicated below.

The Commissioner is hereby authorized to charge any additional fee (or credit any overpayment) associated with this communication to Deposit Account No. 16-0331. Two duplicate copies of this letter are attached.

Respectfully submitted,

PARKHURST & WENDEL, L.L.P.

October 24, 2000
Date

Roger W. Parkhurst
Registration No. 25,177

RWP/jck

Attorney Docket No. CSEM:060

PARKHURST & WENDEL, L.L.P.
1421 Prince Street, Suite 210
Alexandria, Virginia 22314-2805
Telephone: (703) 739-0220

(rev. 05/00)

PLEASE ACCEPT THIS AS
AUTHORIZATION TO DEBIT
OR CREDIT FEES TO
DEP. ACCT. 16-0331
PARKHURST & WENDEL

PT3

**FORMALITIES LETTER**

*OC000000005355175*

**UNITED STATES DEPARTMENT OF COMMERCE**
**Patent and Trademark Office**
Address: COMMISSIONER OF PATENT AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 09/606,040 | 06/29/2000 | Hans Sigrist | CSEM:060 |

Parkhurst & Wendel LLP
1421 Prince Street
Suite 210
Alexandria, VA 22314-2805

OIPE JC68 OCT 24 2000 PATENT & TRADEMARK OFFICE

Date Mailed: 08/25/2000

## NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

### FILED UNDER 37 CFR 1.53(b)

***Filing Date Granted***

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing.
  *Applicant must submit* **$ 690** *to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).*
- The oath or declaration is missing.
  *A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.*
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of $130 for a non-small entity, must be submitted with the missing items identified in this letter.
- **The balance due by applicant is $ 820.**

---

***A copy of this notice MUST be returned with the reply.***

W Meredith

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 2 - COPY TO BE RETURNED WITH RESPONSE

10/25/2000 HNGDR1 00000066 09606040

01 FC:101 710.00 OP
02 FC:105 130.00 OP

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. 18

Peggy A. Clarke
General Electric Company
Global Research
Patent Docket Rm. Bldg K1-4A59
Niskayuna, NY 12309

**MAILED**

JUL 2 6 2004

Technology Center 2100

In re Application of: Shah et al.
Application No. 09/606,093
Attorney Docket No. RD-27,075
Filed: June 27, 2000
For: METHOD AND SYSTEM FOR ENABLING TRAINING OF FIELD SERVICE PERSONNEL AND FIELD SERVICE OF MACHINES

**DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR §1.181**

This is a decision on the petition, filed June 18, 2004 requesting the Withdrawal of the Holding of Abandonment of the above-identified application. This application was held abandoned for failure to properly respond to the final rejection mailed July 14, 2003 (Paper No. 11). A Notice of Abandonment was mailed on June 1, 2004 (Paper No. 16).

In support of the petition, applicants' representative submitted a copy of the originally filed appeal brief along with a copy of a postcard receipt date stamped December 8, 2003. There is no evidence the appeal brief was filed in triplicate.

"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 items listed thereon on the date stamped thereon" (see MPEP § 503). Therefore, the evidence submitted is proof of timely filing.

The petition is **GRANTED**. The application was not abandoned, in fact. The Office regrets any inconvenience caused by the failure to match the papers to the application.

The application file is being forwarded to the Technology Center support staff for processing of applicants' appeal brief. Two additional copies of appellants' brief will be made prior to the application being forwarded to the examiner for consideration of the response. For future reference, petitioners are advised that 37 CFR 1.192 (a) requires the brief be filed in triplicate.

Josie A. Ballato
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 308-0269

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

**December 2, 2008**

**Optisec Ltd.**
**294 Dizengoff Street, POB 6622**
**Tel Aviv, Israel 61066**

Patent No.: 7,024,562 B1
Application No.: 09/606,331
Inventor(s): Yona Flink, et al.
Issued: April 4, 2006
Title: **METHOD FOR CARRYING OUT SECURE DIGITAL SIGNATURE AND SYSTEM THEREFOR**

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 matter, 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<br>Commissioner for Patents<br>Post Office Box 1450<br>Alexandria, VA 22313-1450 |
| By hand: | Customer Service Window<br>Mail Stop Petitions<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |
| By fax: | (571) 273-0025<br>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.

**Virginia Tolbert**
For Mary Diggs, Supervisor
Decisions & Certificate of Correction Branch
(703) 305-8309 or (703) **308-9390 ext 113**

vt

09/606331

eofc

OIPE IAP95
APR 08 2009
PATENT & TRADEMARK OFFICE

# OptiSec Ltd.

The Biometric Solutions Provider

Tel Aviv, Israel P.O.B 6622 T.A. 61066 Tel: 972 3 5445920 Fax: 972 3 6054103

March 23, 2009

To: The Certificate of Correction Branch
Commissioner for Patents
POB 1450
Alexandria, VA 22313-1450, U.S.A.

**Patent No. 7,024,562**

Inventor(s): Flink et al.

Issue date: Apr 4, 2006

Title: A METHOD FOR CARRYING OUT SECURE DIGITAL SIGNATURE AND A SYSTEM THEREFOR

**Request for Confirmation to Corrrect Error in Assignee's Name**

To Whom It May Concern:

I hope the information below and attached documents will be of assistance in confirming the error which occurred when recording the assignee's name with the USPO for Patent No 7,024,562 and which was also assigned incorrectly at the Israel Patent Office (ISO)

OptiSec resides in Israel and made the request to the ISO to correct an error in the assignee's name. Attached you will find a copy of the IPO having accepted the request to correct the incorrect assignee's name from OptiSec Technologies Ltd. to OptiSec Ltd. A translation of the Hebrew document is also attached with certification by a Notary Republic that the translation is an accurate translation of the original IPO document..

All requested payments have been made to the USPO and deposited by the USPO as requested.

Sincerely,

Yona Flink

CEO OptiSec Ltd.

yona@optisec-systems.com

LUZZATTO & LUZZATTO
PATENT ATTORNEYS
17 -02- 2009
RECE
רשות הפטנטים

מדינת ישראל
משרד המשפטים

RECORDED
483133

ישראל

פ.ק.17

# חוק הפטנטים, תשנ"ז - 1967

12 פברואר 2009

לכבוד:
לוצאטו את לוצאטו, עורכי פטנטים
ת.ד. 5352
**באר שבע** 84152

א.ג.נ.,

הנדון: **פטנט 137099**
סימ': מכתבכם מיום 2.2.09

הנני מאשר תיקון שם המבקשת מ

אופטיסק טכנולוגיות בע"מ

.OPTISEC TECHNOLOGIES LTD

ל

אופטיסק בע"מ

.OPTISEC LTD

בברכה,

גדעון כרס, עו"ד
עוזר סגן רשם הפטנטים

רח' הסדנא 4, תלפיות
ירושלים 93420

4 Hasadna Street, Talpiot
Jerusalem 93420

טל: 02-5651666
פקס: 02-5651764
Tel: 02-5651666
Fax: 02-5651764

מס' 36-2009

## CERTIFICATION OF TRANSLATION

## אישור תרגום

I, the undersigned, **Gila Orgal**, Adv.
Notary at 96 Yigal Alon Street, Tel Aviv
hereby declare that I am well acquainted with
the Hebrew and English languages and
that the document attached to this certification
marked "**A**" is,
a correct translation into English of the original
document,
drawn up in the Hebrew language, which has
been produced to me, and a photocopy of which
is also attached herewith and marked "**B**".
In witness whereof I certify the correctness of
the said translation by my signature and seal,
this day 23 March, 2009.

אני הח"מ **גילה אורגל** עו"ד
נוטריון ב רח' יגאל אלון 96 תל-אביב
מצהירה בזה, כי אני שולטת היטב בשפות
העברית ואנגלית וכי
המסמך המצורף לאישור זה והמסומן באות "**A**",
הוא תרגום מדויק לאנגלית של המסמך המקורי ,
הערוך בשפה העברית שהוצג לפני, ואשר העתק צילומי
שלו מצורף גם הוא לאישור זה
ומסומן באות "**B**".
ולראיה הנני מאשרת את דיוק התרגום האמור,
בחתימת ידי ובחותמי, היום 23.03.2009.

NIS 280 fees charged including VAT.

שכר בסך 280 ש"ח נדרש כולל מע"מ.

Signature _____

חתימה _____

Notary's Seal

חותם הנוטריון

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(Symbol)
THE STATE OF ISRAEL
MINISTRY OF JUSTICE

ISRAEL 60 (Symbol)

RECORDED
483133

(Symbol)
Patents Authority

**Patent Law, 5727 – 1967**

12th February 2009

To:
Luatzato and Luatzato, Editors of Patents
P.O. Box No. 5352
Beer Sheva 84152

Dear Sirs,

**Re: Patent 137099**
**Ref: Your letter dated 2.2.09**

I confirm the amendment of the name of the Applicant from:

Optisec Technologies Ltd.
OPTISEC TECHNOLGOEIS LTD.

to
Optisec Ltd.
OPTISEC LTD.

Sincerely yours,

Gideon Kerem, Adv.
Assistant to the Deputy of the Registrar of Patents

**4 Hasadna Street, Talpiot**
**Jerusalem**
**Tel: 02-5651666**
**Fax: 02-5651764**

LUZZATTO & LUZZATTO
PATENT ATTORNEYS
17 -02- 2009
RECEIVED

RECORDED
483133

מדינת ישראל
משרד המשפטים

רשות הסטנטים

פ.ק.17

# חוק הפטנטים, תשכ"ז - 1967

12 פברואר 2009

לכבוד:
לוצאטו את לוצאטו, עורכי פטנטים
ת.ד. 5352
באר שבע 84152

א.נ.,

הנדון: פטנט 137099
סימ' מכתבכם מיום 2.2.09

תנני מאשר תיקון שם המבקשת מ

אופטיסק טכנולוגיות בע"מ

OPTISEC TECHNOLOGIES LTD.

ל

אופטיסק בע"מ

OPTISEC LTD.

בברכה,

גדעון כרם, עו"ד
עוזר סגן רשם הפטנטים


4 Hasadna Street, Talpiot
Jerusalem 93420

רח' הסדנא 4, תלפיות
ירושלים 93420

Tel: 02-5651666 :טל
Fax: 02-5651764 :פקס

UNITED STATES PATENT AND TRADEMARK OFFICE

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MARSTELLER & ASSOCIATES
P O BOX 803302
DALLAS, TX 75380-3302

**MAILED**

MAY 13 2009

OFFICE OF PETITIONS

In re Patent No. 7,024,562 :
Issue Date: April 4, 2006 :
Application No. 09/606,331 : ON PETITION
Filed: June 29, 2000 :
Attorney Docket No. 33342 :

This is a decision in response to the petitions filed December 29, 2008, December 30, 2008, March 18, 2009 and April 10, 2009, which are collectively being treated as a petition under 37 CFR 3.81(b) to correct the name of the assignee on the front page of the above-identified patent by way of a certificate of correction.

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 petition is **DISMISSED**.

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.

Petitioner requests issuance of a certificate of correction to change the Assignee's name from -- Optisec Technologies Ltd.-- to "Optisec Ltd." However, a review of U.S. Patent and Trademark Office assignment records, including the details of the assignment records, show that Optisec Technologies Ltd was the assignee of record at the time of issuance of the application into a patent. In other words, Optisec Ltd. is not an assignee of record in this patent. Accordingly, a

certificate of correction to change the name of Optisec Technologies Ltd. on the front page of the patent would not be proper.

Telephone inquiries concerning this decision on petition should be directed to the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: OPTISEC LTD
TEL AVIV, ISRAEL
P.O.B 6622 T.A. 61066

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Paper No. 6

BEYER WEAVER & THOMAS LLP
P.O. BOX 778
BERKELEY CA 94704-0778

**MAIL**

DEC 04 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Scott S. Firestone
Application No.: 09/606,419
Filed: June 28, 2000
For: **MPEG FILE FORMAT OPTIMIZATION FOR STREAMING**

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed November 5, 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 signer of the petition, William J. Plut, is not appointed as an attorney or agent of record since the petitioner's limited recognition under 37 CFR 10.9(b) expired June 15, 2001.
For the above stated reasons, the request is **DISMISSED AS MOOT**.

All future communications from the Office will continue to be directed to the above-listed address unless the Office receives proper notification of a change in Power of Attorney and/or correspondence address.

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

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

WILLIAM B. KEZER
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111-3834

COPY MAILED

SEP 2 0 2002

OFFICE OF PETITIONS

In re Application of
Lawrence R. McGee et al
Application No. 09/606,433
Filed: June 28, 2000
Attorney Docket No. 18781-002710US

ON PETITION

This is a decision on the petition, filed by facsimile transmission on September 19, 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 August 6, 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.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 1625 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment and Information Disclosure Statement.

Frances Hicks
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 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

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

Paper No. 26

WILLIAM B. KEZER
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111-3834

COPY MAILED

AUG 0 8 2003

OFFICE OF PETITIONS

In re Application of
Lawrence R. McGee et al
Application No. 09/606,433
Filed: June 28, 2000
Attorney Docket No. 18781-002710US

DECISION GRANTING PETITION
UNDER 37 CFR 313(c)(2)

This is a decision on the petition, filed August 7, 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 January 29, 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) 305-8680.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 1625 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
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Alexandria, VA 22313-1450
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#32

WILLIAM B. KEZER
TOWNSEND AND TOWNSEND AND CREW LLP
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111-3834

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DEC 0 3 2004

OFFICE OF PETITIONS

In re Application of :
Lawrence R. McGee et al :
Application No. 09/606,433 : DECISION GRANTING PETITION
Filed: June 28, 2000 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 18781-002710US :

This is a decision on the petition, filed December 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 April 30, 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) 272-3218.

Upon receipt of the file in the Office of Petitions and association of the instant petition, RCE, IDS and decision on petition with the file, the file will be forwarded to Technology Center AU 1625 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently 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. 5

Penny R. Slicer
Stinson Mag & Fizzell
1201 Walnut Street, Suite 2800
PO Box 419251
Kansas City, MO 64141-6251

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OCT 0 6 2000

OFFICE OF PETITIONS
A/C PATENTS

In re Application of
Richard K. Ryan et al.
Application No. 09/606,495
Filed: June 29, 2000
For: Method for Managing a Financial Security

: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed June 29, 2000.

The petition is dismissed.

Rule 47 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 1.47(a)," and should only address the deficiencies noted below. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a). The reply to this decision may include an oath or declaration executed by the non-signing inventors in compliance with 37 CFR 1.63.

The above-identified application was filed on June 29, 2000 with a declaration in compliance with 37 CFR 1.63 and 1.64 and naming Richard K. Ryan, Brandt Thomas Brock, Gregory J. Garvin, Stephane Goyer, Brenda Marie Harwood, Amy Jo Lee, Mary Elaine Nestor and Karen S. Plush as joint inventors. The declaration is executed by joint inventors, Garvin, Goyer, Harwood, Lee, Nestor and Plush, but not executed by joint inventors Ryan and Brock. In addition, petitioner has submitted the instant petition and fee, the last known address of both non-signing inventors and affidavits of facts in support of the petition.

The affidavit of Mr. Roger Viola states that, on June 26, 2000, he contacted joint inventor Richard Ryan regarding execution of the application papers and declaration related to the above-identified application and Mr. Ryan expressly stated that he would not sign the application papers. Mr. Viola further states that, in view of Mr. Ryan's refusal, he would not forward copies

of the patent application to inventor Ryan before filing the patent application. Secondly, the affidavit of joint inventor Amy Jo Lee states that it is her understanding that, on June 23, 2000, Rebecca Wempe, an employee of Security Benefit Group, Inc. (SBGI), forwarded an e-mail version of the patent application to joint inventor Brandt Brock, the additional six joint inventors, and to herself. Ms. Lee further states that, on June 27, 2000, she met with joint inventor Brock and asked him to sign the application papers and he stated that he would not sign the application papers. Lastly, the affidavit of Annette Cripps, an Administrative Assistant for (SBGI), states that she presented joint inventor Brock with the declaration and assignment forms relating to the application and Mr. Brock refused to sign either form.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

As to item (1), Rule 47 applicant has failed to demonstrate that joint inventor Ryan was presented with a copy of the complete application papers (specification, claims, drawings) prior to his statement of refusal. If in fact joint inventor Ryan was not presented with a copy of the complete application papers, then Mr. Ryan rightfully refused to execute the documents which he was requested to sign since he could not attest that he has "reviewed and understands the application papers." Did inventor Ryan receive the application papers? Petitioner should either demonstrate that a copy of the application papers was presented to Mr. Ryan but he did not respond to the request that he sign the oath or declaration or that Mr. Ryan refused to accept delivery of the application papers in order to show that Mr. Ryan has refused to join in the application. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, copy of e-mail transmission, telegram, etc. See MPEP 409.03(d).

As to the statement by Amy Jo Lee that Rebecca Wempe, an employee of (SBGI), sent an e-mail version of the application to Mr. Brock, no documentary or tangible evidence has been presented showing that the application papers were received by e-mail transmission by Mr. Brock or that the e-mail version was actually sent to Mr. Brock. Also, no statement of facts has been presented by Rebecca Wempe, the person having firsthand knowledge of the e-mail transmission of the application papers to Mr. Brock. Therefore, as stated above, before a refusal can be alleged, it must be demonstrated that joint inventor Brock was presented with a copy of the application papers; otherwise, Mr. Brock could not attest that he has "reviewed and understands the application papers" which he was requested to

sign. As previously stated above, rule 47 applicant must demonstrate with documented evidence that inventor Brock refuses to join in the application after having been presented with the application papers. Proof of the pertinent events should be made in a statement by someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, copies of the e-mail notice sent to Mr. Brock, etc.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Latrice Bond.

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

| | |
|---|---|
| By mail: | Office of Petitions<br>Assistant Commissioner for Patents<br>Box DAC<br>Washington, D.C. 20231 |
| By FAX: | (703) 308-6916<br>Attn: Office of Petitions |
| By hand: | Office of Petitions<br>Crystal Plaza Four, Suite 3C23<br>2201 South Clark Place<br>Arlington, VA 22202 |

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

Frances Hicks
Lead 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. 8

Penny R. Slicer
Stinson Mag & Fizzell
1201 Walnut Street, Suite 2800
PO Box 419251
Kansas City, MO 64141-6251

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FEB 0 8 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
Richard K. Ryan et al. :
Application No. 09/606,495 : DECISION ACCORDING STATUS
Filed: June 29, 2000 : UNDER 37 CFR 1.47(a)
For: Method for Managing a Financial Security :

This is in response to the renewed "Petition Under 37 CFR 1.47(a)," filed December 11, 2000.

The petition is granted.

Petitioner has shown that the non-signing inventors have 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 inventorsat the address given in the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

After the mailing of this decision, the file will be forwarded to Office of Initial Patent Examination for preexamination processing.

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

Frances Hicks
Lead 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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FEB 0 8 2001

OFFICE OF PETITIONS
A/C PATENTS

Brandt T. Brock
6345 S. W. South Pointe Drive
Auburn, Kansas 66402

In re Application of
Richard K. Ryan, Brandt T. Brock, Gregory J. Garvin, Stephane Goyer, Brenda M. Harwood, Amy Jo Lee, Mary E. Nestor and Karen S. Plush
Aplication No. 09/606,495
Filed: June 29, 2000
For: Method for Managing a Financial Security

Dear Mr. Brock:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 118 (United States Code), and 37 CFR 1.47(a), Rules Practice in Patent Cases. Should a patent be granted on the application you will 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 patent thereof (at a prepaid cost per 37 CFR 1.19) or make your position or 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. Joining in 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 Latrice Bond at (703) 308-6911. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-6911. 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
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Penny R. Slicer
Stinson Mag & Fizzell
1201 Walnut Street, Suite 2800
PO Box 419251
Kansas City, MO 64141-6251

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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OFFICE OF PETITIONS
A/C PATENTS

Richard K. Ryan
260 W. 113th Street
Carbondale, Kansas 66414

In re Application of
Richard K. Ryan, Brandt T. Brock, Gregory J. Garvin, Stephane Goyer, Brenda M. Harwood, Amy Jo Lee, Mary E. Nestor and Karen S. Plush
Aplication No. 09/606,495
Filed: June 29, 2000
For: Method for Managing a Financial Security

Dear Mr. Ryan:

You are named as a joint inventor in the above identified United States patent application, filed under the provisions of 35 U.S.C. 118 (United States Code), and 37 CFR 1.47(a), Rules Practice in Patent Cases. Should a patent be granted on the application you will 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 patent thereof (at a prepaid cost per 37 CFR 1.19) or make your position or 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. Joining in 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 Latrice Bond at (703) 308-6911. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-6911. 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
Lead Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Penny R. Slicer
Stinson Mag & Fizzell
1201 Walnut Street, Suite 2800
PO Box 419251
Kansas City, MO 64141-6251

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: AUG 7 2001

Paper No. 5

| | | |
|---|---|---|
| In re Application of: | : | |
| Peter H. Seckel | : | |
| Serial No. 09/606,555 | : | DECISION ON |
| Filed: June 29, 2000 | : | PETITION TO MAKE SPECIAL |
| For: DOMED PACKING MATERIAL | : | UNDER 37 C.F.R. 1.102(c) |

This is a decision on the petition filed on July 05, 2001, under 37 C.F.R. 1.102(c) to make Special the above identified application because of the age of the applicant.

The petition is accompanied by a statement signed by Peter H. Seckel, in compliance with the requirements of Rule 37 C.F.R. 1.102(c). Accordingly, the petition is granted.

The petition is GRANTED.

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

Michael R. Friscia
Wolff & Samson
5 Becker Farm Road
Roseland, NJ 07068-1776

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

THE LAW OFFICES OF THOMAS L. ADAMS
120 EAGLE ROCK AVENUE
P.O. BOX 340
EAST HANOVER, NJ 07936

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SEP 0 3 2004

OFFICE OF PETITIONS

In re Application of :
Peter H. Seckel :
Application No. 09/606,555 : ON PETITION
Filed: June 29, 2000 :
Attorney Docket No. 7954/1 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 13, 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)**." 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 item (3).

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
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

**By facsimile:** (703) 872-9306
ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5684.[1]

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

[1] Effective September 27, 2004, the phone number will be 571-272-3210.

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

THE LAW OFFICES OF THOMAS L. ADAMS
120 EAGLE ROCK AVENUE
P.O. BOX 340
EAST HANOVER, NJ 07936

**COPY MAILED**

JUN 29 2005

**OFFICE OF PETITIONS**

In re Application of :
Peter H. Seckel :
Application No. 09/606,555 : ON PETITION
Filed: June 29, 2000 :
Attorney Docket No. 7954/1 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed September 21, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to the Publishing Division.

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

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

Reising Ethington Barnes Kisselle
Learman & McCulloch PC
P O Box 4390
Troy, MI 48099-4390

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Mark R. Johansen | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7600652 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/13/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/606,702 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/29/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1477** 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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 18

Kathleen Chapman
765 Greenville Road
Mason, NH 03048

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FEB 26 2004

OFFICE OF PETITIONS

In re Application of
Cheng, et al. :
Application No. 09/606,721 :
Filed: June 29, 2000 : ON PETITION
Attorney Docket No. CC8128-DR1B :

This is a decision on the petition filed October 20, 2003 and supplemented on October 28, 2003, which is being treated solely as a petition under 37 CFR 1.137(b), 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 4, 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 March 5, 2003.

The application file is being forwarded to Technology Center AU 3761 for further processing.

Telephone inquiries should 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

cc: Dishong Law Offices
40 Bryant Road
Jaffrey, NH 03452

UNITED STATES PATENT AND TRADEMARK OFFICE

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FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

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**APR 0 1 2005**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Lee | : | DECISION ON APPLICATION FOR |
| Application No. 09/606,804 | : | PATENT TERM ADJUSTMENT |
| Filed: June 28, 2000 | : | |
| Atty. Dkt. No.: 06666-040001 | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER" filed July 26, 2004.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is hereby **GRANTED**.

The Office will adjust the PAIR screen to reflect that the Patent Term Adjustment (PTA) determination at the time of mailing of the Notice of Allowance and Issue Fee Due reflects an adjustment of 337 days. A copy of the updated PAIR screen showing the correct determination is enclosed.

Applicant requests that the Determination of Patent Term Adjustment be corrected from 89 days as indicated on the Determination of Patent Term Adjustment mailed June 4, 2004 to an adjustment of 337 days.

Applicant argues that the application is entitled to an adjustment of 400 days for Office delays under 37 CFR 1.702(a)(1). Applicant further argues that the adjustment of 400 days should be reduced 63 days for applicant's failure to engage in reasonable efforts to conclude prosecution.

A review of the application history reveals under 37 CFR 1.702(a)(1), an adjustment of 400 days can be attributed to the Office for failure to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed[1]. In accordance with 37 CFR 1.703(a)(1),

[1] At the time of Determination of PTA, August 18, 2001, the date of mailing of Notice to Comply, was errantly entered as the date of mailing of first notification under 35 USC 132.

the delay began August 29, 2001, the day after the date that is fourteen months after the date on which the application was filed, and ending October 2, 2002, the date a restriction requirement was mailed.

The adjustment of 400 days is reduced 63 days under 37 CFR 1.704(b) for applicant's failure to reply within three months from the date the non-final Office action mailed on May 1, 2003. The reduction began August 2, 2003, the day after the date that is three months after the date of mailing of the non-final Office action, and ended October 3, 2003, the date a reply was submitted.

Thus, at the time of Allowance, the application was entitled to an adjustment of 337 days as argued by applicant.

Receipt of the required application fee of $200.00 is hereby acknowledged.

The application file is being forwarded to the Publications Division for issuance of a patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Adjustment PAIR Calculation

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COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Paper No. 7

ROSS D. SNYDER & ASSOCIATES, INC.
PO BOX 164075
AUSTIN, TX 78716-4075

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SEP 0 8 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| David W. Carr | : | |
| Application No. 09/606,860 | : | DECISION |
| Filed: June 28, 2000 | : | ON PETITION |
| Title of Invention: | : | |
| METHOD AND APPARATUS FOR PACKET REASSEMBLY IN A COMMUNICATIONSWITCH | : | |

This is a decision in response to the Petition Under 37 CFR § 1.137(b), filed August 1, 2005, 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 non-final Office action, mailed November 25, 2003. The Office action set a three (3) month period for reply. No extensions of time having been obtained under 37 CFR 1.136(a), this application became abandoned on February 26, 2004. A Notice of Abandonment was mailed on May 27, 2005.

With the instant petition, Applicant has filed a response to the November 25, 2003 Office action. Accordingly, the petition is granted.

This application is being referred to Technology Center Art Unit 2665 for processing of the Amendment, filed August 1, 2005, in due course.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/607,103 | 06/29/2000 | Hiroyasu Fujinaka | MAT-7985US | 8126 |

7590 08/23/2002

Ratner And Prestia
One Westlakes Berwyn Suite 301
P.O Box 980
Valley Forge, PA 19482-0980

| EXAMINER | |
|---|---|
| LAM, THANH | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2834 | |

DATE MAILED: 08/23/2002

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

In re Application of Fujinaka
Serial No.: 09/607,103
Filing Date: June 29, 2000
For: Motor Core and Motor Using the Same

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

This communication is in response to the letter received on May 9, 2002 in which applicant requests reconsideration of the Restriction Requirement dated October 3, 2001. Petitioner urges that the restriction requirement is improper and should be withdrawn. The Petition fee of $130 has been paid. No additional fees are required.

The petition is **granted**.

A review of the record reveals the following. The examiner required an Election of Species of the claimed invention in the Office action dated October 3, 2001. Upon review of the Office action, it has been determined that the species of the claimed invention had been improperly grouped. Therefore, the Election requirement is hereby withdrawn. The case will be forwarded to the examiner with instructions to issue a new Election of Species with the proper groupings. The Amendment filed May 9, 2002 has been entered.

Nestor R. Ramirez
Supervisory Patent Examiner
Art Unit 2834

NRR:nrr

Lawrence Ashery
Suite 301
One Westlakes, Berwyn
P.O. Box 980
Valley Forge, PA 19482-0980

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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**MICROSOFT CORPORATION**
**ONE MICROSOFT WAY**
**REDMOND WA 98052-6399**

MAILED

JUN 02 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bahl et al. | : | |
| Application No. 09/607,195 | : | DECISION ON PETITION |
| Filed: June 28, 2000 | : | |
| Attorney Docket No. 147649.01 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 13, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to reply in a proper and timely manner to the final Office action mailed July 8, 2005. A two-month extension of time under the provisions of 37 CFR 1.136(a) was timely obtained. Accordingly, this application became abandoned on December 9, 2005.

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 $790.00 and the submission required by 37 CFR 1.114; (2) the petition fee of $1,500.00; and (3) a proper statement of unintentional delay.

The instant application matured into Patent No. 7,571,308 on August 4, 2009. Accordingly, no further action is required.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski
Petitions Examiner
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. 12

William E. Vaughan
BELL, BOYD & LLOYD LLC
P.O. Box 1135
Chicago, Illinois 60690-1135

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JUL 1 2 2002

OFFICE OF PETITIONS

In re Application of :
Tetsujiro Kondo, et al. :
Application No. 09/607,205 : ON PETITION
Filed: June 29, 2000 :
Attorney Docket No. 112857-104 :

This is a decision on the petition under 37 CFR 1.137(b), filed on January 15, 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 14, 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 15, 2001.

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 2600, Art Unit 2613.

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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WASHINGTON, D.C. 20231
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Paper No. 9

**HILLARY W HAWKINS**
**NASA LANGLEY RESEARCH CENTER**
**MAIL STOP 212**
**3 LANGLEY BOULEVARD**
**HAMPTON, VA 23681-2199**

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DEC 1 1 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Erik J. Kielin et al :
Application No. 09/607,211 :
Filed: June 30, 2000 :
Attorney Docket No. LAR 15851-1-CU :

This is a decision on the petition under 37 CFR 1.182, filed September 9, 2002, 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. Erik J. Kielin
2. Billy T. Upchurch
3. David R. Schryer

A corrected filing receipt with the desired order of inventorship is enclosed.

The file is being forward to Technology Center AU 1754.

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

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

Enclosure: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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DEC 17 2007

OFFICE OF PETITIONS

DUNLAP CODDING & ROGERS, P.C.
PO BOX 16370
OKLAHOMA CITY OK 73113

In re Application of :
Freeny : DECISION ON PETITION
Application No. 09/607,227 :
Filed: June 30, 2000 :
Docket No.: 2551.042 :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed July 23, 2007.

The Notice of Abandonment mailed June 14, 2007 indicates that the instant application was held abandoned for failure to reply to an Office communication mailed October 5, 2005.

A review of the record reveals that a non-final Office action was mailed March 11, 2005. A response was filed September 12, 2005. An interview summary was mailed September 22, 2005. An advisory action was mailed October 5, 2005. Applicants submitted an interview summary October 20, 2005.

Accordingly, there was no Office action within the meaning of 35 USC 132 to which applicants failed to timely reply.

In view of the evidence thereof, the petition to withdraw the holding of abandonment is hereby **GRANTED**.

The Notice of Abandonment is hereby **VACATED** and the holding of abandonment is **WITHDRAWN**.

The correspondence address set forth in the petition differs from that contained in official USPTO records. If practitioner desires to receive correspondence at an address other than that contained in the official record, appropriate instruction and documentation to that effect should be submitted. The instant petition is being mailed to both addresses as a courtesy. However, all future correspondence concerning this application will be directed to the official contained in the record until appropriate instruction is received to the contrary.

The application file is being forwarded to the Technology Center 2100 for the mailing of an Office action in response to the reply filed September 12, 2005.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

CC: Marc A. Brockhaus
DUNLAP, CODDING & ROGERS
P.C. 1601 NW Expressway, Suite 1000
Oklahoma City, Oklahoma 73118

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 09162005 #23

Birch Stewart Kolasch & Birch LLP
P O Box 747
Falls Church VA 22040-0747

OCT 14 2005

In re Application of :
NAKAGAWA et al. : DECISION ON PETITION
Application No. 09/607,324 :
Filed: June 30, 2000 :
Attorney Docket No. 2927-0113P :

This is a decision on the petition filed September 3, 2003, requesting that the holding of abandonment in the above-identified application be withdrawn.

The petition to withdraw the holding of abandonment is GRANTED.

This application became abandoned for failure to timely respond to the final Office action mailed on January 29, 2003.

Petitioner asserts that a Reply After Final, a Petition for a Three-Month Extension of Time, a Notice of Appeal and the corresponding fees were timely filed on July 29, 2003 as evidenced by copies of the Reply After Final, the Petition for a Three-Month Extension of Time, the Notice of Appeal and the postcard receipt indicating receipt of all papers in the Patent and Trademark Office on July 29, 2003.

The review of the application file reveals that the Reply After Final, the Petition for a Three-Month Extension of Time and the Notice of Appeal were received but not matched with the file at the time the examiner held the application abandoned. A review of the PALM database reveals that the Three-Month Extension of Time and the Notice of Appeal fees were paid on July 30, 2003.

Consideration of proposed after final amendments are addressed in 37 CFR § 1.113, 37 CFR §1.116, and MPEP 714.13 reproduced, in part, below:

**37 CFR § 1.113 (c) states, in part, the following:**

"(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 CFR § 1.116 (b) and (c) state, in part, the following:**

"(b) ... amendments may be made canceling claims or complying with any requirement of form expressly set forth in a previous Office action. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, and amendment after a final rejection, a final action, an action closing prosecution, or any related proceedings will not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment..."

"(c) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented."

**Section 714.13 of the MPEP states, in part, the following:**

"An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal brief provided the total effect of the amendment is to (A) remove issues for appeal, and/or (B) adopt examiner suggestions."

* * *

"It should be noted that under 37 CFR 1.181(f), the filing of a 37 CFR 1.181 petition will not stay the period for reply to an examiner's action which may be running against an application. See MPEP § 1207 for appeal and post-appeal procedure."

Under current practice, the proposed Reply After Final amendment would be entered if it *prima facie* placed the application in condition for allowance. The examiner, after consideration, has determined that the proposed Reply After Final amendment would *prima facie* place the application in condition for allowance.

For the above reasons, the holding of abandonment for the above-identified application is withdrawn.

The application file is being forwarded to the technical support staff for processing the Reply After Final and the Notice of Appeal. From there, it will be returned to the examiner for further prosecution.

Inquiries regarding this decision should be directed to Jose' G. Dees at (571) 272-1569.

Howard N. Goldberg, Director
Technology Center 2800
Semiconductor, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 9

POULSEN ROSER PACIFIC, INC.
620 SOUTH FRONT STREET
CENTRAL POINT, OR 97502

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NOV 16 2004

**OFFICE OF PETITIONS**

In re Application of :
Pernille Olesen, et al :
Application No. 09/607,327 : ON PETITION
Filed: June 39, 2000 :
Attorney Docket No. None :

This is a decision on the petition to revive the above-identified application under the provisions of 37 CFR 1.137(b), filed September 10, 2004[1].

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. A Notice of Abandonment was mailed on April 4, 2002.

The above-identified application has been abandoned for an extended period of time. The U.S. 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). 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.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries regarding this application should be directed to the Technology Center.

The application file is being forwarded to Technology Center Art Unit 1661 for consideration of the amendment filed September 10, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] The petition filed September 10, 2004 was unsigned. However, a ratification of the unsigned petition was filed on November 12, 2004.

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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FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

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AUG 3 1 2009

OFFICE OF PETITIONS

In re Application of :
Michael J. Miller, et al. :
Application No. 09/670,505 : DECISION ON PETITION
Filed: September 26, 2000 : TO WITHDRAW
Attorney Docket No. 9145.0004-00 : 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 July 8, 2009.

The request is **NOT 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

The request cannot be approved because the practitioner(s) requesting the withdrawal have not certified that they have (1) deliver to the client or duly authorized representative of the client papers and property (including funds) to which the client is entitled; and (2) notified the client of any responses that may be due and the time frame within which the client must respond. The failure to do so may subject the practitioner to discipline. It is also noted that false certification may violate a practitioners' duty under 37 CFR 10.23(b)(4) and (b)(5).

All future communications from the Office will continue to be directed to the above-listed address until otherwise notified by applicant.

Telephone inquiries concerning this decision should be directed to undersigned at 571-272-1642.

All other inquiries concerning the examination or status of this application should be directed to the Technology Center.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

Attachment: Blank copy of PTOL/SB/83 Form

cc: HAYNES AND BOONE, LLP
IP SECTION
2323 VICTORY AVENUE
SUITE 700
DALLAS, TX 75219

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 23 2002

Paper NO. 11
UR

In re Application of
Shenheng Guan et al.
Serial Number: 09/607,535
Filed: June 29, 2000
For: METHOD FOR SCREENING CATALYSTS IN A PARALLEL FIXED BED REACTOR

DECISION ON PETITION UNDER M.P.E.P. 708.02, II

This is a decision on the Petition to Make Special because of Actual Infringement (37 C.F.R. 1.102 and MPEP 708.02) filed February 08, 2002, along with the requisite fee, in the above-noted application. The petition with the accompanying statement, meet the requirements of Section 708.02 (II) of the MPEP.

If the examiner finds any interfering application for the same subject matter, the examiner should consider such application simultaneously with this case and should state in the official letter of such application that the examiner is taking it out of its turn because of a possible interference.

Should an appeal be taken in this case or should this case become involved in an interference, consideration of the appeal and the interference will be expedited by Patent and Trademark Office Officials concerned, contingent likewise upon diligent prosecution by applicant.

After allowance, this case will be given priority for printing. See MPEP 1309.

The petition is GRANTED.

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

**Paul A. Stone Esq**
**Symyx Technologies Inc**
**3100 Central Expressway**
**Santa Clara, CA 95051**

FORM

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST. LOUIS MO 63102

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AUG 1 3 2004

OFFICE OF PETITIONS
ON PETITION

In re Application of :
Shenheng Guan et al :
Application No. 09/607,535 :
Filed: June 29, 2000 :
Attorney Docket No. 98-13DIB1 :

This is a decision on the petition, filed May 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 March 9, 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.

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

---

[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
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Paper No.

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ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Shenheng Guan et al :
Application No. 09/607,535 :
Filed: June 29, 2000 :
Attorney Docket No. 98-13DIV1 :

This is a decision on the petition, filed November 1, 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 30, 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 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

---

[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).

OIPE JC17
JUL 05 2002
TRADEMARK OFFICE

9200/2874

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| Applicant(s): | Stephen H. Houchen | | |
| Assignee: | Cisco Technology, Inc. | | |
| Title: | Protocol for Automatic Traffic Provisioning in 4-Fiber BLSR SONET Networks | | |
| Serial No.: | 09/607,593 | Filing Date: | June 30, 2000 |
| Examiner: | Unassigned | Group Art Unit: | 2874 |
| Docket No.: | CIS0070US (M-8343 US) | | |

Austin, Texas
June 26, 2002

BOX DAC
COMMISSIONER FOR PATENTS
Washington, D. C. 20231

**PETITION TO WITHDRAW HOLDING OF ABANDONMENT**

Dear Sir:

The above-identified application was held abandoned for failure to response to the Notice to File Missing Parts mailed October 6, 2000 which was purportedly due December 6, 2000. Pursuant to 37 C.F.R. § 1.181(a), Applicants respectfully petition the Commissioner to withdraw the holding of abandonment in the above-identified application, in light of the following points.

1. As of June 25, 2002, a Notice to File Missing Parts was never received.

2. The Notice of Abandonment bears a mailing date of May 30, 2002.

3. This Petition is filed within two months of the Notice of Abandonment mailing date. *See* 37 C.F.R. § 1.181(f). Because this Petition is filed timely, no terminal disclaimer is required. *See* MPEP 711.03(c).

4. Accordingly, applicants could not have responded to the Notice to File Missing Parts, having never received same. Applicants therefore respectfully request that the holding of abandonment be withdrawn and a Notice of Missing Parts be forwarded to Applicant's attorney, the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Box DAC, Commissioner for Patents, Washington, D.C. 20231, on June 26, 2002.

Attorney for Applicant(s) — Date of Signature: 6/26/02

Respectfully submitted,

Samuel G. Campbell III,
Attorney for Applicant(s)
Reg. No. 42,381
(512) 439-5084
(512) 439-5099 (fax)

OIPE IAP43
MAY 22 2006
PATENT & TRADEMARK OFFICE

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

April 3, 2003

Samuel G. Campbell III
Campbell Stephenson Ascolese
4807 Spicewood Springs Rd.
Bldg. 4, Suite 201
Austin, TX 78759

In re application of:
Stephen H. Houchen DECISION ON PETITION
Serial No.: 09/607,593
Filed: June 30, 2000
For: PROTOCOL FOR AUTOMATIC TRAFFIC PROVISIONING IN 4-FIBER BLSR SONET

This is a decision on the petition received on July 5, 2002, to withdraw the holding of abandonment in the above-identified application.

On January 28, 2003, the office received the requested docketing evidence to complete the petition.

The petition is hereby GRANTED.

A new Notice to File Missing Parts is enclosed with this Decision setting forth a new response period of two months from the date of the notice.

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

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

# Country Application



OIPE IAP43 MAY 22 2006 PATENT & TRADEMARK OFFICE

**Case Number:** CIS0070 **Country:** US **SubCase:**

**Client:** Cisco Systems, Inc. United States of America

**Case Type:** PRI **Application Status:** Pending

**Applic. Title:** **Protocol for Automatic Traffic Provisioning in 4-Fiber BLSR SONET Networks**

**Application Number:** 09/607593 **Filing Date:** 30-Jun-2000

**Publication Number:** **Publication Date:**

**Patent Number:** **Issue Date:**

**Parent/PCT Number:** **Parent/PCT Date :**

**Parent Issue Number:** **Parent Issue Date :**

**Agent:** **Expiration Date:**

**PTA:** 0

**Agent Reference No.:** **Tax Schedule:** LE

**Confirmation #:**

## List Of Actions

| Action(s) Due | Due Date | | Action Taken |
|---|---|---|---|
| Check Priority Claim | 30-Sep-2000 | Due Date | 30-Sep-2000 |
| Information Disclosure Stmnt | 30-Sep-2000 | Due Date | 19-Sep-2005 |
| Check Filing Receipt | 30-Oct-2000 | Due Date | 06-Oct-2000 |
| Check Recorded Assignment | 30-Jan-2001 | Due Date | 12-Nov-2003 |
| Foreign Filing Reminder | 28-Feb-2001 | Reminder | 26-Mar-2001 |
| Foreign Filing Reminder | 30-Apr-2001 | Reminder | 26-Mar-2001 |
| Foreign Filing Due Soon | 14-Jun-2001 | Due Date | 26-Mar-2001 |
| Foreign Filing Due | 30-Jun-2001 | Final | 26-Mar-2001 |
| IDS from Search Report | 14-Sep-2001 | Due Date | 26-Mar-2001 |
| Application Status Check | 30-Dec-2001 | Due Date | 09-Jan-2003 |
| Respond to Abandonment | 30-Jun-2002 | Due Date | 26-Jun-2002 |
| Notice of Aband Follow Up Date | 26-Dec-2002 | Due Date | 03-Apr-2003 |
| Decision on Petition | 03-Apr-2003 | Due Date | 03-Apr-2003 |
| Response Due | 03-Jun-2003 | Due Date | 30-May-2003 |
| 1st Extension | 03-Jul-2003 | Reminder | 30-May-2003 |
| 2nd Extension | 03-Aug-2003 | Reminder | 30-May-2003 |
| 3rd Extension | 03-Sep-2003 | Reminder | 30-May-2003 |
| 4th Extension | 03-Oct-2003 | Reminder | 30-May-2003 |
| Final Deadline | 03-Nov-2003 | Final | 30-May-2003 |
| Check Recorded Follow Up Date | 12-May-2004 | Due Date | 30-Apr-2004 |

**User ID:** vjuarez
**Date Created:** 26-Jun-2002
**Last Update:** 19-Aug-2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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SEP 25 2006

OFFICE OF PETITIONS

CAMPBELL STEPHENSON ASCOLESE, LLP
4807 SPICEWOOD SPRINGS RD.
BLDG. 4, SUITE 201
AUSTIN, TX 78759

In re Application of :
Houchen : DECISION ON PETITION
Application No. 09/607,593 :
Filed: June 30, 2000 :
Atty. Dkt. No.: CIS0070US :
:

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181 filed May 22, 2006.

The petition is hereby **GRANTED**.

This application was held abandoned December 8, 2004 for failure to timely submit a proper reply to the non-final Office action mailed September 7, 2004. The non-final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed September 15, 2005.

Petitioner alleges non-receipt of the non-final Office action, and attribute the non-receipt to the Office's failure to effect a change of correspondence address submitted subsequent to the mailing of the non-final Office action.

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), petitioner is 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).

Petitioners' arguments have been reviewed and found convincing. In view of the evidence presented, the Notice of Abandonment is hereby **VACATED** and the holding of abandonment is **WITHDRAWN**.

This application is being forwarded to Technology Center 2600 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

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12-20-06

TO SPE OF : ART UNIT 3635

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/607622 Patent No. 6298616

**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.

Should COFC be approved

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

E Young

Certificates of Correction Branch

703-308-9390 ext. 117

**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: _____

Carl D. Friedman
Supervisory Patent Examiner
Group 3600
SPE

3635
Art Unit

PTO/SB/44 (04-04)
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. : 6,298,616

DATED : October 9, 2001

INVENTOR(S) : Mitchell 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 8**
Line 36, after "overlaps" please insert --the--.

MAILING ADDRESS OF SENDER:

Dennis J. Dupray
SHERIDAN ROSS P.C.
1560 BROADWAY
SUITE 1200
DENVER, COLORADO 80202-5141

PATENT NO. 6,298,616

No. of additional copies

1

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.*

PTO/SB/44 (04-04)
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. : 6,298,616

DATED : October 9, 2001

INVENTOR(S) : Mitchell 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 8**
Line 36, after "overlaps" please insert --the--.

MAILING ADDRESS OF SENDER:

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SUITE 1200
DENVER, COLORADO 80202-5141

PATENT NO. 6,298,616

No. of additional copies

1

° 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

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Paper No. 14

**SILVERBROOK RESEARCH PTY LTD**
**393 DARLING STREET**
**BALMAIN 2041**
**AUSTRALIA**

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JUN 17 2004

OFFICE OF PETITIONS

In re Application of :
Lapstun et al. :
Application No. 09/607,656 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. NPA038US :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed May 17, 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 final Office action mailed December 20, 2002. A two-month extension of time under the provisions of 37 CFR 1.136(a) was obtained on April 23, 2003. Accordingly, this application became abandoned on May 21, 2003. A Notice of Abandonment was mailed on March 22, 2004.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

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 $110.00 extension of time fee submitted with the petition on May 17, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and a refund check will be mailed to petitioner.

The file is now being forwarded to Technology Center 2100 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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 PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 20231
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Paper No. 7

AUDLEY A. CIAMPEROCERO JR ESQ
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

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JAN 2 3 2003

OFFICE OF PETITIONS

In re Application of :
Andrew Lawrence Darrow et al :
Application No. 09/607,745 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. ORT1273 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 25, 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 to File Missing Parts of Application (Notice) mailed August 24, 2000. The Notice set a period for reply 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, the above-identified application became abandoned on October 25, 2000.

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 (703) 306-5684.

The application file is being forwarded to the Initial Patent Examination Unit.

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

cc:

Scott E. Scioli
Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia, PA 19103

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 2023
www.uspto.go

JJGJ.:05-03

Paper 7

JAN CAROL LITTLE
BLAKELY SOKOLOFF
TAYLOR & ZAFMAN LLP
SEVENTH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES CA 90025-1026

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MAY 0 7 2003

OFFICE OF PETITIONS

In re Application of
Parker, et al. :
Application No. 09/607,782 : ON PETITION
Filed: 30 June, 2000 :
Attorney Docket No.: 042390.P8837 :

This is a decision on the petition filed (with fee) on 17 December, 2001, and resubmitted via FAX on 8 January, 2002, under 37 C.F.R. §1.182[1] to change the name of name of the named inventor (Douglas Raymond Parker/Rachael Jade Parker).

The Office regrets the delay in addressing this matter.

For the reasons set forth below, the petition under 37 C.F.R. §1.182 is **GRANTED**.

In lieu of an affidavit of the inventor in question, signed by under both names, and stating, *inter alia*, that there was no deceptive intent in the submission of the name in the incomplete form, Petitioner has submitted with the instant petition a copy of the 2 May, 2001, Order of the Circuit Court of the State of Oregon, Washington County.

Petitioner is reminded to submit to the Assignment Division a corrected assignment document and cover sheet--as well as the appropriate fee--as set forth in 37 C.F.R. §1.21(h) for change of the assignment record.

Pursuant to Petitioner's authorization, the petition fee is being charged to Deposit Account 02-2666.

Consistent with the provisions of MPEP §605.04(c), the instant file is being forwarded to the

---

[1] The regulations at 37 C.F.R. §1.182 provide:
**§ 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).
[47 Fed. Reg. 41278, Sept. 17, 1982, effective date Oct. 1, 1982; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

Office of Initial Patent Examination for the change in the records of the Office of the name of the first-named inventor from Douglas Raymond Parker to Rachael Jade Parker, consistent with the Order of the 2 May, 2001, Order of the Circuit Court of the State of Oregon, Washington County, and issuance of a corrected filing receipt. Thereafter the file is to be forwarded for further examination in due course.

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

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
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Richard L Catania
Scully Scott Murphy & Presser
400 Garden City Plaza
Garden City, NY 11530

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JAN 31 2006

OFFICE OF PETITIONS

In re Application of Raghunath :
Application No. 09/607,801 :
Filing Date: June 30, 2000 :
Attorney Docket No. YOR920000238US1 :

Decision on Petition

This is a decision on the petition under 37 CFR 1.137(b), filed October 3, 2005, to revive the above-identified application.

The petition is **granted**.

Petitioner failed to take appropriate action in a timely manner after the decision of April 19, 2005, by the Board of Patent Appeals and Interferences. Therefore, the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(c). As no claim was allowed, the-above-identified proceedings were terminated as of June 20, 2005. See MPEP 1214.06.

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.

Technology Center Art Unit 2672 will be informed of the instant decision so that it may consider the RCE and other papers filed with the petition in due course.

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

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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TOWNSEND AND TOWNSEND AND CREW, LLP
TOW EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

MAILED

DEC 7 2004

Technology Center 2100

In re Application of: Yamamoto, et al.
Application No. 09/607,807
Filed: June 30, 2000
For: STORAGE SYSTEM CONNECTED TO A DATA NETWORK WITH DATA INTEGRITY

DECISION ON PETITION
TO WITHDRAW FROM ISSUE
UNDER 37 C.F.R. §1.313(a)

This is a response to the petition filed November 26, 2004, under 37 C.F.R. §1.313(a) to withdraw the application no. 09/607,807 from issue. Applicant is seeking to withdraw the application from issue based on non-consideration of an IDS filed May 10, 2004. A review of the application file shows the examiner has considered the IDS and mailed a copy of the IDS along with a supplemental notice of allowance on December 1, 2004. Based on the above, the petition is **DISMISSED** as moot.

Applicant is respectfully reminded that no extension of time can be granted for paying the issue fee (see 35 U.S.C. §151), therefore applicant remains responsible for paying the issue fee by the due date (December 10, 2004). Applicant's representative, Ms. Cynthia McKinley, was made aware of the decision through a telephone call on December 6, 2004.

Pinchus M. Laufer
Special Program Examiner
Technology Center 2100
Computer Architecture, Software and Information Security
571-272-3599

MBS

#9

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

Paper No. 9

JOSEPH LUTZ
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

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JUN 12 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of
Valery Kuriakin et al.
Application No. 09/607,825
Filed: June 30, 2000
Attorney Docket No. 42390P9148

: DECISION DISMISSING
: PETITION

This is a decision on the petition, filed on January 12, 2001, in effect requesting that a Notice Of Omitted Item(s) ("Notice"), mailed on December 18, 2000 for the above-identified application, be withdrawn.

The petition is **DISMISSED**.

The application was filed on June 30, 2000. However, on December 18, 2000, the Initial Patent Examination Division of the Office mailed the Notice stating that the application had been accorded a filing date of June 30, 2000, and advising applicants that the Figure 1B described in the specification appeared to have been omitted from the filed application.

In response, the present petition was filed. Petitioner explains that Figure 1B was not omitted on June 30, 2000. Instead, the application included a sheet of drawings containing two figures labeled as "FIG 1" and "FIG 1A," and that "FIG 1" is actually the "FIG 1B" described in the specification. The instant petition is accompanied by a copy of the formerly submitted sheet of drawings containing Figures 1 and 1A, with the label "FIG 1" corrected as "FIG 1B."

It is obvious from the petition that no drawing was actually missing on June 30, 2000. Rather, the drawing of Figure 1B was simply mislabeled as a result of Petitioner's typographical error. However, the December 18, 2000 Notice was correct in stating that Figure 1B described in the specification appeared to have been omitted. Therefore, the Notice was properly mailed and will not be withdrawn. Accordingly, the petition is dismissed. Since the instant petition was not necessitated by any error on the part of the Office, the $130 petition fee will not be refunded.

A preliminary amendment correcting the mislabeled "FIG 1" to "FIG 1B" should be filed prior to first Office action on the merits.

The application is being forwarded to the Initial Patent Examination Division for further processing with a filing date of June 30, 2000, using the 11 sheets of drawings filed on that date.

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.

Beverly M. Flanagan
Supervisory 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

CHARLES N. J. RUGGIERO
OHLANDT, GREELEY, RUGGIERO & PERLE, L.L.P.
ONE LANDMARK SQUARE
STAMFORD, CT 06901-2682

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AUG 16 2007

OFFICE OF PETITIONS

In re Application of :
Peter Schwrtz, et al. :
Application No. 09/607,827 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. 548.0011USU :

This is a decision in response to the petition, filed April 20, 2007, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to a non-final Office action mailed October 19, 2006. On April 20, 2007, the present petition was filed. A Notice of Abandonment was subsequently mailed on April 26, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay[1].

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 $1,020 extension of time fee submitted with the petition on April 20, 2007 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

The application is being referred to Technology Center AU 2877 for consideration of the amendment filed April 20, 2007.

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

[1] 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.

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

**KNOBBE MARTENS OLSON & BEAR LLP**
**2040 MAIN STREET**
**FOURTEENTH FLOOR**
**IRVINE CA 92614**

**COPY MAILED**

FEB 22 2005

**OFFICE OF PETITIONS**

In re Application of :
Anthony A. Nobles et al :
Application No. 09/607,845 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. QUICKPS.003A :

This is a decision on the petition under 37 CFR 1.137(b), filed December 10, 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 July 26, 2002, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on October 27, 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).

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

This matter is being referred to Technology Center AU 3731.

Karen Creasy

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

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

KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Anthony A. Nobles | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7601161 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/13/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/607,845 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/30/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **2401** 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

John A. Molnar, Jr.
Parker-Hannifin Corporation
6035 Parkland Boulevard
Cleveland, Ohio 44124-4141

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MAY 16 2006

**OFFICE OF PETITIONS**

In re Application of:
WOODSIDE, et al.
Application No.: 09/607,864
Filed: June 30, 2000
Atty's Docket No.: 2802-257-125

DECISION ON PETITION UNDER
37 CFR 1.137(b)

This is a decision on the petition for revival of the above-entitled application under 37 CFR 1.137(b), filed January 13, 2006.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice Of Allowance mailed August 17, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned at midnight on November 17, 2005.

On January 13, 2006, applicant filed the petition for revival under 37 CFR 1.137(b) considered herein. The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that it includes: (1) the petition fee; (2) the required statement of unintentional delay; and (3) the required reply in the form of payment of the issue fee. Accordingly, the issue and publication fee payments are accepted as having been unintentionally delayed.

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
(571) 272-3294

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

Nixon & Vanderhye PC
8th Floor
1100 North Glebe Road
Arlington, VA 22201

COPY MAILED

SEP 25 2002

OFFICE OF PETITIONS

In re Application of :
Takahisa Kurahashi, et al. :
Application No. 09/607,965 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. 1883-36 :

This is a decision on the petition to revive under 37 CFR 1.137(b), filed August 19, 2002, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment of the above-identified application.

The petition under 37 CFR 1.137(b) is **DISMISSED-AS-MOOT**.

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

The above-identified application held abandoned for failure to reply in a timely manner to the Notice To File Missing Parts of NonProvisional Appplication mailed August 21, 2000. The Notice set a period for reply of two(2) months from the mail date of the Notice. Under 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 response filed August 30, 2000.

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 2800, Art Unit 2811.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry Brinkley
Petitions Examiner

# 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) |
|---|---|---|---|---|
| 6,613,042 | 2003-09-02 | 09/608,020 | 2000-06-30 | |

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

| 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 | /John R. Ross, III/ | Date (YYYY-MM-DD) | 2008-03-11 |
| Name | John R. Ross, III | Registration Number | 43060 |

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. 6613042
Issue Date: September 2,2003
Application No. 09608020
Filed: June 30,2000
Attorney Docket No.

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

This is a decision on the electronic petition, filed March 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 March 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.

#4

**FORMALITIES LETTER**

*OC000000005345678*

**UNITED STATES DEPARTMENT OF COMMERCE**
**Patent and Trademark Office**
Address: COMMISSIONER OF PATENT AND TRADEMARKS
Washington, D.C. 20231

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 09/608,066 | 06/30/2000 | Astatke . . | 0942.4990001/RWE/CEJ |

Sterne Kessler Goldstein & Fox PLLC
Suite 600
1100 New York NW
Washinton, DC 20005-3934

OIPE
OCT 13 2000
PATENT & TRADEMARK OFFICE
3600

Date Mailed: 08/23/2000

## NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

### FILED UNDER 37 CFR 1.53(b)

***Filing Date Granted***

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing.
  *Applicant must submit* **$ 690** *to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).*
- Total additional claim fee(s) for this application is $1326.
  - **$702** for **39** total claims over 20.
  - **$624** for **8** independent claims over 3 .
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of $130 for a non-small entity, must be submitted with the missing items identified in this letter.
- **The balance due by applicant is $ 2146.**

---

***A copy of this notice MUST be returned with the reply.***

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 2 - COPY TO BE RETURNED WITH RESPONSE

10/17/2000 HNOOR1 00000003 09608066

| | | |
|---|---|---|
| 01 FC:101 | 710.00 | OP |
| 02 FC:102 | 320.00 | OP |
| 03 FC:103 | 306.00 | OP |
| 04 FC:105 | 130.00 | OP |
| 05 FC:199 | 6.00 | OP |

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
ATTORNEYS AT LAW
1100 NEW YORK AVENUE, N.W., SUITE 600
WASHINGTON, D.C. 20005-3934

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PHONE: (202) 371-2600 FACSIMILE: (202) 371-2540

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TRACY-GENE G. DURKIN
MICHELE A. CIMBALA
MICHAEL B. RAY
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DONALD R. MCPHAIL
PATRICK E. GARRETT
STEPHEN G. WHITESIDE
JEFFREY T. HELVEY*

HEIDI L. KRAUS
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RAYMOND MILLIEN
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TERESA U. MEDLER

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ALBERT J. FASULO II *
W. BRIAN EDGE*

KAREN R. MARKOWICZ**
SUZANNE E. ZISKA**
BRIAN J. DEL BUONO**
ANDREA J. KAMAGE**
NANCY J. LEITH**
TARJA H. NAUKKARINEN**

*BAR OTHER THAN D.C.
**REGISTERED PATENT AGENTS

Sector 4

October 13, 2000

*WRITER'S DIRECT NUMBER:*
(202) 789-5525
*INTERNET ADDRESS:*
BRIAND@SKGF.COM

Commissioner for Patents
Washington, D.C. 20231

***Box: Missing Parts***

Re: U.S. Utility Patent Application
Appl. No. 09/608,066; Filed: June 30, 2000
For: **Compositions and Methods for Enhanced Sensitivity and Specificity of Nucleic Acid Snythesis**
Inventors: Astatke *et al.*
Our Ref: 0942.4990001/RWE/CEJ
***Art Unit:*** ***1643***

Sir:

Transmitted herewith for appropriate action are the following documents:

1. A copy of the Notice to File Missing Parts;
2. An original Declaration for Patent Application executed by inventors;
3. Fee Transmittal Form (PTO-SB-17) *(in duplicate)*;
4. Our check no. 29150 in the amount of $1,472.00 to cover the following fees:
   - $710.00 Basic Filing Fee;
   - $312.00 Total Claims in Excess of 20;
   - $320.00 Independent Claims in Excess of 3;
   - $130.00 Surcharge for Late Submission of Declaration; and
5. One (1) Return Postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier. In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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

Brian J. Del Buono
Agent for Applicants
Registration No. 42,473

BJD/PSC:amm
Enclosures

P:\USERS\AMACWILL\cjeffers\0942\4990001\pto.trl.ids
SKGF Rev. 4/27/00 mac

PTO/SB/17 (09-00)
Approved for use through 10/31/2002. OMB 0651-0032
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 TRANSMITTAL for FY 2001

*Patent fees are subject to annual revision.*

OCT 13 2000 PATENT & TRADEMARK OFFICE 600

| TOTAL AMOUNT OF PAYMENT | ($)1,472.00 |
|---|---|

| Complete if Known | |
|---|---|
| Application Number | 09/608,066 |
| Filing Date | June 30, 2000 |
| First Named Inventor | Astatke *et al.* |
| Examiner Name | To be assigned |
| Group Art Unit | 1643 |
| Attorney Docket No. | 0942.4990001/RWE/CEJ |

## METHOD OF PAYMENT (check one)

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayment to:

Deposit Account Number: 19-0036

Deposit Account Name: Sterne, Kessler, Goldstein & Fox P.L.L.C.

☐ Charge Any Additional Fee Required Under 37 CFR §§ 1.16 and 1.17

☐ Applicant claims small entity status See 37 CFR 1.27

2. ☒ Payment Enclosed:

☒ Check ☐ Credit card ☐ Money Order ☒ Other*

*Charge any deficiencies or credit any overpayments in the fees or fee calculations of Parts 1, 2 and 3 below to Deposit Account No. 19-0036.

## FEE CALCULATION

### 1. BASIC FILING FEE

| Large Fee Code | Large Entity Fee ($) | Small Fee Code | Small Entity Fee ($) | Fee Description | Fee Paid |
|---|---|---|---|---|---|
| 101 | 710 | 201 | 355 | Utility filing fee | 710.00 |
| 106 | 320 | 206 | 160 | Design filing fee | |
| 107 | 490 | 207 | 245 | Plant filing fee | |
| 108 | 710 | 208 | 355 | Reissue filing fee | |
| 114 | 150 | 214 | 75 | Provisional filing fee | |

SUBTOTAL (1) ($) 710.00

### 2. EXTRA CLAIM FEES

| | Extra | Fee from below | Fee Paid |
|---|---|---|---|
| Total Claims 59 - 20** = | 39 | X 18 = | 312 |
| Indep. Claims 7 - 3** = | 80 | X 80 = | 320 |
| Multiple Dependent | | 0 = | 0 |

| Large Fee Code | Large Entity Fee ($) | Small Fee Code | Small Entity Fee ($) | Fee Description |
|---|---|---|---|---|
| 103 | 18 | 203 | 9 | Claims in excess of 20 |
| 102 | 80 | 202 | 40 | Independent claims in excess of 3 |
| 104 | 270 | 204 | 135 | Multiple dependent claim |
| 108 | 80 | 209 | 40 | **Reissue independent claims over original patent |
| 110 | 18 | 210 | 9 | **Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) ($) 632.00

** or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

| Large Entity Fee Code | Large Entity Fee ($) | Small Entity Fee Code | Small Entity Fee ($) | Fee Description | Fee paid |
|---|---|---|---|---|---|
| 105 | 130 | 205 | 65 | Surcharge - late filing fee or oath | 130.00 |
| 127 | 50 | 227 | 25 | Surcharge - late provisional filing fee or cover sheet | |
| 139 | 130 | 139 | 130 | Non-English specification | |
| 147 | 2,520 | 147 | 2,520 | For filing a request for *ex parte* reexamination | |
| 112 | 920* | 112 | 920* | Requesting publication of SIR prior to Examiner action | |
| 113 | 1,840* | 113 | 1,840* | Requesting publication of SIR after Examiner action | |
| 115 | 110 | 215 | 55 | Extension for reply within first month | |
| 116 | 390 | 216 | 195 | Extension for reply within second month | |
| 117 | 890 | 217 | 445 | Extension for reply within third month | |
| 118 | 1,390 | 218 | 695 | Extension for reply within fourth month | |
| 128 | 1,890 | 228 | 945 | Extension for reply within fifth month | |
| 119 | 310 | 219 | 155 | Notice of Appeal | |
| 120 | 310 | 220 | 155 | Filing a brief in support of an appeal | |
| 121 | 270 | 221 | 135 | Request for oral hearing | |
| 138 | 1,510 | 138 | 1,510 | Petition to institute a public use proceeding | |
| 140 | 110 | 240 | 55 | Petition to revive - unavoidable | |
| 141 | 1,240 | 241 | 620 | Petition to revive - unintentional | |
| 142 | 1,240 | 242 | 620 | Utility issue fee (or reissue) | |
| 143 | 440 | 243 | 220 | Design issue fee | |
| 144 | 600 | 244 | 300 | Plant issue fee | |
| 122 | 130 | 122 | 130 | Petitions to the Commissioner | |
| 123 | 50 | 123 | 50 | Petitions related to provisional applications | |
| 126 | 240 | 126 | 240 | Submission of Information Disclosure Stmt | |
| 581 | 40 | 481 | 40 | Recording each patent assignment per property (times number of properties) | |
| 146 | 710 | 246 | 355 | Filing a submission after final rejection (37 CFR 1.129(a)) | |
| 149 | 710 | 249 | 355 | For each additional invention to be examined (37 CFR 1.129(b)) | |
| 179 | 710 | 279 | 355 | Request for Continued Examination (RCE) | |
| 169 | 900 | 169 | 900 | Request for expedited examination of a design application | |

Other fee (specify) :

Other fee (specify) :

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($) 130.00

| SUBMITTED BY | | | | Complete (*if applicable*) | |
|---|---|---|---|---|---|
| Name (*Print/Type*) | Brian J. Del Buono | Registration No. (*Attorney/Agent*) | 42,473 | Telephone | 202-371-2600 |
| Signature | | | | Date | Oct. 13, 2000 |

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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. 5

MAIL

MAY 28 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

OPPENHEIMER WOLFF
& DONNELLY LLP
P.O. BOX 10356
PALO ALTO, CA 94303

In re Application of:
Shahoian
Application No.: 09/608,130
Filed: June 30, 2000
For: MOVING MAGNET ACTUATOR FOR PROVIDING HAPTIC FEEDBACK L

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney of record filed May 6, 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 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.

Ken Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: Phil Albert, Esq.
Townsend & Townsend
Two Embarcadero Center/Eighth Floor
San Francisco, CA 94111

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov
DIW 04-01

Paper No. 6

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

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MAY 2 1 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
Balasinski, Coburn, Kim, and Hong : DECISION ACCORDING STATUS
Application No. 09/608,158 : UNDER 37 CFR 1.47(a)
Filed: 30 June, 2000 :
Attorney's Docket No. 10200/82 :

This is in response to the petition under 37 CFR 1.47(a) filed on 26 December, 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 after having been presented with the application papers. Specifically, the declaration of petitioners' attorney, Paul E. Rauch, establishes that a copy of the application was sent to the last known address of the non-signing joint inventor, Keeho E. Kim, on two occasions, but the non-signing inventor has failed to sign and return the Declaration.

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.

It is noted that the declaration filed on 26 December, 2000, does not identify, by city and state or foreign county, the residence

of each inventor. A new oath or declaration in accordance with 37 CFR 1.63 should be filed within two (2) months of this decision, or when required by the examiner.[1]

After this decision is mailed, the application will be forwarded to Technology Center 2700 for further processing.

Telephone inquiries related to this decision should be directed to Petitions Attorney Douglas I. Wood at 703.308.6918.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[1] MPEP 605.02.

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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DIW 04-01

Paper No. 7

Keeho E. Kim
350 Elan Village Lane #210
San Jose, CA 95134

**COPY MAILED**

**MAY 2 1 2001**

**OFFICE OF PETITIONS**
**A/C PATENTS**

In re Application of
Balasinski et al.
Application No. 09/608,158
Filed: 30 June, 2000
For: Scheme for Improving the Predictability And/or Reliability of Photolithographic Images

Dear Mr. Kim:

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 Petitions Attorney Douglas I. Wood at 703/308-6918. 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).

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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**STOUT, UXA, BUYAN & MULLINS LLP**
**4 VENTURE, SUITE 300**
**IRVINE CA 92618**

**COPY MAILED**

JAN 10 2006

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Guell et al. | : | |
| Application No. 09/608,234 | : | ON PETITION |
| Filed: June 30, 2000 | : | |
| Attorney Docket No. A-1559 | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed November 22, 2005, 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 RCE, an Amendment and requisite fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 2677 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

Liana Chase
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

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JAN 0 4 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

Paper No. 6

Finnegan, Henderson, Farabow,
Garrett & Dunner L.L.P.
1300 I Street N.W.
Washington, D.C. 20005-3315

In re Application of: Jean L. Missinhoun et al. )
Application No. 09/608,293 )
Filed: June 30, 2000 ) **DECISION ON REQUEST FOR**
For: SYSTEM AND METHOD FOR ) **WITHDRAWAL AS ATTORNEY**
PROVIDING A MULTICHANNEL )
CUSTOMER INTERACTION )
CENTER )

This is a decision on the Request To Withdraw from Representation filed December 28, 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: Joel Benson
Brinks Hofer Gilson & Lione
455 N. CityFront Plaza Drive
Chicago, Illinois 60611-5599

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ACCENTURE CHICAGO 28164
BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO IL 60610

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OFFICE OF PETITIONS

In re Application of :
Missinhoun et al. :
Application No. 09/608293 : DECISION ON APPLICATION
Filing or 371(c) Date: 06/30/2000 : FOR PATENT TERM ADJUSTMENT
Attorney Docket Number: :
10022/225 :

This is a decision on the "Request for Reconsideration of Patent Term Adjustment Pursuant to 37 C.F.R. 1.705(b)," filed September 24, 2007.

The application for patent term adjustment is **DISMISSED**.

On June 26, 2007, 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 257 days.

On September 24, 2007, applicant timely submitted the instant application for patent term adjustment[1]. Applicant requests review of the Patent Term Adjustment determination, in particular, the 127 day period of reduction for applicant delay for the time period extending from the day after the August 29, 2006, Response after non-final Action was filed, or August 30, 2006, to the January 3, 2007, filing of the Response after non-final Action (Response to Notice of Non-Compliant Amendment).

Applicant does not dispute the delay of 727 days attributed to the Office under 1.702(a), for failing to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed under 35 U.S.C. 111(a). Nor does Applicant dispute the delay of 64 days attributed to Applicant under 37 CFR 1.704(b), for filing a reply to the non-final Office action, mailed August 27, 2003, more than three (3) months after the mail date of the Office action; the delay of 92 days attributed to Applicant under 37 CFR 1.704(b), for filing a reply to the final Office action,

[1] PALM records show that the Issue Fee payment was received in the Office on September 24, 2007.

mailed April 21, 2004, more than three (3) months after the mail date of the final Office action, or the delay of three (3) days for filing a reply to the non-final Office action, mailed January 11, 2005, more than three (3) months after the mail date of the Office action. Applicant also does not dispute the delay of 90 days attributed to Applicant under 37 CFR 1.704(b), for filing a reply to the final Office action, mailed June 15, 2005, more than three (3) months after the mail date of the final Office action, or the delay of 94 days attributed to Applicant under 37 CFR 1.704(b), for filing a reply to the non-final Office action, mailed February 27, 2006, more than three (3) months after the mail date of the non-final Office action.

Regarding the delay of 127 days attributed to Applicant under 37 CFR 1.704(c)(7), for filing the Response to Notice of Non-Compliant Amendment on January 3, 2007, after filing the response to the non-final Office action on August 29, 2006,

37 CFR 1.704(c) provides, in pertinent part, that:

> Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
>
> > (7) Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

The MPEP 2732 further explains that

> 37 CFR 1.704(c)(7) establishes submission of a reply having an omission (37 CFR 1.135(c)) as a circumstance that constitutes a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Submitting a reply having an omission requires the Office to issue an action under 37 CFR 1.135(c) and await and process the applicant's reply to the action under 37 CFR 1.135(c) before the initial reply (as corrected) can be treated on its merits. In addition, 37 CFR 1.704(c)(7) provides that in such a case the period of adjustment set forth in 37 CFR 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed. The reference to 37 CFR 1.135(c) is parenthetical because 37 CFR 1.704(c)(7) is not limited to Office actions under 37 CFR 1.135(c) but applies when the Office issues any action or notice indicating that a reply has an omission which must be corrected: e.g., (1) a decision on a petition under 37 CFR 1.47 dismissing the petition as lacking an item necessary to grant the petition; or (2) a notice indicating that the computer readable format sequence listing filed in reply to a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (PTO-1661) does not comply with 37 CFR 1.821 et seq.

In this instance, Applicant filed a response (Amendment) to the non-final rejection, on August 29, 2006. However, the Amendment was non-compliant. Applicant was notified in a Notice of Non-Compliant Amendment. Applicant filed a supplemental reply in the form of an Amendment in response to the Notice of Non-Compliant Amendment, on January 3, 2007. Pursuant to 37 CFR § 1.704(c)(7) the patent term adjustment should have been reduced by one hundred twenty-seven (127) days for applicant delay, from August 30, 2006, to January 3, 2007, in filing a Response correcting the omission.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **two hundred fifty-seven (257) days** (727 days of PTO delay, reduced by 470 (64+92+3+90+94+127) days of applicant delay).

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 Publications Division for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Attorney Derek Woods at (571) 272-3232.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : 2/13/09

**TO SPE OF** : ART UNIT 3623

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 09608293 Patent No.: 7353182 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.

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

**Comments:** _____

_____

_____

_____

_____

/Beth Boswell/ **SPE, Art Unit 3623**

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United States Patent and Trademark Office
P.O. Box 1450
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**LUCENT TECHNOLOGIES INC**
**DOCKET ADMINISTRATOR**
**101 CRAWFORDS CORNER ROAD**
**ROOM 3J-219**
**HOLMDEL, NJ 07733**

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JUN 2 0 2005

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| John P. Hearn et al | : | |
| Application No. 09/608,473 | : | ON PETITION |
| Filed: June 30, 2000 | : | |
| Attorney Docket No. 1-21-1 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed June 6, 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 May 27, 2004, 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)). The amendment submitted on November 19, 2004, did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed January 21, 2005. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed, extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on November 28, 2004.

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 $1,020 extension of time submitted on February 22, 2005 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's Deposit Account No. 12-2325.

The Office Finance records show that the Notice of Appeal was inadvertently

charged twice. Therefore, a refund of $500 is being credited to the above-noted deposit account.

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

This matter is being referred to Technology Center AU 2155.

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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**MAIL**

Paper No. 9

Gordon Lindeen
Blakely Sokoloff Taylor & Zafman LLP
12400 Wilshire Blvd
7th Floor
Los Angeles CA 90025

FEB 2 7 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: MICHAEL RENN NEAL, ET AL.
Application No.: 09/608,494
Filed: June 30, 2000
For: **METHOD AND APPARATUS FOR MANAGING UPDATES TO A CATALOG**

**DECISION ON PETITION TO RESET PERIOD FOR REPLY**

This is in reply to Petitioner's petition to reset period for reply filed in the United States Patent and Trademark Office on January 23, 2004. No fee is required.

A review of the file record reveals that Petitioner, on June 24, 2003, submitted a response to the non-final Office Action dated February 24, 2003. The Examiner, on August 20, 2003, issued a Notice of Non-Responsive amendment (Paper No. 5) which was not received by Petitioner. The Examiner, on January 13, 2004, issued an Interview Summary, wherein the Notice of Non-Responsive amendment and Form PTO 948 were enclosed.

Petitioner submitted a statement from the practitioner stating that the Office Letter dated August 20, 2003 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 Letter was not received. A copy of the docket record where the non-received Office Letter would have been entered had it been received and docketed was also submitted.

Since Petitioner has never received the Office Letter mailed August 20, 2003, and has promptly submitted a response to the Office Letter after learning about its existence, Petitioner's response to the Notice of Non-Responsive amendment (Paper No. 5)'is considered timely filed. Accordingly, the Petition is **DISMISSED AS MOOT**.

The application will be forwarded to the Examiner of Record for prompt action on the merits of the application.

Bot LeDynh, J.D., Ph.D.
Special Programs Examiner

Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 305-0651

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
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FEB 27 2003

Paper No. 17

In re Application of :
Arun Vishwanathan *et al* : DECISION ON PETITION
Application No. 09/608,537 :
Filed: June 30, 2000 :
Attorney Docket No. 126

The paper filed on February 6, 2003 by facsimile transmission is considered to be a petition under 37 CFR 1.8(b) to withdraw the holding that this application stands abandoned for failure to file a reply to the Office letter dated June 18, 2002. No fee is required.

The petition is granted.

Petitioners allege that a timely reply to the Office letter in question was in fact filed. This allegation is established by the submission of a copy of the reply, which has affixed thereto a 37 CFR 1.8(a) certificate dated July 11, 2002, together with the statement of Ms. Barbara A. Wiley the party who signed that certificate and who has personal knowledge of the mailing of the reply in accordance with that certificate. Petitioners have also supplied a copy of a filing receipt showing that the reply was actually received on July 16, 2002.

It is clear that petitioners have established 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 examiner for action on the reply filed on July 16, 2002.

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Rodel Holdings, Inc.
Attn: Kenneth A. Benson
1105 North Market Street
Suite 1300
Wilmington, DE 19899

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

McCormick Paulding & Huber
City Place II
185 Asylum Street
Hartford, CT 06103-4102

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**NOV 23 2004**

**OFFICE OF PETITIONS**

In re Application of :
Blume, et al : DECISION ON PETITION
Application No. 09/608,620 :
Filed: June 30, 2000 :
Atty. Dkt. No.: 3309P-114 :

This decision is in response to the petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.67(a)(2) filed August 30, 2004.

The petition under 37 CFR 1.183 is **DISMISSED**.

In an Office communication mailed December 4, 2003, the Examiner objected to the declaration as four of the inventors named herein failed to provide the date of execution of the declaration. Petitioners herein request waiver of the requirements of 37 CFR 1.67(a)(2) as regards inventors R. Rozelle and A. Serwinowski whom petitioners allege cannot be reached or located to execute the supplemental declaration.

The requirements of 37 CFR 1.183 set forth that "[I]n 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)."

In accordance with 37 CFR 1.67(a), "[t]he Office may require, or inventors and applicants may submit, a supplemental oath or declaration meeting the requirements of § 1.63 or § 1.162 to correct any deficiencies or inaccuracies present in the earlier filed oath or declaration.

Further, 37 CFR 1.67(a)(2) states that "[d]eficiencies or inaccuracies relating to fewer than all of the inventor(s) or

applicant(s) (§§ 1.42, 1.43 or § 1.47) may be corrected with a supplemental oath or declaration identifying the entire inventive entity but signed only by the inventor(s) or applicant(s) to whom the error or deficiency relates.

Petitioners herein state that attempts to mail supplemental declarations to inventors R. Rozelle and A. Serwinowski at their last known addresses were unsuccessful and that the packages containing the supplemental declarations were returned as undeliverable.

Petitioners have failed to establish the existence of an "extraordinary situation." While petitioners state they have attempted to contact the inventors via the inventors last known addresses to no avail, petitioners have failed to provide any evidence of subsequent efforts to locate the inventors. At the very least, a search of the internet, telephone directories, and international registries should be undertaken in regions where it is suspected the inventors may reside. Petitioners should reference and supply evidence of any such searches in a renewed petition.

Moreover, while petitioners allege the inventors cannot be reached or located via their last known addresses, a cursory review of Lexis®.com EZFIND Combined Person Locator Nationwide database indicates that the inventors may have more recently resided as follows:

A. SERWINOWSKI
10142 NW 69TH MNR
PARKLAND, FL 33076

R. ROZELLE
7696 HILLSIDE DR., APT. 248
WEST BLOOMFIELD, MI 48322-2852

Any renewed petition must establish that diligent efforts have been made to reach or locate the herein referenced inventors for execution of the supplemental declaration.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTH** from mail date of this decision. Such request may include declarations executed by the inventor(s). 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 1.183."

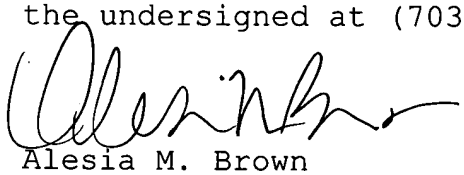
Further correspondence with respect to this matter should be addressed as follows:

| | |
|---|---|
| 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**<br>Crystal Plaza Two, Lobby, Room 1B03<br>Arlington, VA 22202 |

This application is being returned to the Office of Publications for further processing of the amendment submitted March 18, 2003 in response to the "Notice to File Corrected Application Papers," mailed March 31, 2003.

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

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0310.



Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

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Hartford, CT 06103-4102

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SEP 28 2005

**OFFICE OF PETITIONS**

In re Patent No. 6,944,580 :
Issued: September 13, 2005 : DECISION ON PETITION
Application No. 09/608,620 :
Filed: June 30, 2000 :
Atty. Dkt. 3309P-114 :

This decision is in response to the petition under 37 CFR 1.183, filed January 25, 2005.

The above-identified application matured into U.S. Pat. No. 6,944,580 on September 13, 2005. Prior to the issuance of the patent, petitioners sought waiver of the supplemental declaration requirements of 37 CFR 1.67.

Prior to the issuance of the patent, petitioners submitted a properly executed supplemental declaration in accordance with 37 CFR 1.67.

Accordingly, the instant petition under 37 CFR 1.183 is hereby **DISMISSED AS MOOT**.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

# 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) |
|---|---|---|---|---|
| 6374557 | 2002-04-23 | 09608626 | 2000-06-30 | 501247.00177 |

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 J. Nykaza/ | Date (YYYY-MM-DD) | 2007-08-08 |
| Name | Paul J. Nykaza | Registration Number | 38984 |

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. 6374557
Issue Date: April 23,2002
Application No. 09608626
Filed: June 30,2000
Attorney Docket No. T8465863US

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

This is a decision on the electronic petition, filed August 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 August 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No.

MAR - 9 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paul J. Skwierawski
ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, VA 22209

In re Application of:
Leitner, et al.
Application No. 09/608,645
Filed: June 30, 2000
For: MEMORY UTILIZATION IN A NETWORK INTERFACE

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed June 05, 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 June 05, 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 Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

cc: Anne Richards
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
1600 TCF Tower
121 South Eight Street
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

PET DEC

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UNITED STATES PATENT AND TRADEMARK OFFICE
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JUN 23 2004

VP
PAPER NO. ___

In re Application of
Frank M. Keese et al.
Serial Number: 09/608,649
Filed: June 30, 2000
For: FLEXIBLE COMPOSITES WITH INTEGRAL FLIGHTS FOR USE IN HIGH-TEMPERATURE FOOD PROCESSING EQUIPMENT AND METHODS FOR PRODUCING THE SAME

PETITION UNDER
M.P.E.P.708.02 IV

This is in response to the petition filed March 5, 2004, requesting that the above-identified application be granted Special Status under Section 708.02 IV of the MPEP and 37 CFR 1.102(c) (**no fee required**).

The request for Special Status considered under Section 708.02 IV of the MPEP is granted because criteria under 37 CFR 1.102(c) has been met.

Accordingly the petition is **GRANTED.**

Marian C. Knode

Marian C. Knode, Special Programs Examiner
Technology Center 1700
Chemical and Materials Engineering

JASON E. PAULS
FOLEY & LARDNER
SUITE 3800
777 EAST WISCONSIN AVENUE
MILWAUKEE MI 53202-5306

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JASON E. PAULS
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SUITE 3800
777 EAST WISCONSIN AVENUE
MILWAUKEE, MI 53202-5306

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DEC 0 3 2004

OFFICE OF PETITIONS

In re Application of :
Frank M. Keese, et al. :
Application No. 09/608,649 : ON PETITION
Filed: June 30, 2000 :
Atty Docket No. 025948-0104 :

This is a decision on the petition, filed November 26, 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 30, 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 1772 for further processing of the request for continued examination under 37 CFR 1.114 filed November 26, 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

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APR 26 2005

OFFICE OF PETITIONS

SAWYER LAW GROUP LLP
P.O. BOX 51418
PALO ALTO CA 94303

In re Application of :
Martin J. Pagel :
Application No. 09/608,735 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. 1775P :

This is a decision on the petition, filed April 20, 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 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 should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2132 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).

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& NEUSTADT
1940 DUKE STREET
ALEXANDRIA, VA 22314

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OFFICE OF PETITIONS

In re Application of :
Nader Vijeh et al :
Application No. 09/608,747 : DECISION GRANTING PETITION
Filed: June 30, 2000 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 257370US28 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 15, 2004, and to the paper filed December 3, 2004, 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 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 December 4, 2003, is accepted as having been unintentionally delayed.

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

The application file is being forwarded to Technology Center AU 2661.

Karen Ceasy

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

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HUFFMAN LAW GROUP, P.C.
1832 N. CASCADE AVE.
COLORADO SPRINGS, CO 80907-7449

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JAN 28 2005

**OFFICE OF PETITIONS**

In re Application of :
Mario Nemirovsky et al :
Application No. 09/608,750 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. P3815 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 30, 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 June 7, 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 above-identified application became abandoned on September 8, 2004.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

The matter is being forwarded to Technology Center AU 2126 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
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HUFFMAN LAW GROUP, P.C.
1900 MESA AVE.
COLORADO SPRINGS CO 80906

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APR 25 2007

OFFICE OF PETITIONS

In re Patent No. 7,032,226 :
Issue Date: April 18, 2006 :
Application No. 09/608,750 : DECISION ON PETITION
Filed: June 30, 2000 : UNDER 37 CFR 1.182 AND REQUEST
Attorney Docket No. MIPS.0169-00-US : FOR CERTIFICATE OF CORRECTION

This is a decision on the petition under 37 CFR 1.182, filed August 23, 2006, seeking to add a claim for priority to nonprovisional Application No. 09/602,279, filed June 23, 2000, by way of a certificate of correction.

Petitioners filed Application No. 09/608,750 on June 30, 2000, which issued as Patent No. 7,032,226 on April 18, 2006. A claim for priority was submitted on filing; however, the claim failed to provide the application number of the prior application. On October 22, 2003, and March 10, 2004, petitioners submitted amendments requesting the entry of the claim for priority to Application No. 09/602,279. The examiner failed to acknowledge either amendment.

Pursuant to 37 CFR 1.78(a)(2)(iii), a reference to a prior-filed nonprovisional application must be submitted in an application data sheet or in the first sentence of the specification after the title. In this instance, petitioners failed to include the reference to nonprovisional Application No. 09/602,279 in the first sentence following the title in the specification in accordance with 37 CFR 1.78(a)(2)(iii). Rather, petitioners included the reference under the cross-reference section of the specification. The Office further notes that the amendment submitted by petitioners during the pendency of the application only amended the contents of the sentence, but not the location.

As petitioners are not entitled to entry of the priority data, no certificate of correction will be issued. Accordingly, the petition is **dismissed**.

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

Any questions concerning this matter may be directed to Charlema R. Grant at (571) 272-3215.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Examiner
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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**BLAKELY SOKOLOFF TAYLOR & ZAFMAN**
**12400 WILSHIRE BOULEVARD**
**SEVENTH FLOOR**
**LOS ANGELES, CA 90025**

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DEC 15 2005

**OFFICE OF PETITIONS**

In re Application of :
Stephen S. Chang :
Application No. 09/608,869 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. 042390.P8815 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 1, 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 April 29, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on July 30, 2005.

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; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentional delayed.

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
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 No. 13

**JOHN G. POSA**
**GIFFORD KRASS GROH**
**280 N OLD WOODWARD AVE**
**SUITE 400**
**BIRMINGHAM, MI 48009**

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SEP 19 2005

OFFICE OF PETITIONS

In re Application of :
Jyoti Mazumder :
Application No. 09/608,874 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. POM-12302/29 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 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 May 29, 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 August 30, 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 non-final Office action of May 29, 2003 is accepted as having been unintentionally delay.

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 $60 extension of time submitted with the petition on August 29, 2005 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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 (571) 272-3220.

The application file is being forwarded to Technology Center AU 2125.

Wan Laymon

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

cc: JOHN G. POSA
GIFFORD KRASS GROH SPRINKLE
PO BOX 7021
TROY, MI 48007

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MINNEAPOLIS, MN 55440-1022

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MAR 23 2006

OFFICE OF PETITIONS

In re Application of :
Ravi Kolagotla et al :
Application No. 09/608,983 : DECISION GRANTING PETITION
Filed: June 30, 2000 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 10559/257001/P8906 :

This is a decision on the petition, filed March 21, 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 January 31, 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 should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 2183 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
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 Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission), which includes the following language thereon: "The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee in 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
UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

OCT -9 2002

Paper No. 13

In re Application of
Andy Latts *et al*
Application No. 09/608,985
Filed: June 30, 2000
Attorney Docket No. P 64112

: DECISION ON PETITION

The duplicate paper filed by facsimile transmission on August 8, 2002 and perfected on August 21, 2002, is construed as a petition by which petitioners request withdrawal of the holding that this application stands abandoned for failure to file a reply to the Office letter dated October 19, 2001. No fee is required for the petition.

The petition is granted.

Petitioners allege that a reply to the Office letter in question was timely by reason of the filing of a Notice of Appeal, together with the appeal fee, on February 13, 2002, together with a request for extension of time and the fee for a one month extension. Petitioners have established this allegation in the manner provided for by 37 CFR 1.8(b) by including copies of these papers which each have affixed thereto a 37 CFR 1.8(a) certificate of mailing dated February 13, 2002. In addition, Office financial records show that the extension fee and appeal fee have been received.

It is clear from the showing in support of 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 Supervisory Applications Examiner for entry of the Notice of Appeal which is attached to the petition, entry of the appeal brief filed on July 22, 2002, and entry of the change of address and power of attorney filed on February 13, 2002 as attached to the petition and resubmitted on September 11, 2002. All extension fees and appeal fees have in fact been received by the Office, as indicated in the Office financial records. Thereafter, the application will be forwarded to the examiner for action on the appeal brief.

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Attachment

Pillsbury Winthrop L.L.P.
Intellectual Property Group
11682 El Camino Real
Suite 200
San Diego, CA 92130

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SUITE 900
15 WEST SOUTH TEMPLE
SALT LAKE CITY, UT 84101

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In re Patent No. 7,032,110 :
Issue Date: April 18, 2006 :
Application No. 09/608,986 : NOTICE
Filed: June 30, 2000 :
Patentee(s): Jin Su, et. al. :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28, filed April 7, 2006. 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**. Therefore, status as a small entity has been removed and all future fees paid must be paid at the large entity rate.

Inquiries related to this communication should be directed to the undersigned at (571) 272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

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BRINKS HOFER GILSON & LIONE
NBC TOWER - SUITE 3600
455 CITYFRONT PLAZA DR
CHICAGO IL 60611-5599

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| | | |
|---|---|---|
| In re Application | : | |
| Milani, et al. | : | |
| Application No. 09/609,016 | : | DECISION ON APPLICATION |
| Filed: June 30, 2000 | : | FOR PATENT TERM ADJUSTMENT |
| Atty Docket No. 115/575 | : | |

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. §1.705(b)," filed April 1, 2005. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to three hundred nine (309) days.

For the reasons set forth below, a decision on the request for reconsideration of the patent term adjustment indicated on the patent is being **HELD IN ABEYANCE** until after the actual patent date.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicant's written request for reconsideration.

On December 28, 2004, 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 zero (0) days. On April 1, 2005, applicants timely[1] submitted an application for patent term adjustment, asserting that the correct number of days of PTA is three hundred nine (309) days.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of thirty-four (34) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), and forty-three (43) and sixty-seven (67) days, both pursuant to 35 U.S.C. (b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), reduced by applicants' delays of five (5), one hundred fifty-five (155), and ninety-four (94) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), and thirteen (13) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8). All periods of adjustment have been reviewed and found to be correct.

It is noted that with respect to the sixty-seven (67) days of adjustment, applicants assert that the adjustment should be sixty-eight (68) days. Office records indicate that a final rejection was filed on March 11, 2004, in response to an amendment filed on September 4, 2003. However, applicants state that the amendment was filed by express mail on September 3, 2003. A review of the amendment does not reveal that it was filed express mail, nor have applicants offered any proof to indicate that it was.

In addition, applicants assert additional PTO delay of four hundred thirty-one (431) days for the failure on the part of the Office to issue the patent within three years of its filing. The Office will be able to assess whether or not any additional PTA is accorded once the issue date is established.[2]

Receipt of the $200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged.

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[1] Applicants filed the application for patent term adjustment together with the payment of the issue fee, and included a Certificate of Mailing dated March 28, 2005.

[2] Applicants should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

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455 CITYFRONT PLAZA DR
CHICAGO IL 60611-5599

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| | |
|---|---|
| In re | : DECISION ON APPLICATION |
| Milani, et al. | : FOR PATENT TERM ADJUSTMENT |
| Application No. 09/609,016 | : AND NOTICE OF INTENT |
| Filed: June 30, 2000 | : TO ISSUE |
| Patent No. 7,060,311 | : CERTIFICATE OF CORRECTION |
| Issued: June 13, 2006 | : |

This is a decision on the "RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT PURSUANT TO 37 C.F.R. §1.705(b)," filed June 23, 2006. Patentee requests that the determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from three hundred eighty-two (382) days to five hundred one (501) days.

The request is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **five hundred two (502)** days.

On December 28, 2004, 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 zero (0) days. On April 1, 2005, applicants timely[1]

[1] Applicants filed the application for patent term adjustment together with the payment of the issue fee, and included a Certificate of Mailing dated March 28, 2005.

submitted an application for patent term adjustment, asserting that the correct number of days of PTA is three hundred nine (309) days. The request was held in abeyance in a decision mailed on July 5, 2005. The application issued into a patent on June 13, 2006 with a patent term adjustment of three hundred eighty-two (382) days.

Applicants state that the patent is not subject to a terminal disclaimer.

The Office determined a patent term adjustment of three hundred eighty-two (382) days based on an adjustment for PTO delay of thirty-four (34) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), forty-three (43) and sixty-seven (67) days, both pursuant to 35 U.S.C. (b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), three hundred sixteen (316) days pursuant to 35 U.S.C. 154(b)(1)(A)(iv) and 37 C.F.R. § 1.703(a)(6), and three hundred fifty-five (355) days pursuant to 35 U.S.C.(b)(1)(B) and 37 C.F.R. § 1.703(b), reduced by applicants' delays of five (5), one hundred fifty-five (155), ninety-four (94) and four (4) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), thirteen (13) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8), and one hundred twenty (120) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(10). The adjustment of one hundred twenty (120) days is at issue.

A review of the record reveals that applicants were assessed one hundred twenty (120) days for filing the application for patent term adjustment on Pursuant to 37 C.F.R. § 1.704(e), the submission of an application for patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution of the application.

Given the basis for granting this petition, the $200.00 fee set forth in 37 C.F.R. § 1.18(e) was not required, and has not been charged.

The application file is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction, indicating a Patent Term Adjustment of **five hundred two (502) days**.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery A Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enc: draft Certificate of Correction

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# DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,060,311 B1

DATED : June 13, 2006

INVENTOR(S) : Milani, 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,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (382) days

Delete the phrase "by 382 days" and insert – by 502 days—

Day : Tuesday
Date: 7/25/2006

PALM INTRANET

Time: 10:48:37

| PTA Calculations for Application: 09/609016 | | | |
|---|---|---|---|
| Application Filing Date: | 06/30/2000 | PTO Delay (PTO): | 815 |
| Issue Date of Patent: | 06/13/2006 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 433 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 502 |
| PTO Delay Adjustment: | 120 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 94 | 07/25/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | 120 | | |
| 90.5 | 05/24/2006 | PTA 36 MONTHS | 355 | | |
| 90 | 06/13/2006 | PATENT ISSUE DATE USED IN PTA CALCULATION | 316 | | 82 |
| 89 | 05/16/2006 | RECEIPT INTO PUBS | | | |
| 88 | 05/16/2006 | RECEIPT INTO PUBS | | | |
| 87 | 05/12/2006 | DISPATCH TO FDC | | | |
| 86 | 05/12/2006 | DISPATCH TO FDC | | | |
| 85 | 05/12/2006 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 84 | 04/01/2005 | WORKFLOW - DRAWINGS FINISHED | | 120 | 77 |
| 83 | 05/12/2006 | TC RETURN TO PUBS | | | |
| 82 | 04/01/2005 | ISSUE FEE PAYMENT VERIFIED | | 4 | 57 |
| 81 | 05/12/2006 | RECEIPT INTO PUBS | | | |
| 80 | 05/12/2006 | WORKFLOW - QUERY REQUEST - FINISH | | | |
| 79 | 04/13/2006 | PUBS CASE REMAND TO TC | | | |
| 77 | 05/08/2006 | MAIL EXAMINER'S AMENDMENT | | | |
| 76 | 05/08/2006 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 75 | 05/03/2006 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 74 | 05/04/2006 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 73 | 04/13/2006 | PUBS CASE REMAND TO TC | | | |
| 72 | 04/17/2006 | WORKFLOW - QUERY REQUEST - BEGIN | | | |
| 71 | 04/17/2006 | RECEIPT INTO PUBS | | | |
| 70 | 03/13/2006 | RECEIPT INTO PUBS | | | |
| 69 | 03/09/2006 | MAIL RESPONSE TO 312 AMENDMENT (PTO-271) | | | |

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|---|---|---|---|---|---|
| 68 | 03/07/2006 | RESPONSE TO AMENDMENT UNDER RULE 312 | | | |
| 67 | 11/17/2005 | PUBS CASE REMAND TO TC | | | |
| 66 | 02/18/2005 | AMENDMENT AFTER NOTICE OF ALLOWANCE (RULE 312) | | 42 | 69 |
| 65 | 07/05/2005 | PETITION DECISION - DISMISSED | | | |
| 64 | 06/27/2005 | RECEIPT INTO PUBS | | | |
| 63 | 04/01/2005 | PETITION ENTERED | | | |
| 62 | 04/01/2005 | ISSUE FEE PAYMENT RECEIVED | | | |
| 61 | 02/18/2005 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 60 | 01/04/2005 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 59 | 01/13/2005 | WORKFLOW - FILE SENT TO CONTRACTOR | | | |
| 58 | 01/07/2005 | RECEIPT INTO PUBS | | | |
| 57 | 12/28/2004 | MAIL NOTICE OF ALLOWANCE | | | |
| 56 | 12/28/2004 | MAIL FORMAL DRAWINGS REQUIRED | | | |
| 55 | 12/28/2004 | MAIL EXAMINER'S AMENDMENT | | | |
| 54 | 12/08/2004 | ISSUE REVISION COMPLETED | | | |
| 53 | 12/08/2004 | FORMAL DRAWINGS REQUIRED | | | |
| 52 | 12/08/2004 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 51 | 12/08/2004 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 50 | 12/08/2004 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 49 | 12/08/2004 | NOTICE OF ALLOWABILITY | | | |
| 48 | 11/16/2004 | DATE FORWARDED TO EXAMINER | | | |
| 47 | 11/10/2004 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 46 | 11/16/2004 | DATE FORWARDED TO EXAMINER | | | |
| 45 | 11/10/2004 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | | |
| 44 | 11/16/2004 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 43 | 11/10/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 42 | 11/10/2004 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 41 | 09/20/2004 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 40 | 09/13/2004 | NOTICE OF APPEAL FILED | | 94 | 36 |
| 39 | 09/13/2004 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 38 | 04/16/2004 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |

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|---|---|---|---|---|---|
| 37 | 04/14/2004 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 36 | 03/11/2004 | MAIL FINAL REJECTION (PTOL - 326) | 67 | | 33 |
| 35 | 02/04/2004 | FINAL REJECTION | | | |
| 34 | 10/14/2003 | DATE FORWARDED TO EXAMINER | | | |
| 33 | 09/04/2003 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 32 | 08/01/2003 | MAIL NON-FINAL REJECTION | | | |
| 31 | 06/30/2003 | NON-FINAL REJECTION | | | |
| 30 | 04/23/2003 | DATE FORWARDED TO EXAMINER | | | |
| 29 | 04/11/2003 | RESPONSE AFTER NON-FINAL ACTION | | 155 | 23 |
| 28 | 03/24/2003 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 27 | 03/24/2003 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 26 | 03/24/2003 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 25 | 03/17/2003 | MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT | | | |
| 24 | 11/20/2002 | DATE FORWARDED TO EXAMINER | | | |
| 23.1 | 11/07/2002 | INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION | | | |
| 23 | 11/07/2002 | RESPONSE AFTER NON-FINAL ACTION | | 5 | 22 |
| 22 | 08/02/2002 | MAIL NON-FINAL REJECTION | 43 | | 18 |
| 21 | 05/06/2002 | NON-FINAL REJECTION | | | |
| 20 | 03/05/2002 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 13 | 18 |
| 19 | 02/28/2002 | DATE FORWARDED TO EXAMINER | | | |
| 18 | 02/20/2002 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 17 | 01/25/2002 | MAIL RESTRICTION REQUIREMENT | | | |
| 16 | 12/31/2001 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 15 | 10/23/2001 | DATE FORWARDED TO EXAMINER | | | |
| 14 | 10/18/2001 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 13 | 10/03/2001 | MAIL RESTRICTION REQUIREMENT | 34 | | -1 |
| 12 | 09/06/2001 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 11 | 08/01/2001 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 10 | 05/11/2001 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 9 | 01/05/2001 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 8 | 12/06/2000 | CASE DOCKETED TO EXAMINER IN GAU | | | |
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|---|---|---|---|---|---|
| 7 | 06/30/2000 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 11/16/2000 | APPLICATION DISPATCHED FROM OIPE | | | |
| 5 | 11/16/2000 | APPLICATION IS NOW COMPLETE | | | |
| 4 | 09/01/2000 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| 3 | 08/31/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 2 | 07/28/2000 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 06/30/2000 | INITIAL EXAM TEAM NN | | | |

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**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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OFFICE OF PETITIONS

In re Application of :
Yacov Yacobi, et al. :
Application No. 09/609,019 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. MS-65/1(116619.2) :

This is a decision on the petition, filed May 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 February 25, 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 2136 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).

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| | | |
|---|---|---|
| In re Application of | : | |
| Ronald Reiger et al | : | |
| Application No. 09/609,021 | : | ON PETITION |
| Filed: June 30, 2000 | : | |
| Attorney Docket No. ATTW04-00098 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed June 1, 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 July 24, 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 October 25, 2003.

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 2681.

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

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SILVERBROOK RESEARCH PTY LTD
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BALMAIN, 2041
AUSTRALIA

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OFFICE OF PETITIONS

In re Application of :
Kis Silverbrook et al :
Application No. 09/609,140 : ON PETITIONS
Filed: June 30, 2000 :
Attorney Docket No. PAK01US :

This is a decision on the petition under 37 CFR 1.137(b), filed July 9, 2003, to revive the above-identified application. This is also in response to the paper filed concurrently under 37 CFR 1.28(b) requesting that status as a Small Entity be removed.

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

The petition under 37 CFR 1.28(b), request status as a Small Entity has been **REMOVED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment (37 CFR 1.121) (Notice) mailed July 11, 2002. The Notice set a period for reply of one (1) month or thirty (30) days (whichever is later) from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 12, 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 2863.

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

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**WALKER DIGITAL MANAGEMENT, LLC**
**2 HIGH RIDGE PARK**
**STAMFORD CT 06905**

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|---|---|---|
| In re Application of | : | |
| Jay S. Walker et al | : | |
| Application No. 09/609,147 | : | DECISION ON PETITION |
| Filed: June 30, 2000 | : | UNDER 37 CFR 1.78(a)(6) |
| Attorney Docket No. 99-110 | : | |

This is a decision on the petition filed June 7, 2007, which is being treated as a petition under 37 CFR 1.78(a)(6), to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **GRANTED.**

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

Additionally, the instant nonprovisional application must be pending at the time of filing of the reference to the prior-filed provisional application as required by 37 CFR 1.78(a)(5)(ii). Further, the nonprovisional application claiming the benefit of the prior-filed provisional application must have been filed within twelve months of the filing date of the prior-filed provisional application.

All of the above requirements having been satisfied, the late claim for priority under 35 U.S.C. § 119(e) is accepted as being unintentionally delayed.

***The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(6) should not be construed as meaning that this application is entitled to the benefit of the filing date of the prior-filed application. In order for this application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the application is entitled to the benefit of the earlier filing date.***

A corrected Filing Receipt, which includes the priority claim to the prior-filed provisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3208. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The application is being forwarded to Technology Center AU 3622 for consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional application.

Karen Creasy
Petitions Examiner
Office of Petitions

**ATTACHMENT**: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING or 371(c) DATE | GRP ART UNIT | FIL FEE REC'D | ATTY.DOCKET.NO | TOT CLAIMS | IND CLAIMS |
|---|---|---|---|---|---|---|
| 09/609,147 | 06/30/2000 | 3622 | 3021 | 99-110 | 67 | 21 |

**CONFIRMATION NO. 2957**

**CORRECTED FILING RECEIPT**

22927
WALKER DIGITAL MANAGEMENT, LLC
2 HIGH RIDGE PARK
STAMFORD, CT 06905

Date Mailed: 12/13/2007

Receipt is acknowledged of 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 write to the Office of Initial Patent Examination's Filing Receipt Corrections. 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)**

Jay S. Walker, Ridgefield, CT;
James A. Jorasch, Stamford, CT;
Daniel E. Tedesco, Westport, CT;
John M. Packes JR., Hawthorne, NY;
Geoffrey M. Gelman, Stamford, CT;
Peter Kim, Stamford, CT;
Andrew P. Golden, New York, NY;
Timothy A. Palmer, Stamford, CT;
Steven M. Santisi, Stamford, CT;

**Power of Attorney:** The patent practitioners associated with Customer Number 22927

**Domestic Priority data as claimed by applicant**

This appln claims benefit of 60/201,134 05/02/2000

**Foreign Applications**

**If Required, Foreign Filing License Granted:** 08/31/2000

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 09/609,147**

**Projected Publication Date:** None, application is not eligible for pre-grant publication

**Non-Publication Request:** No

**Early Publication Request:** No

**Title**

METHOD AND APPARATUS FOR COMPENSATING PARTICIPATION IN MARKETING RESEARCH

**Preliminary Class**

705

## 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).

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 23 2001

#7

PAUL A. COLETTI, ESQ.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

| | | |
|---|---|---|
| In re Application of | : | |
| Robert E. Fischell et al | : | |
| Serial No.: 09/609,163 | : | DECISION ON PETITION |
| Filed: June 30, 2000 | : | |
| For: Stent with Improved Flexible Connecting Links | : | |

This is in response to applicants' petition filed April 16, 2001, to make the above-identified application special under the provisions of 37 CFR 1.102(c), based on the age of the applicant.

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, IV. Therefore the petition is **GRANTED**.

**The application will be forwarded to the examiner for action on the merits commensurate with this decision.**

Should there be any questions with regard to this letter please contact John Kittle by letter addressed to the Director, Technology Center 3700/2900, Washington, DC 20231, or by telephone at (703) 308-0873 or by facsimile transmission at (703) 308-3139.

John E. Kittle
Director
Technology Center 3700/2900

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Alexandria, VA 22313-1450
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OCT 26 2005

Myron Amer P C
114 Old Country Road
Suite 310
Mineola, NY 11501

Paper No. 18

*In re* Application of
BERKE, MICHAEL N.
Appl. No.: 09/609,166
Filed: July 03, 2000
For: SELF-ADMINISTERED BACK MASSAGE
Attorney Docket Number: P-3627-2

**DECISION DISMISSING PETITION**
*37 CFR 1.181*

This is a decision on petitioner's request filed January 10, 2002 with a supplement to the petition filed January 11, 2002 to review the holding of abandonment, mailed April 8, 2003. The petition is considered pursuant to 37 CFR 1.181. No fee is required for this petition.

The petition is dismissed.

A review of the file history indicates that a final rejection was mailed on August 31, 2001 setting a shortened statutory period for response of 3 months. Extensions of time were available under 37 CFR 1.136(a). Failure to reply within the set or extended period for reply will, by statute, cause the application to become abandoned (35 USC 133). An after-final amendment was timely filed on September 17, 2001. The examiner issued an advisory action (mailed September 27, 2001) indicating that the proposed amendment would not be entered because the amendment raises new issues that would require further consideration and/or search. The examiner issued second and third advisory actions (mailed October 23, 2001 and November 1, 2001); however, the proposed after-final amendment was never indicated as being entered. No extensions of time were filed after the final rejection, so the application became abandoned by statute 3 months after the mailing of the final rejection (i.e. the application became abandoned by statute on December 1, 2001).

After the application became abandoned by statute, applicant filed a Request for an Extension of Time to File an Appeal Brief on January 10, 2002. This paper is in error because it refers to a Notice of Appeal that had not yet been filed and because the shortened statutory period for reply to the final rejection had expired and applicant did not request or pay for any extensions under 37 CFR 1.136(a).

The petition filed piecemeal on January 10 and January 11, 2002 is dismissed as untimely and moot in view of the fact that the application was abandoned.

It is noted that a Notice of Appeal was subsequently filed January 24, 2002. Although the Notice of Appeal contains an authorization to charge the fee for the Notice of Appeal, there is no authorization to charge fees for extensions of time under 37 CFR 1.136(a). So the Notice of Appeal filed January 24, 2002 is untimely. It is further noted that even if papers had been filed to extend the period of response so that the Notice of Appeal was timely, no Appeal Brief was ever filed and the time period for an appeal brief to be filed has also expired.

Lastly, it appears that a spurious paper was issued by the office and mailed March 17, 2005. This paper is vacated. Although a Notice of Abandonment has not been mailed, the application remains abandoned by statute.

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. Petitioner may wish to consider filing a petition to revive under 37 CFR 1.137.

Richard A. Bertsch, Director
Technology Center 3700

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Paper No. 20

MYRON AMER P C
114 OLD COUNTRY ROAD
SUITE 310
MINEOLA, NY 11501

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FEB 0 6 2006

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Michael N. Berke | : | |
| Application No. 09/609,166 | : | ON PETITION |
| Filed: July 3, 2000 | : | |
| Attorney Docket No. P-3627-2 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed November 9, 2005, to revive the above-identified application.

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.**

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 31, 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)). The amendments submitted on September 17, 2001 and October 9, 2001, did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed September 27, 2001, October 23, 2001 and November 1, 2001. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed, and no extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on December 1, 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 Wan Laymon at (571) 272-3220.

The application file is being forwarded to Technology Center AU 3764.

Wan Laymon
Petitions Examiner
Office of Petitions

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Paper No. 090705

McGinn & Gibbs, PLLC
8321 Old Courthouse Road, Suite 200
Vienna, Virginia 22182-4100

SEP 0 8 2005

In re Application of:
Ihara et al.
Serial No.: 09/609,169
Filed: June 30, 2000
Attorney Docket No.: KUD.026

ON PETITION

This is a decision on the petition filed on June 2, 2005 under 37 CFR § 1.181, requesting for withdrawal of notice of defective appeal brief, entry of after-final amendment, and an examiner's answer.

The petition is granted to the extent indicated below.

Upon review of the application, it is agreed that the new grounds of rejection necessary to meet the limitation currently presented was not necessitated by the amendment, therefore, the prosecution will be reopened and a new non-final office action will follow to address the limitation set forth in the after-final amendment filed on September 30, 2004.

The application file is being forwarded to the examiner for consideration of the response and preparation of the office action.

Inquiries related to this decision should be directed to Robert Kim (571) 272-2293.

Janice A. Falcone

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

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RUSSO & DUCKWORTH , LLP
9090 IRVINE CENTER DRIVE , SECOND FLOOR
IRVINE, CA 92618

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Jeffrey Bryson | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7596509 | : RECALCULATION of PATENT |
| **Issue Date** | : 09/29/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/609,231 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 06/30/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **960** 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.

26 FEB 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Whiteford, Taylor & Preston, LLP
Attn: Gregory M. Stone
Seven Saint Paul Street
Baltimore, MD 21202-1626

| | | |
|---|---|---|
| In re Application of EISERMANN | : | |
| U.S. Application No.: 09/609,251 | : | DECISION |
| Attorney Docket No.: 40529W003 | : | |
| For: METHOD FOR LAYING AND INTERLOCKING PANELS | : | |

This is in response to applicant's "Request for Transfer to Status Under 35 USC 371" filed 17 October 2000, which is being treated as a petition under 37 CFR 1.182. The requisite $130.00 petition fee will be charged to Deposit Account No. 02-4300 as authorized in the petition.

## BACKGROUND

On 30 June 2000, applicant submitted application papers in the USPTO including, *inter alia*, a Utility Patent Application Transmittal (Form PTO/SB/05).

On 17 October 2000, applicant filed the present petition under 37 CFR 1.182 to convert the application to a filing under 35 U.S.C. 371.

02/27/2003 SHAJARRO 00000017 024300 09609251
01 FC:1460 130.00 CH

## DISCUSSION

Any intended filing of an international application as a national stage application must clearly and unambiguously be identified as such and must satisfy all of the conditions set forth in 35 U.S.C. 371(c). The official USPTO Notice published in the Official Gazette at 1077 OG 13 entitled "Minimum Requirements for Acceptance of Applications Under 35 U.S.C. 371 (the National Stage of PCT)" states, in part, the following:

> The Patent and Trademark Office is continuing to receive application papers which do not clearly identify whether the papers (1) are being submitted to enter the national stage of the Patent Cooperation Treaty (PCT) under 35 U.S.C. 371 or (2) are being filed as a regular national application under 35 U.S.C. 111.

* * *

> If there are any conflicting instructions as to which sections of the statute (371 or 111) is intended the application will be accepted under 35 U.S.C. 111.
>
> * * *
>
> To clearly indicate an international application is being filed under 35 U.S.C. 371 the applicant should use the "Transmittal Letter for United States Designated Office" (Form PTO-1390) as the transmittal letter.
>
> Alternatively, one of the following indications may be used:
>
> 1) the applicant shall clearly state in the transmittal or cover letter that he or she is filing under 35 U.S.C. 371 or entering the national stage under PCT; or
>
> 2) the applicant clearly identifies in the oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the described in the identified international application.

In the present case, Form PTO/SB/05 clearly indicates that applicant intended to file a national application under 35 U.S.C. 111(a). Specifically, Form PTO/SB/05 states that the application is being submitted under 37 CFR 1.53(b). MPEP 201.06(c) states in relevant part, "37 CFR 1.53(b) is the section under which all applications are filed EXCEPT: (1) an application resulting from entry of an international application into the national stage under 35 U.S.C. 371 and 37 CFR 1.494 or 37 CFR 1.495. . . ." Furthermore, Form PCT/SB/05 states that the application is a continuation of PCT/DE00/00870 and not a national stage entry. Therefore, the application was properly treated under 35 U.S.C. 111(a).

U.S. statutes and regulations do not make specific provision for the requested action and as such the Office does not grant such petitions for conversion as a mere matter of course. The Office will only grant such petitions upon a showing by applicant of sufficient cause (e.g., the loss of patent rights) where no other remedy is available. In the present case, applicant has failed to make such a showing.

## CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.182". No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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BANNER & WITCOFF , LTD
ATTORNEYS FOR CLIENT NUMBER 007412
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

Mail Date: 04/26/2010

| | | |
|---|---|---|
| **Applicant** | : Michael L. Asmussen | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7565680 | : RECALCULATION of PATENT |
| **Issue Date** | : 07/21/2009 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 09/609,316 | : OF WYETH |
| **Filed** | : 06/30/2000 | : |
| | | : |

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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OFFICE OF PETITIONS

**FLESHNER & KIM, LLP**
**P.O. BOX 221200**
**CHANTILLY VA 20153**

In re Application of :
Hyeon Jun Kim :
Application No. 09/609,392 : ON PETITION
Filed: July 3, 2000 :
Attorney Docket No. P-102 :

This is a decision on the petition, filed June 13, 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 May 11, 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 should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2628 will consider the request for continued examination under 37 CFR 1.114.

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 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. 6

IVOR R ELRIFI
MINTZ LEVIN COHN FERRIS
GLOVSKY & POPEO
ONE FINANCIAL CENTER
BOSTON, MA 02111

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SEP 25 2001

OFFICE OF PETITIONS

In re Application of :
Michael Jeffers et al :
Application No. 09/609,543 : ON PETITION
Filed: July 3, 2000 :
Attorney Docket No. 15966-557 CIP1 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 8, 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 Notice to File Missing Parts of Application (Notice) mailed September 11, 2000. The Notice set a period for reply 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, the above-identified application became abandoned on November 12, 2000.

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

The application file is being forwarded to Initial Patent Examination Division.

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

Paper No. 9

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN, 2041 AU AUSTRALIA

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OCT 0 8 2004

OFFICE OF PETITIONS

In re Application of :
Paul Lapstun et al :
Application No. 09/609,553 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. NPA068US :

This is a decision on the petition, filed September 23, 2004, under 37 CFR 1.137(b ) 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).

A petition to revive cannot be granted where there is an outstanding requirement. In the instant case, there was no response to the outstanding Office Action mailed on October 26, 2001. For applicants' convenience, a copy of the October 26, 2001 Office Action along with the new USPTO Fee Schedule effective October 1, 2004 is enclosed.

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
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

By facsimile: (703) 872-9306
ATTN: Office of Petitions

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3210.

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

Attachments: The October 26, 2001 Office Action and the new USPTO Fee Schedule effective October 1, 2004.

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

SILVERBROOK RESEARCH PTY LTD
393 DARLING STREET
BALMAIN 2041 AU AUSTRALIA

**COPY MAILED**

DEC 0 3 2004

**OFFICE OF PETITIONS**

In re Application of :
Paul Lapstun et al :
Application No. 09/609,553 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. NPA068US :

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

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

The application is being forwarded to Technology Center AU 3622 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. 6

Thomas M. Fisher
Armstrong Teasdale LLP
One Metropolitan Square
Suite 2600
St. Louis, MO 63102-2740

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MAY 24 2002

OFFICE OF PETITIONS

In re Application of :
Michael Lee McIntyre, et al. :
Application No. 09/609,560 : ON PETITION
Filed: June 30, 2000 :
Attorney Docket No. 9D-HR-19189 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 5, 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 to File Missing Parts of Application (Notice) mailed August 30, 2000. The Notice set a period for reply 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, the above-identified application became abandoned on October 31, 2000.

Telephone inquiries concerning this decision should be directed to Retta Williams at (703) 306-5594 or in my absence, Latrice Bond at (703) 308-6911.

The application file is being forwarded to Office of Initial Patent Examination for further processing.

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
For Patent Examination Policy

Latrice Bond
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. 5

STEVENS, DAVIS, MILLER & MOSHER, LLP
1615 L STREET, NW, SUITE 850
P.O. BOX 34387
WASHINGTON, D.C. 20043-4387

In re Application of :
Naoyasu Miyagawa et al. :
Reissue Application No. 09/609,699 : DECISION ON PETITION
Filed: November 22, 1999 :
Attorney Docket No. JEL 28567RE-B :

This is a decision on the petition under 37 CFR 1.182, filed June 30, 2000, to reconstruct the instant reissue patent application.

The petition is **granted**.

The application history for this application is as follows: Application No. 07/740,629, filed on August 5, 1991, issued into Patent No. 5,235,581 on August 10, 1993. On March 1, 1995, Application No. 08/396,981 was filed as a reissue application of Patent No. 5,235,581. Reissue Application No. 08/396,981 issued into Patent No. RE36445 on December 14, 1999. On November 22, 1999, petitioners filed the instant application papers as a continuation of Reissue Application No. 08/396,981. Unfortunately, however, the application papers were lost in the Office. Consequently, petitioners have filed the present petition requesting a reconstruction of the instant application.

The postcard receipt attached to the present petition is persuasive evidence of a November 22, 1999 filing date for the instant application. The application papers have been placed in a reissue application file wrapper and assigned Application No. 09/609,699.

The preliminary amendment filed on December 13, 1999 has been entered into the record for this application file.

No fee is associated with this petition.

This application file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Karen Canaan at (703) 306-3313.

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, DC 20231
www.uspto.gov

Paper No. 19

JAMES LEDBETTER, ESQ.
STEVENS DAVIS MILLER & MOSHER, LLP
1615 L STREET, NW
P O BOX 34387, SUITE 850
WASHINGTON, DC 20043-4387

MAIL

JUL 2 4 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Naoyasu Miyagawa, et al. :
Application No. 09/609,699 : DECISION ON PETITION
Filed: November 22, 1999 : FOR EXTENSION OF TIME
For: OPTICAL RECORDING/REPRODUCING APPARATUS FOR OPTICAL DISKS WITH VARIOUS DISK SUBSTRATE THICKNESSES : UNDER 37 CFR 1.136(b)

This is a decision on the petition filed July 21, 2003, under the provisions of 37 CFR 1.136(b) requesting an extension of time to file a reply to the Examiner's Answer and to file a request for Oral Hearing. The request is for a one month extension of time.

The provisions of 37 CFR 1.136(b) state:

> When a response with petition and fee for extension of time cannot be filed pursuant to paragraph (a) of this section, the time for response will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. In no case can any extension carry the date on which response to an Office action is due beyond the maximum time period set by statute or be granted when the provisions of paragraph (a) of this section are available. See § 1.304 for extension of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action, § 1.550(c) for extension of time in reexamination proceedings.

The request for a one month extension of time complies with the above noted requirements. The request is for sufficient cause and for a reasonable time specified. Accordingly, the request is granted and the reply brief and/or request for Oral Hearing is due on or before August 23, 2003.

SUMMARY: EXTENSION OF TIME **GRANTED.**

After the mailing of this decision, the application will returned to the TC 2600 Central files to await a response.

James L. Dwyer, Director
Technology Center 2600
Communications
(703) 305-4800

# 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) |
|---|---|---|---|---|
| 6721989 | 2004-04-20 | 09609825 | 2000-07-03 | |

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

| 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 | /Robert N. Barlow/ | Date (YYYY-MM-DD) | 2008-07-24 |
| Name | Robert N. Barlow | | |
| Enter Reel and Frame Number | | Remove | |
| Reel Number | 015797 | Frame Number | 0290 |
| 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.

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. 6721989
Issue Date: April 20,2004
Application No. 09609825
Filed: July 3,2000
Attorney Docket No.

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

This is a decision on the electronic petition, filed July 24,2008 ,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 July 24,2008 . 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. 5

07/29/03

STEVENS, DAVIS, MILLER & MOSHER, LLP
1615 L STREET, NW, SUITE 850
P.O. BOX 34387
WASHINGTON, D.C. 20043-4387

In re Application of :
Naoyasu Miyagawa et al. :
Reissue Application No. 09/609,829 : DECISION ON PETITION
Filed: November 22, 1999 :
Attorney Docket No. JEL 28567RE-C :

This is a decision on the petition under 37 CFR 1.182, filed June 30, 2000, to reconstruct the instant reissue patent application.

The petition is **granted**.

The application history for this application is as follows: Application No. 07/740,629, filed on August 5, 1991, issued into Patent No. 5,235,581 on August 10, 1993. On March 1, 1995, Application No. 08/396,981 was filed as a reissue application of Patent No. 5,235,581. Reissue Application No. 08/396,981 issued into Patent No. RE36445 on December 14, 1999. On November 22, 1999, petitioners filed the instant application papers as a continuation of Reissue Application No. 08/396,981. Unfortunately, however, the application papers were lost in the Office. Consequently, petitioners have filed the present petition requesting a reconstruction of the instant application.

The postcard receipt attached to the present petition is persuasive evidence of a November 22, 1999 filing date for the instant application. The application papers have been placed in a reissue application file wrapper and assigned Application No. 09/609,829.

The preliminary amendment filed on December 13, 1999 has been entered into the record for this application file.

No fee is associated with this petition.

This application file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Karen Canaan at (703) 306-3313.

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, DC 20231
www.uspto.gov

Paper No. 25

JAMES LEDBETTER, ESQ.
STEVENS DAVIS MILLER & MOSHER, LLP
1615 L STREET, NW
P O BOX 34387, SUITE 850
WASHINGTON, DC 20043-4387

MAIL

JUL 24 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Naoyasu Miyagawa, et al. :
Application No. 09/609,829 : DECISION ON PETITION
Filed: November 22, 1999 : FOR EXTENSION OF TIME
For: OPTICAL RECORDING/REPRODUCING APPARATUS FOR OPTICAL DISKS WITH VARIOUS DISK SUBSTRATE THICKNESSES : UNDER 37 CFR 1.136(b)

This is a decision on the petition filed July 21, 2003, under the provisions of 37 CFR 1.136(b) requesting an extension of time to file a reply to the Examiner's Answer and to file a request for Oral Hearing. The request is for a one month extension of time.

The provisions of 37 CFR 1.136(b) state:

> When a response with petition and fee for extension of time cannot be filed pursuant to paragraph (a) of this section, the time for response will be extended only for sufficient cause and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. In no case can any extension carry the date on which response to an Office action is due beyond the maximum time period set by statute or be granted when the provisions of paragraph (a) of this section are available. See § 1.304 for extension of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action, § 1.550(c) for extension of time in reexamination proceedings.

The request for a one month extension of time complies with the above noted requirements. The request is for sufficient cause and for a reasonable time specified. Accordingly, the request is granted and the reply brief and/or request for Oral Hearing is due on or before August 23, 2003.

SUMMARY: EXTENSION OF TIME **GRANTED.**

After the mailing of this decision, the application will be returned to the TC 2600 central files area to await a response.

James L. Dwyer, Director
Technology Center 2600
Communications
(703) 305-4800

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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CHA & REITER, LLC
210 ROUTE 4 EAST STE 103
PARAMUS NJ 07652

**MAIL**

AUG 2 3 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Yun-Hee Lee :
Application No. 09/609,909 : DECISION ON REQUEST TO
Filed: July 3, 2000 : WITHDRAW APPLICATION FROM
For: **HOMEZONE SERVICE METHOD FOR MOBILE TELEPHONE SUBSCRIBERS IN MOBILE RADIO COMMUNICATION SYSTEM** : ISSUE

This is a decision on the petition, filed April 22, 2004, to withdraw the above-identified application from issue pursuant to the provisions of 37 C.F.R. §1.313(a).

The petition **Denied**.

Petitioner's reasons for requesting withdraw of the application from issue is such that the Office might consider an IDS submission. The IDS for consideration was submitted with the subject petition. Petitioner ends the petition by stating "Favorable action on this Request for Extension of Time is courteously solicited." It will be assumed that this was just a typographical error and Petitioner was referring to the request for withdrawal from issue instead.

A review of the application file reveals that a Notice of Allowance and a Notice of Allowability were mailed for the above-identified application on March 18, 2004. The IDS and Petition were filed on April 22, 2004 and the Issue fee was paid on June 21, 2004.

37 C.F.R. §1.313 Withdrawal from issue, states in part:

> (a) Applications may be withdrawn from issue for further action at the initiative of the Office or upon petition by the applicant. To request that the Office withdraw an application from issue, 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 withdrawal of the application from issue is necessary. A petition under this section is not required if a request for continued examination under § 1.114 is filed prior to payment of the issue fee. If the Office withdraws the application from issue, the Office will issue a new notice of allowance if the Office again allows the application.

MPEP §609 Information Disclosure Statement, states in part:

> III. MINIMUM REQUIREMENTS FOR AN INFORMATION DISCLOSURE STATEMENT

RECEIVED
JAN 2 1 2005
Technology Center 2600

> B(3) Information Disclosure Statement Filed After B(2), but Prior to Payment of Issue Fee 37 CFR 1.97(d) An information disclosure statement will be considered by the examiner if filed on or after the mailing date of any of the following: a

final action under 37 CFR 1.113; a notice of allowance under 37 CFR 1.311; or an action that closes prosecution in the application, e.g., an Ex parte Quayle action, but before or simultaneous with payment of the issue fee, provided the statement is accompanied by:

(A) a statement as specified in 37 CFR 1.97(e) (see the discussion in subsection B(5); and
(B) the fee set forth in 37 CFR 1.17(p).

These requirements are appropriate in view of the late stage of prosecution when the information is being submitted, i.e., after the examiner has reached a final determination on the patentability of the claims presented for examination. Payment of the fee (37 CFR 1.17(p)) and submission of the appropriate statement (37 CFR 1.97(e)) are the essential elements for having information considered at this advanced stage of prosecution, assuming the content requirements of 37 CFR 1.98 are satisfied.

If an applicant chose not to comply, or could not comply, with the requirements of 37 CFR 1.97(d), the applicant may file a RCE under 37 CFR 1.114, or a continuing application under 37 CFR 1.53(b) or (d) to have the information considered by the examiner. [emphasis added]

The IDS was filed prior to payment of the issue fee. Therefore, for consideration by the examiner, Applicant would need to comply with the requirements of 37 C.F.R. §1.97(d) which requires a statement as specified in 37 C.F.R. §1.97(e) and the fee. Neither of these were found on the petition or the IDS. Therefore, Applicant has not complied with the requirements for filing an IDS after Notice of Allowance, before payment of the issue fee, in order for the examiner to consider the IDS.

Moreover, Applicant states on the IDS transmittal that "No fee is believed due for the filing of this statement inasmuch as it is being filed before the mailing of the first official action on the merits." However, no request for an RCE was filed with the petition. Therefore, the request to withdraw the application from issue in accordance with 37 C.F.R. §1.313(a) is denied.

The application will be forwarded to the Office of Publications for issuance in appropriate turn.

Andrew Faile, Director (Acting)
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. 8

MANDEL & ADRIANO
35 N ARROYO PARKWAY
SUITE 60
PASADENA, CA 91103

COPY MAILED

JAN 2 5 2002

OFFICE OF PETITIONS

In re Application of :
Peter S. Linsley et al :
Application No. 09/609,915 : DECISION GRANTING
Filed: July 3, 2000 : STATUS UNDER 37 CFR 1.47(a)
For: SOLUBLE CTLA4 MUTANT :
MOLECULES AND USES THEREOF :

This is a decision on the petition filed January 4, 2002, requesting reconsideration of a decision mailed September 5, 2001, which refused to accord 37 CFR 1.47(a) status to the above-identified application.

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(c), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

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

This application is being forwarded to Technology Center AU 1646 for examination in due course.

Frances Hicks
Lead Petitions Examiner
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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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD CT 06905

**COPY MAILED**

NOV 29 2005

**OFFICE OF PETITIONS**

In re Application of :
Walker et al. :
Application No. 09/609,931 :
Filed: June 30, 2000 :
Attorney Docket No. 99-099 :

CORRECTED DECISION
ON PETITIONS

This is in response to the petition under 37 CFR 1.48(a), filed June 3, 2005, to add persons as inventors of the above-identified application. This is also in response to the petition under 37 CFR 1.183, filed June 3, 2005, to waive 37 CFR 1.48(a)(3), which requires the actual inventors to execute an oath or declaration in compliance with 37 CFR 1.63.

In the present petitions, petitioner authorized the Office to charge any necessary fees to Deposit Account No. 50-0271. The current fee for a petition under 37 CFR 1.183 is $400.00. The current processing fee for a petition under 37 CFR 1.48 is $130.00.

On November 25, 2005, the Office mailed a decision granting the petition under 37 CFR 1.183 and dismissing the petition under 37 CFR 1.48. Unfortunately, Deposit Account No. 50-0271 contains insufficient funds to pay either the petition fee or the processing fee.

The Office notes that the rules and statutory provisions governing the operations of the USPTO require payment of a fee upon filing a petition. Accordingly, the decision of November 25, 2005, must be vacated and the petition must be dismissed because of the lack of payment of the fees upon filing the petitions.

In view of the above, petitioner must file both a request for reconsideration under 37 CFR 1.183 and 37 CFR 1.48(a) and pay the outstanding fees, totaling $530.00, within **TWO (2) MONTHS** of this decision. No extensions of time are permissible.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

| | |
|---|---|
| By mail: | Mail Stop Petition<br>Commissioner for Patents<br>P.O. Box 1450<br>Alexandria, VA 22313-1450 |
| By FAX: | (571) 273-8300<br>Attn: Office of Petitions |
| By hand: | Customer Service Window<br>Randolph Building<br>401 Dulany Street<br>Alexandria, VA 22314 |

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
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
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WALKER DIGITAL
FIVE HIGH RIDGE PARK
STAMFORD CT 06905

COPY MAILED

NOV 25 2005

OFFICE OF PETITIONS

In re Application of :
Walker et al. :
Application No. 09/609,931 :
Filed: June 30, 2000 :
Attorney Docket No. 99-099 :

DECISION ON PETITIONS

This is a decision on the petition under 37 CFR 1.48(a), filed June 3, 2005, to add persons as inventors of the above-identified application. This is also a decision on the petition under 37 CFR 1.183, filed June 3, 2005, to waive 37 CFR 1.48(a)(3), which requires the actual inventors to execute an oath or declaration in compliance with 37 CFR 1.63. The petitions were recently forwarded to the Office of Petitions for a decision on the merits. The Office sincerely apologizes for any inconvenience to petitioner.

On June 30, 2000, petitioner filed the above-identified application, including a properly executed declaration. On June 3, 2005, petitioner filed a petition to add Daniel E. Tedesco, Andrew S. Van Luchene, and John B. Dickerson as joint inventors in the above-identified application. Petitioner stated that inventor, Anna Rath, who executed the original declaration, refused to execute the declaration submitted with the petition pursuant to 37 CFR 1.48(a)(3).

**Petition Under 37 CFR 1.183**

In the present petition, petitioner asserted that inventor, Anna Rath, who executed the original declaration, refused to execute the declaration submitted with the petition pursuant to 37 CFR 1.48(a)(3). Thus, petitioner requested that the Office waive the requirement of 37 CFR 1.48(a)(3).

Pursuant to 37 CFR 1.183, in an extraordinary situation, when justice requires, any requirement of the regulations, 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. In support of petitioner's assertion of Ms. Rath's refusal, petitioner submitted the Affidavit of Michael D. Brinton. Mr. Brinton stated that he mailed a copy of the application papers, including the drawings, a Combined Declaration and Power of Attorney, an Assignment, and a self-addressed stamped envelope to Ms. Rath at her last known address. Additionally, Mr. Brinton attested that he left a telephone message for Ms. Rath at her place of employment; however, she did not contact him or executed the requested documents.

In view of the fact that Ms. Rath refused to sign the declaration, it is agreed that justice would be served by waiving the requirement of 37 CFR 1.48(a)(3).

Accordingly, the petition under 37 CFR 1.183 is **granted**.

**Petition Under 37 CFR 1.48(a)**

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

(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).

Although the petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.48(a)(3) is granted, the petition lacks item (5) above.

Section 201.03(II)(D) of the Manual of Patent Examining Procedure states, in pertinent part: "The written consent of every existing assignee of the original named inventors must be submitted. 37 CFR 1.48(a)(5)." MPEP 201.03(II)(D). "37 CFR 1.48(a) does not limit assignees to those who are recorded in the U.S. Patent and Trademark Office record." Id. "The individual signing on behalf of the assignee giving its consent to the requested inventorship correction, should specifically state that he or she has the authority to act on behalf of the assignee." Id. "Further, the assignee must establish its ownership of the application in accordance with 37 CFR 3.73. MPEP § 324." Id.

In the present petition, the assignee established its ownership of the application in accordance with 37 CFR 3.73. However, a review of the record does not indicate that that petitioner submitted the written consent of the assignee with the present petition in compliance with 37 CFR 1.48(a)(5).

Accordingly, the petition under 37 CFR 1.48 is **dismissed**.

The $400.00 fee for filing the petition under 37 CFR 1.183 and the $130.00 processing fee for the petition under 37 CFR 1.48 will be charged to petitioner's Deposit Account, as authorized.

Petitioner is given TWO (2) MONTHS from the mailing date of this decision to reply, correcting the above-noted deficiency. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.48." Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

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
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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FIVE HIGH RIDGE PARK
STAMFORD CT 06905

**COPY MAILED**

JAN 0 6 2006

**OFFICE OF PETITIONS**

In re Application of :
Walker et al. :
Application No. 09/609,931 : DECISION ON PETITIONS
Filed: June 30, 2000 :
Attorney Docket No. 99-099 :

This is a decision on the petition under 37 CFR 1.48(a), filed December 20, 2005, to add persons as inventors of the above-identified application. This is also a decision on the petition under 37 CFR 1.183, filed December 20, 2005, to waive 37 CFR 1.48(a)(3), which requires the actual inventors to execute an oath or declaration in compliance with 37 CFR 1.63.

On June 30, 2000, petitioner filed the above-identified application, including a properly executed declaration. On petition, petitioner requested that the Office add Daniel E. Tedesco, Andrew S. Van Luchene, and John B. Dickerson as joint inventors in the above-identified application. Petitioner stated that inventor, Anna Rath, who executed the original declaration, refused to execute the declaration submitted with the petition pursuant to 37 CFR 1.48(a)(3).

**Petition Under 37 CFR 1.183**

Petitioner asserted that inventor, Anna Rath, who executed the original declaration, refused to execute the declaration submitted with the petition pursuant to 37 CFR 1.48(a)(3). Thus, petitioner requested that the Office waive the requirement of 37 CFR 1.48(a)(3).

Pursuant to 37 CFR 1.183, in an extraordinary situation, when justice requires, any requirement of the regulations, 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. In support of petitioner's assertion of Ms. Rath's refusal, petitioner submitted the Affidavit of Michael D. Brinton. Mr. Brinton stated that he mailed a copy of the application papers, including the drawings, a Combined Declaration and Power of Attorney, an Assignment, and a self-addressed stamped envelope to Ms. Rath at her last known address. Additionally, Mr. Brinton attested that he left a telephone message for Ms. Rath at her place of employment; however, she did not contact him or executed the requested documents.

In view of the fact that Ms. Rath refused to sign the declaration, it is agreed that justice would be served by waiving the requirement of 37 CFR 1.48(a)(3).

Accordingly, the petition under 37 CFR 1.183 is **granted**.

**Petition Under 37 CFR 1.48(a)**

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

(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).

Petitioner has met the requirements of 37 CFR 1.48(a). Accordingly, the petition under 37 CFR 1.48 is **granted**. A corrected filing receipt accompanies this decision.

Lastly, in the petition of June 3, 2005, petitioner asked that upon the acceptance of the request to add the new inventors, the Office change the order of inventors as listed in the petition. **The Office notes that the order of inventors will appear as listed in the executed declaration submitted on that date. However, petitioner may file a petition under 37 CFR 1.182 with a $400.00 petition fee, requesting that the Office change the order of the inventors as indicated in the petition.**

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Corrected filing receipt

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. 15

SHEMWELL GREGORY & COURTNEY LLP
4880 STEVENS CREEK BOULEVARD
SUITE 201
SAN JOSE CA 95129

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AUG 11 2005

OFFICE OF PETITIONS

In re Application of :
Miller :
Application No. 09/609,961 :
Filed: July 1, 2000 :
Attorney Docket No. MILLER1 :

DECISION
ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 30, 2004, 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 May 28, 2003. No extensions of time having been obtained pursuant to 37 CFR 1.136(a), this application became abandoned on August 29, 2003. A Notice of Abandonment was mailed on March 4, 2004.

Receipt of a Notice of Appeal, filed January 30, 2004, is acknowledged. Accordingly, the 2-month period for filing the appeal brief accompanied by the fee required by law runs from the date of this decision.

The file is being forwarded to Technology Center G.A.U. 2121 to enter the Notice of Appeal, filed January 30, 2004, and to await receipt of the appeal brief.

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

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

# 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) |
|---|---|---|---|---|
| 6685949 | 2004-02-03 | 09610034 | 2000-07-05 | NIH142.001C1 |

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 Hart/ | Date (YYYY-MM-DD) | 2008-04-03 |
| Name | Daniel Hart | Registration Number | 40637 |

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. 6685949
Issue Date: February 3,2004
Application No. 09610034
Filed: July 5,2000
Attorney Docket No. NIH142.001C1

:

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

:

This is a decision on the electronic petition, filed April 3,2008 ,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 April 3,2008 . 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

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON KY 40550-0999

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OFFICE OF PETITIONS

ON PETITION

In re Application of
Cook et al
Application No.09/610,081
Filed: July 5, 2000
Attorney Docket Number: LE9-00-045
Title of Invention: Printer Apparatus With Integrated Graphical User Interface and Method For Using The Same

This is a decision on the petition filed August 14, 2006, 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 January 3 , 2006. 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 April 4, 2006. A Notice of Abandonment was mailed on July 14, 2006.

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

# 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) |
|---|---|---|---|---|
| 6,579,489 | 2003-06-17 | 09610103 | 2000-06-30 | CGI 0120 PUS |

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 | /John A. Artz/ | Date (YYYY-MM-DD) | 2007-09-13 |
| Name | John A. Artz | Registration Number | 25824 |

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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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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In re Patent No. 6579489
Issue Date: June 17,2003
Application No. 09610103
Filed: June 30,2000
Attorney Docket No. 0114-00105

:

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

:

This is a decision on the electronic petition, filed September 13,2007,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 13,2007. 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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ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO, TX 75024

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DEC 2 3 2009

**OFFICE OF PETITIONS**

In re Patent of Speiser et al. :
Patent No. 7,103,041 :
Issue Date: September 5, 2006 : Letter Regarding
Application No. 09/610,116 : Patent Term Adjustment
Filing Date: June 30, 2000 :
Attorney Docket No. P63080-USA :

This letter is in response to the "37 CFR 1.322 & 37 CFR 1.323 Request for Certificate of Correction for USPTO and/or Applicant Mistake" filed November 20, 2008. Patentee's Request is being treated in part as a letter regarding patent term adjustment filed pursuant to patentee's duty of good faith and candor to the Office.[1]

The request for review of the patent term adjustment is **DISMISSED**.

On December 12, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) ("Determination") in the above-identified application. The Notice stated the patent term adjustment to date is 702 days.

On September 5, 2006, the application matured into United States Patent No. 7,103,041 with a revised patent term adjustment of 997 days.

Patentees request a certificate of correction to replace the "997" days of patent term adjustment on the patent with "702" days of patent term adjustment. Patentees cite the third page of the Notice of Allowance in support of the assertion the 997 days of adjustment should be 702 days.

The amount of patent term adjustment indicated in the Notice of Allowance is not necessarily the final amount of patent term adjustment. As stated in MPEP 2735,

> Since the Office is obligated to provide a determination of patent term adjustment under 35 U.S.C. 154(b) in the notice of allowance (i.e. before the actual patent issue date), the Office must project (or estimate) the actual patent issue date and base its patent term adjustment determination on that projection. Additionally, there are a number of papers which if submitted by an applicant after the mailing of the notice of allowance will result

[1] *See Comment 43, Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 56,366 (September 18, 2000).

in a reduction of any patent term adjustment , and there may be Office delays occurring after mailing the notice of allowance in an increase in the amount of patent term adjustment.

The Office has reviewed all the patent term adjustment calculations, determined the Office acted properly when it increased the patent term adjustment amount listed in the Notice of Allowance, and determined issuance of a Certificate of Correction lowering the amount of patent term adjustment appearing on the patent would be inappropriate.

A copy of the PALM calculations for this application is enclosed.

The revised Patent Term Adjustment remains nine hundred ninety-seven (997) days.

As the Request was not submitted in order to increase the amount of patent term adjustment listed on the patent, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks patentee for their good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to the Certificates of Correction Branch for consideration of the issues remaining in the request for Certificate of Correction filed November 20, 2008. No change to the patent term adjustment will be made.

Telephone inquiries specific to this decision should be directed to Senior Petitions Attorney Steven Brantley at (571) 272-3203.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of PALM Screen

| PTA Calculations for Application: 09/610116 | | | |
|---|---|---|---|
| Application Filing Date: | 06/30/2000 | PTO Delay (PTO): | 1163 |
| Issue Date of Patent: | 09/05/2006 | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 166 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 997 |
| PTO Delay Adjustment: | 0 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 57.5 | 08/16/2006 | PTA 36 MONTHS | 370 | | |
| 57 | 09/05/2006 | PATENT ISSUE DATE USED IN PTA CALCULATION | 50 | | 50 |
| 56 | 07/21/2006 | EXPORT TO FINAL DATA CAPTURE | | | |
| 55 | 07/19/2006 | FINISHED INITIAL DATA CAPTURE | | | |
| 54 | 07/20/2006 | DISPATCH TO FDC | | | |
| 53 | 07/20/2006 | DISPATCH TO FDC | | | |
| 52 | 03/23/2006 | APPLICATION IS CONSIDERED READY FOR ISSUE | | | |
| 51 | 01/06/2006 | WORKFLOW - DRAWINGS FINISHED | | 0 | |
| 50 | 03/17/2006 | ISSUE FEE PAYMENT VERIFIED | | 5 | 44 |
| 49 | 03/21/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 48 | 03/17/2006 | ISSUE FEE PAYMENT RECEIVED | | | |
| 47 | 01/06/2006 | WORKFLOW - DRAWINGS FINISHED | | 0 | |
| 46 | 01/06/2006 | WORKFLOW - DRAWINGS FINISHED | | 120 | |
| 45 | 12/19/2005 | EXPORT TO INITIAL DATA CAPTURE | | | |
| 44 | 12/12/2005 | MAIL NOTICE OF ALLOWANCE | | | |
| 43 | 12/12/2005 | MAIL FORMAL DRAWINGS REQUIRED | | | |
| 42 | 12/12/2005 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 41 | 12/12/2005 | MAIL EXAMINER'S AMENDMENT | | | |
| 40 | 12/09/2005 | ISSUE REVISION COMPLETED | | | |
| 39 | 12/09/2005 | FORMAL DRAWINGS REQUIRED | | | |
| 38 | 12/09/2005 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 37 | 12/09/2005 | EXAMINER'S AMENDMENT COMMUNICATION | | | |
| 36 | 12/09/2005 | NOTICE OF ALLOWABILITY | | | |

| | | | | | |
|---|---|---|---|---|---|
| 35 | 12/06/2005 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 34 | 08/22/2005 | AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED | | | |
| 33 | 08/29/2005 | DATE FORWARDED TO EXAMINER | | | |
| 32 | 08/22/2005 | RESPONSE AFTER NON-FINAL ACTION | | 5 | 29 |
| 31 | 08/22/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 30 | 08/09/2005 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 29 | 05/17/2005 | MAIL NON-FINAL REJECTION | 17 | | 26 |
| 28 | 05/16/2005 | NON-FINAL REJECTION | | | |
| 27 | 03/22/2005 | DATE FORWARDED TO EXAMINER | | | |
| 26 | 12/30/2004 | RESPONSE AFTER NON-FINAL ACTION | | 2 | 24 |
| 25 | 12/30/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 24 | 09/28/2004 | MAIL NON-FINAL REJECTION | | | |
| 23 | 09/27/2004 | NON-FINAL REJECTION | | | |
| 22 | 07/30/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 21 | 07/30/2004 | DATE FORWARDED TO EXAMINER | | | |
| 20 | 06/14/2004 | RESPONSE AFTER NON-FINAL ACTION | | 32 | 15 |
| 19 | 06/14/2004 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 18 | 11/28/2000 | SUBSTITUTE SPECIFICATION FILED | | | |
| 17 | 11/27/2000 | OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL) | | | |
| 16 | 06/14/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 15 | 02/13/2004 | MAIL NON-FINAL REJECTION | | | |
| 14 | 02/09/2004 | NON-FINAL REJECTION | | | |
| 13 | 12/05/2003 | DATE FORWARDED TO EXAMINER | | | |
| 12 | 11/28/2003 | RESPONSE AFTER NON-FINAL ACTION | | 2 | 11 |
| 11 | 08/26/2003 | MAIL NON-FINAL REJECTION | 726 | | -1 |
| 10 | 08/25/2003 | NON-FINAL REJECTION | | | |
| 9 | 08/07/2003 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 8 | 03/11/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 7 | 01/10/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 6 | 12/06/2000 | APPLICATION DISPATCHED FROM OIPE | | | |
| 5 | 12/06/2000 | APPLICATION IS NOW COMPLETE | | | |
| 4 | 09/05/2000 | NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 3 | 09/05/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 2 | 07/25/2000 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 06/30/2000 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

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BLDG 082-1
LEXINGTON KY 40550-0999

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MAY 09 2007

OFFICE OF PETITIONS

In re Application of :
Rasche, et al. :
Application No. 09/610,129 : DECISION ON PETITION
Filed: July 5, 2000 :
Attorney Docket No. LE9-00-051 :

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed March 2, 2007.

The petition is **GRANTED**.

The above-identified application was held abandoned for not filing a reply after applicant withdrew the appeal. Applicants filed an Appeal Brief on December 29, 2004. The Examiner mailed an Answer on April 19, 2005. On May 2, 2005, Applicants filed a "WITHDRAWAL OF APPEAL". The Office mailed a Notice of Abandonment on February 7, 2007.

MPEP 1215.02 states:

> If an application contains allowed claims, as well as claims on appeal, the withdrawal of the appeal does not operate as an abandonment of the application, but is considered a withdrawal of the appeal as to those claims and authority to the examiner to cancel the same. An amendment canceling the appealed claims is equivalent to a withdrawal of the appeal

A review of the Examiner's Answer reveals that there were allowed claims.

In view of the above and per MPEP 1215.02, it is obvious that the Notice of Abandonment was mailed in error.

Accordingly, **the holding of abandonment is withdrawn.**

The matter is being forwarded to Group Art Unit 2625 for consideration of the "WITHDRAWAL OF APPEAL", filed May 2, 2005.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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DEC - 1 2003

Paper No. 8

In re Application of :
Tommy Leo Myatt : DECISION ON PETITION
Application No. 09/610,196 :
Filed: July 5, 2000 :
Attorney Docket No. 5300-001

This is a decision on the petition filed by facsimile transmission on March 6, 2002 and resubmitted by facsimile transmission on May 29, 2002. Petitioner requests that the examiner's holding that this application stands abandoned for failure to file a proper and timely reply to the Office letter dated August 2, 2001 be withdrawn. The petition is being treated under 37 CFR 1.181 and no fee is required. However, petitioner requests that in the alternative, the application be revived pursuant to 37 CFR 1.137(b). It is noted that petitioner has authorized a charge against Deposit Account No. 50-0464 as may be necessary.

The petition to withdraw the holding of abandonment is denied.

It appears from the record that on August 2, 2001, a requirement to restrict this application by electing one of a plurality of patentably distinct inventions was mailed to petitioner at the correspondence address of record (i.e., to counsel of record). Counsel for petitioner alleges that counsel replied to this requirement by telephoning the examiner on August 20, 2001 and making an election consonant with the restriction requirement. This allegation by including contemporaneous notes made by counsel with respect to that telephone conversation, and records indicating that a telephone call was place by counsel to examiner on that date. It further appears from the petition that the examiner telephoned counsel on February 20, 2002 to inquire "as to whether abandonment of the case was intended." Counsel states that this was the first time that counsel was aware that the oral election "had not been accepted."

Petitioner argues that there is no absolute requirement that an applicant submit all responses to all Office actions in writing, and that oral responses to restriction requirements are encouraged. Petitioner cites MPEP 812.01 in support of these propositions. Petitioner further argues that even where a restriction requirement is made in writing, a response thereto (i.e. an election) may be made orally, and cites MPEP 714.04 (*sic,* MPEP 713.04) in support of that proposition. Petitioner argues, alternatively, that even if the oral election was deemed to be defective for some reason, the examiner should have treated the oral election as a *bona fide* attempt to respond and taken action pursuant to 37 CFR 1.135(c), rather than holding the application to have become abandoned.

37 CFR 1.111 reads in pertinent part:

> **"Reply by applicant or patent owner to a non-final Office action.**
> (a)(1) If the Office action after the first examination (§ 1.104) is adverse in any respect, the applicant or patent owner, if he or she persists in his or her application for a patent or reexamination proceeding, must reply and request reconsideration or further examination, with or without amendment. See §§ 1.135 and 1.136 for time for reply to avoid abandonment.
>
> ...
>
> (b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. ..."

37 CFR 1.104 reads in pertinent part:

" **Nature of examination.**
(a) Examiner 's action .
(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated."

37 CFR 1.142 reads in pertinent part:

"**Requirement for restriction.**
" If two or more independent and distinct inventions are claimed in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an invention to which the claims will be restricted, this official action being called a requirement for restriction (also known as a requirement for division). Such requirement will normally be made before any action on the merits; however, it may be made at any time before final action."

37 CFR 1.143 reads in pertinent part:

"**Reconsideration of requirement.**
If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor (See § 1.111).

MPEP § 812.01 is entitled "Telephone Restriction Practice" and states, in pertinent part:

"If an examiner determines that a requirement for restriction should be made in the application ... [T]hereupon, the examiner should telephone the attorney or agent of record and request an oral election ... . However, no telephone communication need be made ... . If the attorney or agent objects to making an oral election, or fails to respond, the usual restriction letter will be mailed and this letter should contain reference to the unsuccessful telephone call. ... "

Consideration of these Federal Regulations and the section of the MPEP cited by petitioner, it is clear that petitioner's arguments are not persuasive. An applicant's ability to make a telephonic election is predicated on the examiner having first made a telephonic restriction requirement. Where no telephonic restriction requirement was attempted, or was attempted without an election resulting, then as indicated by 37 CFR 1.142, the examiner will render "an Office action" and, pursuant to 37 CFR 1.143 and, in particular, the reference to 37 CFR 1.111 contained therein, an applicant must thereafter respond in writing. 37 CFR 1.104, last sentence, makes it clear that an Office action is not limited to patentability matters only, but may address matters of form and requirements of the regulations, e.g., restriction. And 37 CFR 1.111 makes it clear that a response to an Office action must be in writing.

While it is appreciated that the Office encourages telephonic elections, the condition precedent to such an election is clearly set forth in MPEP 812.01 as being an examiner initiated telephonic restriction. The record shows, paper No. 4, last sentence, that the examiner attempted to do this but the examiner's attempt did not result in an oral telephonic election. The examiner satisfied the requirements of MPEP §§ 812.01 and 713.04 by recording the unsuccessful attempt to obtain a telephonic election. Beyond that, it is not clear to the undersigned what relevance the interview practice discussed in MPEP § 713.04 has to the facts of this matter. While the examiner should have advised counsel that counsel's August 21, 2003 attempt to reply telephonically to a written restriction requirement did not satisfy 37 CFR 1.111 and 37 CFR 1.143, the examiner failure to do so does not relieve petitioner of the burden of complying with these regulations. The examiner is without authority to waive the regulations.

While it is noted that petitioner has argued that the oral election on August 21, 2001 should have been accepted as a *bona fide* attempt to respond to the restriction requirement, petitioner concedes that no written response to paper No. 4 was filed. In the absence of such a response, 37 CFR 1.135(c) does not apply, because 37 CFR 1.135 is, by its terms, limited to the failure of a reply to be "such complete and proper reply as the condition of the application may require." As the application contained a written restriction requirement, a written reply was required. 37 CFR 1.111 and 1.143. An oral response cannot be accepted as an incomplete written reply because an oral response not a written reply at all.

For the foregoing reasons, it does not appear that the examiner has acted in an arbitrary or capricious manner, or otherwise abused his discretion, in holding that this application stands abandoned for failure to file a timely and proper reply to paper No. 4. It appears, therefore, that there is no basis upon which to withdraw the examiner's holding of abandonment. Accordingly, this application is being forwarded to the Office of Petitions to consider the alternative relief requested under 37 CFR 1.137(b).

PETITION DENIED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Mary M. Lee, P.C.
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Paper No. 9

MARY M LEE, P.C.
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OKLAHOMA CITY, OK 73134

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JUN 0 9 2004

OFFICE OF PETITIONS

In re Application of :
Tommy Leon Myatt :
Application No. 09/610,196 : ON PETITION
Filed: July 5, 2000 :
Attorney Docket No. 5300-001 :

This is a decision on the petition, filed March 6, 2002, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

A review of the record discloses that the application became abandoned for a failure to reply in a timely manner to the non-final Office action mailed August 2, 2001. A Notice of Abandonment was mailed on February 26, 2002. In response, on March 6, 2002, the present petition was filed. It is noted that the petition was initially denied in a decision mailed December 1, 2003, as the petition was treated as a request to withdraw the holding of abandonment under 37 CFR 1.181. The petition is alternatively being treated under 37 CFR 1.137(b) as requested.

The petition is found to be in compliance with 37 CFR 1.137(b). Accordingly, 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 Technology Center.

The application file is being forwarded to Technology Center Art Unit 3742 for consideration of the response filed March 6, 2002.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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MARY M LEE PC
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JAN 24 2006

**OFFICE OF PETITIONS**

In re
Tommy Leon Myatt : DECISION ON APPLICATION
Application No. 09/610,196 : FOR PATENT TERM ADJUSTMENT
Filed: July 5, 2000 :
Attorney Docket No. 5300-001 :

This decision is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT", filed August 17, 2005. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to nine hundred thirty (930) 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 **six hundred twenty-one (621) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 18, 2005, 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 zero (0) days. On August 17, 2005, Applicant timely[1] submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is nine hundred thirty (930) days.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of one hundred two (102) days, pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. §1.703(a)(2), reduced by nine hundred fifty (950) days of Applicant delay pursuant to 37 C.F.R. §1.704(b).

A Restriction Requirement was mailed on August 2, 2001, setting a one month extendable period for reply. No reply was filed, and as such, the application became abandoned by operation of law on September 3, 2001. A courtesy Notice of Abandonment was mailed on February 26, 2002. Applicants filed a petition to revive, together with a Response to Restriction Requirement, on March 6, 2002. The petition was granted in a decision mailed on June 9, 2004. 37 C.F.R. § 1.704(c)(3) states:

> (c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:
>
> (3) Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:
>
> (i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or
>
> (ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

---

[1] Applicant filed the application for patent term adjustment prior to payment of the issue fee on August 18, 2005.

The application became abandoned on September 3, 2001. Four months after the date the grantable petition to revive was filed is July 6, 2002. Accordingly, applicant failed to engage in reasonable efforts to conclude examination of the application from the period beginning on September 3, 2001 and ending on July 6, 2002, or three hundred seven (307) days.

As set forth above, applicant filed the Response to Restriction Requirement with the petition to revive on March 6, 2002, not June 9, 2004. Therefore applicant should not have been assessed delay of nine hundred fifty (950) days. The Office did not mail a reply to the Response to Restriction Requirement until January 19, 2005. Accordingly, pursuant to 37 C.F.R. § 1.703(a)(2), PTO delay should have been assessed as nine hundred twenty-eight (928) days, not one hundred two (102) days as shown in PAIR, and not one thousand fifty (1050) days as asserted by applicant. Pursuant to 37 C.F.R. § 1.702(a)(2), the Office had four months from March 2, 2002 to file an Office action in response to the Response to Restriction Requirement.

In view thereof, the correct determination of patent term adjustment is **six hundred twenty-one (621) days** (928 days of PTO delay, reduced by 307 days of applicant delay).

Receipt of the $200 fee under 37 C.F.R. §1.18(e) is acknowledged.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this letter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

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**OBLON SPIVAK McCLELLAND**
**MAIER & NEUSTADT PC**
**1940 DUKE STREET**
**ALEXANDRIA, VA 22314**

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**OFFICE OF PETITIONS**

In re Application of :
Kimio Nakayama et al :
Application No. 09/610,222 : DECISION GRANTING PETITION
Filed: July 3, 2000 : UNDER 37 CFR 313(c)(2)
Attorney Docket No. 193769US0 :

This is a decision on the petition, filed December 5, 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 30, 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) 305-8680.

The file will be taken up by Technology Center AU 1771 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
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Paper No. 7

OBLON SPIVAK McCLELLAND
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

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MAR 0 7 2003

OFFICE OF PETITIONS

In re Application of :
Mohamed Bouzekri :
Application No. 09/610,224 : DECISION ON PETITION
Filed: July 3, 2000 : UNDER 37 CFR 1.181
Attorney Docket No. 193377US55X :

This is a decision on the petition received by facsimile transmission on November 20, 2002 (and again on February 23, 2003),[1] which is being treated as a petition under 37 CFR 1.181 requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **granted**.

This application was held abandoned for failure to timely reply to the Notice to File Missing Parts of Nonprovisional Application, mailed September 5, 2000, which set a two month extendable period for submitting an executed oath or declaration in compliance with 37 CFR 1.63. A Notice of Abandonment was mailed on July 17, 2002.

Petitioner states that the Notice of September 5, 2000 was never received. In support of this assertion, petitioner has supplied a copy of his records where the Notice would have been recorded had it been received.

The evidence submitted is sufficient to establish nonreceipt of the Notice of September 5, 2000. While the petition does not contain the statement that "a search of the file jacket and docket records indicates that the Office communication was not

[1] Petitioner has submitted a stamped postcard which evidences receipt by the U.S. Patent and Trademark Office (USPTO)of a petition to withdraw the holding of abandonment on August 30, 2002. Unfortunately, to date, the originally submitted petition has not to date been associated with the instant file. Accordingly, the petition will be treated as having been received in the USPTO on August 30, 2002.

received," the statements presented in the petition will so construed.

In view of the above, the holding of abandonment for failure to reply to the Notice of September 5, 2000 is hereby withdrawn and the application is restored to pending status.

The reply in the form of an executed oath or declaration was received by facsimile transmission on February 6, 2003 and has been made of record in the application file.

Any questions concerning this decision on petition may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to the Office of Initial Patent Examination for pre-examination processing.

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

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JAN 14 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Blakely Sokoloff Taylor & Zafmann
12400 Wilshire Boulevard
Seventh Floor
Los Angeles, CA 90025-1026

In re Application of
Roy Malcolm Moody, et al.
Application No. 09/610,229
Filed: July 5, 2000
For: A WINDOW OPERATOR

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

This is in reply applicant's Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181 filed in the United States Patent and Trademark Office on September 16, 2003.

The petition is **DISMISSED**.

A review of the file record indicates that the application was held abandoned for failure to timely file a proper response to the Office action dated December 31, 2002 and a Notice to that effect was mailed on August 26, 2003.

Petitioner states that a response was filed on June 2, 2003 by facsimile transmission. The copy of the response submitted with the petition includes a Certificate of Transmission dated June 2, 2003.

Any petition to withdraw the holding of abandonment based upon a Certificate of Transmission by facsimile must include the following requirements:

(1) A copy of the original response bearing a signed Certificate of Transmission which includes the date of signing; and

(2) A statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of transmitting the *original* response on the date indicated on the Certificate of Transmission (see 37 CFR 1.8 and MPEP 512).

While meeting requirement (1) above the petition fails, under requirement (2), to also include a statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of sending the *original* response by facsimile transmission on the date indicated on the certificate, by the person who signed the certificate.

Further, the copy of the facsimile confirmation page having the June 2, 2003 date cannot be relied upon as proof of timely filing the response. See section 512 of the MPEP.

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(b) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment Under 37 CFR 1.81."

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866

KJD/cps: 1/8/03

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Blakely Sokoloff Taylor & Zafmann
12400 Wilshire Boulevard
Seventh Floor
Los Angeles CA 90025-1026

In re Application of
Roy Malcolm Moody et al.
Application No. 09/610,229
Filed: August 19, 2002
For: WINDOW OPERATOR

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

This is in reply to applicant's renewed petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office on February 6, 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 June 2, 2003. 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.

mjz/ 2/27/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 16

FLIESLER DUBB MEYER & LOVEJOY, LLP
FOUR EMBARCADERO CENTER
SUITE 400
SAN FRANCISCO CA 94111

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APR 1 6 2003

OFFICE OF PETITIONS

In re Application of
Johnson, et al.
Application No. 09/610,239
Filed: July 5, 2000
Attorney Docket No. 023890-031 (SD-8267)
For: IN-VACUUM EXPOSURE SHUTTER

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed February 11, 2003, to revive the above-identified application. In the alternative, petitioners request revival under 37 CFR 1.137(b).

The petition under 37 CFR 1.137(a) is **DISMISSED**.

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

The above-identified application became abandoned for failure to properly reply to the final Office action mailed May 14, 2002. Petitioners filed an amendment after final on November 8, 2002 (certificate of mailing date June 5, 2002), which failed to place the application in prima facie condition for allowance. A Notice of Abandonment was mailed on January 20, 2003.

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, Petitioners have failed to provide adequate evidence that the delay was unavoidable. Petitioners are reminded that after a final action, there are only four possible replies: (1) a Notice of Appeal, (2) the filing of a continuing application, (3) a 37 CFR 1.129(a) submission, if appropriate, or (4) an amendment after final that makes the case ready for issuance. 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.

Petitioners' November 8, 2002 (certificate of mailing date June 5, 2002) Amendment After Final failed to eliminate all of the Examiner's objections and rejections, as was stated in the Advisory Opinion of November 15, 2002. An Advisory Opinion does not restart the prosecution of the application. The post-final rejection of amendments does not obligate the Office or examiner to provide an applicant with a new time period or time limit in which to provide a complete response under 37 CFR 1.113.

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 fully 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).

Petitioners did not file a proper reply to the final Office action.

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), 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).

The petition under 37 CFR 1.137(a) is dismissed.

It is apparent that petitioners never intended for this application to become abandoned. The petition under 37 CFR 1.137(b) is granted.

Pursuant to petitioners' authorization, deposit account no. 06-1325 will be charged the $1,300 fee associated with the filing of a petition under 37 CFR 1.137(b).

After the mailing of this decision, the application file will be forwarded to Technology Center 2800 for processing the RCE, filed February 11, 2003 and consideration of the Preliminary Amendment and 2 sheets of drawings, filed June 5, 2002 and resubmitted with the instant petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-6712.

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
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Paper 34

LEXMARK INTERNATIONAL, INC.
INTELLECTUAL PROPERTY LAW DEPARTMENT
740 WEST NEW CIRCLE ROAD
BLDG. 082-1
LEXINGTON KY 40550-0999

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FEB 1 4 2007

**OFFICE OF PETITIONS**

In re Application of :
Barry Cavill et al. :
Application No. 09/610,250 : ON PETITION
Filed: July 5, 2000 :
Attorney Docket No. **LE9-00-043** :

This is a decision on the petition filed September 29, 2006 under 37 CFR 1.137(b),[1] to revive the above-identified application.

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

This application became abandoned June 24, 2004 for failure to timely pay the issue fee on or before June 23, 2004. Accordingly, a Notice of Abandonment was mailed March 7, 2005, after the filing of the instant petition.

The issue fee and petition fee have been applied. All other requirements of 37 CFR 1.137(b) having now been met, this application file is being forwarded to the Publishing Division to be processed into a patent.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[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.

(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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LEXINGTON, KY 40550-0999

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APR 18 2007

OFFICE OF PETITIONS

In re Application of :
Barry Cavill, et al. :
Application No. 09/610,250 : ON PETITION
Filed: July 5, 2000 :
Attorney Docket No.: LE9-00-043 :

This is a decision on the petition, filed April 16, 2007, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

It does not appear that the petition is signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of Geoffrey L. Oberhaus appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party on whose behalf he acts. A courtesy copy of this decision is being mailed to Mr. Oberhaus, the petitioner herein. However, if Mr. Oberhaus desires to receive future correspondence regarding this file, the appropriate power of attorney documents must be submitted. All future correspondence regarding this application file will be directed solely to the above-noted correspondence address of record.

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 29, 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.

[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.*

The application is being referred to Technology Center AU 2624 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: GEOFFREY L. OBERHAUS
DINSMORE & SHOHL, LLP
1900 CHEMED CENTER
255 EAST FIFTH STREET
CINCINNATI, OH 45202

UNITED STATES PATENT AND TRADEMARK OFFICE

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**BLDG. 082-1**
**LEXINGTON KY 40550-0999**

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APR 13 2010

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Barry Cavill et al | : | |
| Application No. 09/610,250 | : | DECISION ON PETITION |
| Filed: July 5, 2000 | : | |
| Attorney Docket No. LE9-00-043 | : | |

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 28, 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 the issue fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance mailed July 26, 2007, is accepted as having been unintentionally delayed.

It is noted that a Publication Fee of $300.00 was also submitted with the issue fee payment on December 28, 2009. The Notice of Allowance mailed July 26, 2007, does not indicate that a publication fee is due.

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

This application is being referred to the Office of Data Management to be processed into a patent.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

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WASHINGTON, DC 20043-9998

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NOV 23 2005

**OFFICE OF PETITIONS**

In re Application of :
Kume et al. : DECISION ON APPLICATION
Application No. 09/610,263 : FOR
Filed: July 5, 2000 : PATENT TERM ADJUSTMENT
Atty Docket No. 31671-164489RK:

This is a decision on the "Request for PTA Calculation Review" filed June 13, 2005. Applicants request that the initial determination of patent term adjustment under § 154(b) be corrected from 0 days to 309 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 two hundred fifty-seven (257) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 11, 2005, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised that the patent term adjustment to date is 0 days.

In response, applicants timely filed the instant request for reconsideration of the patent term adjustment along with payment of the fee set forth in 37 CFR § 1.18(e)[1]. Applicants contend

[1] The Issue Fee payment was also received on June 13, 2005.

that the PTA at the time of the mailing of the notice of allowance should be 309 days, based on the following: i) applicants state that the period of adjustment pursuant to 1.703(a)(1) is 136 days (not 146 days); ii) a period of adjustment of 242 days should be entered for Office delay in not responding until May 28, 2003 to their amendment to the first Office action filed May 29, 2003; and iii) otherwise, applicants' calculations agree with those of record.

The record supports a conclusion that the patent issuing from the application is not subject to a terminal disclaimer.

The application history has been reviewed and it has been determined that period of adjustment pursuant to 1.703(a)(1) of 146 days is correct. As agreed by applicants, the application was filed on July 5, 2000, and the Office mailed a first Office action under 35 U.S.C. 132 on January 29, 2002. The period of adjustment under § 1.703(a)(1) is 146 days, beginning on the day after the date that is fourteen months after the date on which the application was filed under 35 U.S.C. 111(a), September 6, 2001 and ending on the date of mailing of an action under 35 U.S.C. 132, January 29, 2002. Applicants' calculation of 136 days is incorrect.

However, applicants are correct that a period of adjustment should be entered for Office delay in taking action in response to their amendment filed May 29, 2002. An Office action was re-mailed to applicants on May 28, 2003. (The Office action was previously re-mailed on August 28, 2002 to incorrect address.) In view thereof, it is appropriate to use May 28, 2003, as the date of mailing of an action under 35 U.S.C. 132. Accordingly, the period of adjustment under § 1.703(a)(2) is 241 days, counting the number of days in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed, September 30, 2002 and ending on the date of mailing of an action under 35 U.S.C. 132, May 28, 2003.

Furthermore, a review of the record reveals that the patent term adjustment should not have been reduced by 402 days for applicants' filing of a response on November 28, 2003. The examiner did re-mail the Office action on May 28, 2003 and restart the period for reply. Applicants responded outside of the three months period set forth in § 1.704(b), but only by 92 days. Accordingly, the period of reduction is 92 days, not 402 days.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is 257 days (440 (146 + 241 + 53) days of Office delay reduced by 183 (30 + 92 + 61).

The $200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 22-0185, as acknowledged.

The application is being forwarded to the Publishing Division for processing into a patent.

Telephone inquiries regarding this matter should be directed to Senior Petitions Attorney Nancy Johnson at (571) 272-3219.

Kery A. Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of updated PAIR screen

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HICKMAN PALERMO TRUONG & BECKER LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE, CA 95110

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JUL 21 2005

OFFICE OF PETITIONS

In re Application of :
Derek W. Bolton :
Application No. 09/610,301 : ON PETITION
Filed: July 5, 2000 :
Attorney Docket No. CSC01275 :

This is a decision on the petition under 37 CFR 1.314, filed February 7, 2005, to defer issuance of the instant application into a patent.

The petition is granted.

Petitioner requests deferral of issuance of the application in order to allow the Examiner sufficient time to consider a concurrently filed pending 37 CFR 1.312 amendment.

In the absence of an extraordinary circumstance, it has been the policy of the Office to defer issuance of a patent, upon request, for a period of up to one month only. Note MPEP 1306.01. The deferral period has now passed.

If an additional deferral period is required, another petition and fee should be promptly submitted. The petition must include a showing of extraordinary circumstances; MPEP 1306.01.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 2661 to take such action as necessary on the amendment under 37 CFR 1.312 filed February 7, 2005.

Frances Hicks
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, D.C. 20231
WWW.USPTO.GOV

SB
Paper Number 10

Mailed:
MAY - 6 2002

In re application of :
Mohamed BOUZEKRI :
Serial No.: 09/610,343 :
Filed: July 3, 2000 :
For: Steel Sheet With Low :
Aluminum Content For :
Containers :

**DECISION ON PETITION**

This is a decision on the petition under 37 CFR 1.144 received November 16, 2001 to request the Commissioner to review and withdraw the Restriction Requirement of June 19, 2001.

**DECISION**

In making a restriction requirement it is understood that the initial burden is on the Office to establish a *prima facie* case that: (a) the claimed inventions are independent or distinct and (b) there would be a serious (or undue) burden on the examiner if restriction is not required. See MPEP 803.

In this application the Examiner has required a restriction between Group I directed to a process of manufacturing a steel strip and Group II directed to a steel product. To justify the Examiner's burden of establishing distinctness he has asserted that the steel product of Group II could be produced by a materially different process utilizing ultra-low C steel.

As correctly pointed out by the applicant in his response to the restriction requirement "The carbon content of the claimed steel strip and that of the steel strip used in the claimed process are exactly the same. Accordingly, the claimed steel strip cannot be made by a process with ultra-low C steel. Therefore the Examiner has not met his burden to establish that Groups I and II are distinct.

The Examiner responded that applicant "did not submit a clear admission that the unpatenability of Group I invention would imply the unpatentability of the Group II. In re Lee, 199 USPQ 108 (Cmr. Pats. 1978)." There is no requirement in In re Lee for applicant to make such a submission.

The petition is **GRANTED**.

Richard Fisher, Director
Technology Center 1700
Chemical and Materials Engineering

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Fourth Floor
1755 Jefferson Davis Highway
Arlington, Va. 22202

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : February 1, 2007

TO SPE OF : ART UNIT 2621

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/610380 Patent No.: 7085475 B1

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**.

*Elisha Evans*

**Certificates of Correction Branch**

**703-308-9390 ext. 110**

**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:** _____

THAI Q. TRAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

**SPE**

2621
**Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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DRW 05-01

Paper No. 4

GUY PERRY
SKADDEN ARPS SLATE MEAGHER & FLOM LLP
FOUR TIMES SQUARE
NEW YORK, NY 10022

COPY MAILED

JUN 0 4 2001

OFFICE OF PETITIONS
A/C PATENTS

| | | |
|---|---|---|
| In re Application of | : | |
| Levkoff et al. | : | |
| Application No. 09/610,402 | : | ON PETITION |
| Filed: 5 July, 2000 | : | |
| Attorney Docket No. MSGNT-001 | : | |

This is a decision on the petition under 37 CFR 1.48(a), filed on 30 January, 2001, requesting correction of the inventorship of the above-referenced patent application.

This is also a decision on the petition under 37 CFR 1.183, filed on 30 January, 2001, to waive 37 CFR 1.63 and 1.67, which require that the named inventor execute a supplemental declaration

The petitions are dismissed.

The present application was filed on 5 July, 2000, with an executed declaration naming Jonathon Stephen Levkoff as the sole inventor.

On 3 January, 2001, a petition under 37 CFR 1.48(a) was filed, seeking to correct the inventorship by adding as Peter A. Rinfret, Michael Elling, and Sunir Kochhar as joint inventors. The petition is accompanied by

(a) a statement signed by Messrs. Rinfret, Elling, and Kochhar stating that the omission occurred without deceptive intention;

(b) consent of the assignee as given by Peter Rinfret, Chairman and CEO of MessageNet LLC, assignee of record.

Petition Under 37 CFR 1.48(a)

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by: (1) a petition including a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part; (2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47; (3) the fee set forth in 37 CFR 1.17 (I); and (4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The petition lacks item (2). The new declaration is not signed by joint inventor Levkoff. Additionally, as described below, petitioners have not provided sufficient showing under 37 CFR 1.183 to waive the rules under 37 CFR 1.63 as they pertain to obtaining the signature of all inventors on the supplemental declaration.

Petition Under 37 CFR 1.183

Suspension of the rules under 37 CFR 1.183 may be granted in an "extraordinary situation, when justice requires." The facts presented on the record do not adequately establish an extraordinary situation. Petitioner has not sufficiently established any special circumstances of equities that would require suspension of the rules in the interests of justice.

There is no requirement for a showing under 37 CFR 1.47, as noted above. This application bears an original Declaration executed by inventor Jonathon Stephen Levkoff (Levkoff), and thus, the provisions of 37 CFR 1.47 do not apply in this instance. Nevertheless, it is appropriate to apply the principles thereof to the situation at hand.

The petition is deficient in that it does not adequately show or provide proof (a) that a copy of the application (specification, including claims, drawings, if any, and the oath or declaration listing the actual inventors) was sent or given to Levkoff, and (b) that Levkoff refused to sign the new declaration after receipt thereof. Petitioners may show that the application was sent or given to Levkoff by providing a copy of the cover letter transmitting the new declaration or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details. Likewise, proof that Levkoff refused to sign the

new declaration must be provided. If there is a written refusal, petitioners should submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

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

By FAX: (703) 308-6916
Attn: Special Program Law Office

By hand: One Crystal Park, Suite 520
2011 Crystal Drive
Arlington, VA

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood at 703.308.6918.

Beverly M. Flanagan
Supervisory 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
DIW 08-01

Paper No. 7

GUY PERRY
SKADDEN ARPS SLATE MEAGHER & FLOM LLP
FOUR TIMES SQUARE
NEW YORK, NY 10022

COPY MAILED

SEP 2 0 2001

OFFICE OF PETITIONS

In re Application of :
Levkoff et al. :
Application No. 09/610,402 : ON PETITION
Filed: 5 July, 2000 :
Attorney Docket No. MSGNT-001 :

This is a decision on the renewed petition under 37 CFR 1.48(a), filed by facsimile on 26 June, 2001, and supplemented on 27 June and 17 August, 2001, requesting correction of the inventorship of the above-referenced patent application. This is also a decision on the renewed petition under 37 CFR 1.183 seeking waiver of 37 CFR 1.67 and 1.63 where they require that a supplemental declaration be executed by the named inventor.

The petition is **granted**.

Petition Under 37 CFR 1.48(a)

As a result of the papers filed on 3 January, 2001, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and, accordingly, this application has been corrected in compliance with 37 CFR 1.48(a)(2). The inventorship of this application has been changed by the addition of Peter A. Rinfret, Greenwich, CT; Michael Elling, Mendham, NJ, and Sunir Kochlar, Franklin, TN.

Petition Under 37 CFR 1.183

In view of the efforts recounted in the petition to obtain the signature of Jonathon S. Levkoff, it is agreed that justice would be served by waiving the requirement for his signature on the supplemental declaration filed on 17 August, 2001.

The aforementioned supplemental declaration has been accepted, on petition, and placed in the file.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt and correction of PTO PALM data to reflect the inventorship as corrected. Thereafter, the application will be forwarded to Technology Center 2100 for for examination in due course.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Douglas I. Wood at 703.308.6918.

Beverly M. Flanagan
Supervisory 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. 9

THOMSON MULTIMEDIA LICENSING INC.
PATENT OPERATIONS
P O BOX 5312
PRINCETON, NJ 08543-5312

COPY MAILED

AUG 2 6 2003

OFFICE OF PETITIONS

In re Application of :
Roman Boll :
Application No. 09/610,719 :
Filed: July 6, 2000 :
Attorney Docket No. BTSPH099090 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 13, 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 January 27, 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 application became abandoned on April 28, 2003.

The file does not indicate a change of address has been submitted, although the address given on the petition slightly differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5594.

The application file is being forwarded to Technology Center 2600, Art Unit 2614 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
WASHINGTON, D.C. 20231
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**MAILED**

OCT 23 2001

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

Paper No. 10

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. 09/610,738
Filed: July 6, 2000
For: MODULAR BACKUP AND RETRIEVAL SYSTEM USED IN CONJUNCTION WITH A STORAGE AREA NETWORK

**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

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
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
WASHINGTON, DC 20231
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Paper No. 4

Snell & Wilmer LLP
One Arizona Center
400 East Van Buren
Phoenix AZ 85004-0001

MAILED

APR 11 2002

Technology Center 2100

In re Application of : D. Duncan
Application No. 09/610,772
Filed: July 6, 2000
For: ON-LINE INTERACTIVE SYSTEM AND METHOD FOR TRANSACTING BUSINESS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition to make special filed May 4, 2001 based on M.P.E.P. §708.02(VIII) Accelerated Examination.

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(h);
> (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 clearly comply with (B), (D) and (E) above. With respect to (B), there is no statement that applicant will make an election without traverse if the Office determines that all the claims are not obviously directed to a single invention. Concerning (D), no indication is found that the references submitted are "deemed most closely related to the subject matter encompassed by the claims". With respect to (E), the discussion of the references does not point out how the *claimed* subject matter is patentable over the references. The discussion of the references asserts that the references do not teach locking out of requested product information. However, the assertions made with regard to the references do not match the scope of all of the independent claims. Claim 22 for example does not recited this step.

Accordingly, the petition is **DISMISSED**. 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

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MAY 3 1 2002

**DIRECTOR'S OFFICE**
**TECHNOLOGY CENTER 3600**

Paper No. 7

Snell & Wilmer LLP
One Arizona Center
400 East Van Buren
Phoenix AZ 85004-0001

In re Application of : D. Duncan
Application No. 09/610,772
Filed: July 6, 2000
For: ON-LINE INTERACTIVE SYSTEM AND METHOD FOR TRANSACTING BUSINESS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the renewed petition filed May 23, 2002 from the decision mailed April 11, 2002 regarding the petition to make special filed May 4, 2001 based on M.P.E.P. §708.02(VIII) Accelerated Examination.

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(h);
> (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 May 23, 2002 and May 4, 2001 together meet all the criteria set out above. Accordingly, the petition is **GRANTED**. The application file is being forwarded to the examiner of record for expedited 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 3600
703-305-9780

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

April 29, 2002

Michael A. Cornman
Schweitzer Cornman Gross & Bondell
292 Madison Ave.
New York, NY 10017

In re application of:
Laurent Pouget DECISION ON PETITION
Serial No.: 09/610,779
Filed: July 6, 2000

For: FRONT STRUCTURE FOR A MOTOR VEHICLE

This is a decision on the documents received on July 16, 2001, 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 September 11, 2000. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned November 14, 2000. A notice of abandonment was mailed on July 9, 2001.

On July 16, 2001, 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 October 12, 2000.

The evidence submitted is sufficient to establish that the petitioners responded to the Notice to File Missing Parts of Application on October 12, 2000.

The petition is hereby GRANTED.

The application has been completed for release to Technology Center 3612.

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

Doshie E. Day
Program Management Assistant

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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STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
1100 NEW YORK AVE., N.W.
WASHINGTON, DC 20005

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Suresh Krishna | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7600131 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/06/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/610,798 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/06/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1456** 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6360645
Issue Date: March 26,2002
Application No. 09610846
Filed: July 5,2000
Attorney Docket No. JMC-11

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

This is a decision on the electronic petition, filed March 5,2008 ,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 March 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 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.

# 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) |
|---|---|---|---|---|
| 6360645 | 2002-03-26 | 09610846 | 2000-07-05 | JMC-11 |

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 | /Leonard Tachner/ | Date (YYYY-MM-DD) | 2008-03-05 |
| Name | Leonard Tachner | Registration Number | 26344 |

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.

#4

OIPE JC69
OCT 10 2000
PATENT AND TRADEMARK OFFICE

UNITED STATES PATENT AND TRADEMARK OFFICE

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

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|---|---|---|---|
| 09/610,935 | 07/06/2000 | Brian W. Ward | SGM 6934.1 |

321
SENNIGER POWERS LEAVITT AND ROEDEL
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

**FORMALITIES LETTER**

*OC000000005436476*

Date Mailed: 09/28/2000

## NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

**FILED UNDER 37 CFR 1.53(b)**

***Filing Date Granted***

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of $130 for a non-small entity, must be submitted with the missing items identified in this letter.

- **The balance due by applicant is $ 130.**

---

*A copy of this notice MUST be returned with the reply.*

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 2 - COPY TO BE RETURNED WITH RESPONSE

10/13/2000 EHAMMOND 00000001 09610935

01 FC:105 130.00 OP

OIPE JC66
OCT 10 2000
PATENT & TRADEMARK OFFICE

SGM 6934.1
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Brian W. Ward et al. Group Art Unit 1743
Serial No. 09/610,935
Filed July 6, 2000
For TRACER REAGENTS THAT ENHANCE REACTION-PRODUCT ANALYSIS

October 4, 2000

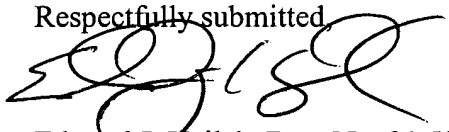
**LETTER IN RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION - FILING DATE GRANTED**

TO THE COMMISSIONER OF PATENTS AND TRADEMARKS,
SIR:

In response to the "Notice to File Missing Parts of Application - Filing Date Granted," dated September 28, 2000, enclosed is applicant's signed Declaration and Power of Attorney in the above-referenced application. A copy of the Notice is returned herewith.

* Also enclosed is a check for $130.00 in payment of the surcharge.

Respectfully submitted,



Edward L. Hejlek, Reg. No. 31,525
SENNIGER, POWERS, LEAVITT & ROEDEL
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400

CERTIFICATE OF MAILING

I hereby certify that the foregoing Response to Notice to File Missing Parts of Application - Filing Date Granted in the application of Brian W. Ward et al., Serial No. 09/610,935, filed July 6, 2000 is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Box Missing Parts, Assistant Commissioner for Patents, Washington, D.C. 20231 on this 4th day of October, 2000.

Darlene Pearman
Darlene Pearman

EJH/dep
*Enclosures

OIPE JC66
OCT 10 2000
PATENT & TRADEMARK OFFICE

SECTOR 4

# FEE TRANSMITTAL

Application Number 09/610,935
Filing Date July 6, 2000
First Named Inventor Brian W. Ward et al.
Group Art Unit 1743
Attorney Docket Number SGM 6934.1

## METHOD OF PAYMENT

1. [ ] The Commissioner is hereby authorized to charge the indicated fees to Deposit Account No. 19-1345, in the name of Senniger, Powers, Leavitt & Roedel.

   [ ] The Commissioner is hereby authorized to charge any additional filing and claim fees under 37 CFR 1.16 and application processing fees under 37 CFR 1.17 to Deposit Account No. 19-1345, in the name of Senniger, Powers, Leavitt & Roedel.

2. [X] Check Enclosed. The Commissioner is hereby authorized to charge any under payment or credit any over payment to Deposit Account No. 19-1345, in the name of Senniger, Powers, Leavitt & Roedel.

## FEE CALCULATION

1. [ ] BASIC FILING FEE $_____ (Type: _____)
   Entity Status: large

2. [ ] CLAIM FEE $_____

   Total Claims _____
   Independent Claims _____
   Multiple Dependent Claims _____

3. [X] ADDITIONAL FEES $130.00

   [X] Surcharge - late filing fee or oath
   [ ] Surcharge - late provisional filing fee or cover sheet
   [ ] Extension for reply within _____ month
   [ ] Notice of Appeal
   [ ] Filing a Brief in Support of an appeal
   [ ] Request for Reexamination
   [ ] Petitions to the Commissioner
   [ ] Submission of Information Disclosure Statement
   [ ] Recording each patent assignment per property
   [ ] Other: _____

**TOTAL AMOUNT OF PAYMENT** $ 130.00

10/4/00

Edward J. Hejlek, Reg. No. 31,525 Date

EJH/dep

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

COPY MAILED

JAN 31 2007

OFFICE OF PETITIONS

Brian K. Stierwalt, Esq.
Sigma-Aldrich Co.
3050 Spruce Street
St. Louis, MO 63103

In re Patent No. 6,942,964 : LETTER REGARDING PTA
Issued: September 13, 2005 : and NOTICE OF INTENT
Application No. 09/610,935 : TO ISSUE CERTIFICATE
Filed: July 6, 2000 : OF CORRECTION
Atty. Dkt. No.: SGM 6934.1 :

This letter is in response to the "LETTER REGARDING PATENT TERM ADJUSTMENT," filed October 11, 2005. The Office thanks patentees for their good faith and candor in bringing this to our attention.

The above-identified application issued as U.S. Pat. No. 6,942,964 on September 13, 2005. The patent issued with an adjustment of 61 days. Patentees indicate that the correct adjustment at the time of issuance is zero days.

A review of the application history reveals that patentees are correct. At the time of issuance, an adjustment of 109 days could be attributed to the Office. However, a reduction of 150 days could be attributed to applicants for failure to engage in reasonable efforts to conclude prosecution, yielding an adjustment of zero, as indicated by patentees. *See*, endnote[i].

As this letter was submitted as an advisement to the Office of an error in Applicants' favor, the Office will not assess the $200.00 application fee under 37 CFR 1.705(b).

This application will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by zero days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Draft Certificate of Correction

---

[i] The adjustment for Office delays were as follows: 20 days in accordance with 37 CFR 1.702(b) and 89 days in accordance with 37 CFR 1.702(a)(4). The reductions for applicant delays were as follows: 28 days in accordance with 37 CFR 1.704(b); 28 days in accordance with 37 CFR 1.704(b); 62 days in accordance with 37 CFR 1.704(b); and 32 days in accordance with 37 CFR 1.704(b).

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT : 6,942,964 B1

DATED : September 13, 2005

INVENTOR(S) : Ward et al.

DRAFT

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,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (61) days

Delete the phrase "by 61" and insert – by 0 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Patent Administrator
Testa, Hurwitz & Thibeault, LLP
High Street Tower
125 High Street
Boston, MA 02110

OCT 23 2002

In re Application of:
Eugene A. Fitzgerald
Application No. 09/611,024
Filed: July 6, 2000
Docket No. ASC-023C1

DECISION ON PETITION
TO WITHDRAW
HOLDING OF ABANDONMENT

This is a decision on the petition under 37 CFR 1.181 filed December 5, 2001, to withdraw the holding of abandonment in the above-identified application. No petition fee is required.

The petition is **granted.**

The application was held abandoned for failure to file a proper response to the Office action mailed April 9, 2001. A Notice of Abandonment was mailed on November 21, 2001.

Petitioner asserts that on April 18, 2001, a response entitled Response to Restriction Requirement was timely filed in the above-identified application. To support this assertion, petitioner has submitted a copy of the response and a copy of a return postcard which properly identifies and acknowledges receipt of the response by the U.S. Patent and Trademark Office (PTO) on April 23, 2001.

A review of the application file record reveals that the above-identified response having been acknowledged as being received in the PTO on April 23, 2001, is not of record in the application file and cannot be located. However, M.P.E.P. § 503 states that "A postcard receipt which itemizes and properly identifies the items 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." Accordingly, it is concluded that the response was timely received in the PTO but lost after receipt thereof.

For the above stated reason, the petition is **granted**. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

The copy of the response submitted with the petition on December 5, 2001, is accepted since the response originally submitted was apparently lost.

The application file is being forwarded to the Technology Center 2800 support staff for entry of the response. From there, the application will be forwarded to the examiner for further action.

Inquiries regarding this decision should be directed to Ed Glick at (703) 308-4858.

Edward J. Glick, Special Programs Examiner
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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MARCUS G. THEODORE
466 SOUTH 500 EAST
SALT LAKE CITY, UT 84102

**COPY MAILED**

**APR 0 8 2005**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Mike Katsanevas | : | |
| Application No. 09/611,073 | : | ON PETITION |
| Filed: July 6, 2000 | : | |
| Attorney Docket No. N/A | : | |

This is a decision on the petition under 37 CFR 1.137(a), filed November 22, 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(a)."

This application became abandoned for failure to timely pay the issue fee and publication fee, if applicable, on or before August 23, 2004. Accordingly, this application became abandoned on August 24, 2004. A Notice of Abandonment was mailed on November 12, 2004.

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 lacks items (1) and (3), above.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> 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. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

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 USPQ 666, 167-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (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 cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Regarding item (1):

Petitioner has submitted $665.00 for the issue fee. On November 22, 2004, (the date of receipt of the instant petition), the

small entity issue fee increased to $685.00. As any fee amount paid on or after November 22, 2004, was subject to the new fee, the issue fee submitted by petitioner on November 22, 2004 was insufficient. Please note, as of December 8, 2004, the small entity issue fee has changed to $700.00. Accordingly, petitioner must submit an additional $35.00.

Regarding Item (3):

Petitioner asserts that the delay was caused by the lack of notice by the Office that an insufficient issue fee was submitted by applicant on July 7, 2004.

Applicant was placed on notice as to the required fee in the Notice of Allowance (Notice), mailed May 21, 2004. It is the responsibility and burden of the applicants' to timely submit the required issue fee by the date indicated on the Notice.

Furthermore, please note, a delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), 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). 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: (1) the applicant's reliance upon oral advice from Office employees; or (2) **the Office'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); see also In re Colombo, Inc., 33 USPQ2d 1530, 1532 (Comm'r Pat. 1994)(while the Office attempts to notify applicants of deficiencies in their responses in a manner permitting a timely correction, the Office has no obligation to notify parties of deficiencies in their responses in a manner permitting a timely correction).

Accordingly, the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 151 and 37 CFR 1.137(a).

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

By mail: Mail Stop Petition
Commissioner for Patents
Box 1450
Alexandria, VA 22313

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

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

Telephone inquiries should be directed to the undersigned at (571)272-3228.

Edward J. Tannouse
Petitions Attorney
Office of Petitions/Patent
United States 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

**MARCUS G. THEODORE**
**466 SOUTH 500 EAST**
**SALT LAKE CITY, UT 84102**

**COPY MAILED**

JUN 22 2005

**OFFICE OF PETITIONS**

ON PETITION

In re Application of :
Mike Katsanevas :
Application No. 09/611,073 :
Filed: July 6, 2000 :
For: BANK CARD TERMINAL COVER :

This is a decision on the petition under 37 CFR 1.137(b), filed June 8, 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 May 21, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on August 24, 2004.

The drawings filed on May 21, 2004 and October 18, 2004 have been approved by the Draftsperson. A copy of the Notice of Draftsperson's Patent Drawing Review (PTO-948) is attached.

Telephone inquiries should be directed to Wan Laymon at (571) 272-3220.

This matter is being referred to Publishing Division.

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

Attachment: PTO-948

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

MANUEL R VALCARCEL IV
GREENBERG TRAURIG PA
1221 BRICKELL AVENUE
MIAMI, FL 33131

**COPY MAILED**

OCT 20 2004

**OFFICE OF PETITIONS**

In re Application of :
Apel, et al. :
Application No. 09/611,112 : ON PETITION
Filed: July 6, 2000 :
Attorney Docket No. 19094.010000 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 28, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the Office action mailed February 11, 2004. Accordingly, this application became abandoned on May 12, 2004. A Notice of Abandonment was mailed on August 24, 2004.

The file is being forwarded to Technology Center 1700, for review of the "Response to the Office Action Mailed 2/11/04," submitted September 28, 2004.

Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3228.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
United States Patent and Trademark Office

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

**BOLESH J SKUTNIK PhD JD**
**515 SHAKER ROAD**
**EAST LONGMEADOW, MA 01028**

COPY MAILED

DEC 1 8 2002

OFFICE OF PETITIONS

In re Application of :
Wolfgang Neuberger et al :
Application No. 09/611,144 : ON PETITION
Filed: July 6, 2000 :
Attorney Docket No. BJA170A :

This is a decision on the petition under 37 CFR 1.137(b), filed November 27, 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 January 31, 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 1, 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 3739.

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

Paper No. 9

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

COPY MAILED

AUG 12 2005

OFFICE OF PETITIONS

In re Application of
Adisak Mekkittikul et al.
Application No. 09/611,180
Filed: July 6, 2000
Attorney Docket Number: LANT-002
Title: METHOD AND SYSTEM FOR WEIGHTED FAIR FLOW CONTROL IN AN ASYNCHRONOUS METRO PACKET TRANSPORT RING NETWORK

DECISION ON PETITION UNDER 37 C.F.R. §1.137(b)

This is a decision on the petition under 37 CFR §1.137(b)[1], filed November5, 2004, to revive the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.112 in a timely manner to the non-final Office action mailed January 16, 2004, which set a shortened statutory period for reply of 3 months. No response was received, and no extensions of time were requested. As such, the above-identified application became abandoned on April 17, 2004.

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.

---

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.

With the present petition, Petitioner has submitted the petition fee, an amendment, and a statement which is being construed as the proper statement of unintentional delay.

Petitioner has met all requirements for a grantable petition under 37 C.F.R. §1.137(b). As such, the petition is **GRANTED**.

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.

The Power of Attorney and Change of Correspondence Address Indication has been entered and made of record.

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

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Attention William C. Fuess
Fuess & Davidenas
Attorneys at Law
Suite II G 10951 Sorrento Valley Road
San Diego, CA 92121-1613

COPY MAILED
DEC 0 4 2006
OFFICE OF PETITIONS

In re Application of :
Mager : DECISION ON PETITION
Application No. 09/611,221 :
Filed: July 6, 2000 :
Atty. Dkt. No.: MAG 0002P :

The above-identified application has been forwarded to the Office of Petitions for consideration of the petition to withdraw the holding of abandonment under 37 CFR 1.181 filed October 16, 2006.

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.

This application became abandoned June 22, 2006 for failure to timely submit a proper reply to the Notice of Allowance (Notice) mailed March 21, 2006. The Notice set a three month statutory period of time for reply. Notice of Abandonment was mailed August 17, 2006.

Petitioner alleges non-receipt of the Notice mailed March 21, 2006.

In the absence of any irregularity in the mailing of the Notice, there is a strong presumption that the Notice 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 any evidence to support petitioner's contention of non-receipt of the Notice. Any renewed petition must include supporting documentation to establish non-receipt of the Notice.

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 hand delivery: | U.S. Patent and Trademark Office<br>Customer Window, **Mail Stop Petition**<br>Randolph Building<br>401 Dulany Street<br>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
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Attention William C. Fuess
Fuess & Davidenas
Attorneys at Law
Suite II G 10951 Sorrento Valley Road
San Diego, CA 92121-1613

COPY MAILED

JUN 21 2007

OFFICE OF PETITIONS

In re Application of :
Mager : DECISION ON PETITION
Application No. 09/611,221 :
Filed: July 6, 2000 :
Atty. Dkt. No.: MAG 0002P :

The above-identified application has been forwarded to the Office of Petitions for consideration of the renewed petition to withdraw the holding of abandonment under 37 CFR 1.181 filed January 25, 2007.

This application was held abandoned June 22, 2006 for failure to timely submit a proper reply to the Notice of Allowance (Notice) mailed March 21, 2006. The Notice set a three month statutory period of time for reply. Notice of Abandonment was mailed August 17, 2006.

Petitioner continues to allege non-receipt of the Notice mailed March 21, 2006. Petitioner has, moreover, provided supporting documentation to support a contention of non-receipt.

In the absence of any irregularity in the mailing of the Notice, there is a strong presumption that the Notice 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.

Nevertheless, in view of the evidence presented, the petition to withdraw the holding of abandonment is hereby **GRANTED**.

The Notice of Abandonment is hereby **VACATED** and the holding of abandonment is **WITHDRAWN**.

This application is being forwarded to Group Art Unit 2621 for re-mailing of the Notice of Allowance and Notice of Allowability. The time period for reply will be set therein.

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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James G. Uber, Esq.
Mine Safety Appliances Company
P. O. Box 426
Pittsburgh, PA 15230-0426

COPY MAILED

MAR 0 9 2005

OFFICE OF PETITIONS

In re Application of :
Marc A. Moeckli, et al. :
Application No. 09/611,384 : ON PETITION
Filed: July 7, 2000 :
Attorney Docket No. Moeckli et al. :

This is a decision on the petition filed January 7, 2005[1], under 37 CFR 1.137(a) or in the alternative, under 37 CFR 1.137(b), to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED.**

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

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed;[2] (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 as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).
A Final Office action was mailed to applicant on August 29, 2003, which set a three-month shortened statutory period within which to submit a reply. On October 27, 2003, a reply was received in the USPTO. However, the reply did not place the application in condition for allowance. Nevertheless, an Advisory Action was not mailed until after the six-month statutory period; therefore, the application became abandoned on February 28, 2004.

---

[1] In view of the certificate of mailing under 37 CFR 1.8, the petition was filed May 21, 2004.

[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.

Petitioner argues that the reply was timely received in the Office, but an Advisory Action was not mailed until after the six-month statutory period expired. In view thereof, petitioner believes that this delay should be construed as unavoidable.

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). See MPEP 711.03(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay. 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).

MPEP 711.03(c)(III)(C)(2) in pertinent part states:

> "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). For example, as 37 CFR 1.116 and 1.135(b) are manifest that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal, a delay is not "unavoidable" when 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. 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 USPTO, 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 "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 USPTO employees; or **(B) the USPTO'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)**

In accordance with the above, the failure to receive an Advisory Action before the end of the six-month statutory period is not deemed unavoidable. Since the Office has considered petitioner's arguments for unavoidable delay, the petition fee of $110 will be charged to petitioner's deposit account in due course.

Nevertheless, the instant petition meets the requirements set forth in 37 CFR 1.137(b), with regard to 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. Since the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement is being construed as the statement required by 37 CFR 1.137(b)(3).

The Office wishes to apologize for the delay in responding to the instant petition, which was due to the misplacement of the original petition papers. Any inconvenience to petitioner is regretted.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to Technology Center 2800 for further prosecution.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Examination Policy

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James G. Uber, Esq.
Mine Safety Appliances Company
P. O. Box 426
Pittsburgh, PA 15230-0426

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JUN 15 2005

OFFICE OF PETITIONS

In re Application of :
Marc A. Moeckli, et al. :
Application No. 09/611,384 : ON PETITION
Filed: July 7, 2000 :
Attorney Docket No. Moeckli et al. :

**CORRECTED DECISION**

This is a corrected decision on the petition filed January 7, 2005[1], under 37 CFR 1.137(b), to revive the above-identified application.

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

The decision mailed March 9, 2005 stated, "...the instant petition meets the requirements set forth in 37 CFR 1.137(b), with regard to unintentional delay." However, a thorough review of the application shows that the petition was improperly granted. The petition did not, in fact, meet the requirements set forth in § 1.137(b) because petitioner did not provide a reply to the outstanding office action. Nevertheless, petitioner has now provided a Request for Continued Examination (RCE) under the provisions of 37 CFR 1.114. In view of the above, the previous decision is hereby vacated and the application is revived as of the mail date of this decision.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to Technology Center 2800 for processing the RCE filed May 17, 2005.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Examination Policy

[1] In view of the certificate of mailing under 37 CFR 1.8, the petition was filed May 21, 2004.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

RECEIVED
APR 12 2006
TC 1700

Paper No.: 8

DATE : 1-3-06

TO SPE OF : ART UNIT 1751

SUBJECT : Request for Certificate of Correction on Patent No.: 6953534

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.

Claims + drawings

**Thank You For Your Assistance**

EVA JAMES
Thanks
**Certificates of Correction Branch**
***Tel. No. 703-308-9309 ext. 116***

**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 Certificate corrects mistakes made by the USPTO only.

Douglas McGinty
**SPE** 1751

4-11-06
**Art Unit**

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 8

DATE : 1-3-06

TO SPE OF : ART UNIT 1751

SUBJECT : Request for Certificate of Correction on Patent No.: 6953534

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.

Claims T Drawings

EVA JAMES

**Thank You For Your Assistance**

**Certificates of Correction Branch**
*Tel. No. 703-308-9309 ext. 116*

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

RECEIVED
APR 12 2006
TC 1700

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 Certificate corrects mistakes made by the USPTO only.

Douglas McGinty — SPE 1751

4-11-06 — Art Unit

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ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. None

Baker Botts LLP
Attn Laurence H Posorske
The Warner Suite 1300
1299 Pennsylvania Avenue NW
Washington DC 20004-2400

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DEC 14 2006
OFFICE OF PETITIONS

In re Application of :
Leonard A. Smith et al. :
Application No. 09/611,419 :
Filed: July 6, 2000 : DECISION ON PETITION
Attorney Docket No. 067252.0105 : UNDER 37 C.F.R. §1.137(B)
Title: RECOMBINANT VACCINE :
AGAINST BOTULINUM NEUROTOXIN :

This is a decision on the petition filed August 7, 2006, 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 October 17, 2005, 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 response was received. Accordingly, the above-identified application became abandoned on January 18, 2006. A notice of abandonment was mailed on June 26, 2006.

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.

With the present petition, Petitioner has submitted the petition fee and the proper statement of unintentional delay. Petitioner has further included a Request for Continued Examination (RCE) under 37 C.F.R. §1.114, the associated fee, and an amendment.

No terminal disclaimer is required. The RCE has been accepted as the required reply under 37 C.F.R. §1.137(b)(1). The concurrently submitted amendment shall serve as the required submission.

As such, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

Petitioner has also submitted a three-month extension of time. An extension of time under 37 C.F.R. §1.136 must be filed prior to the expiration of the maximum extendable period for reply[2]. Accordingly, since the $1020 extension of time submitted with the petition on August 7, 2006 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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.

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 can be processed.

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2 See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988).

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[3]. 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

cc: BAKER BOTTS, LLP
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-4498

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3 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
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P.O. Box 1450
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In re Patent No. 6870026
Issue Date: March 22,2005
Application No. 09611521
Filed: July 8,2000
Attorney Docket No. LIDO:003

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

This is a decision on the electronic petition, filed May 11,2009 ,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 May 11,2009 . 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) |
|---|---|---|---|---|
| 6870026 | 2005-03-22 | 09611521 | 2000-07-08 | LIDO:003 |

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 | /karen tripp/ | Date (YYYY-MM-DD) | 2009-05-11 |
| Name | Karen B. Tripp, Attorney at Law | Registration Number | 30452 |

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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MAR 3 0 2010

NEIFELD IP LAW, PC
4813-B EISENHOWER AVENUE
ALEXANDRIA VA 22304

| | | |
|---|---|---|
| In re Application of | : | |
| Douglas G. LOWENSTEIN et al. | : | |
| Application No. 09/611,548 | : | DECISION ON PETITION |
| Filed: July 7, 2000 | : | TO WITHDRAW |
| For: FINANCING OF TENANT | : | RESTRICTION REQUIREMENT |
| IMPROVEMENTS | : | UNDER 37 CFR 1.181 |

This is in response to applicant's petition under 37 CFR 1.181 filed July 6, 2009 requesting that the restriction requirement made on January 10, 2008 be withdrawn and to vacate the final rejection mailed on October 3, 2008.

The petition is **DISMISSED as moot.**

The record reveals that the examiner issued an Office action on January 10, 2008 requiring a provisional election between Group I of claims 1-27, 31-52, 56-59 and 74-181 drawn to a method of leasing a space to a tenant; Group II of claims 28-30 and 53-55 drawn to a computer program to solicit proposals from tenants for financing tenant improvements to leased spaces; and Group III of claims 60-73 drawn to a method of leasing a longer-lived asset and a shorter-lived asset to a lessee. Applicants elected Group I of claims 1-27, 31-52, 56-59, and 74-141 with traverse in a response filed June 10, 2008. The examiner maintained the restriction requirement in the final Office action mailed on October 3, 2008 and withdrew claims 28-30, 3-55 and 60-73 as being drawn to a non-elected invention. Applicant timely filed a petition on July 6, 2009 to withdraw the restriction requirement and to vacate the final rejection mailed on October 3, 2008.

Applicants' petition alleges that the restriction requirement was improper because claims 1-118 have been examined multiple times and allowed over the art, and that there is no serious burden of search.

A review of the file shows that claims 1-118 had been fully examined in the Office actions mailed on January 29, 2003, January 22, 2004, October 20, 2005, April 20, 2006, and November 1, 2006. Claims 119-125 had been examined in the Office actions dated November 1, 2006. Claims 126-178 were added in the amendment filed on February 26, 2007 responding to the Office action dated November 1, 2006. Claims 179-181 were added in the amendment filed on

October 10, 2007 responding to the Notice of non-compliance amendment mailed on September 10, 2007. MPEP § 803 states that " If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." Since the claims 1-125 have been fully examined up to the point the restriction requirement was made on January 10, 2008 and the examiner determined that the newly added claims 126-181 have the same scope as claims 1-27, 31-52 and 56-59, there is no serious burden on the examiner to continue the examination of claims 1-125, and to search as well as examine the new claims 126-181. The restriction requirement dated January 10, 2008 was improper and the finality of the Office action dated October 3, 2008 was also improper.

In the non-final Office action dated February 19, 2010, the examiner opened prosecution, withdrew the restriction requirement and vacate the final rejection dated October 3, 2008. In view of these facts, the issues raised in the petition of July 6, 2009 are considered moot. The petition is hereby dismissed.

Any questions regarding this decision should be directed to Supervisory Patent Examiner Charles Kyle at (571) 272-6746.

Wynn W. Coggins, Director
Patent Technology Center 3600
(571) 272-5350

lm: 3/22/10
LM

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MR CHRISTOPHER JOHN ROURK
JACKSON WALKER LLP
901 MAIN STREET SUITE 6000
DALLAS TX 75202

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Meckenstock, et al. | : | |
| Application No. 09/611,622 | : | DECISION ACCORDING STATUS |
| Filed: July 7, 2000 | : | UNDER 37 CFR 1.47(a) |
| Attorney Docket No. B-67587 (014354/0003) | : | |

This is in response to the petition under 37 CFR 1.47(a), filed July 7, 2000. The petition was recently forwarded to the Office of Petitions for consideration.

The petition under 37 CFR 1.47(a) is **GRANTED**.

On petition, petitioner has established that inventor Colon has refused to sign the application papers. Specifically, petitioner has attested that a copy of the application papers was mailed to Colon May 2, 2000, but as of the mail date of the petition, no executed declaration has been received.

The above-identified application and papers have been reviewed and found to be in compliance with 37 CFR 1.47(a). Accordingly, the above-identified application is hereby accorded Rule 1.47(a) status. As provided in 37 CFR 1.47(c), this Office will forward notice of this application's filing to the non-signing inventor at the last known address provided on the declaration. Notice of the filing of this application will also be published in the Official Gazette.

Receipt of $130 for the petition fee is acknowledged.

The matter is being forwarded to the Office of Data Management for processing into a patent.

Telephone inquiries related 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

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OFFICE OF PETITIONS

In re Application of
Meckenstock, et al.
Application No. 09/611,622
Filed: July 7, 2000
Title: System and Method for Programming Point of Sale Devices

LETTER

Dear Mr. Colon:

You are named as a joint inventor in the above-identified United States patent application filed under the provisions of 35 USC 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 joint 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, agent of record 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 Petitions Attorney Cliff Congo at (571)272-3207. 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 the Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Cliff Congo
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

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

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JUN 0 9 2006

OFFICE OF PETITIONS

In re Application of :
Toru Kamibayashi et al :
Application No. 09/611,716 : ON PETITION
Filed: July 6, 2000 :
Attorney Docket No. 04329.2347 :

This is a decision on the petition, filed June 9, 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 May 5, 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 should be directed to the undersigned at (571) 272-3208.

The examiner of Technology Center AU 2136 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

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 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. _____

Date : June 9, 2006

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) :Toru Kimibayashi
Application No. :09/611,716
Filed :July 6, 2000

The above-identified application has been assigned Patent No. 7,068,784 and an issue date of June 27, 2006.

It is hereby directed that this application be withdrawn from issue at the request of the applicant.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of June 27, 2006:

"All reference to Patent No. 7,068,784 to Toru Kimibayashi et al of Japan for CONTENTS MANAGEMENT METHOD, CONTENTS MANAGEMENT APPARATUS, AND RECORDING MEDIUM appearing in the Official Gazette of June 27, 2006 should be deleted since no patent was granted."

Karen Creasy

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

cc: Paul Harrison, MDW-4B03,(FAX-273-5468)
Deneise Boyd, MDE-3D39 (FAX-273-5124)
Mary Louise McAskill, ST-8C15 (FAX 305-4372)
Niomi Farmer, ST-8C14 (FAX-305-4372)
Mary E. Johnson (Cookie), MDE-7C71 (FAX 273-0038
Duane Davis P/OPC MDE-7D89

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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. |
|---|---|---|---|---|
| 09/611,764 | 07/07/2000 | Harald Feuerherm | FEUERHERM ET AL-2 | 7406 |

7590 03/31/2005

COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, NY 11576

| EXAMINER | |
|---|---|
| DEL SOLE, JOSEPH S | |
| **ART UNIT** | **PAPER NUMBER** |
| 1722 | |

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF COMMERCE
**Patent and Trademark Office**
ASSISTANT SECRETARY AND COMMISSIONER
OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Applicant: Harald Feuerherm
Serial No.: 09/611,764
Filed: July 7, 2000
For: EXTRUDER HEAD

DECISION ON PETITION

This is a decision on the petition filed March 3, 2005 and the submissions of verified statements filed with the petition in support thereof, to correct the inventorship of the present Patent under 37 CFR 1.48(b).

The requirements of 37 CFR 1.48(b) having been complied with, the Petition to Correct Inventorship is **GRANTED**.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming the actual inventors.

Benjamin L. Utech
Supervisory Patent Examiner
Art Unit 1722
Technology Center 1700
Chemical Materials & Engineering

HARTER, SECREST & EMERY LLP
1600 Bausch & Lomb Place
Rochester, NY 14604

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OFFICE OF PETITIONS

In re Application of :
Hiroyasu Inoue et al :
Application No. 09/611,846 : ON PETITION
Filed: July 7, 2000 :
Attorney Docket No. 1324.64496 :

This is a decision on the petition, filed July 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 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 (571) 272-3208.

The examiner of Technology Center AU 2871 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).

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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

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**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Schmidl et al. | : | |
| Application No. 09/611,879 | : | DECISION ON PETITION |
| Filed: 7 July, 2000 | : | |
| Atty Docket No. TI-30718 | : | |

This is a decision on the "Petition to Revive Patent Application" filed on 6 January, 2006,[1] which, in light of petitioners' statement that a response was timely filed, is being treated as a petition to withdraw the holding of abandonment.

The petition is **DISMISSED**.

A review of the record reveals that a non-final Office action was mailed on 18 October, 2004. The filing of the present petition precedes the mailing of Notice of Abandonment.

Petitioners state, in pertinent part:

> Applicants, through their Attorney, hereby petition the Assistant Commissioner of Patents to revive the above-identified application.
>
> A timely response to the Office Action mailed on October 18, 2004 was filed on January 27, 2005. Enclosed is a copy of the response and a receipt from the patent and Trademark Office indicating the acceptance of the response.

---

[1] It is noted that the petition and other papers filed on 6 January, 2006, miscaption the application number as "08/611,879" (emphasis added). The correct application number for this application is Application No. 09/611,879. All future correspondence should reference the correct application number.

> Although we do not feel the abandonment was the fault of Texas Instruments, if necessary, please charge the Deposit Account of Texas Instruments Incorporated…, with the amount sufficient to revive the above identified application.
>
> …

At the outset, it is noted that a petition to revive an application for patent must be made on the basis of either unavoidable and/or unintentional delay, pursuant to the provisions of 37 CFR 1.137(a) or (b). Petitioners herein have not averred whether the delay is unintentional and/or unavoidable. As it cannot be determined what type of petition to revive petitioners intended to file, the Office cannot treat the papers filed on 6 January, 2006, as a petition to revive under 37 CFR 1.137(a) or (b). If petitioners desire to revive the application, a petition should be filed under 37 CFR 1.137(a) or (b), accompanied by the proper fee, asserting unintentional and/or unavoidable delay.

A copy of the petition forms is enclosed for petitioners' reference.

In view of petitioners' statement that a response to the outstanding Office action was timely filed, the petition will be treated as a petition to withdraw the holding of abandonment.

In support, petitioners have supplied a copy of an amendment and a one (1) month extension of time. The first page of each document contains a Certificate of Facsimile Transmission dated 27 January, 2005, signed by Tommie Chambers.

Any petition to withdraw the holding of abandonment based on a Certificate of Transmission by facsimile must include the following requirements:

> (1) A copy of the original response bearing a signed Certificate of Transmission which includes the date of signing; and
>
> (2) A statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of transmitting the ***original*** response on the date indicated on the Certificate of Transmission (*see* 37 CFR 1.8 and MPEP 512).

The petition lacks item (2) above. Petitioners should supply a statement by the individual who signed the Certificate of Transmission.

Any request for reconsideration must be filed within **TWO MONTHS** of the date of this decision. **This period may not be extended.**[2]

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

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: PTO/SB/61
PTO/SB/64

[2] 37 CFR 1.181(f).

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MAR 2 1 2006

OFFICE OF PETITIONS

In re Application of :
Schmidl et al. :
Application No. 09/611,879 : DECISION ON PETITION
Filed: 7 July, 2000 :
Atty Docket No. TI-30718 :

This is a decision on the petition filed on 21 February, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 19 January, 2005, for failure to timely reply to the non-final Office action mailed on 18 October, 2004. The filing of the present petition precedes the mailing of Notice of Abandonment. The petition filed on 6 January, 2006, was dismissed on 6 February, 2006.

---

[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)).

Petitioners have filed an amendment as the required reply.

The statement contained in the instant petition does not set forth that the entire delay from the due date of the required reply to the date of the filing of a grantable petition was unintentional as required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition is being so construed. Petitioner **must** notify the Office if this is not a correct interpretation.

The petition fee will be charged to counsel's deposit account, as authorized the petition.

This application is being referred to Technology Center Art Unit 2664 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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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DALLAS TX 75265

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OFFICE OF PETITIONS

In re Application of
Schmidl et al.
Application No. 09/611,879
Filed: July 7, 2000
Attorney Docket Number: TI-30718
Title of Invention: Dynamic Assignment of Retransmission Slots For Enhanced Quality in Wireless Communication Links

ON PETITION

This is a decision on the petition filed July 7, 2006, 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 March 30, 2006. 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 July 1, 2006. A Notice of Abandonment was mailed on August 29, 2006.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CONNOLLY BOVE LODGE & HUTZ LLP
1990 M Street, N.W., Suite 800
Washington, DC 20036-3425

In re Application of:
Cyprian E. UZOH et al.
Serial No.: 09/611,955
Filed: July 6, 2000
Attorney Docket No.: **F19-97-205US2**

DECISION ON PETITION

This is a decision in response to the communication filed June 3, 2004. The communication has been treated as a petition under 37 C.F.R. § 1.181, requesting reconsideration of the objection to the specification, drawing and claims for new matter. No petition fee is required.

The petition is **GRANTED.**

In support of the petition, it is asserted that "[t]he specification as originally filed explicitly discloses that recesses are formed in at least one major surface of the semiconductor substrate. For instance see page 1, lines 14-16 of the original disclosure that state: '[t]his is achieved by selectively plating recesses in a semiconductor substrate with conductive metal such as copper or gold.' Also, see original claim 25 as filed which states 'recesses located in at least one major surface of said semiconductor substrate.' In addition, see the original Abstract of the Disclosure that states: 'Recesses in a semiconductor structure are selectively plated...' Accordingly, the above recitation is not new matter and claims 25 and 32 properly recite 'in.'"

Upon further considering the original disclosure, particularly original claim 25 which contains the limitation "recesses located in at least one major surface of said semiconductor substrate; electrical insulating layer over said at least one major surface and in said recesses," there is reasonable support therein for the Amendment filed July 31, 2004. Therefore, the amendments to the specification, drawings and claims do not contain new matter.

The application is being forwarded to the examiner for further consideration of the instant application in light of this decision.

James C. Dwyer, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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JAN 28 2005

OFFICE OF PETITIONS

ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619

In re Application of :
Joseph H. Sklar :
Application No. 09/612,055 :
Filed: July 7, 2000 :
Attorney Docket No. SKLAR-21

ON PETITION

This is a decision on the petition under 37 CFR 1.181 filed on November 15, 2004, to have fees refunded.

The petition is **DISMISSED**.

The record reflects that on June 2, 2004, a final Office action was mailed allowing a shortened statutory period for reply of three months from its mailing date. The next response, on record as having been received on November 15, 2004, included a Request for Continued Examination, Request for an Extension of Time within the third month, and the instant petition. Petitioner requests a refund of the fees associated with the Request for Continued Examination (RCE), extension of time, and the instant petition fee because petitioner maintains that the RCE was only necessary to save the application from abandonment because the amendment that was mailed August 2, 2004, was lost in the mail.

It is noted that 37 CFR 1.26, governing refunds, states that:

> [t]he Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for oral hearing, will not entitle a party to a refund of such fee.

There is nothing in the instant petition to suggest that the fees were mistakenly paid. The payment of the fees was quite deliberate as they were paid with the intention of keeping the application from going abandoned. While it is regretful that the amendment was allegedly lost by the United States Postal Service (USPS), petitioner is not entitled to a refund of the fees paid to the USPTO for alternate filings necessitated by the mistake of USPS, but which applicant deemed necessary to properly prosecute the application.

It is further noted, that rather than filing an RCE upon realizing that the amendment has not been received, petitioner had the option of timely filing the amendment via 37 CFR 1.8 or 1.10—and even filing an RCE to be considered only if the amendment was determined not to place the application in condition for allowance. Yet, petitioner chose to file the RCE, presumably to avoid the possibility that the amendment would not have placed the application in condition for allowance and the application still going abandoned. While petitioner certainly has the right to prosecute the application in this way,

petitioner is not entitled to a refund when petitioner makes a deliberate choice to file what amounted to a preemptive and precautionary RCE. Petitioner is, therefore, not entitled to a refund of the fee for the RCE, or the fee for the extension of time, or the fee for the instant petition. The petition is dismissed, accordingly.

The application file will be directed to Technology Center 3700, GAU 3732 for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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JAN 28 2005

OFFICE OF PETITIONS

ST.ONGE STEWARD JOHNSTON & REENS LLC
986 Bedford Street
Stamford, CT 06905-5619

In re Application of :
Joseph H. Sklar :
Application No. 09/612,055 : ON PETITION
Filed: July 7, 2000 :
Attorney Docket No. SKLAR-21

This is a decision on the petition under 37 CFR 1.181 filed on November 15, 2004, to have fees refunded.

The petition is **DISMISSED**.

The record reflects that on June 2, 2004, a final Office action was mailed allowing a shortened statutory period for reply of three months from its mailing date. The next response, on record as having been received on November 15, 2004, included a Request for Continued Examination, Request for an Extension of Time within the third month, and the instant petition. Petitioner requests a refund of the fees associated with the Request for Continued Examination (RCE), extension of time, and the instant petition fee because petitioner maintains that the RCE was only necessary to save the application from abandonment because the amendment that was mailed August 2, 2004, was lost in the mail.

It is noted that 37 CFR 1.26, governing refunds, states that:

> [t]he Director may refund any fee paid by mistake or in excess of that required. A change of purpose after the payment of a fee, such as when a party desires to withdraw a patent filing for which the fee was paid, including an application, an appeal, or a request for oral hearing, will not entitle a party to a refund of such fee.

There is nothing in the instant petition to suggest that the fees were mistakenly paid. The payment of the fees was quite deliberate as they were paid with the intention of keeping the application from going abandoned. While it is regretful that the amendment was allegedly lost by the United States Postal Service (USPS), petitioner is not entitled to a refund of the fees paid to the USPTO for alternate filings necessitated by the mistake of USPS, but which applicant deemed necessary to properly prosecute the application.

It is further noted, that rather than filing an RCE upon realizing that the amendment has not been received, petitioner had the option of timely filing the amendment via 37 CFR 1.8 or 1.10—and even filing an RCE to be considered only if the amendment was determined not to place the application in condition for allowance. Yet, petitioner chose to file the RCE, presumably to avoid the possibility that the amendment would not have placed the application in condition for allowance and the application still going abandoned. While petitioner certainly has the right to prosecute the application in this way,

petitioner is not entitled to a refund when petitioner makes a deliberate choice to file what amounted to a preemptive and precautionary RCE. Petitioner is, therefore, not entitled to a refund of the fee for the RCE, or the fee for the extension of time, or the fee for the instant petition. The petition is dismissed, accordingly.

The application file will be directed to Technology Center 3700, GAU 3732 for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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**OFFICE OF PETITIONS**

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| In re Application of | : | |
| Joel Naumann | : | |
| Application No. 09/612,067 | : | DECISION ON PETITION |
| Filed: July 7, 2000 | : | |
| Attorney Docket No. 73081 | : | |

This is a decision on the petition under 37 CFR 1.137(b), filed January 8, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a proper and timely manner to the Notification of Non-Compliant Appeal Brief (Notice) mailed April 25, 2007, which set a period for reply of one (1) month or thirty (30) days, whichever is longer. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on May 26, 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) and fee of $810.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $1,620.00; and (3) a proper statement of unintentional delay.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing 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. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to Joan Olszewski at (571) 272-7751.

The file is now being forwarded to Technology Center 2616 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

/Liana Walsh/
Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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PATTERSON & SHERIDAN, LLP/CISC
3040 POST OAK BLVD.
SUITE 1500
HOUSTON, TX 77056-6582

Mail Date: 07/09/2010

| | | |
|---|---|---|
| **Applicant** | : Joel Naumann | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7646735 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/12/2010 | : TERM ADJUSTMENT IN VIEW |
| **Application No** | : 09/612,067 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/07/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1938** 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

**MICHAEL J. BUCHENHORNER**
**HOLLAND & KNIGHT**
**701 BRICKELL AVENUE, STE. 3000**
**MIAMI FL 33131**

**COPY MAILED**

APR 0 4 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Nagano et al. | : | |
| Application No. 09/612,136 | : | ON PETITION |
| Filed: July 7, 2000 | : | |
| Attorney Docket No. JA999-118X | : | |

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 12, 2007, 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 Amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

This matter is being referred to Technology Center 2600 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

Ex. J. Wilson

**SPE RESPONSE FOR CERTIFICATE OF CORRECTION**

DATE : 8/18/06

Paper No.: _____

TO SPE OF : ART UNIT 3732

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/612,188 Patent No.: 7008453

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:** It is noted, that in the scanned certificate, "Column 39, Line 15" looks like line 16, however, it is Line 15.

Cris L. Rodriguez
ACTING **SPE**

3732
**Art Unit**

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 8-22-07 Paper No.: _____

TO SPE OF : ART UNIT 4700

SUBJECT : Request for Certificate of Correction for Appl. No. 6995257 B1 09/612226

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**.

Please response A/S/A/P. Applicant & Attorney wants to know the status

E M James

**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:** _____

_____

_____

_____

_____

_____ _____

**SPE** **Art Unit**

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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MAIL

AUG 2 5 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

In re Application of
Kenichiro Sakai, et al.
Application No. 09/612,288
Filed: July 7, 2000
For: **DOCUMENT IMAGE CORRECTING DEVICE AND A CORRECTING**

DECISION ON PETITION
TO WITHDRAW HOLDING OF
ABANDONMENT

This is a decision on the Petition to Withdraw the Holding of Abandonment filed August 11, 2005, pursuant to 37 C.F.R. §1.181. No fee is required.

The petition is **GRANTED.**

The application was abandoned for failure to respond in a timely and effective manner to the final Office action mailed March 31, 2004. A Notice of Abandonment was mailed July 26, 2005.

Petitioner asserts that response was timely filed. In support of the petition, Petitioner has submitted, a copy of the request for RCE transmittal which contains a certificate of mailing dated August 2, 2004 and a date-stamped post card receipt which itemizes a Request for Continued Examination (via Certificate of Mail) and a "check" in the amount of $770.00 The date stamped on the post card receipt is August 4, 2004.

The original correspondence filed was not matched with the application 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." The date stamped on the post card receipt of August 4, 2004 is subsequent to the due date for response to the outstanding Office action, including the one month extension of time paid for. However, the copy of the RCE transmittal letter includes a certificate of mailing certifying deposit on August 2, 2004 in accordance with 37 CFR 1.8(a). The due date for response to the final Office action was July 31, 2004 including the one month extension of time. July 31, 2004 fell on a Saturday and therefore, the response was due by the next business day or Monday; August 2, 2004.

Therefore, in accordance with 37 C.F.R. §1.8, the copy of the response is accepted as having been timely filed. Furthermore, a review of the PTO Revenue Accounting and Management (RAM) system finds that the RCE filing fee was received on August 4, 2004 and processed on August 5, 2004. Accordingly, it is concluded that the Request for Continued Examination was timely filed in the Patent and Trademark Office but not matched with the application file.

In view of the above stated reasons, the holding of abandonment is withdrawn.

The application file will be forwarded to the Technology Center's technical support staff for entering the copy of the RCE request submitted with the petition. From there, the file will be forwarded to the examiner for appropriate action in due course.

Dwayne Bost
Special Program Examiner
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
AMB 07-01

Paper No. 10

CHARLES A. MUSERLIAN
C/O BIERMAN MUSERLIAN AND
LUCAS
600 THIRD AVENUE
NEW YORK, NY 10016

COPY MAILED

JUL 30 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
Bigg, et al. :
Application No. 09/612,382 : ON PETITION
Filed: July 7, 2000 :
Attorney Docket No. 427.010-1-DIV-2:

This is a decision on the petition under 37 CFR 1.137(b), filed July 18, 2001, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned March 9, 2001. The application became abandoned for failure to properly reply to the non-final Office action mailed December 8, 2000. The non-final Office action set a shortened statutory period for reply of three (3) months. A three (3) month extension of time under the provisions of 37 CFR 1.136(a) was obtained on June 8, 2001 at which time an improper Request for Continued Examination ("RCE") was filed. Notice of improper RCE was mailed June 27, 2001. Notice of Abandonment was mailed July 11, 2001.

Receipt of the amendment submitted herewith is acknowledged.

As requested, the previously submitted RCE fee has been refunded to deposit account no. 02-2275.

This application will be forwarded to Technology Center 1600 for further processing.

Telephone inquiries concerning this matter may be directed to Petitions Attorney Alesia M. Brown at 703-305-0310.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.: X**

**DATE** : September 14, 2007

**TO SPE OF** : ART UNIT 2815

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 09/612,482 Patent No.: 6703679

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**

*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:** The change request is hereby accepted by Joseph Nguyen

SPE

2815
Art Unit

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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ERICSSON INC
6300 LEGACY DR
M/S EVR 1-C-11
PLANO TX 75024

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MAR 20 2006
OFFICE OF PETITIONS

In re Application of
Johan Karoly Peter Galyas :
Application No. 09/612,628 : DECISION ON
Filed: July 7, 2000 : PETITION
Attorney Docket No. P11542-US1 :

This is in response to the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed February 9, 2006.

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

The holding of abandonment is **WITHDRAWN**.

The above-identified application was held abandoned for failure to timely file a reply to the non-final Office action mailed April 8, 2003. No extensions of time under 37 CFR 1.136(a) were obtained. No response having been received, the above-identified application became abandoned on July 9, 2003. A Notice of Abandonment was mailed on December 1, 2005.

Petitioner has supplied a copy of an Amendment, bearing a Certificate of Transmission under 37 CFR 1.8 dated July 8, 2003.

In view of the above, the holding of abandonment is withdrawn.

Given the basis for granting this petition, no petition fee was required.

The application file is being forwarded to Group Art Unit 2654 for consideration of the Amendment (Certificate of Mailing dated July 8, 2003) supplied with the instant petition.

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

Cliff Congo
Petitions Attorney
Office of Petitions

#24

UNITED STATES PATENT AND TRADEMARK OFFICE

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

November 2004

Stephen A. Gratton
The Law Office of Steve Gratton
2764 South Braun Way
Lakewood, CO 80228

NOV 30 2004

In re Application of:
Alan G. Wood et al.
Serial No.: 09/612,696
Filed: July 10, 2000
Attorney Docket No.: 91-62.20

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on the petition to withdraw holding of abandonment under 37 C.F.R. § 1.181(a) filed on April 1, 2004. There is no fee for this petition. As such, the $130.00 petition fee that applicant paid by check will be credited to Deposit Account 07-1857 as requested in the petition.

The petition is **GRANTED**.

The application was held abandoned for failure to file a proper reply to the non-final Office action mailed on September 5, 2003. A Notice of Abandonment was mailed on March 23, 2004. The Notice of Abandonment incorrectly noted the mail date of the non-final Office action as September 8, 2003.

Petitioner asserts that a response was timely mailed to the U.S Patent and Trademark Office (USPTO) on October 3, 2003 via the procedure set forth in 37 C.F.R. § 1.8. The evidence provided by the petitioner includes a statement which attests upon a personal knowledge basis to the previous mailing of the response as well as a copy of the response. The copy of the response contains the required certificate of mailing (dated October 3, 2003) under 37 C.F.R. § 1.8 (a)(1)(ii). The evidence is sufficient under 37 C.F.R. § 1.8 (b) to establish that the response was timely filed.

For the above stated reason, the petition is granted. The Notice of Abandonment mailed March 23, 2004 is hereby **VACATED** and the holding of abandonment is withdrawn.

The copy of the response submitted with the petition on April 1, 2004 is accepted since the response originally submitted was apparently lost.

The response will be processed by the Technology Center 2800 support staff and the examiner will prepare an Office action based upon the response.

Any inquiries regarding this decision should be directed to Edward Westin at (571) 272-1638.

Sharon A. Gibson, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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**MAILED**

JUL 14 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE, 10TH FLOOR
NEW YORK, NY 10151

In re Application of:
Ryoji SUZUKI, et al
Application No. 09/612,752
Filed: July 10, 2000
For: **SOLID-STATE IMAGING DEVICE, ITS DRIVING METHOD, AND CAMERA SYSTEM**

DECISION
ON PETITION

This is a response to the facsimile copy of a previously filed Petition to Withdraw Holding of Abandonment, filed April 20, 2005. The communication is being treated under 37 CFR 1.8(b) to withdraw the holding of abandonment

*The petition is **granted**.*

This application became abandoned for failure to timely file a response to the Office action mailed April 22, 2004, which set a shortened statutory period of three (3) months to reply. A Notice of Abandonment has not been mailed.

Petitioner alleges to have timely filed a response to the Office action on August 23, 2004. To support this position, Petitioner has included with the instant petition a copy of the response along with petition for one months extension of time bearing a proper certificate of mailing having a date of August 23, 2004.

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.

The application will be forwarded to the Technology Center's technical support staff for entry of the response and petition for one months extension. From there, the file will be forwarded to the examiner for consideration in due course.

Doris To
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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JUL 14 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE, 10TH FLOOR
NEW YORK, NY 10151

DOCKETED

In re Application of:
Ryoji SUZUKI, et al
Application No. 09/612,752
Filed: July 10, 2000
For: **SOLID-STATE IMAGING DEVICE, ITS DRIVING METHOD, AND CAMERA SYSTEM**

DECISION
ON PETITION

This is a response to the facsimile copy of a previously filed Petition to Withdraw Holding of Abandonment, filed April 20, 2005. The communication is being treated under 37 CFR 1.8(b) to withdraw the holding of abandonment

*The petition is **granted**.*

This application became abandoned for failure to timely file a response to the Office action mailed April 22, 2004, which set a shortened statutory period of three (3) months to reply. A Notice of Abandonment has not been mailed.

Petitioner alleges to have timely filed a response to the Office action on August 23, 2004. To support this position, Petitioner has included with the instant petition a copy of the response along with petition for one months extension of time bearing a proper certificate of mailing having a date of August 23, 2004.

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.

The application will be forwarded to the Technology Center's technical support staff for entry of the response and petition for one months extension. From there, the file will be forwarded to the examiner for consideration in due course.

Doris To
Special Program Examiner
Technology Center 2600
Communications

FROMMER LAWRENCE & HAUG, LLP
JUL 19 A 10:20

UNITED STATES PATENT AND TRADEMARK OFFICE

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JUL 14 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE, 10TH FLOOR
NEW YORK, NY 10151

In re Application of:
Ryoji SUZUKI, et al
Application No. 09/612,752
Filed: July 10, 2000
For: **SOLID-STATE IMAGING DEVICE, ITS DRIVING METHOD, AND CAMERA SYSTEM**

DECISION
ON PETITION

This is a response to the facsimile copy of a previously filed Petition to Withdraw Holding of Abandonment, filed April 20, 2005. The communication is being treated under 37 CFR 1.8(b) to withdraw the holding of abandonment

*The petition is **granted**.*

This application became abandoned for failure to timely file a response to the Office action mailed April 22, 2004, which set a shortened statutory period of three (3) months to reply. A Notice of Abandonment has not been mailed.

Petitioner alleges to have timely filed a response to the Office action on August 23, 2004. To support this position, Petitioner has included with the instant petition a copy of the response along with petition for one months extension of time bearing a proper certificate of mailing having a date of August 23, 2004.

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.

The application will be forwarded to the Technology Center's technical support staff for entry of the response and petition for one months extension. From there, the file will be forwarded to the examiner for consideration in due course.

Doris To
Special Program Examiner
Technology Center 2600
Communications

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

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JAN 22 2008

OFFICE OF PETITIONS

In re Application of :
Hepworth et al. :
Application No. 09/612766 : DECISION
Filing or 371(c) Date: 07/10/2000 : ON PETITION
Attorney Docket No.: 040246-002000US :

This is a decision on the "Request to Correct Assignee After Payment of Issue Pursuant to 37 C.F.R. § 3.81(b)," filed November 21, 2007, to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The Petition is **granted**.

The petition was accompanied by a certificate of correction as required by 3.81(b), and the fee submitted with the present petition. Further, Office assignment records reflect that MarkMonitor, Inc., is an assignee of record. As the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to be processed.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

This matter is being referred to the Certificates of Correction Branch for processing of a certificate of correction after issuance of this application into a patent.

Derek L. Woods
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. 17

Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

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MAR 29 2004

OFFICE OF PETITIONS

In re Application of :
Victor N. Krashykh et al. :
Application No. 09/612,852 : ON PETITION
Filed: July 10, 2000 :
Attorney Docket No. 678503-2006.2 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 16, 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 December 23, 2002, 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 February 24, 2002. See MPEP 1215.04.

The application file is being forwarded to Technology Center AU 1635 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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

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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MAY - 9 2005

PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN VA 22102

In re Application of:
Hanna et al.
Serial No.: 09/612,914
Filed: July 10, 2000
Attorney Docket No.: 012712-905

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in response to applicants' petition under 37 CFR. § 1.181(a) and MPEP 711.03(c) filed on April 25, 2005, requesting withdrawal of the holding of abandonment of the above-identified application based on non-receipt of an Office action and to restore the application to a pending status.

A review of the file history shows that the examiner mailed an Office action to applicants on December 9, 2003, setting a one-month statutory time period for reply. On February 23, 2005, the examiner mailed a notice of abandonment for failure to respond to the outstanding Office action.

Applicants' state that the Office action of December 9, 2003 was never received and provides as evidence thereof a copy of the attorney docket reports where the Office action would have been entered if received, showing non-receipt of the Office action. Based on the evidence presented, it is concluded that applicants never received the Office action. In view thereof, the Notice of Abandonment mailed February 23, 2005, is vacated and the application is restored to pending status with the mailing date of this decision.

Applicant' petition is **GRANTED**. The application will be forwarded to the examiner for prompt mailing of a new Office action.

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 at 703-872-9306.

Marianne C. Seidel for

Jasemine Chambers
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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BORDEN LADNER GERVAIS LLP
WORLD EXCHANGE PLAZA
100 QUEEN STREET SUITE 1100
OTTAWA ON K1P 1J9 CA CANADA

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FEB 1 3 2006

OFFICE OF PETITIONS

In re Application of :
Matthew D. Brown et al. :
Application No. 09/612,976 : ON PETITION
Filed: July 10, 2000 :
Attorney Docket No. PAT 2593-2 :

This is a decision on the petition filed August 24, 2005 under 37 CFR 1.137(b),[1] to revive the above-identified application.

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

This application became abandoned May 24, 2005 for failure to timely pay the issue fee on or before May 23, 2005. Subsequent to the filing of the Petition to Revive, the Notice of Abandonment was mailed August 24, 2005.

Receipt is also acknowledged of the revocation and power of attorney signed by assignee. However, a review of the power of attorney discloses that it is unacceptable since it is not in compliance with 37 CFR 3.73(b) in that the putative assignee has not established its right to take action in accordance with 37 CFR 3.73(b). Specifically, petitioners have not provided documentary evidence of a chain of title from the original owner to the assignee, nor shown that documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*i.e.*

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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.

(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)).

reel and frame number). Upon completion and submission of a Certificate Under 37 CFR 3.73(b) form, the power of attorney will be acceptable.

Until such time as the power of attorney and correspondence address is accepted, all future correspondence will be directed to the attorney of record at the address of record.

The issue fee, petition fee and publication fee have been applied. All other requirements of 37 CFR 1.137(b) having now been met, this application file is being forwarded to the Publishing Division to be processed into a patent.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

SMART AND BIGGAR
438 UNIVERSITY AVENUE
SUITE 1500 BOX 111
TORONTO, CANADA M5G2K-8

UNITED STATES PATENT AND TRADEMARK OFFICE

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BERRY & ASSOCIATES P.C.
9255 SUNSET BOULEVARD
SUITE 810
LOS ANGELES, CA 90069

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FEB 27 2007

OFFICE OF PETITIONS

In re Application of :
Eric M. Lunsford, et al. :
Application No. 09/613,028 : ON PETITION
Filed: July 10, 2000 :
Attorney Docket No. PALM-3184.US.P :

This is a decision on the petition under 37 CFR 1.137(b), filed August 15, 2006, to revive the above-identified application.

The petition is **GRANTED**.

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 January 10, 2005. No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, a Notice of Abandonment was mailed on July 26, 2005.

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 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 Request for Continued Examination (RCE), including the fee of $790 and the submission required by 37 CFR 1.114; (2) the petition fee of $1500; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 2673 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THE FARRELL LAW FIRM, P.C. - IBM
290 Broadhollow Road
Suite 210E
Melville, NY 11747

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : Dirk Husemann | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7577910 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/18/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/613,113 | : OF WYETH |
| **Filed** | : 07/10/2000 | : |
| | | : |

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
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WASHINGTON, D.C. 20231
www.uspto.gov

**MAILED**

DEC 10 2001

Office of the Director
Group 3600

CARL M NAPOLITANO
ALLEN DYER DOPPELT MILBRATH
& GILCHRIST
PO BOX 3791
ORLANDO, FL 32802

PAPER NO: 17

| | | |
|---|---|---|
| Applicant | : LARSON et al | ) |
| Serial No | : 09/613,154 | ) **PETITION TO CORRECT** |
| Filed | : 06/30/2000 | ) **INVENTORSHIP** |
| For | : Water Sport Towing | ) **UNDER** |
| | : Apparatus and Method | ) ***37 C.F.R. 1.324*** |

This is a decision on the petition to correct inventorship under 37 CFR 1.324, which was filed June 30, 2000 in reissue application 09/613,154 for U.S. Patent No. 5,979,350.

The petition is **DISMISSED**.

MPEP 1412.04 sets forth:

> The reissue application with its reissue oath or declaration under 37 CFR 1.175 provides a complete mechanism to correct inventorship. See A.F. Stoddard & Co. v. Dann, 564F.2d at 567, 195 USPQ at 106. A request under 37 CFR 1.48 or a petition under 37CFR 1.324 cannot be used to correct the inventorship of a reissue application. If a request under 37 CFR 1.48 or a petition under 37 CFR 1.324 is filed in a reissue application, the request or petition should be dismissed and the processing or petition fee refunded. The material submitted with the request or petition should then be considered to determine if it complies with 37 CFR 1.175. If the material submitted with the request or petition does comply with the requirements of 37 CFR 1.175 (and the reissue application is otherwise in order), the correction of inventorship will be permitted as a correction of an error in the patent under 35 U.S.C. 251.

As the materials submitted with the petition to correct inventorship do not comply with the requirements of 37 CFR 1.175, a new reissue declaration clearly setting forth the error of inventorship as set forth in MPEP 1412.04 is suggested. Any

petition fee charged shall be refunded. As set forth previously, since the reissue declaration provides the complete mechanism for correction of inventorship, the petition under 37 CFR 1.324 is dismissed.

**Summary:** Petition **DISMISSED**

S. Joseph Morano
Supervisory Patent Examiner
Art Unit 3617

sjm: December 7, 2001

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Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
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Paper No. 21

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P.O. BOX 3791
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SEP 1 7 2004

OFFICE OF PETITIONS

In re Patent No. RE37,823 :
Issue Date: September 3, 2002 :
Application No. 09/613,154 : ON PETITION
Filed: June 30, 2000 :
Patentee(s) Borden M. Larson et al :

This is a decision on the petition under 37 CFR 1.378(c), filed September 7, 2004, to accept the delayed payment of a maintenance fee for the above-identified patent.

The petition is **GRANTED.**

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 Irvin Dingle at (703) 306-5684.

The patent file is being forwarded to 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
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#23

**CARL M. NAPOLITANO**
**ALLEN DYER DOPPELT MILBRATH**
**& GILCHRIST PA**
**P.O. BOX 3791**
**ORLANDO FL 32802**

MAILED

JAN 07 2010

OFFICE OF PETITIONS

In re Patent No. RE37823 :
Issue Date: September 3, 2002 :
Application No. 09/613,154 : NOTICE
Filed: June 30, 2000 :
Attorney Docket No. 20238.2RE :

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**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

Inquiries related to this communication should be directed to Diane C. Goodwyn at (571) 272-6735.

Thurman K. Page
Petitions Examiner
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. 8

MCNEES WALLACE & NURICK LLC
100 PINE STREET
P.O. BOX 1166
HARRISBURG, PA 17108-5300

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MAR 1 0 2003

OFFICE OF PETITIONS

In re Application of :
Thomas Mesing et al :
Application No. 09/613,162 : ON PETITION
Filed: July 10, 2000 :
Attorney Docket No. 13DV-12817 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 3, 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 5, 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 October 6, 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 1700 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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/613,177 | 07/10/2000 | Kuber T. Sampath | CIBT-P02-540 | 8978 |

28120 7590 07/29/2002

ROPES & GRAY
ONE INTERNATIONAL PLACE
BOSTON, MA 02110-2624

| EXAMINER |
|---|
| FREDMAN, JEFFREY NORMAN |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1637 | 12 |

DATE MAILED: 07/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

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

William G. Gosz
Ropes & Gray
One International Place
Boston, MA 02110-2624

| | | |
|---|---|---|
| In re Application of | : | |
| Sampath et al | : | |
| Serial No.: 09/613,177 | : | PETITION DECISION |
| Filed: July 10. 2000 | : | |
| Attorney Docket: CIBT-P02-540 | : | |

This is in response to applicants' "Petition To Withdraw Holding of Abandonment" filed July 25, 2002.

A review of the file history indicates that a Final Office Action was mailed on November 2, 2001. Applicants state that the Office action dated November 2, 2002 was never received. A search of the file jacket and the docket records indicates that the Office action was not received. A copy of docket records is attached. Applicants' statement and evidence show that the office action of November 2, 2001 was never received. The instant application is technically abandoned. However, notice of Abandonment has not been mailed. Application is in pending status. Accordingly, the petition is Dismissed. The Final Office action dated November 2, 2001 is being remailed herewith. A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS LETTER.

Petition is **Dismissed.**

Should there be any questions regarding this decision, please contact Cecilia Tsang by mail addressed to Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703) 308-0254 or by facsimile transmission at (703) 305-7230.

Cecilia Tsang for

Bruce M. Kisliuk
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
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Sanford J. Piltch
1132 Hamilton Street--Suite 201
Allentown, PA 18101-1024

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APR 2 8 2005

OFFICE OF PETITIONS

In re Application of

Hsu, et al.

Application No. 09/613,209

Filed: July 10, 2000

Attorney Docket No. 429-11

DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), February 4, 2005, to revive the above-identified application.

The petition is **granted**.

This application became abandoned for failure to timely remit the issue fee of $700.00 as required by the Notice of Allowance and Issue Fee Due (the "Notice") mailed September 23, 2003. The Notice set forth a three (3) month statutory period for reply. No response was received within the allowable period. Accordingly, this application became abandoned on December 24, 2003. A Notice of Abandonment was mailed on March 31, 2004.

The issue fee of $700.00 was received on February 4, 2005.

Form PTOL-85B was received on February 4, 2005, and is made of record.

The application is being forwarded to the Office of Patent Publications for further processing.

Telephone inquiries concerning this matter may 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
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Paper No. 5

LOUIS J. BACHAND
P. O. BOX 1508
LA CANADA, CA 91012-5508

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JAN 2 9 2003

OFFICE OF PETITIONS

In re Application of :
Peter Hauber :
Application No. 09/613,294 :
Filed: July 10, 2000 :
Attorney Docket No. BLDR-01 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 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 Notice to File Missing Parts of Nonprovisional Application mailed September 11, 2000. The Notice set a period for reply 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, the above-identified application became abandoned on November 12, 2000.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-5594.

The application file is being forwarded to the Office of Initial Patent Examination for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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**MAIL**

Paper No. 6

MAR 1 6 2001

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Alan A. Limbach
Limbach & Limbach L.L.P.
2001 Ferry Building
San Francisco, California 94111

In re Application of: Craig M. Janik
Application No. 09/613,322
Filed: July 11, 2000
For: CLOCK WITH LINK TO THE INTERNET

**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed February 2, 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) the United States Patent and Trademark Office (Office) does not recognize firms - each attorney for whom withdrawal is requested must be individually listed; (2) there is no statement that Mr. Limbach is ***authorized*** to sign on behalf of the other listed attorneys; and (3) there is no indication that applicant has been notified of this request. 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
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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 8

Alan A. Limbach
Limbach & Limbach L.L.P.
2001 Ferry Building
San Francisco, California 94111

| | | |
|---|---|---|
| In re Application of: Craig M. Janik | ) | |
| Application No. 09/613,322 | ) | **DECISION ON REQUEST FOR** |
| Filed: July 11, 2000 | ) | **WITHDRAWAL AS ATTORNEY** |
| For: CLOCK WITH LINK TO THE INTERNET | ) | |

This is a decision on the Request To Withdraw from Representation filed April 17, 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 that the United States Patent and Trademark Office (Office) does not recognize firms - each attorney for whom withdrawal is requested must be individually listed. 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
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Electronic Commerce
(703) 306-4160

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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GREENBERG TRAURIG LLP
77 WEST WACKER DRIVE
SUITE 2500
CHICAGO IL 60601-1732

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NOV 29 2007

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Application of | : | |
| Craig M. Janik | : | |
| Application No. 09/613,322 | : | ON PETITION |
| Filed: July 11, 2000 | : | |
| Attorney Docket No. 81230.521US | : | |

This is a decision on the petition filed on August 7, 2007, 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 file a proper reply to the final Office action mailed November 27, 2006. This Office action set a shortened statutory period for reply of three (3) months. Applicant filed a response on December 11, 2006, and again on February 8, 2007. However, in an Advisory Action mailed April 3, 2007, the Office informed Applicant that the response would not be entered because it failed to place the application in condition for allowance. Applicant filed a Notice of Appeal on April 23, 2007. However, the Notice of Appeal lacked the appropriate extension of time fee. Accordingly, the application became abandoned on February 28, 2007. The mailing of this decision precedes the mailing of a Notice of Abandonment.

On petition, petitioner paid the petition fee and made the proper statement of unintentional delay. The required reply in the form of a Notice of Appeal and Pre-Appeal Brief Request for Review were previously filed.

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 $450.00 extension of time fee submitted with the petition on August 7, 2007 was subsequent to the maximum period obtainable for reply (May 28, 2007), this fee has been refunded to petitioner's Deposit Account No. 50-2428.

**Please be advised that the two month period for filing an appeal brief (accompanied by the fee required by 37 CFR 1.17(c)) runs from the date of this decision.**

The matter is being returned to Group Art Unit 2116 to await for applicant's submission of the appeal brief.

Telephone inquiries specific to this decision should 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. 9

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON, VA 22202

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JUL 3 1 2002

OFFICE OF PETITIONS

In re Application of :
Masamoto Tago et al :
Application No. 09/613,331 : ON PETITION
Filed: July 7, 2000 :
Attorney Docket No. WN-2205 :

This is a decision on the petition, filed July 29, 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 July 8, 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.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2818 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

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[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 th previously paid issu fee be applied towards th new Notice and payment of any balance du will r sult in th abandonment of the application.**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 8

Christopher B. Kilner, Esq.
Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive
Suite 1000
Reston, Virginia 20191-5302

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SEP 1 2 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Mark E. Valenti )
Application No. 09/613,387 )
Filed: July 11, 2000 )
For: SYSTEM AND METHOD FOR INTERNET BROADCAST SEARCHING )

DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER M.P.E.P. §708.02(VIII)

This is a decision on the petition, filed December 24, 2001 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII): Accelerated Examination, to make the above-identified application special and supplemented by the submission filed September 10, 2002.

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(h);

(b) Presents all claims directed to a single invention, ...

(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 combined submissions 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 Security, Architecture, and Software
(703) 306-4160

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Paper No. 7

SMART & BIGGAR
100 DE LA GAUCHETIERE STREET WEST
SUITE 3400
MONTREAL, QUEBEC H3B 4W5
CANADA

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APR 16 2004

OFFICE OF PETITIONS

In re Application of
Mayer, Michael G.
Application No. 09/613,418
Filed: July 10, 2000
Attorney Docket No. 85773-227

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 7, 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 September 5, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on December 6, 2003.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b).

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 $950.00 extension of time fee submitted with the petition on April 7, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

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 & TRADEMARK OFFICE
Washington, D.C. 20231

# REQUEST FOR PATENT FEE REFUND

1 Date of Request: 4/15/04

2 Serial/Patent # 09/613418

| | 3 Please refund the following fee(s): | 4 PAPER NUMBER | 5 DATE FILED | 6 AMOUNT |
|---|---|---|---|---|
| | Filing | | | $ |
| ✓ | Amendment | | | $ |
| ✓ | Extension of Time | #6 | 4/7/04 | $ 950.00 |
| | Notice of Appeal/Appeal | | | $ |
| | Petition | | | $ |
| | Issue | | | $ |
| | Cert of Correction/Terminal Disc. | | | $ |
| | Maintenance | | | $ |
| | Assignment | | | $ |
| | Other | | | $ |

7 TOTAL AMOUNT OF REFUND $ 950.00

8 TO BE REFUNDED BY:

| | |
|---|---|
| ✓ | Treasury Check |
| ✓ | Credit Deposit A/C #: |

9 1 9 -- 2 5 5 0

10 REASON:

| | |
|---|---|
| | Overpayment |
| ✓ | Duplicate Payment |
| ✓ | No Fee Due (Explanation): |

EOT filed outside maximum extendable timeframe.

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Dana Chase TITLE: Paralegal

SIGNATURE: D Chase PHONE: 306-0482

OFFICE: Petitions

**********

THIS SPACE RESERVED FOR FINANCE USE ONLY:

APPROVED: [signature] DATE: 4-15-04

*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)

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OFFICE OF PETITIONS

Sughrue Mion Zinn Macpeak & Seas
2100 Pennsylvania Avenue NW
Washington, DC 20037-3202

In re Application of :
Hirofumi Ando :
Application No. 09/613,426 : ON PETITION
Filed: July 10, 2000 :
Attorney Docket No. Q60058 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 1, 2004, 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 April 28, 2004.

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 2622, for further processing of the request for continued examination under 37 CFR 1.114 filed November 1, 2004.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Paper No. 11

Nadeem G. Bridi c/o Kinetic Concepts Inc.
PO Box 659508
San Antonio, TX 78265-9508

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OFFICE OF PETITIONS

In re Application of :
Kenneth Hunt et al. :
Application No. 09/613,497 : ON PETITION
Filed: July 11, 2000 :
Attorney Docket No. VAC.709A.US :

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 Granted.

The above-identified application became abandoned for failure to reply in a timely manner to the Office action under Ex parte Quayle, 1935 Dec. Comm'r Pat. 11 (1935), mailed November 6, 2001, which set a shortened statutory period for reply of two (2) 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 7, 2002.

The application file is being forwarded to Technology Center AU 3761 for further processing.

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

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**LEGAL DEPARTMENT INTELLECTUAL PROPERTY**
**KINETIC CONCEPTS, INC.**
**P.O. BOX 659508**
**SAN ANTONIO TX 78265-9508**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Kenneth William **HUNT**, et al. | : | |
| Application No. 09/613,497 | : | DECISION GRANTING PETITION |
| Filed: July 11, 2000 | : | UNDER 37 CFR 1.313(c)(2) |
| Attorney Docket No. VAC.709A.US | : | |

This is a decision on the petition under 37 CFR 1.313(c)(2), filed February 26, 2007, 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 12, 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 Monica Graves at (571) 272-7253.

This application is being referred to Technology Center AU 3743 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

[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.*

#34

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DEC 23 2003

TIMOTHY J. GAUL
AMGEN INC.
DEPT. 4300, M/S 27-4-A
ONE AMGEN CENTER DRIVE
THOUSAND OAKS, CA 91320-1779

In re Application of
William J. Boyle et al
Serial No.: 09/613,591
Filed: July 10, 2000
Attorney Docket No. :A-378CIP5

WITHDRAWAL OF ABANDONMENT

This is in response to the petition under 37 CFR 1.181, filed October 27, 2003, requesting withdrawal of abandonment of the above-identified application based on non-receipt of the last Office Action.

A review of the file history shows that the examiner mailed a Final Office action to applicants on January 22, 2003. Upon failure to receive a response, the application was held abandoned by Notice of Abandonment mailed September 30, 2003. Applicants state that the Office action mailed January 22, 2003, was never received. Applicant has provided statements and docket record evidence of non-receipt in support thereof. In view thereof, the Notice of Abandonment is withdrawn and the application is restored to a pending status with the mailing of this decision.

Applicants' petition is **GRANTED**.

**The application will be forwarded to the examiner for remailing of the last Office action.**

**No petition fee is due for this petition and the petition fee submitted of $130.00 will be credited to applicants' Deposition Account No. 01-0519.**

Should there be any questions regarding this decision, please contact William R. Dixon, Jr., by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.

Jasmine Chambers
Director, Technology Center 1600

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OFFICE OF PETITIONS

MCKENNA LONG & ALDRIDGE LLP
1900 K STREET, NW
WASHINGTON DC 20006

In re Application of :
KELLY et al. :
Application No. 09/613,592 :
Filed: July 10, 2000 :
Attorney Docket No. 8608.001.00 :

DECISION
ON PETITION

This is a decision on a petition under 37 CFR 1.137(b), filed August 16, 2006 and resubmitted on August 11, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to submit the issue fee in a timely manner in reply to the Notice of Allowance and Fee(s) Due, mailed May 9, 2006, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on August 10, 2006.

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

The petition references a Response to Notice to File Corrected Application Papers (Notice) in Box 2.A. No reply was located in the file. Furthermore, a review of the file does not show a Notice was mailed to applicant in the above-identified application, and thus, no reply to a Notice was due. If a Notice was mailed to applicants, petitioner must notify the Office.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4787.

The application matter is being forwarded to Office of Patent Publication.

Denise Pothier
Petitions Examiner
Office of Petitions

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Paper No. 24

Jack D. Todd
MORRIS, MANNING & MARTIN LLP
6000 FAIRVIEW ROAD
SUITE 1125
CHARLOTTE NC 28210

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OFFICE OF PETITIONS

In re Application of
Cheryl NEOFYTIDES et al.
Application No. 09/613,615
Filed: July 11, 2000
Attorney Docket No. 10722-32691

DECISION
ON PETITION
37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed December 8, 2003, to revive the above-identified application. The instant application became abandoned for failure to pay the fee required for filing the Appeal Brief, filed June 27, 2003.

The petition is **GRANTED**.

Petitioner has met the requirements for filing a grantable petition under 37 CFR 1.137(b).

The application file is being forwarded to the Technology Center 2100 for consideration of the Appeal Brief filed June 27, 2003.

Any questions concerning this matter may be directed to Ehud Gartenberg at (703) 305-4066 or, in his absence, to the undersigned at (703) 308-3865.

BethAnne Dayoan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Paper No.

FOLEY & LARDNER LLP
P.O. BOX 80278
SAN DIEGO, CA 92138-0278

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OFFICE OF PETITIONS

In re Application of :
Kenneth Buechler : DECISION ON PETITION
Application No. 09/613,650 :
Filed: July 11, 2000 :
Atty Docket No. 071949-1307 :

This is a decision on the PETITION UNDER 37 CFR §§ 1.181 OR 1.182 TO ACCEPT A FILING AS OF IT'S DATE OF FACSIMILE TRANSMISSION IN ACCORDANCE WITH 37 CFR §1.8 filed June 19, 2006.

On February 7, 2006, the Office mailed a non-final Office action in the above-identified application. This Office action set a three-month period for response, with extensions of time obtainable under § 1.136(a).

On June 19, 2006, applicant filed the instant petition, asserting that the response had been timely filed by facsimile transmission on Monday, May 8, 2006. In support thereof, applicant submits a copy of the response as maintained to have been timely faxed and a copy of a purported facsimile transmission confirmation.

A review of the record confirms that no response was received on May 8, 2006, as no such response is present in the image file wrapper for this application.

37 CFR 1.8(b) provides 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 U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is 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 Director 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's evidence has been considered, but not found persuasive that the response should be considered timely submitted pursuant to § 1.8(b). Effective December 1, 2003, the Office required, with few exception, that all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (703) 872-9306. See *Centralized Delivery and Facsimile Transmission Requirements for Patent Application Related Correspondence*, 1275 OG 200 (October 28, 2003). In the Office action mailed February 7, 2006, the examiner noted the centralized facsimile number of 703-872-9306. Effective July 15, 2005, the centralized facsimile number was changed to (571) 273-8300, with all facsimile transmissions sent to the old facsimile number being forwarded to the new number. See *New Patents Central FAX Number and Updated Lists of Exceptions to the Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence*, 1296 OG 76 (July 12, 2005).

However, applicants, according to their own evidence, faxed the response to an incorrect facsimile number, 571-273-0814. Moreover, the evidence submitted includes neither a statement from the person who transmitted the facsimile attesting to its successful transmission nor does it include a facsimile transmission confirmation. Applicant has not submitted a confirmation, but rather applicant has submitted a copy of the

facsimile transmission letter. The letter includes no indicia of successful facsimile transmission.

Under the circumstances, the holding of abandonment is proper and will not be withdrawn.

No fee is required on petition under § 1.181.

Nonetheless, as of the filing date of this petition, June 19, 2006, the period for reply to the Office action mailed February 7, 2006, with extensions of time continued to run. Receipt of the response on petition is acknowledged. To accept the response as timely, a petition fee for extension for response within the second month is being charged to Deposit Account No. 50-0872, as authorized.

Technology Center AU 1743 has been advised of this decision. The application is, thereby, being forwarded to the examiner for consideration of the response filed June 19, 2006.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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JUN 15 2007

**OFFICE OF PETITIONS**

In re Application of :
Kenneth Buechler : DECISION ON PETITION
Application No. 09/613,650 :
Filed: July 11, 2000 :
Atty Docket No. 071949-1307 :

This is in response to the REQUEST FOR RECONSIDERATION OF A DECISION ON PETITION filed August 2, 2006.

On February 7, 2006, the Office mailed a non-final Office action in the above-identified application. This Office action set a three-month period for response, with extensions of time obtainable under § 1.136(a).

By decision mailed July 24, 2006, the "petition to accept a filing as of its date of facsimile transmission in accordance with 37 CFR §1.8" filed June 19, 2006, was dismissed. The evidence submitted included neither a statement from the person who transmitted the facsimile attesting to its successful transmission nor a facsimile transmission confirmation.

Nonetheless, because the petition was filed on June 19, 2006, which was within the period for reply to the Office action mailed February 7, 2006, the response was accepted as timely filed with a petition for extension of time for response within the second month (and extension fee).

On instant request for reconsideration, applicants supply a copy of their receipt evidencing successful facsimile transmission on the date alleged, May 8, 2006. Applicants request refund of the two-month extension of time fee.

With respect to the merits of the request for reconsideration, 37 CFR 1.8(b) provides 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 U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is 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 Director 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's evidence has been reconsidered, and found persuasive that the response should be considered timely submitted pursuant to § 1.8(b).

However, it is noted that effective December 1, 2003, the Office required, with few exception, that all patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, then (703) 872-9306. See *Centralized Delivery and Facsimile Transmission Requirements for Patent Application Related Correspondence*, 1275 OG 200 (October 28, 2003). Effective July 15, 2005, the centralized facsimile number was changed to (571) 273-8300, with all facsimile transmissions sent to the old facsimile number being forwarded to the new number. See *New Patents Central FAX Number and Updated Lists of Exceptions to the Centralized Delivery and Facsimile Transmission Policy for Patent Related Correspondence*, 1296 OG 76 (July 12, 2005). Moreover, in the Office action mailed February 7, 2006, the examiner noted the centralized

facsimile number of 703-872-9306. However, applicants, according to their own evidence, faxed the response to an incorrect USPTO facsimile number, 571-273-0814.

In this instance, the response will be accepted as filed on May 8, 2006[1] and the two-month extension of time fee refunded to Deposit Account No. 50-0872, as authorized. However, any future failure to use the proper facsimile number may not result in withdrawal of the holding of abandonment. It is further noted that the Office is not precluded from considering the failure to use the proper facsimile number as a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application within the meaning of 37 CFR 1.704.

The petition under § 1.181 is **GRANTED**.

No fee is required on petition under § 1.181.

Technology Center AU 1743 has been advised of this decision. The application is, thereby, being forwarded to the examiner for further examination in due course.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

[1] This decision corrects the decision mailed July 24, 2006, to the extent that it makes clear that this application was never considered abandoned for failure to file a reply to the February 7, 2006 Office action.

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4417 LANCASTER PIKE
WILMINGTON, DE 19805

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OFFICE OF PETITIONS

In re Application of :
Jo-Ann T. Schwartz et al :
Application No. 09/613,698 : ON PETITION
Filed: July 11, 2000 :
Attorney Docket No. CH2746USNA :

This is a decision on the petition under 37 CFR 1.137(b), filed June 4, 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 August 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 November 16, 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 1700 for further processing.

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

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Paper No. 7

Hewlett-Packard Company
Intellectual Property Administration
PO Box 272400
Fort Collins CO 80528-9599

MAIL

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Rogelio Robles
Application No. 09/613,700
Filed: July 11, 2000
For: **DISTRIBUTED PRINTING SYSTEM AND METHOD**

DECISION
ON PETITION

This is a decision on the Petition to Withdraw the Holding of Abandonment filed on October 21, 2004 which is treated as a pursuant to MPEP §711.03 and 37 C.F.R. §1.181. No fee is required.

*The petition is **granted**.*

This application became abandoned for failure to timely file a response to the non-final Office action mailed January 20, 2004, which set a shortened statutory period of three months to reply. A Notice of Abandonment was mailed on October 6, 2004.

Petitioner alleges to have timely filed a proper response to the non-final Office action mailed January 20, 2004. In support, petitioner has provided as evidence, a copy of said response and a copy of a Certificate of Facsimile Transmission dated April 19, 2004. Also included with the response is a copy of an Auto-Reply Facsimile Transmission indicating that a 14-page document from Petitioner was received in the U.S. Patent and Trademark Office on April 19, 2004.

37 C.F.R. § 1.8 Certificate of mailing or transmission states in part:
(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated. [emphasis added]

Petitioner is the one who executed the certificate of transmission. Furthermore, the Auto-Reply Facsimile Transmission report is evidence that the documents were in fact transmitted to the

Office. Accordingly, it is deemed that the original response was received on April 19, 2004 and subsequently misplaced.

Given that Petitioner has successfully demonstrated the receipt of the response within the U.S. Patent and Trademark Office on April 19, 2004, the Notice of Abandonment is vacated and the holding of abandonment withdrawn.

The application file is being forwarded to the technical support staff for entry of the copy of the original response which accompanied the subject petition. Thereafter, the application will be forwarded to the Examiner for appropriate action in due course.

Dwayne D. Bost
Special Program Examiner
Technology Center 2600
Communications

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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

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OFFICE OF PETITIONS

In re Application of :
Masayoshi Okura et al :
Application No. 09/613,742 : DECISION GRANTING PETITION
Filed: July 11, 2000 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 046601-5053 :

This is a decision on the petition, filed June 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 June 9, 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 2872 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
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).*

# 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) |
|---|---|---|---|---|
| 6451096 | 2002-09-17 | 09613796 | 2000-07-11 | 2338-1 |

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

| | Fee | Code |
|---|---|---|
| ◉ | 3 ½ year | (1551) |
| ○ | 7 ½ year | (1552) |
| ○ | 11 ½ year | (1553) |

Small Entity

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (2552) |
| ○ | 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 | /Andrew W. Chu/ | Date (YYYY-MM-DD) | 2008-09-05 |
| Name | Andrew W. Chu | Registration Number | 46625 |

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. 6451096
Issue Date: September 17,2002
Application No. 09613796
Filed: July 11,2000
Attorney Docket No. 1191-41

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

This is a decision on the electronic petition, filed September 5,2008 ,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 September 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.

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. 14

Kolisch Hartwell Dickinson
Mc Cormack & Heuser
200 Pacific Building
520 S. W. Yamhill Street
Portland, OR 97204

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SEP 1 2 2003

OFFICE OF PETITIONS

In re Application of :
Robert G. Wendt et al. :
Application No. 09/613,951 : ON PETITION
Filed: July 11, 2000 :
Attorney Docket No. TPG 306 :

This is a decision on the petition under 37 CFR 1.137(b), filed September 2, 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 in reply to the final Office action mailed November 8, 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 February 9, 2003.

**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.**

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 3742.

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

KOLISCH HARTWELL DICKINSON
MCCORMACK & HEUSER
520 S.W. YAMHILL STREET, SUITE 200
PORTLAND, OR 97204

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APR 13 2005

OFFICE OF PETITIONS

In re Application of
Robert G. Wendt et al
Application No. 09/613,951
Filed: July 11, 2000
Attorney Docket No. TGP 306

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 4, 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 September 21, 2004, 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 December 22, 2004.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being forwarded to Technology Center AU 3742 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
www.uspto.gov

In re Patent No. 6363688
Issue Date: April 2,2002
Application No. 09613955
Filed: July 11,2000
Attorney Docket No. 8403.226

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

This is a decision on the electronic petition, filed April 8,2010 ,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 8,2010 . 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) |
|---|---|---|---|---|
| 6363688 | 2002-04-02 | 09613955 | 2000-07-11 | 8403.226 |

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

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (1551) |
| ◉ | 7 ½ year | (1552) |
| ○ | 11 ½ year | (1553) |

Small Entity

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (2552) |
| ○ | 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 | /klhester/ | Date (YYYY-MM-DD) | 2010-04-09 |
| 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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MERCHANT & GOULD PC
3200 IDS CENTER
80 SOUTH EIGHTH STREET
MINNEAPOLIS, MN 55402-2215

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OFFICE OF PETITIONS

In re Application of :
A. Bart Flick :
Application No. 09/613,961 : DECISION GRANTING PETITION
Filed: July 11, 2000 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 60200.0022US11 :

This is a decision on the petition, filed February 23, 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 18, 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 3743 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
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 Part B – Fee(s) Transmittal Form (along with any balance due at the time of submission), which includes the following language thereon: "The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee in 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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JUN 10 2003

Paper No. 10

In re Application of
Dillis V. Allen
Application No. 09/614,107
Filed: July 12, 2000
Attorney Docket No. G-33

: DECISION ON PETITION

This is a decision on the petition filed on May 27, 2003 (37 CFR 1.8(a) certificate of mailing dated May 19, 2003) by which petitioner requests withdrawal of the finality of the Office letter dated February 19, 2003 so that the concurrently filed amendment will be entered as a matter of right under 37 CFR 1.111. No fee is required for the petition, and a refund of the $130.00 petition fee will be made in due course.

The petition is dismissed as haven been untimely filed.

37 CFR 1.181(f) reads:

"§ 1.181 Petition to the Commissioner.

...

(f) 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."

It appears that the instant petition was filed more than two months subsequent to the date of the final Office action. The petition is, therefore, untimely filed.

This application is being forwarded to the examiner for consideration of the concurrently filed amendment. After an appropriate action is rendered on the amendment, the application will be forwarded to the Head Supervisory Applications Examiner to schedule a refund of the $130.00 petition fee.

PETITION DISMISSED.

John E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Dillis V. allen
Attorney at Law
Suite 205
1080 Nerge Road
Elk Grove Village, IL 60007

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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JUL 14 2004

Paper No. 21

In re Application of
Dillis V. Allen
Application No. 09/614,107
Filed: July 12, 2000
Attorney Docket No. G-33

: DECISION ON PETITION

This is a decision on the petition filed by facsimile transmission on June 29, 2004 by which petitioner requests withdrawal of the examiner's holding that this application stands abandoned for failure to file a timely and proper reply to the Office letter dated October 10, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioner alleges that the application is not abandoned because a reply to the Office letter in question was actually filed on November 20, 2003. Petitioner has supported this allegation by furnishing a copy of the reply and a copy of a post card filing receipt for the reply that shows that the reply was in fact received in the Office on November 20, 2003. In addition, the reply has affixed thereto a 37 CFR 1.8(a) certificate of mailing dated November 10, 2003, a date within the period for filing a reply to the Office letter in question. Based upon this evidence, it is clear that this application is not abandoned. In particular, see 37 CFR 1.8(b).

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 entry of the reply filed on November 20, 2003, certificate of mailing date November 10, 2003. Thereafter, the application will be forwarded to the examiner for action on the reply.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Dillis V. Allen, Esq.
105 S. Roselle Road
Suite 101
Schaumburg, IL 60193

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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Ernest I. Gifford
Gifford, Krass, Groh, Sprinkle,
Anderson & Citkowski, P.C.
280 North Old Woodward, Suite 400
Birmingham, MI 48009

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OFFICE OF PETITIONS

In re Application of

Stevanovski and Cantrell

Application No. 09/614,109

Filed: July 12, 2000

Attorney Docket No. TIC-10402/08

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 9, 2005, 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 final Office action mailed April 7, 2004, which set a shortened statutory period for reply of three (3) months. A response was filed on August 31, 2004, along with a request for an extension of time within the second month. An Advisory Action mailed October 25, 2004, advised that the response of August 31, 2004, failed to place the application in condition for allowance. No further proper responses were received within the allowable period and the application became abandoned on October 2, 2004.

The Request for Continued Examination filed March 9, 2005, is noted and made of record.

The application is being forwarded to Technology Center 3600, GAU 3624 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
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Alexandria, VA 22313-1450
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GIFFORD, KRASS, GROH, SPRINKLE & CITKOWSKI, P.C
PO BOX 7021
TROY, MI 48007-7021

In re Application of :
Stevanovski, et al. :
Application No. 09/614,109 : DECISION ON PETITION
Filed: July 12, 2000 :
Attorney Docket No. TIC-10402/08 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 20, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to file a timely and proper reply to the final Office action mailed February 28, 2006, which set a three (3) month shortened statutory period for reply. A response was filed on July 21, 2006. On August 28, 2006, an Advisory Action was issued informing petitioner that the response of July 21, 2006, failed to place the application in condition for allowance. No further responses were received within the allowable period, and the application became abandoned on July 29, 2006. A Notice of Abandonment was mailed only October 19, 2006.

**The Notice of Appeal, filed October 20, 2006, has been entered and made of record. Accordingly, 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 application file is being forwarded to Technology Center 3600, GAU 3693 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

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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GIFFORD, KRASS, SPRINKLE,ANDERSON & CITKOWSKI, P.C
PO BOX 7021
TROY, MI 48007-7021

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : David Stevanovski | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7653597 | : RECALCULATION of PATENT |
| **Issue Date** | : 01/26/2010 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/614,109 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/12/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **1798** 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

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 30

JOSEPH A. WALKOWSKI
TRASK BRITT
P.O. BOX 2550
SALT LAKE CITY UT 84110

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JAN 12 2004
OFFICE OF PETITIONS

In re Application of
Pai-Hung Pan et al
Application No. 09/614,113
Filed: July 12, 2000
Attorney Docket No. 2915.3US(96-0149.2)

ON PETITION

This is a decision on the petition, filed January 9, 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 October 9, 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 1765 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).

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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. 31

Date : January 12, 2004

TO : Director, Office of Publication and Dissemination

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Pai-Hung Pan et al
Application No. : 09/614,113
Filed : July 12, 2000

The above-identified application has been assigned Patent No. 6,677,241 and an issue date of January 13, 2004.

It is hereby directed that this application be withdrawn from issue at the request of the January 13, 2004.

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of January 13, 2004:

> "All reference to Patent No. 6,677,241 to Pai-Hung Pan et al of Idaho for METHODS OF FORMING A GATE STACK THAT IS VOID OF SILICON CLUSTERS WITHIN A METALLIC SILICIDE FILM THEREOF appearing in the Official Gazette of January 13, 2004 should be deleted since no patent was granted."

Karen Creasy

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

cc: Geraldine Dozier, Crystal Park 3-441 (FAX-306-2737)
Deneise Boyd, Crystal Park 2, Suite 1100 (FAX-308-5413)
Mary Louise McAskill, Crystal Park 3-910 (FAX 305-4372)
Niomi Farmer, Crystal Park 3-910 (FAX-305-4372)
Mary E. Johnson (Cookie), P/OCS, CM1-6D07
Duane Davis, P/OCS, CM1-6A07
Tamara Greene, Crystal Park 3-908

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Paper No. 7

BROWN RUDNICK BERLACK & ISRAELS
BOX IP, 18TH FLOOR
ONE FINANCIAL CENTER
BOSTON, MA 02111

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AUG 0 1 2003

OFFICE OF PETITIONS

In re Application of :
Dan A. Steinberg et al :
Application No. 09/614,155 : ON PETITION
Filed: July 11, 2000 :
Attorney Docket No. ACT-121 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 28, 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 January 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 April 29, 2003.

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.

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 2839.

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

cc: J GRANT HOUSTON
HOUSTON ELISEEVA
4 MILITIA DRIVE, STE 4
LEXINGTON, MA 02421

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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ALEXANDRIA, VA 22313-1450
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Paper No. 19

IBM CORPORATION
T.J. WATSON RESEARCH CENTER
P.O. BOX 218
YORKTOWN HEIGHTS, NY 10598

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APR 28 2005

OFFICE OF PETITIONS

In re Application of :
Fritz Gfeller, et al. :
Application No. 09/614,231 : ON PETITION
Filed: July 12, 2000 :
Attorney Docket No. SZ998-038 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 27, 2004, to revive the above-identified application.

This application became abandoned for failure to timely reply to a Notice Regarding Drawings mailed August 4, 2003. A Notice of Abandonment was mailed on November 21, 2003.

The application is revived for consideration of a submission under 37 CFR 1.114 (request for continued examination).

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3204.

The application file is being referred to Technology Center AU 2133 for further processing of the request for continued examination under 37 CFR 1.114 filed December 27, 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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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 3

JAMES HAO
WAGNER, MURABITO & HAO
TWO NORTH MARKET STREET
THIRD FLOOR
SAN JOSE, CALIFORNIA 95113

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NOV 15 2000

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
Airey, Peercy, Drebin, Montrym, Dignam, :
Migdal : DECISION REFUSING STATUS
Application No. 09/614,363 : UNDER 37 CFR 1.47(b)
Filed: July 12, 2000 :
For: Display System Having Floating :
Point Rasterization and Floating Point
Framebuffering

This is in response to the petition under 37 CFR 1.47(b), filed July 12, 2000.

The fee required for a petition under 37 CFR 1.47 is missing (37 CFR 1.17(i)) and a general authorization to charge a deposit account has not been filed. Although the petition indicates that a check for the petition fee was enclosed, Office records indicate that no fee was ever received. Petitioner was contacted to obtain an authorization to charge the fee or to verify that indeed a check had been submitted and cashed. No response was received from petitioner.

Therefore, this petition is dismissed.

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

Telephone inquiries related to this decision should be directed to Petitions Attorney Elenore Niu at 703-305-0272.

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
www.uspto.gov

Paper No. 6

Wagner Murabito & Hao
Third Floor
Two North Market Street
San Jose, CA 95113

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SEP 2 1 2001

OFFICE OF PETITIONS

In re Application of
John M. Airey et al.
Application No. 09/614,363
Filed: July 12, 2000
For: Display System having Floating Point Rasterization and Floating Point Framebuffering

: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)

This is in response to the petition filed April 2, 2001, pursuant to the provisions of rule 37 CFR 1.47(b), which is being treated pursuant to the provisions of 37 CFR 1.47(a).[1]

The petition is dismissed.

Rule 47 applicant is given TWO (2) 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 1.47(a)," and should only address the deficiencies noted below. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor.

The petition lacks item (1) set forth above.

---

[1]The petition under 37 CFR 1.47 was filed on April 2, 2001 more than two months past the January 15, 2001 due date for submitting a reply to the decision mailed November 15, 2000. Therefore, in view of the authorization to charge any additional fees required, the amount of $890 for a three month extension of time will be charged to petitioner's deposit account.

As to item (1), Rule 47 applicant has failed to establish that the nonsigning inventors refuse to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings), such that the declaration can be accepted under 37 CFR 1.47. In this regard, the statement of facts indicates that the declaration and assignment forms were mailed to the nonsigning inventors; however, no evidence has been presented to show that the complete application papers were presented to the nonsigning inventors. Unless the nonsigning inventors were presented with a complete copy of the application papers (specification, claims, and drawings), they could not attest that they have "reviewed and understand the application papers" and therefore could not sign the declaration which they were given. Accordingly, petitioner failed to show or provide proof that the inventors have refused to sign the declaration. See M.P.E.P. 409.03(d). Petitioner should show that a complete copy of the application papers was presented to the two non-signing inventors, but that they did not respond to the request that they sign the declaration in order to show that the inventors have refused to join in the application. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events.

If the inventors cannot be reached, petitioner should send a complete copy of the application papers to the last known addresses of the non-signing inventors with a request that they sign the declaration for the patent application. A forwarding address should be requested, if the papers are returned, and other attempts to locate the inventors, through the Internet, e-mail or telephone) continue to fail, then petitioner will have established that the inventors cannot be reached.

Where there is an express or oral refusal, that fact, along with the time and place of the refusal, must be stated in an affidavit or declaration by the party to whom the refusal was made. Where there is a written refusal, a copy of the documents(s) evidencing that refusal must be made part of the affidavit or declaration.

Petitioner should note that in view of the abandonment of application no. 09/098,041 on September 8, 1998, if petitioner desires to claim benefits under 35 U.S.C. 120 in application no. 09/614,363 and maintain copendency with prior application no. 09/098,041, petitioner would have to file a petition to revive application 09/098,041.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Latrice Bond.

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 FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Office of Petitions
Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries related to 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

Frances Hicks
Lead 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

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

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SEP 3 0 2002

OFFICE OF PETITIONS

In re Application of :
John M. Airey et al :
Application No. 09/614,363 : DECISION GRANTING
Filed: July 12, 2000 :STATUS UNDER 37 CFR 1.47(a)
Attorney Docket No: 15-4-632.51 :
:

This is a decision on the petition filed April 8, 2002, requesting reconsideration of a decision mailed September 21, 2001, which refused to accord 37 CFR 1.47(a) status to the above-identified application.

The petition is granted.

Petitioner has shown that the nonsigning inventors (John Montrym and Robert A. Drebin) have 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(c), this Office will forward notice of this application's filing to the nonsigning inventors at the addresses given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-8680.

This application is being forwarded to the Office of Initial Patent Examination to complete processing of the application.

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

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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SEP 3 0 2002

OFFICE OF PETITIONS

Robert A. Drebin
1100 Cedar Street
Palo Alto, CA 95051-0917

In re Application of: **John M. Airey; Mark S. Peercy; Robert A. Drebin; John Montrym; David L. Dignam; Christopher J. Migdal; and Danny D. Loh**
Application No. 09/614,363
Filed: July 12, 2000
For: DISPLAY SYSTEM HAVING FLOATING POINT RASTERIZATION AND FLOATING POINT FRAMEBUFFERING

Dear Mr. Drebin:

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 in 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) 305-8680. 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
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

Sterne Kessler Goldstein & Fox PLLC
1100 New York Avenue, N.W., Suite 600
Washington, DC 20005-3934

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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SEP 3 0 2002

OFFICE OF PETITIONS

John Montrym
1429 Miravalle Avenue
Los Altos, CA 94024

In re Application of: **John M. Airey; Mark S. Peercy; Robert A. Drebin; John Montrym; David L. Dignam; Christopher J. Migdal; and Danny D. Loh**
Application No. 09/614,363
Filed: July 12, 2000
For: DISPLAY SYSTEM HAVING FLOATING POINT RASTERIZATION AND FLOATING POINT FRAMEBUFFERING

Dear Mr. Montrym:

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 in 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) 305-8680. 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
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:

Sterne Kessler Goldstein & Fox PLLC
1100 New York Avenue, N.W., Suite 600
Washington, DC 20005-3934

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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FISH & NEAVE LLP
1251 AVENUE OF THE AMERICAS
50TH FLOOR
NEW YORK, NY 10020-1105

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**DEC 14 2004**

**OFFICE OF PETITIONS**

| | | |
|---|---|---|
| In re Patent No. 6,628,526 | : | |
| Issued: September 30, 2003 | : | |
| Application No. 09/614,374 | : | DECISION REGARDING PTA |
| Filed: July 21, 2000 | : | |
| Atty. Dkt. No.: TY-001 | : | |

This decision is in response to the "PETITION UNDER 35 U.S.C. § 154(b)(3)B)(ii) and 37 C.F.R. § 1.182," filed October 29, 2003. This request for reconsideration of patent term adjustment will be considered under 37 CFR 1.705(d)[1].

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **DISMISSED**.

Patentee requests that the Determination of Patent Term Adjustment be corrected from the 0 day determination indicated on the Letters Patent to a determination of 43 days.

The Office initially determined a PTA of 44 days[2]. The adjustment of 44 days was reduced an additional 112 days for applicants' failure to engage in reasonable efforts to conclude prosecution in accordance with 37 CFR 1.704(c)(10) for submission of formal drawings on June 11, 2003. The delay began June 11, 2003, the date of receipt of the drawings, and ended September 30, 2003, the date the patent issued.

Applicants, however, argue that the reduction for submission of the drawings is 1 day. Applicants' argue that the period of reduction began June 11, 2003, the date the drawings were received, and ended June 11, 2003, the date the Patent Application Information Retrieval ("PAIR") system indicated the drawings were "finished." Applicants argue that the designation of "finished" in the PAIR system is a "notice" within the meaning of 37 CFR 1.704(c)(10)(i).

Applicants' arguments have been considered and found unconvincing. The period of adjustment of the term of a patent under 37 CFR 1.703(a)

---

[1]Prior to May 24, 2004, the provisions of 37 C.F.R. § 1.705(d) were available after the issuance of a patent but were limited to situations wherein the patent issues on a date other than the projected date of issue and this change necessitates a revision in the patent term indicated on the Notice of Allowance. The Office, however, construed this provision to include grounds for contesting any PALM entry affecting PTA which occurs after the mailing of the Notice of Allowance until the issuance of the patent regardless of whether the patent issues on a date other than the projected date of issue.

[2] An adjustment of 138 days for Office delays was reduced 94 days at the time of mailing of Notice of Allowance.

through (e) shall be reduced by a period equal to the period of time during which the applicant failed to engage in reasonable efforts to conclude prosecution (processing or examination) of the application. *See*, 37 C.F.R. § 1.704(a). Submission of a paper, including formal drawings, after the Notice of Allowance has been mailed constitutes a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application. *See*, 37 C.F.R. § 1.704(c)(10) and 1247 Off. Gaz. Pat. Off. 111 (June 26, 2001). In accordance with 37 CFR 1.704(c)(10), "[s]ubmission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of: (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or (ii) Four months."

Thus, in accordance with 37 CFR 1.704(c)(10)(i), the period of adjustment is reduced 112 days for submission of the formal drawings. The period of adjustment began June 11, 2003, the date the drawings were filed, and ended September 30, 2003, the date patent issued. The mailing of the letters patent on June 11, 2003 is "notice" within the meaning of 37 CFR 1.704(c)(10)(i).

Applicant has submitted $130.00 in connection with this matter. The fee required for an application for patent term adjustment under 37 CFR 1.705(d) is $200.00. Thus, $70.00 has been charged to Deposit Account No. 06-1075 as authorized in the instant application.

Applicant is given one (1) month to request reconsideration of this decision. The period of time for reconsideration is not extendible under 73 CFR 1.136(a) or 37 CFR 1.136(b).

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3202.

Kery A. Fries
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of 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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TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

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DEC 27 2004

OFFICE OF PETITIONS

In re Application of :
Ned S. Rasor, et. al. :
Application No. 09/614,389 : ON PETITION
Filed: July 12, 2000 :
Attorney Docket No. 020017-000110US :

This is a decision on the petition under 37 CFR 1.137(b), filed November 4, 2004, to revive the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113, to the final Office action mailed April 6, 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 above-identified application became abandoned after midnight July 6, 2004.

In response, petitioner submitted with the instant petition an authorization to charge $685 for the petition to revive fee, $395 for the filing of a Request for Continued Examination (RCE), and an amendment as the submission required under 37 CFR 1.114.

Petitioner should note that the above fees were charged, as authorized, to the Deposit Account listed in the instant petition.

Since the requirements for a grantable petition have been met, the petition is **GRANTED**.

The application file is being forwarded to Technology Center Art Unit 3743, for processing the Request for Continued Examination under 37 CFR 1.114, and for further review of the amendment filed with the instant petition.

Telephone inquiries concerning this decision should be directed to Andrea Smith 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
www.uspto.go

Paper No. 11

SCHNECK & SCHNECK
P.O. BOX 2-E
SAN JOSE CA 95109-0005

COPY MAILED

MAY 2 7 2004

OFFICE OF PETITIONS

In re Application of :
Gary Ferrell :
Application No. 09/614,485 : DECISION ON PETITION
Filed: July 10, 2000 :
Title of Invention: METHOD AND :
DEVICE FOR MEASURING
CAVITATION

This is a decision on the petition under 37 CFR 1.137(b), filed May 10, 2004, to revive the above-identified application.

This above-identified application became abandoned for failure to timely file a reply to a non-final Office Action mailed April 10, 2001. The non-final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on July 11, 2001. A Notice of Abandonment was mailed on November 20, 2001.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

Petitioner submitted a request for a three (3) month extension of time with the instant petition. However, 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 USPQ2d 1630, 1631 (Comm'r Pats. 1988) Petitioner's six (6) month maximum extendable period expired on October 11, 2001. Petitioner is ineligible for any extensions of time. Thus, deposit account no. 19-0590 will be credited with the $950.00 submitted to obtain the three month extension of time.

This application is being forwarded to Technology Center 3600 for further processing.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant
Petitions Attorney
Office of Petitions

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

**Paper No.:** _____

**DATE** : July 7, 2006

**TO SPE OF** : ART UNIT 2151

**SUBJECT** : Request for Certificate of Correction for Appl. No.: 09/614489 Patent No.: 6,982,953 B1

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**.

*Elisha Evans*
**Certificates of Correction Branch**

**703-308-9390 ext. 110**

**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:** OK to enter.

Khanh Dinh
KHANH DINH
PRIMARY EXAMINER
TECHNOLOGY CENTER 2100

[signature]
**SPE**

2151
**Art Unit**

OIPE IAP80 JUN 26 2006 PATENT & TRADEMARK OFFICE

4 of 4

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Patent No.: 6,982,953 Issued: Jan. 3, 2006

OK to enter
K. DINH
12/20/06

Inventor: Swales, Andrew G.

Ser. Nr.: 09/614,489

Filing or 371 (c) Date: 07/11/2000 Atty Dkt No: LAN01-US

Title: AUTOMATIC DETERMINATION OF CORRECT IP ADDRESS FOR NETWORK-CONNECTED DEVICES

To: Commissioner for Patents
Attn: Certificate of Correction Branch
PO Box 1450
Alexandria, VA 22313-1450

Fr: 24222

Certificate
JUN 28 2006
of Correction

CERTIFICATE OF MAILING 37 CFR 1.8: I certify that this correspondence is being deposited on the below date with the U.S. Postal Service with sufficient postage as FIRST CLASS MAIL addressed to: Commissioner for Patents, Attn: Certificate of Correction Branch, PO Box 1450, Alexandria, VA 22313-1450.

Date: 6/21/06 [X] Dawn M. Case or [ ] Scott J. Asmus, Reg No 42,269

Commissioner:

REQUEST FOR CERTIFICATE OF CORRECTION
(35 U.S.C. 254)

1. The above patent contains errors, as indicated on the attached Certificate of Correction form (submitted in duplicate), which were not the fault of the Applicant. These errors arose through the fault of the Patent and Trademark Office, and are clearly disclosed by the records of the Office, therefore issuance of the Certificate of Correction, without charge, is respectfully requested. Attached please find a copy of the Information Disclosure Statement initialed by the examiner.

2. Transmitted herewith is: 1 page Certificate of Correction.

3. All required fees are intended to be included with this submission. However, the Office is hereby authorized to charge any deficiency or credit any overpayment in the fees to deposit account #500323.

Respectfully submitted,

Cus. No. 24222
Maine & Asmus
PO Box 3445
Nashua, NH 03061-3445
Tel. No. (603) 886-6100, Fax. No. (603) 886-4796
Patents@maineandasmus.com

Vernon C. Maine, Reg. No. 37,389
Scott J. Asmus, Reg. No. 42,269
Andrew P. Cernota, Reg. No. 52,711
Kristina M. Grasso, Reg. No. 39,205
Attorneys/Agents for Applicant

JUN 28 2006

PTO/SB/44 (04-04)
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. : 6,982,953

DATED : 01/03/2006

INVENTOR(S) : Swales, Andrew G.

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

Title page,
Item [56], References Cited

| | | | |
|---|---|---|---|
| Insert -- 5,410,730 | 4/1995 | Longsdorf et al. | .....709/203 -- |
| Insert -- 5,446,897 | 8/1995 | Mathaia et al. | .....709/206 -- |
| Insert -- 5,724,510 | 3/1998 | Arndt et al. | .....709/217 -- |
| Insert -- 5,838,907 | 11/1998 | Hansen | .....709/217 -- |
| Insert -- 5,917,808 | 6/1999 | Kosbab | .....370/254 -- |
| Insert -- 5,980,078 | 11/1999 | Krivoshein et al. | .....364/131 -- |
| Insert -- 5,987,524 | 11/1999 | Yoshida et al. | .....709/245 -- |
| Insert -- 6,021,429 | 2/2000 | Danknick | .....709/208 -- |

OTHER PUBLICATIONS
Insert -- POSTEL, J., "Internet Control Message", RFC0792, September 1981 --
Insert -- PLUMMER, D., "An Ethernet Address Resolution Protocol", RFC0826, November 1982 --
Insert -- FINLAYSON, R. et al., "A Reverse Address Resolution Protocol", RFC0903, June 1984 --
Insert -- CROFT, W. et al., "Bootstrap Protocol", RFC951, September 1985 --
Insert -- CASE, J. et al., "A Simple Network Management Protocol", RFC1157, May 1990 --
Insert -- DECKER, E. et al., "Definitions of Managed Objects for Bridges", RFC1493, July 1993 --
Insert -- DROMS, R. et al., "Dynamic Host Configuration Protocol", RFC2131, March 1997 --
Insert -- ALEXANDER, S., "DHCP Options and BOOTP Vendor Extensions", RFC2132, March 1997 --

MAILING ADDRESS OF SENDER:

Maine & Asmus
PO Box 3445
Nashua, NH 03061-3445

PATENT NO. 6,982,953

No. of additional copies

⇨ 1

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.*

JUN 28 2006

PTO/SB/44 (04-04)
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. : 6,982,953

DATED : 01/03/2006

INVENTOR(S) : Swales, Andrew G.

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

Title page,
Item [56], References Cited
Insert -- 5,410,730 4/1995 Longsdorf et al. .....709/203 --
Insert -- 5,446,897 8/1995 Mathaia et al. .....709/206 --
Insert -- 5,724,510 3/1998 Arndt et al. .....709/217 --
Insert -- 5,838,907 11/1998 Hansen.....709/217 --
Insert -- 5,917,808 6/1999 Kosbab.....370/254 --
Insert -- 5,980,078 11/1999 Krivoshein et al. .....364/131 --
Insert -- 5,987,524 11/1999 Yoshida et al. .....709/245 --
Insert -- 6,021,429 2/2000 Danknick .....709/208 --

OTHER PUBLICATIONS
Insert -- POSTEL, J., "Internet Control Message", RFC0792, September 1981 --
Insert -- PLUMMER, D., "An Ethernet Address Resolution Protocol", RFC0826, November 1982 --
Insert -- FINLAYSON, R. et al., "A Reverse Address Resolution Protocol", RFC0903, June 1984 --
Insert -- CROFT, W. et al., "Bootstrap Protocol", RFC951, September 1985 --
Insert -- CASE, J. et al., "A Simple Network Management Protocol", RFC1157, May 1990 --
Insert -- DECKER, E. et al., "Definitions of Managed Objects for Bridges", RFC1493, July 1993 --
Insert -- DROMS, R. et al., "Dynamic Host Configuration Protocol", RFC2131, March 1997 --
Insert -- ALEXANDER, S., "DHCP Options and BOOTP Vendor Extensions", RFC2132, March 1997 --

MAILING ADDRESS OF SENDER:

Maine & Asmus
PO Box 3445
Nashua, NH 03061-3445

PATENT NO. 6,982,953

No. of additional copies

⇨ 1

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.*

JUN 28 2006

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

ANTONELLI TERRY STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON VA 22209

COPY MAILED

MAR 12 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
Kato et al :
Application No. 09/614,764 : ON PETITION
Filed: July 12, 2000 :
Attorney Docket No. 503.30414V18 :

This is a decision on the petition, filed March 9, 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).

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

The application is being forwarded to Technology Center 3700 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

ANTONELLI, TERRY, STOUT AND KRAUS
SUITE 1800
1300 NORTH SEVENTEENTH STREET
ARLINGTON, VA 22209

COPY MAILED

APR 0 3 2001

OFFICE OF PETITIONS
A/C PATENTS

ON PETITION

In re Application of
Shigekazu Kato, et al
Application No. 09/614,770
Filed: July 12, 2000
Attorney Docket No. 503.30414V17

This is a decision on the petition under 37 CFR 1.313(c)(2), filed March 16, 2001, 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 16, 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) 305-9220.

The application is being forwarded to Technology Center 3700 for 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

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. 7

CHERNOFF VILHAUER MCCLUNG & STENZEL
1600 ODS TOWER
601 SW SECOND AVENUE
PORTLAND, OR 97204

COPY MAILED

MAY 0 6 2004

OFFICE OF PETITIONS

In re Application of :
Srinivas Kandala, et al. :
Application No. 09/614,784 : ON PETITION
Filed: July 12, 2000 :
Attorney Docket No. TAL 7146.075 :

This is a decision on the petition, filed April 26, 2004, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for a failure to reply in a timely manner to the non-final Office action mailed October 6, 2003, which set a shortened statutory period for reply of three (3) months. On April 26, 2004, an amendment, a petition for extension of time and the present petition were filed.

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 $950 extension of time fee submitted with the petition is unnecessary and will be refunded to petitioner's deposit account as authorized.

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 AU 2634 for consideration of the amendment filed April 26, 2004.

Sherry D. Brinkley
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

WILLIAM R. EVANS
C/O LADAS & PARRY, LLP
26 WEST 61ST STREET
NEW YORK, N.Y. 10023

**COPY MAILED**

SEP 2 2 2005

**OFFICE OF PETITIONS**

In re Patent No. 6,908,270 :
Issue Date: June 21, 2005 :
Application No. 09/614,849 : NOTICE
Filed: July 12, 2000 :
Attorney Docket No. U 012852-3

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

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

Paper No. 7

LUMEN INTELLECTUAL PROPERTY SERVICES, INC.
2345 YALE STREET, 2ND FLOOR
PALO ALTO CA 94306

MAIL

FEB 2 6 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Witold KULA :
Application No. 09/614,945 :DECISION ON PETITION TO
Filed: July 12, 2000 :WITHDRAW HOLDING OF
For: **SPIN VALVE MAGNETIC PROPERTIES WITH OXYGEN-RICH NIO UNDERLAYER** :ABANDONMENT
:

This is a decision on the petition filed October 17, 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.

This application became abandoned for failure to timely respond to the non-Final Office action mailed March 18, 2002. A Notice of Abandonment was mailed on November 18, 2002.

Petitioner alleges that neither the non-Final Office action mailed March 18, 2002, nor the Notice of Abandonment mailed November 18, 2002, were 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 finds that the non-Final Office action was properly mailed to the practitioner of record at the correspondence address at the time of mailing. It also finds that the Notice of Abandonment was properly mailed to another correspondence address which was the

correct address of record at that time. Thus, there was no irregularity in mailing the non-Final Office action or the Notice of Abandonment on the part of the U.S. Patent and Trademark Office.

The allegation of non-receipt is supported by statements from the petitioner attesting that the Office Action was not received by Lumen Intellectual Property Services at either of the prior correspondence addresses of record, and that a search of the contents of the file jacket and docket records reveal no evidence of receipt. Copies of the docket records have also been included to corroborate petitioner's claim.

The showing offered complies with the requirements of a successful petition to withdraw the holding of abandonment due to non-receipt of the non-Final Office action as set forth above. Therefore, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Accordingly, the petition is **GRANTED.**

Applicant is reminded of their duty to timely notify the Office of any future changes in correspondence address.

Due to the time lapse from the previous Office action and this decision, the file is being forwarded to the examiner for updating the search and the Office action as appropriate. The time period for response will be set to run from the mailing date of the new action.

Mark Powell, 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. 16

FELICITY E. GROTH
WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE - 46TH FLOOR
PHILADELPHIA PA 19103

COPY MAILED

APR 0 7 2003

OFFICE OF PETITIONS

In re Application of :
Russell A. Brierley et al :
Application No. 09/614,947 : DECISION ON PETITION
Filed: July 12, 2000 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 02655-046005 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed January 29, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional applications.

The petition is **DISMISSED** as moot.

The instant application was filed on July 12, 2000. A petition under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. See MPEP Section 201.11 and 65 FR 57024 (Sept. 20, 2000). Therefore, the petition is dismissed as involving a moot issue.

In view of the above, the $1,300 fee submitted for the petition under 37 CFR 1.78(a)(3) is unnecessary and will be credited to Deposit Account No. 23-3050 as authorized.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

The application is being forwarded to Technology Center Art Unit 1647 for processing the amendment filed January 29, 2003.

Frances Hicks
Lead Petitions Examiner
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: _____ 2 Serial/Patent # 09/614947

| 3 Please refund the following fee(s): | | 4 PAPER NUMBER | 5 DATE FILED | 6 AMOUNT |
|---|---|---|---|---|
| | Filing | | | $ |
| | Amendment | | | $ |
| | Extension of Time | | | $ |
| | Notice of Appeal/Appeal | | | $ |
| | Petition | | 1-29-03 | $ 1300 |
| | Issue | | | $ |
| | Cert of Correction/Terminal Disc. | | | $ |
| | Maintenance | | | $ |
| | Assignment | | | $ |
| | Other | | | $ |

7 TOTAL AMOUNT OF REFUND $

8 TO BE REFUNDED BY:

| | |
|---|---|
| | Treasury Check |
| ✓ | Credit Deposit A/C #: |

9 2 3 -- 3 0 5 0

10 REASON:

| | |
|---|---|
| | Overpayment |
| | Duplicate Payment |
| | No Fee Due (Explanation): |

Petition dismissed as moot.

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Karen Creasy TITLE: Pets. Exmr.

SIGNATURE: Karen Creasy PHONE: 305-8859

OFFICE: OAC for Patents

**********

THIS SPACE RESERVED FOR FINANCE USE ONLY:

APPROVED: Alan Kelly DATE: 3/7/03

*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 f 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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 7

MAR 29 2002

John A. Artz
Artz & Artz
28333 Telegraph Road, Suite 250
Southfield, MI 48034

In re Application of:
George F. Kirkman
Application No. 09/615,019
Filed: July 13, 2000
Attorney Docket No. PD-990235

DECISION TO WITHDRAW
HOLDING
OF ABANDONMENT

This is a decision on the petition filed February 12, 2002, and supplemented on March 14, 2002, to withdraw the holding of abandonment in the above-identified application.

The petition is **granted**.

The application was held abandoned for failure to timely file a response to the Office action mailed on May 7, 2001. A Notice of Abandonment was mailed on December 13, 2001.

Petitioner asserts that a response was timely filed in the United States Patent and Trademark Office (PTO) via facsimile transmission on August 3, 2001. To support this assertion, petitioner has submitted a copy of a 5 page response bearing a certificate under 37 CFR 1.8(a) showing a date of transmission of August 3, 2001, a copy of a report from petitioner's facsimile machine which acknowledges satisfactory facsimile transmission of 5 pages to the PTO on August 3, 2001, and a statement which attests to the previous timely transmission of the response to the PTO.

A review of the application file record reveals that the above-identified response is not of record in the application file and cannot be located. However, 37 CFR § 1.8(b) provides for accepting a correspondence as being timely filed if it was mailed or transmitted in accordance with 37 CFR § 1.8(a), and is reproduced below:

> 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 is 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.

The petition, as supplemented, meets the conditions of 37 CFR 1.8(b) to establish the previous timely filing of the response. Accordingly, the petition is **granted.**

For the above stated reason, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. The application is restored to pending status.

The copy of the response submitted on March 14, 2002, is accepted since the response originally submitted was apparently lost.

The application file is being forwarded to the Technology Center 2800 support staff for entry of the response. From there, the application will be forwarded to the examiner for further examination.

Inquiries regarding this decision should be directed to Ed Glick at (703) 308-4858.

Edward J. Glick, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

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Paper No.

JOSEPH SWAN,
A PROFESSIONAL CORPORATION
1334 PARKVIEW AVENUE, SUITE 100
MANHATTAN BEACH CA 90266

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Phillips et al. | : | DECISION ON APPLICATION |
| Application No. 09/615,021 | : | FOR |
| Filed: July 13, 2000 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 35512-00033 | : | |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705," filed February 11, 2009. Applicants request that the initial determination under 35 USC 154(b) be increased from one thousand five hundred thirteen (1513) days to one thousand nine hundred fifty-six (1956) 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 Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one thousand five hundred seventy-five **(1575)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On February 2, 2009, 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 1513 days. On February 11, 2009, applicants timely[1] submitted an application for patent term adjustment (with required fee). Applicants request entry of a period of adjustment of 381 days for the Office taking until

[1] PALM records indicate that the Issue Fee payment was received on February 11, 2009.

June 5, 2007 to mail a Notification of Noncompliant Appeal Brief in response to the Appeal Brief filed January 20, 2006. In addition, applicants request reinstatement of 62 days of reduction for applicant delay in filing a supplemental Appeal Brief on September 5, 2007.

The record supports a conclusion that the patent issuing from this application is not subject to a terminal disclaimer.

Applicants' arguments have been considered, but not found persuasive. There was no Office delay, within the meaning of 35 U.S.C. 154(b)(1)(A)(ii), in taking action in response to the date on which an appeal was taken in this application.

35 U.S.C. 154(b)(1)(A) provides, in pertinent part, that:

> Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the Patent and Trademark Office to –
>
> ...
>
> (ii) respond to a reply under section 132, or to an appeal taken under section 134, within 4 months after the date on which the reply was filed or the appeal was taken;

37 CFR 1.702(a) provides, in pertinent part that subject to the provisions of 35 U.S.C. 154(b) and this subpart, 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:

> (2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken;

However, as provided in 37 CFR 1.703(a), this period is calculated as:

> (4) The number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 41.37 of this title was filed and ending on the date of mailing of any of an examiner's answer under § 41.39 of this title, an action

> under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

Furthermore, as stated in the Final Rule[2],

> Section 1.703(a)(4) also pertains to the provisions of 35 U.S.C. 154(b)(1)(A)(ii). Section 1.703(a)(4) specifies that the period is the number of days, if any, beginning on the day after the date that is four months after the date an appeal brief in compliance with 1.192 was filed and ending on the mailing date of any of an examiner's answer under 1.193, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first. As discussed below, the phrase "the date on which" an "appeal was taken" in 35 U.S.C. 154(b)(1)(A)(ii) means the date on which an appeal brief (and not a notice of appeal) was filed. The phrase "appeal brief in compliance with 1.192" requires that: (1) the appeal brief fee (1.17(c)) be paid (1.192(a)); and (2) the appeal brief complies with 1.192(c)(1) through (c)(9). (*See also* the Response to Comment 38).

Applicants are incorrect in calculating a period of adjustment for Office delay from the date of filing of a non-compliant Appeal Brief on January 20, 2006 to the mailing of a Notification of Non-compliant Appeal Brief on June 5, 2007. In this instance, the Appeal Brief filed January 24, 2006 (not January 20, 2006[3]) was non-compliant. An appeal brief in compliance with 1.192 was filed on July 5, 2007 and the Office took action in response on December 5, 2006 by mailing a notice of allowance. As this was within four months of the filing of the compliant appeal brief there was no Office delay within the meaning of the statute or the rules.

However, applicants are correct in noting that a period of reduction is not warranted for the filing of a supplemental

---

[2] See *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 56366 (September 18, 2000).

[3] "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. 37 CFR 1.703(f), See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

appeal brief on September 5, 2007. The period of reduction of 62 days is being removed.

In view thereof, the determination of patent term adjustment at the time of the mailing of the Notice of Allowance is 1,575 days ((504 + 25 + 1086 days of Office delay) - (5 + 4 + 4 + 27 days of applicant delay).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified of the revised patent term adjustment to be indicated on the patent in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for 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

| PTA Calculations for Application: 09/615021 | | | |
|---|---|---|---|
| Application Filing Date: | 07/13/2000 | PTO Delay (PTO): | 1615 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 102 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1575 |
| PTO Delay Adjustment: | 62 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 115 | 07/21/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | 62 | | |
| 106 | 02/02/2009 | MAIL NOTICE OF ALLOWANCE | | | |
| 105 | 01/30/2009 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 104 | 01/30/2009 | DOCUMENT VERIFICATION | | | |
| 103 | 01/30/2009 | ISSUE REVISION COMPLETED | | | |
| 102 | 01/24/2009 | NOTICE OF ALLOWABILITY | | | |
| 97 | 01/13/2009 | MAIL BPAI DECISION ON APPEAL - REVERSED | 1086 | | 53 |
| 96 | 01/13/2009 | BPAI DECISION - EXAMINER REVERSED | | | |
| 95 | 10/06/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 94 | 06/17/2008 | DOCKETING NOTICE MAILED TO APPELLANT | | | |
| 92 | 06/16/2008 | ASSIGNMENT OF APPEAL NUMBER | | | |
| 91 | 06/03/2008 | APPEAL AWAITING BPAI DOCKETING | | | |
| 90 | 02/14/2008 | MAIL REPLY BRIEF NOTED BY EXAMINER | | | |
| 89 | 02/13/2008 | REPLY BRIEF NOTED BY EXAMINER | | | |
| 88 | 02/11/2008 | MAIL REPLY BRIEF NOTED BY EXAMINER | | | |
| 87 | 02/11/2008 | MAIL REPLY BRIEF NOTED BY EXAMINER | | | |
| 86 | 02/11/2008 | REPLY BRIEF NOTED BY EXAMINER | | | |
| 85 | 02/08/2008 | DATE FORWARDED TO EXAMINER | | | |
| 84 | 02/04/2008 | REPLY BRIEF FILED | | | |
| 83 | 02/08/2008 | APPEAL READY FOR BPAI DOCKETING | | | |
| 82 | 02/05/2008 | REPLY BRIEF NOTED BY EXAMINER | | | |
| 81 | 12/28/2007 | MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT | | | |
| 80 | 12/26/2007 | MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT | | | |

| | | | | | |
|---|---|---|---|---|---|
| 79 | 12/18/2007 | RETURN OF UNDOCKETED APPEAL TO THE TC | | | |
| 78 | 12/18/2007 | EXAM. ANS. REVIEW COMPLETE | | | |
| 77 | 12/04/2007 | MAIL SUPPLEMENTAL EXAMINER'S ANSWER | | | |
| 76 | 12/02/2007 | 2ND OR SUBSEQUENT EXAMINER'S ANSWER TO APPEAL BRIEF | | | |
| 75 | 10/17/2007 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 74 | 10/04/2007 | DATE FORWARDED TO EXAMINER | | | |
| 73 | 09/05/2007 | SUPPLEMENTAL APPEAL BRIEF | | 62 | 67 |
| 72 | 09/21/2007 | EXAM. ANS. REVIEW COMPLETE | | | |
| 71 | 08/27/2007 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 70 | 03/08/2007 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 68 | 08/08/2007 | DATE FORWARDED TO EXAMINER | | | |
| 67 | 07/05/2007 | RESP. TO POST-EXAMINER ANS | | | |
| 66 | 02/20/2007 | MISCELLANEOUS INCOMING LETTER | | | |
| 65 | 06/05/2007 | MAIL POST-EXAMINER ANS. COM | | | |
| 64 | 05/26/2007 | POST-EXAMINER ANS. COM | | | |
| 62 | 05/15/2007 | ORDER RETURNING UNDOCKETED APPEAL TO THE EXAMINER | | | |
| 61 | 04/04/2007 | APPEAL AWAITING BPAI DOCKETING | | | |
| 60 | 10/11/2006 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 59 | 09/08/2006 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 58 | 09/08/2006 | CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA) | | | |
| 57 | 04/06/2006 | MAIL SUPPLEMENTAL EXAMINER'S ANSWER | | | |
| 56 | 04/03/2006 | 2ND OR SUBSEQUENT EXAMINER'S ANSWER TO APPEAL BRIEF | | | |
| 55 | 01/26/2006 | DATE FORWARDED TO EXAMINER | | | |
| 54 | 01/24/2006 | APPEAL BRIEF FILED | | | |
| 53 | 01/24/2006 | NOTICE OF APPEAL FILED | | | |
| 52 | 12/22/2005 | MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT | 25 | | 43 |
| 51 | 12/20/2005 | MISCELLANEOUS ACTION WITH SSP | | | |
| 50 | 10/18/2005 | ORDER RETURNING UNDOCKETED APPEAL TO THE EXAMINER | | | |
| 49 | 08/30/2005 | APPEAL AWAITING BPAI DOCKETING | | | |
| 48 | 08/25/2005 | MAIL REPLY BRIEF NOTED BY EXAMINER | | | |
| 47 | 08/22/2005 | REPLY BRIEF NOTED BY EXAMINER | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 45 | 08/01/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 44 | 08/01/2005 | DATE FORWARDED TO EXAMINER | | | |
| 43 | 07/27/2005 | REPLY BRIEF FILED | | | |
| 42 | 06/16/2005 | MAIL EXAMINER'S ANSWER | | | |
| 41 | 06/13/2005 | EXAMINER'S ANSWER TO APPEAL BRIEF | | | |
| 40 | 05/18/2005 | DATE FORWARDED TO EXAMINER | | | |
| 39 | 05/16/2005 | APPEAL BRIEF FILED | | | |
| 38 | 03/15/2005 | NOTICE OF APPEAL FILED | | 27 | 30 |
| 37 | 03/15/2005 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 36 | 02/28/2005 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 35 | 02/15/2005 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 34 | 02/11/2005 | ADVISORY ACTION (PTOL-303) | | | |
| 33 | 02/02/2005 | DATE FORWARDED TO EXAMINER | | | |
| 32 | 01/25/2005 | AMENDMENT AFTER FINAL REJECTION | | | |
| 31 | 01/25/2005 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 30 | 11/16/2004 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 29 | 11/14/2004 | FINAL REJECTION | | | |
| 28 | 09/07/2004 | DATE FORWARDED TO EXAMINER | | | |
| 27 | 08/10/2004 | RESPONSE AFTER NON-FINAL ACTION | | 4 | 25 |
| 26 | 08/10/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 25 | 05/06/2004 | MAIL NON-FINAL REJECTION | | | |
| 24 | 05/03/2004 | NON-FINAL REJECTION | | | |
| 23 | 02/26/2004 | DATE FORWARDED TO EXAMINER | | | |
| 22 | 02/19/2004 | APPEAL BRIEF FILED | | | |
| 21 | 12/22/2003 | NOTICE OF APPEAL FILED | | | |
| 20 | 10/09/2003 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 19 | 10/06/2003 | FINAL REJECTION | | | |
| 18 | 09/05/2003 | DATE FORWARDED TO EXAMINER | | | |
| 17 | 08/26/2003 | RESPONSE AFTER NON-FINAL ACTION | | 4 | 16 |
| 16 | 05/22/2003 | MAIL NON-FINAL REJECTION | | | |
| 15 | 05/19/2003 | NON-FINAL REJECTION | | | |
| 14 | 05/13/2003 | DATE FORWARDED TO EXAMINER | | | |
| 13 | 05/05/2003 | RESPONSE AFTER NON-FINAL ACTION | | 5 | 12 |
| 12 | 01/30/2003 | MAIL NON-FINAL REJECTION | 504 | | -1 |
| 11 | 01/27/2003 | NON-FINAL REJECTION | | | |
| 10 | 07/03/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |

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|---|---|---|---|---|---|
| 9 | 04/23/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 8 | 04/23/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 7 | 11/13/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 6 | 06/08/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 5 | 11/18/2000 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 10/06/2000 | APPLICATION DISPATCHED FROM OIPE | | | |
| 3 | 08/30/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 2 | 08/09/2000 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 07/13/2000 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

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JOSEPH SWAN, A PROFESSIONAL CORPORATION
1334 PARKVIEW AVENUE, SUITE100
MANHATTAN BEACH, CA 90266

Mail Date: 04/21/2010

| | | |
|---|---|---|
| **Applicant** | : G. Michael Phillips | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7580876 | : RECALCULATION of PATENT |
| **Issue Date** | : 08/25/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/615,021 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/13/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **2398** 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.

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MITCHELL SILBERBERG & KNUPP LLP
11377 WEST OLYMPIC BLVD
LOS ANGELES CA 90064

| | | |
|---|---|---|
| In re Application | : | |
| Phillips, et al. | : | |
| Application No. 09/615,026 | : | DECISION ON PATENT TERM |
| Filed: July 13, 2000 | : | ADJUSTMENT |
| Attorney Docket No. 35512-35 | : | |

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT", filed February 16, 2006, requesting correction of the patent term adjustment (PTA) from two hundred sixty-one (261) days to three hundred forty-two (342) days.

The application for patent term adjustment is **GRANTED**.

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 **three hundred forty-two (342) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 14, 2005, 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 two hundred sixty-one (261) days. On February 16, 2006, Applicants timely[1] submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is three hundred forty-two (342) days.

Applicants assert entitlement to a patent term adjustment of three hundred forty-two (342) days on the basis that the PTO improperly assessed Applicants a delay of eighty-two (81) days for filing an Information Disclosure Statement on March 18, 2005, after Applicants had filed a response on December 27, 2004.

Applicants state that the patent issuing from the application is subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of two hundred sixty-one (261) days based on an adjustment for PTO delay of three hundred sixty-nine (369) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1) and three (3) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. 1.703(a)(2), reduced by Applicants' delays of ten (10), five (5), five (5), five (5) and five (5) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b) and eighty-one (81) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8). The adjustment of 81 days is at issue.

The application file is the official file of record. A review of the file fails to reveal an IDS filed on March 18, 2005. Accordingly, as no IDS was filed, applicant delay of eighty-one (81) days is unwarranted.

Accordingly, the correct determination of PTA at the time of mailing of the Notice of Allowance is **three hundred forty-two (342) days** (372 (369+3) days of PTO delay reduced by 30 (37+91) days of applicant delay).

Receipt of the $200 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

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[1] Applicants filed the application for patent term adjustment together with the filing of the issue fee.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery A Fries

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enc: updated PAIR screen

PALM INTRANET

Day : Sunday
Date: 4/9/2006
Time: 11:09:51

| PTA Calculations for Application: 09/615026 | | | |
|---|---|---|---|
| Application Filing Date: | 07/13/2000 | PTO Delay (PTO): | 372 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 111 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 342 |
| PTO Delay Adjustment: | 81 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
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| 70 | 04/09/2006 | ADJUSTMENT OF PTA CALCULATION BY PTO | 81 | | |
| 61 | 11/14/2005 | MAIL NOTICE OF ALLOWANCE | | | |
| 60 | 10/30/2005 | ISSUE REVISION COMPLETED | | | |
| 59 | 10/30/2005 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 58 | 10/30/2005 | NOTICE OF ALLOWABILITY | | | |
| 56 | 09/13/2005 | NOTICE OF APPEAL FILED | | | |
| 55 | 06/13/2005 | MAIL NON-FINAL REJECTION | | | |
| 54 | 06/09/2005 | NON-FINAL REJECTION | | | |
| 53 | 05/17/2005 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 52 | 05/13/2005 | ADVISORY ACTION (PTOL-303) | | | |
| 51 | 05/11/2005 | DATE FORWARDED TO EXAMINER | | | |
| 50 | 05/06/2005 | AMENDMENT AFTER FINAL REJECTION | | | |
| 49 | 04/11/2005 | REQUEST FOR REFUND | | | |
| 48 | 04/11/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 47 | 03/18/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | 81 | 42 |
| 46 | 04/10/2005 | FINAL REJECTION | | | |
| 45 | 04/10/2005 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 44 | 03/18/2003 | LETTER REQUESTING INTERVIEW WITH EXAMINER | | | |
| 43 | 03/22/2005 | DATE FORWARDED TO EXAMINER | | | |
| 42 | 12/27/2004 | RESPONSE AFTER NON-FINAL ACTION | | 5 | 39 |
| 41 | 02/28/2005 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 40 | 12/27/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 39 | 09/22/2004 | MAIL NON-FINAL REJECTION | | | |
| 38 | 09/19/2004 | NON-FINAL REJECTION | | | |

| | | | | | |
|---|---|---|---|---|---|
| 37 | 08/15/2004 | DATE FORWARDED TO EXAMINER | | | |
| 36 | 08/02/2004 | APPEAL BRIEF FILED | | | |
| 35 | 08/15/2004 | DATE FORWARDED TO EXAMINER | | | |
| 34 | 08/02/2004 | AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL | | | |
| 33 | 08/02/2004 | REQUEST FOR EXTENSION OF TIME - GRANTED | | | |
| 30 | 07/30/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 29 | 05/03/2004 | NOTICE OF APPEAL FILED | | 5 | 28 |
| 28 | 01/28/2004 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 27 | 01/26/2004 | FINAL REJECTION | | | |
| 26 | 12/30/2003 | DATE FORWARDED TO EXAMINER | | | |
| 25 | 12/16/2003 | RESPONSE AFTER NON-FINAL ACTION | | 5 | 24 |
| 24 | 09/11/2003 | MAIL NON-FINAL REJECTION | 3 | | 19 |
| 23 | 06/12/2003 | NON-FINAL REJECTION | | | |
| 22 | 05/13/2003 | DATE FORWARDED TO EXAMINER | | | |
| 21 | 05/08/2003 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 20 | 05/13/2003 | DATE FORWARDED TO EXAMINER | | | |
| 19 | 05/08/2003 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 5 | 14 |
| 18 | 05/13/2003 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 17 | 05/08/2003 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 16 | 03/31/2003 | MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413) | | | |
| 15 | 03/24/2003 | EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413) | | | |
| 14 | 02/03/2003 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 13 | 01/30/2003 | FINAL REJECTION | | | |
| 12 | 01/27/2003 | DATE FORWARDED TO EXAMINER | | | |
| 11 | 12/27/2002 | RESPONSE AFTER NON-FINAL ACTION | | 10 | 9 |
| 10 | 10/04/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 9 | 09/17/2002 | MAIL NON-FINAL REJECTION | 369 | | -1 |
| 8 | 09/09/2002 | NON-FINAL REJECTION | | | |
| 7 | 08/16/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 6 | 05/21/2002 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 5 | 12/01/2000 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 08/30/2000 | APPLICATION DISPATCHED FROM OIPE | | | |
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|---|---|---|---|---|---|
| 3 | 08/29/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 2 | 08/07/2000 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 07/13/2000 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

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OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| Bever et al. | : | |
| Application No. 09/615,163 | : | ON PETITION |
| Filed: 13 July, 2000 | : | |
| Attorney Docket No. 11927 P01 | : | |

This is a decision on the petition under 37 CFR 1.182, filed on 8 July, 2004, to change the order of the names of the inventors.

The petition is **granted**.

The Office is construing the copy of the declaration filed with the present petition as containing the desired order of inventor's names. Therefore, the order of the names of the inventors will be changed as follows:

1. Thomas G. Bever

2. John Robbart II

A corrected Filing Receipt is enclosed for petitioners' records.

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

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 308-6918.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: Corrected Filing Receipt

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**3M INNOVATIVE PROPERTIES COMPANY**
**PO BOX 33427**
**ST. PAUL MN 55133-3427**

**MAILED**

MAR 3 0 2010

**OFFICE OF PETITIONS**

In re Patent No. 6,383,804 :
Issue Date: May 7, 2002 :
Application No. 09/615,185 : NOTICE
Filed: July 13, 2000 :
Attorney Docket No. BIPR115639 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28 filed January 8, 2010. 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. The petition is **GRANTED**.

This application is no longer entitled to small entity status. Accordingly, all future fees paid in this application must be paid at the large entity rate.

This file is being forwarded to Files Repository.

Telephone inquiries related to this decision should be directed to the Kimberly Inabinet at (571) 272-4618.

Carl Friedman
Petitions Examiner
Office of Petitions

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In re Patent No. 6367619
Issue Date: April 9,2002
Application No. 09615236
Filed: July 13,2000
Attorney Docket No. 790063.90544

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

This is a decision on the electronic petition, filed July 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 July 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) |
|---|---|---|---|---|
| 6,367,619 | 2002-04-09 | 09/615,236 | 2000-07-13 | 790063.90544 |

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

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (1551) |
| ◉ | 7 ½ year | (1552) |
| ○ | 11 ½ year | (1553) |

Small Entity

| | Fee | Code |
|---|---|---|
| ○ | 3 ½ year | (2551) |
| ○ | 7 ½ year | (2552) |
| ○ | 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 G. Radler/ | Date (YYYY-MM-DD) | 2010-07-21 |
| Name | Daniel G. Radler | Registration Number | 43028 |

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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OFFICE OF PETITIONS

In re Application of :
Craig R. Shambaugh et al :
Application No. 09/615,266 : DECISION DISMISSING PETITION
Filed: July 13, 2000 : UNDER 37 CFR 1.1.313(b)
Attorney Docket No. OOECO19/77780 :

This is a decision on the "Petition under 37 C.F.R. 1.313(b)," filed December 10, 2004, requesting that the subject application be withdrawn from issue due to a mistake on the part of the Office.

The petition is **dismissed as inappropriate**.

Petitioner states that one of the inventors has been omitted from the list of inventors shown on the filing receipt.

Applicable Statutes and Regulations

The issuance and withdrawal from issue of patents are governed by statute and regulation.

35 USC § 131 states:

> The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

35 USC § 151 states in pertinent part:

> If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall

> specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter. Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

37 CFR 1.313(b) states:

> Once the issue fee has been paid, the Office will not withdraw the application from issue at its own initiative for any reason except:
> (1) A mistake on the part of the Office;
> (2) A violation of § 1.56 or illegality in the application;
> (3) Unpatentability of one or more claims; or
> (4) For interference.

## Opinion

37 CFR 1.313(b) applies to those situations where the Office, **at its own initiative**, may withdraw an application from issue, but only in those situations which meet the conditions of 37 CFR 1.313(b). See Sampson v. Dann, 466 F.Supp. 965, 973-74, 201 USPQ 15, 22 (D.D.C. 1978). Therefore, 37 CFR 1.313(b) is inapplicable here since the rule does not provide for withdrawal from issue at the request of, as here, the applicant. That is, the filing of a paper prompting or suggesting that the Office take action *at its own initiative* in an application, is a contradiction in terms.

As to petitioner's assertion that one of the inventors has been omitted from the list of inventors shown on the filing receipt was due to a mistake on the part of the Office, it is noted that the signature of Mr. Jared Bluestein is missing on the declaration submitted upon filing of the application on July 13, 2000. Because the signature on the declaration was missing, the Office inadvertently and improperly failed to recognize Mr. Bluestein as a joint inventor.

The Office should have mailed a Notice To File Missing Parts, since the declaration submitted July 13, 2000, is unexecuted. However, the above matter did not relieve applicant from submitting an executed declaration along with the surcharge fee of $130 for its late submission.

Petitioner has submitted a Request for Continued Examination (RCE) on December 10, 2004, however, no authorization was given to charge for the petition fee. Therefore, petitioner must submit the required petition fee of $130 along with the surcharge fee of $130 for the late submission of the declaration on January 30, 2006, and supplemented on February 1, 2006.

Applicant may wish to renew the instant petition as one filed under 37 CFR 1.313(c)(2).

If petitioner desires to withdraw this application from issue, the petition under 37 CFR 1.313(c) meeting one of the conditions thereunder must be promptly filed. Petitioner is reminded that 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. *Note* 37 CFR 1.313(d).

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 Window located at:

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) 272-3208.

Karen Creasy

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

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OFFICE OF PETITIONS

In re Application of :
Craig R. Shambaugh et al :
Application No. 09/615,266 : ON PETITION
Filed: July 13, 2000 :
Attorney Docket No. OOECO19/77780 :

This is a decision on the renewed petition, filed March 16, 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 October 22, 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 2626 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).

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OFFICE OF PETITIONS

In re Application :
Knowles, et al. :
Application No. 09/615,294 : PATENT TERM ADJUSTMENT
Filed: July 13, 2000 :
Dkt. No.: A-68944 :

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed June 26, 2008. This matter is being properly treated as an application for patent term adjustment pursuant to 37 CFR 1.705(b).

The application for patent term adjustment (PTA) under 37 CFR 1.705(b) is **GRANTED IN PART and HELD IN ABEYANCE IN PART**.

The Determination of Patent Term Adjustment under 35 U.S.C. 154(b), mailed June 11, 2008, indicated a patent term adjustment (PTA) to date of 179 days. The instant application for PTA was timely filed June 26, 2008, prior to issue fee payment. Applicants argue that the application is entitled to an adjustment of 1,601 days.

The correct adjustment at the time of allowance is 1,410 days, as discussed herein.

Applicants argue that the adjustment was improperly reduced 39 days in connection with the reply filed January 22, 2002. Applicants argue that a reply to the non-final Office action mailed September 14, 2001 was timely filed December 14, 2001. Applicants argue that the reply bears a certificate of mailing date of December 14, 2001.

Applicants argument has been carefully considered, but is not found convincing. In accordance with 37 CFR 1.703(f), the date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation. Accordingly, the reduction of 39 days will not be withdrawn.

As undisputed, the application is entitled to an adjustment of eight days in accordance with 37 CFR 1.702(a)(2) in connection with the mailing of the final Office action on May 30, 2002.

As undisputed by applicants, the adjustment is properly reduced four days in accordance with 37 CFR 1.704(b) in connection with the request for continued examination filed September 3, 2002.

Applicants argue that the adjustment was improperly reduced 454 days in connection with the reply to the non-final Office action mailed November 18, 2002.

A review of the record reveals that the reply to the non-final Office action mailed November 18, 2002 was received February 24, 2003.

In view thereof, the proper reduction in this regard under 37 CFR 1.704(b) is six days. The reduction commenced February 19, 2003, the day after the date that is three months after the date that the non-final Office action was mailed, and ended February 24, 2003, the date that the reply was filed.

Applicants further argue that the application is entitled to an adjustment of 346 days in connection with the mailing of an Office on May 28, 2004.

A review of the record does not reveal that an Office communication was mailed May 28, 2004. An Office action was mailed August 11, 2004. Thus, the application is entitled to an adjustment of 414 days in accordance with 37 CFR 1.702(a)(2). The adjustment commenced June 25, 2003, the day after the date that is four months after the date of reply dated February 24, 2003, and ended August 11, 2004, the date that the Office action was mailed. *See*, 37 CFR 1.703(a)(2).

A review of the record reveals that the Office errantly accorded an adjustment of 61 days in connection with the mailing of the examiner's answer on February 23, 2006. A compliant appeal brief was filed December 13, 2005. Therefore, the examiner's answer was timely mailed within the meaning of 37 CFR 1.703(a)(4). Thus, the adjustment of 61 days has been removed.

Applicants do not contest the reduction of 24 days under 37 CFR 1.704(b) in connection with the appeal brief filed December 5, 2006.

Applicants contest the adjustment of 631 days in connection with the Board decision mailed May 19, 2008. Applicants argue that the correct adjustment in this regard is 1,061 days.

A review of the record reveals that the Board decision mailed May 19, 2008 reversed the examiner. Thus, in accordance with 37 CFR 1.702(e), the application is entitled to an adjustment of 1,061 days, as argued. The adjustment commenced June 24, 2005, the date that Notice of Appeal was filed, and ended May19, 2008, the date that the Board decision reversing the examiner was mailed. *See*, 37 CFR 1.702(e).

In view thereof, at the time of allowance, the application was entitled to an adjustment of 1,410 days (adjustments totalling 1,483 days less reductions totalling 73 days).

The instant application for patent term adjustment also requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date of the application. A decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term for Office failure to issue the patent within three years. *See*, 37 CFR 1.703(b).

Applicants are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent

within three years. A copy of this decision should accompany the request. Applicants may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of 37 CFR 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

With respect to the over 3 year calculation, rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

Applicants are further advised that the patent term adjustment indicated in the patent will include any additional patent term accrued pursuant to §§ 1.702(a)(4) and 1.702(b).

The required patent term adjustment application fee of $200.00 has been charged to applicants' deposit account, as authorized. No additional fee will be required if applicants are solely requesting reconsideration of additional time related to failing to issue the patent within three years in accordance with 37 CFR 1.702(b).

The application file is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

/Kery A Fries/

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Day : Monday
Date: 3/23/2009

PALM INTRANET

Time: 16:11:37

| PTA Calculations for Application: 09/615294 | | | |
|---|---|---|---|
| Application Filing Date: | 07/13/2000 | PTO Delay (PTO): | 700 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 521 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1410 |
| PTO Delay Adjustment: | 1231 | | |

**File Contents History**

| Number | Date | Contents Description | PTO | APPL | START |
|---|---|---|---|---|---|
| 133 | 03/23/2009 | ADJUSTMENT OF PTA CALCULATION BY PTO | 1231 | | |
| 120 | 06/11/2008 | MAIL NOTICE OF ALLOWANCE | | | |
| 119 | 06/09/2008 | ISSUE REVISION COMPLETED | | | |
| 118 | 06/09/2008 | DOCUMENT VERIFICATION | | | |
| 117 | 06/09/2008 | NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED | | | |
| 116 | 06/09/2008 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 115 | 06/03/2008 | NOTICE OF ALLOWABILITY | | | |
| 110 | 05/19/2008 | MAIL BPAI DECISION ON APPEAL - REVERSED | 631 | | 82 |
| 109 | 05/19/2008 | BPAI DECISION - EXAMINER REVERSED | | | |
| 107 | 11/08/2007 | DOCKETING NOTICE MAILED TO APPELLANT | | | |
| 106 | 11/08/2007 | ASSIGNMENT OF APPEAL NUMBER | | | |
| 105 | 08/27/2007 | APPEAL AWAITING BPAI DOCKETING | | | |
| 104 | 08/15/2007 | MAIL REPLY BRIEF NOTED BY EXAMINER | | | |
| 103 | 08/13/2007 | REPLY BRIEF NOTED BY EXAMINER | | | |
| 102 | 06/19/2007 | DATE FORWARDED TO EXAMINER | | | |
| 101 | 05/15/2007 | REPLY BRIEF FILED | | | |
| 100 | 05/10/2007 | EXAM. ANS. REVIEW COMPLETE | | | |
| 99 | 03/15/2007 | MAIL SUPPLEMENTAL EXAMINER'S ANSWER | | | |
| 98 | 03/14/2007 | 2ND OR SUBSEQUENT EXAMINER'S ANSWER TO APPEAL BRIEF | | | |
| 97 | 01/10/2007 | APPEAL BRIEF REVIEW COMPLETE | | | |
| 96 | 01/10/2007 | DATE FORWARDED TO EXAMINER | | | |
| 95 | 12/05/2006 | APPEAL BRIEF FILED | | 24 | 78 |
| 85 | 11/28/2006 | NOTICE -- DEFECTIVE APPEAL BRIEF | | | |
| 84 | 09/12/2006 | DATE FORWARDED TO EXAMINER | | | |

| | | | | | |
|---|---|---|---|---|---|
| 83.1 | 08/28/2006 | DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED | | | |
| 83 | 08/28/2006 | APPEAL BRIEF FILED | | | |
| 82 | 08/28/2006 | NOTICE OF APPEAL FILED | | | |
| 78 | 08/11/2006 | MAIL POST-EXAMINER ANS. COM | | | |
| 77 | 08/09/2006 | POST-EXAMINER ANS. COM | | | |
| 67 | 07/26/2006 | ORDER RETURNING UNDOCKETED APPEAL TO THE EXAMINER | | | |
| 66 | 07/20/2006 | APPEAL AWAITING BPAI DOCKETING | | | |
| 65 | 07/17/2006 | MAIL REPLY BRIEF NOTED BY EXAMINER | | | |
| 64 | 07/10/2006 | REPLY BRIEF NOTED BY EXAMINER | | | |
| 63 | 04/28/2006 | DATE FORWARDED TO EXAMINER | | | |
| 62 | 04/24/2006 | REPLY BRIEF FILED | | | |
| 61 | 02/23/2006 | MAIL EXAMINER'S ANSWER | 61 | | 55 |
| 60 | 02/21/2006 | EXAMINER'S ANSWER TO APPEAL BRIEF | | | |
| 59 | 12/15/2005 | DATE FORWARDED TO EXAMINER | | | |
| 58 | 12/13/2005 | APPEAL BRIEF FILED | | | |
| 57 | 11/16/2005 | NOTICE -- DEFECTIVE APPEAL BRIEF | | | |
| 56 | 08/30/2005 | DATE FORWARDED TO EXAMINER | | | |
| 55.1 | 08/24/2005 | DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED | | | |
| 55 | 08/24/2005 | APPEAL BRIEF FILED | | | |
| 54 | 07/19/2005 | MAIL ADVISORY ACTION (PTOL - 303) | | | |
| 53 | 07/13/2005 | ADVISORY ACTION (PTOL-303) | | | |
| 52 | 07/07/2005 | DATE FORWARDED TO EXAMINER | | | |
| 51 | 06/24/2005 | AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL | | | |
| 50 | 06/24/2005 | NOTICE OF APPEAL FILED | | | |
| 49 | 07/05/2005 | DATE FORWARDED TO EXAMINER | | | |
| 48 | 06/24/2005 | AMENDMENT AFTER FINAL REJECTION | | | |
| 47 | 06/15/2005 | MAIL FINAL REJECTION (PTOL - 326) | | | |
| 46 | 06/13/2005 | FINAL REJECTION | | | |
| 45 | 04/05/2005 | DATE FORWARDED TO EXAMINER | | | |
| 44 | 03/17/2005 | RESPONSE AFTER NON-FINAL ACTION | | | |
| 43 | 01/18/2005 | REFERENCE CAPTURE ON IDS | | | |
| 42.7 | 01/18/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 42 | 01/18/2005 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |

| | | | | | |
|---|---|---|---|---|---|
| 41 | 12/17/2004 | MAIL NON-FINAL REJECTION | | | |
| 40 | 12/13/2004 | NON-FINAL REJECTION | | | |
| 39 | 09/23/2004 | DATE FORWARDED TO EXAMINER | | | |
| 38 | 08/17/2004 | RESPONSE AFTER EX PARTE QUAYLE ACTION | | | |
| 37 | 09/21/2004 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 36 | 08/17/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 35 | 08/11/2004 | MAIL EX PARTE QUAYLE ACTION (PTOL - 326) | | | |
| 34 | 08/09/2004 | EX PARTE QUAYLE ACTION | | | |
| 33 | 06/01/2004 | IFW TSS PROCESSING BY TECH CENTER COMPLETE | | | |
| 32 | 06/01/2004 | DATE FORWARDED TO EXAMINER | | | |
| 31 | 05/17/2004 | RESPONSE AFTER NON-FINAL ACTION | | 454 | 27 |
| 30 | 04/19/2004 | MISCELLANEOUS INCOMING LETTER | | | |
| 29 | 05/27/2004 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 28 | 05/17/2004 | WORKFLOW INCOMING AMENDMENT IFW | | | |
| 27 | 11/18/2002 | MAIL NON-FINAL REJECTION | | | |
| 26 | 11/18/2002 | NON-FINAL REJECTION | | | |
| 25 | 09/12/2002 | DATE FORWARDED TO EXAMINER | | | |
| 24 | 09/03/2002 | AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE | | | |
| 23 | 09/12/2002 | DATE FORWARDED TO EXAMINER | | | |
| 22 | 09/03/2002 | REQUEST FOR CONTINUED EXAMINATION (RCE) | | 4 | 19 |
| 21 | 09/12/2002 | DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA) | | | |
| 20 | 09/03/2002 | WORKFLOW - REQUEST FOR RCE - BEGIN | | | |
| 19 | 05/30/2002 | MAIL FINAL REJECTION (PTOL - 326) | 8 | | 16 |
| 18 | 05/28/2002 | FINAL REJECTION | | | |
| 17 | 03/06/2002 | DATE FORWARDED TO EXAMINER | | | |
| 16 | 01/22/2002 | RESPONSE AFTER NON-FINAL ACTION | | 39 | 14 |
| 15 | 11/06/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 14 | 09/14/2001 | MAIL NON-FINAL REJECTION | | | |
| 13 | 09/10/2001 | NON-FINAL REJECTION | | | |
| 12 | 06/04/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 11 | 07/19/2001 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 10 | 07/06/2001 | DATE FORWARDED TO EXAMINER | | | |
| 9 | 06/29/2001 | RESPONSE TO ELECTION / RESTRICTION FILED | | | |
| 8 | 06/05/2001 | MAIL RESTRICTION REQUIREMENT | | | |
| | | | | | |

| | | | | | |
|---|---|---|---|---|---|
| 7 | 06/04/2001 | REQUIREMENT FOR RESTRICTION / ELECTION | | | |
| 6.7 | 10/10/2000 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 6 | 10/10/2000 | INFORMATION DISCLOSURE STATEMENT (IDS) FILED | | | |
| 5 | 10/13/2000 | CASE DOCKETED TO EXAMINER IN GAU | | | |
| 4 | 10/04/2000 | APPLICATION DISPATCHED FROM OIPE | | | |
| 3 | 08/25/2000 | CORRESPONDENCE ADDRESS CHANGE | | | |
| 2 | 08/07/2000 | IFW SCAN & PACR AUTO SECURITY REVIEW | | | |
| 1 | 07/13/2000 | INITIAL EXAM TEAM NN | | | |

**Search Another: Application#** [ ] Search

**EXPLANATION OF PTA CALCULATION**

**EXPLANATION OF PTE CALCULATION**

To go back, right click here and select Back. To go forward, right click here and select Forward. To refresh, right click here and select Refresh.

Back to OASIS | Home page

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 8

COLLEN A. BEARD
BIOCURE, INC.
2975 GATEWAY DRIVE, SUITE 100
NORCROSS, GA 30017

COPY MAILED

FEB 8 2002

OFFICE OF PETITIONS

In re Application of :
Wolfgang Meier et al. :
Application No. 09/615,305 :
Filed: July 13, 2000 :
Attorney Docket No. :

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 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
Washington, D.C. 20231
www.uspto.gov

Paper No. 7

Neil F. Maloney
FENWICK & WEST LLP
Two Palo Alto Square
Palo Alto, CA 94306

**MAIL**

MAY 0 7 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Marc S. Casalaina
Application No. 09/615,383
Filed: July 13, 2000
For: DELTA CACHING

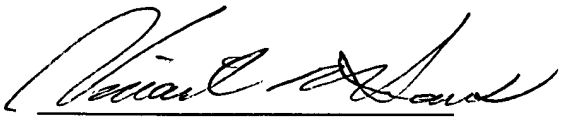
**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed February 26, 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 filed February 26, 2002 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.



Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software,
and Electronic Commerce
(703) 305-9750

cc: Randy Gard, Esq.
Carr & Ferrell LLP
2225 East Bayshore Road, Suite 200
Palo Alto, CA 94303

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

**DATE** : March 11, 2007

**TO SPE OF** : ART UNIT 2155

**SUBJECT** : Request for Certificate of Correction on Patent No.: **7058700 B1 – 09/615383**

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.

Elisha Evans

**Thank You For Your Assistance**

**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:**

Typographical error has been fixed on a certificate of correction.

_____

_____

_____

_____

_____ 2155

**SPE** **Art Unit**

PTO/SB/44 (04-05)

# UNITED STATES PATENT AND TRADEMARK OFFICE
# CERTIFICATE OF CORRECTION



PATENT NO. : 7,058,700 B1

APPLICATION NO.: 09/615,383

ISSUE DATE : June 6, 2006

INVENTOR(S) : Marc S. Casalaina

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:

In the References Cited Section, U.S. Patent Documents:

Please delete: 6,238,246 B1 Ferrill

Please add: ~~-6,226,442 Beranek-~~

--6,226,642 Beranek--

PBT 4/30/07

MAILING ADDRESS OF SENDER:
Naya M. Chatterjee-Marathe
Townsend and Townsend and Crew
Two Embarcadero Center, 8th Floor
San Francisco, CA 94111

PATENT NO. 7,058,700 B1

No. of additional copies: 0

60938694 v1

FEB 2 0 2007

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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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TOWNSEND AND TOWNSEND AND CREW LLP/ORACLE
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

MAILED

APR 08 2010

OFFICE OF PETITIONS

In re Patent No. 7,058,700 :
Issued: June 6, 2006 :
Application No. 09/615,383 : ON PETITION
Filed: July 13, 2000 :
Attorney Docket No: 021756-015800US :

This is a decision regarding your requests for acceptance of fee deficiency submissions and loss of small entity status filed December 3, 2009 and February 11, 2010 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.33d 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 and the petition is **GRANTED**. Status as a small entity has also been removed.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (571) 272-3282.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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SCHWABE, WILLIAMSON & WYATT, P.C.
PACWEST CENTER, SUITE 1900
1211 SW FIFTH AVENUE
PORTLAND, OR 97204

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MAR 3 1 2008

In re Application of :
**DECOSEMO**, Peter A. :
Application No. 09/615,472 : DECISION ON PETITION
Filed: July 13, 2000 : TO WITHDRAW
Attorney Docket No. **PET600** : 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 11, 2007 and resubmitted November 01, 2007.

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 Nathan R. Maki on behalf of all attorneys of record who are associated with customer No. 25943. All attorneys/agents associated 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.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **PETER A. DECOSEMO**
**1410 S.E. 35TH AVENUE**
**PORTLAND, OR 97214**

cc: **CAROLE WEIDNER**
**P.O. BOX 170**
**WASHOUGAL, WA 98671**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/615,507 | 07/13/2000 | Claude Q.C. Hayes | P-5534-27 | 4652 |

7590 06/27/2002

Jaspan Schlesinger Hoffman LLP
300 Garden City Plaza
Garden, NY 11530

| EXAMINER | |
|---|---|
| BISSETT, MELANIE D | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1711 | 8 |

DATE MAILED: 06/27/2002

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.

In re Application of
Hayes
Application No. 09/615,507
Filed: 7/13/2000
Attorney Docket No. P-5534-27

: DECISION GRANTING PETITION
: TO REMAIL AN OFFICE ACTION
: AND RESTART PERIOD FOR REPLY

This is a decision on the petition filed on 4/10/02, requesting that the Office communication mailed on 1/4/02 be supplied with a new mail date and the shortened statutory period for reply set forth in the Office communication be restarted on the new mail date.

The petition is granted.

Petitioner provided a statement that a significant amount of correspondence mailed by the Office between October 13, 2001 and January 4, 2002 when delivery of mail from the Office to certain regions of the country was delayed, including the Office communication mailed on 1/4/02, has not been received by the applicant at the correspondence address of record.

Accordingly, the Office communication originally mailed on 1/4/02 will be remailed and the shortened statutory period that was originally set forth in the Office communication shall be restarted to run from the mail date of the newly supplied Office action or notice.

William Krynski, Special Program Examiner,
Technology Center 1700
(703) 308-2376

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

Jaspan Schelesinger Hoffman
300 Garden City Plaza
Garden, NY 11530

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MAR 1 7 2003

OFFICE OF PETITIONS

In re Application of :
Claude Q.C. Hayes :
Application No. 09/615,507 : ON PETITION
Filed: July 13, 2000 :
Attorney Docket No. P-5534-27 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 26, 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 4, 2002, which set a period for reply of (1) One Month or (30) Thirty Days from the mailing date of the Notice, whichever is later. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, a Notice of Abandonment was mailed on January 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 1711 for further processing.

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
WASHINGTON, D.C. 20231
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Paper No. 9

KEUSEY TUTUNJIAN & BITETTO, P.C.
14 VANDERVENTER AVENUE, SUITE 128
PORT WASHINGTON, NY 11050

COPY MAILED

JUL 0 2 2002

OFFICE OF PETITIONS

In re Application of :
Robert Leifer et al :
Application No. 09/615,564 : ON PETITION
Filed: July 13, 2000 :
Attorney Docket No. 200-109(CIP) :

This is a decision on the petition under 37 CFR 1.137(b), filed May 31, 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 October 3, 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 4, 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 2875.

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

SPE: T. Tran

## SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 7/6/06

TO SPE OF : ART UNIT 2621

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/615,577 Patent No.: 6993148

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:** Please see the attached page for comments.

Matthew C. Bella

MATTHEW C. BELLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

**SPE** **Art Unit**

1. Title page correction ("At Item (56)...Kurokid et al. should read - - Parker et al. - -.) on page 1 of certificate of correction is not approved. See the front page of U.S. Patent 5,113,310. If at all, the correction should be made from "Kurokid et al." to "Kuroki et al."

2. Column 1 line 37 correction ("FIG." Should read - - FIGS. - -") on page 1 of certificate of correction is not approved. Column 1 line 37 states "FIG. 2 or 4" which is correct.

3. Column 9 line 7 correction on page 1 of certificate of correction is not approved. This should refer to line 8 and not line 7.

US005113310A

# United States Patent [19]

Kuroki et al.

[11] Patent Number: 5,113,310

[45] Date of Patent: May 12, 1992

## [54] DIELECTRIC FILTER

[75] Inventors: Hiroshi Kuroki; Yoshifumi Yamagata, both of Kagoshima; Youichi Yamashita, Shiga, all of Japan

[73] Assignee: Kyocera Corporation, Kyoto, Japan

[21] Appl. No.: 590,150

[22] Filed: Sep. 28, 1990

[30] Foreign Application Priority Data

Sep. 30, 1989 [JP] Japan ..... 1-115078[U]
Sep. 30, 1989 [JP] Japan ..... 1-115079[U]
Dec. 28, 1989 [JP] Japan ..... 1-153151[U]

[51] Int. Cl.[5] ..... H01P 1/205; H01G 1/14; H01G 4/42; H01G 7/00

[52] U.S. Cl. ..... 361/302; 333/202; 361/321; 29/25.42

[58] Field of Search ..... 361/302, 321, 328, 329; 29/25.42; 333/302, 181

[56] References Cited

U.S. PATENT DOCUMENTS

| | | | |
|---|---|---|---|
| 4,144,509 | 3/1979 | Boutros | 361/302 |
| 4,179,673 | 12/1979 | Nishikawa et al. | 333/204 |
| 4,839,773 | 6/1989 | Ishikawa et al. | 361/321 |

FOREIGN PATENT DOCUMENTS

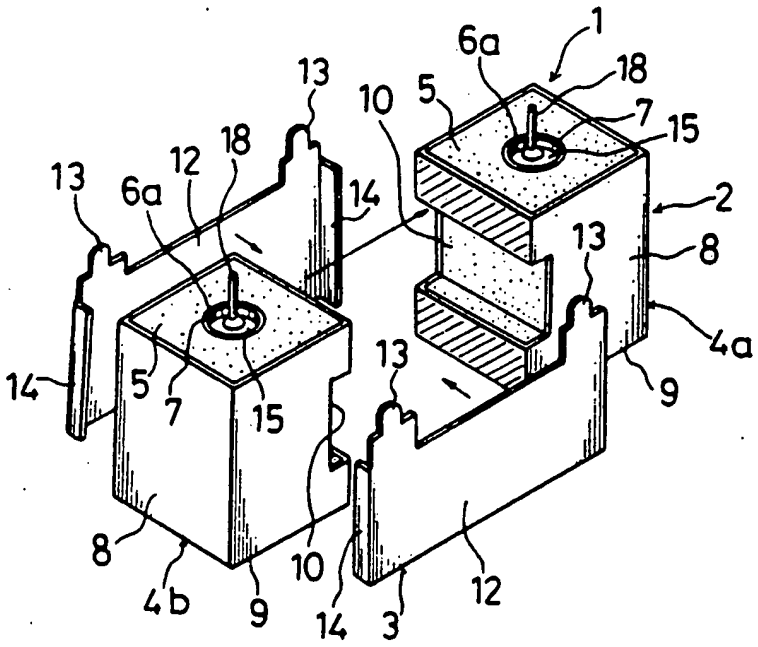
| | | |
|---|---|---|
| 0038996 | 11/1981 | European Pat. Off. . |
| 0093956 | 11/1983 | European Pat. Off. . |
| 0208424 | 1/1987 | European Pat. Off. . |
| 61-292401 | 12/1986 | Japan . |
| 24702 | 2/1988 | Japan . |
| WO83/00092 | 8/1983 | PCT Int'l Appl. . |
| WO88/01104 | 2/1988 | PCT Int'l Appl. . |
| WO87/01210 | 2/1988 | PCT Int'l Appl. . |
| 2109641 | 10/1982 | United Kingdom . |
| 2163606A | 2/1986 | United Kingdom . |
| 2165098 | 4/1986 | United Kingdom . |
| 2184608 | 6/1987 | United Kingdom . |
| 2210225A | 6/1989 | United Kingdom . |

*Primary Examiner*—Donald A. Griffin
*Attorney, Agent, or Firm*—Spensley Horn Jubas & Lubitz

[57] ABSTRACT

A dielectric filter comprises a first resonator and second resonator. Each of the resonators includes a dielectric block having a through-hole, an inner conductive layer placed on the inner surface of the through-hole, and an outer conductive layer placed on the outer surface of the dielectric blocks. The first and second resonators have a coupled hole extending transversely to the through-holes in portions of the resonator couples adjacent to each other. The dielectric filter may further include a frame made of a pair of metal plates covering said coupling hole. The pair of metal plates have legs for earthing and are affixed to the filter body, whereupon the metal plates are located, apart from each other. A method for producing a dielectric filter comprises the steps of making a filter body by connecting a first resonator and second resonator; providing a pair of lead frames incorporating a plurality of metal plates; disposing said filter body between said metal plates of the pair of lead frames; and fixing the metal plates to opposite sides of the filter body.

34 Claims, 5 Drawing Sheets



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PRINTER'S TRIM LINE

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 6,993,148 B1

DATED : January 31, 2006

INVENTOR(S) : Tomoyuki Miyashita, 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 TITLE PAGE
At Item (56), U.S. Patent Documents, "Kurokid et al." should read --Parker et al.--.

COLUMN 1
Line 31, "shown as" should read --as shown--.
Line 37, "FIG." should read --FIGS.--.

COLUMN 5
Line 18, "frequency-band-components" should read --frequency band components--.

COLUMN 7
Line 5, "be" should read --the--.
Line 19, "+i" should read --i--.

COLUMN 8
Line 9, "values×and y" should read --values x and y--.
Line 36, "bit" should read --bit- --.

COLUMN 9
Line 7, "all-positions" should read --all positions--.

MAILING ADDRESS OF SENDER:
FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
(212) 218-2100 - Telephone
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PATENT NO. 6,993,148 B1

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PRINTER'S TRIM LINE

UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 6,993,148 B1

DATED : January 31, 2006

INVENTOR(S) : Tomoyuki Miyashita, 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 14
Line 36, "set $I_2$" should read --set $I_1$--.

COLUMN 17
Line 29, "(a'-b')" should read --(a'$_i$-b'$_i$)--.

COLUMN 18
Line 16, "including-the" should read --including the--.

COLUMN 19
Line 17, "large-size" should read --large size--.

COLUMN 20
Line 4, "obtaining" should read --obtained--.
Line 27, "$P_{gl}$" should read --$P_{gl+1}$--.

COLUMN 21
Line 26, "y" should read --by--.

COLUMN 23
Line 22, "divided" should read --divided by--.

MAILING ADDRESS OF SENDER:
FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
(212) 218-2100 - Telephone
(212) 218-2200 - Facsimile

PATENT NO. 6,993,148 B1

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UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 6,993,148 B1

DATED : January 31, 2006

INVENTOR(S) : Tomoyuki Miyashita, 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 24
Line 13, "addition;" should read --addition,--.
Line 25, "Means)" should read --Means]--.
Line 40, "(num]" should read --[num]--.
Line 55, ")" should be deleted.

COLUMN 25
Line 67, "assigned." should read --assigned).--.

COLUMN 28
Line 41, "wI'" should read --wI'$_1$--.
Line 42, "wI'" should read --wI'$_1$--.

COLUMN 29
Line 10, "example" should read --examples--.
Line 33, "32$^c$" should read --32$c^2$--.
Line 66, "32$^2$" should read --32$c^2$--.

COLUMN 31
Line 17, "using-the" should read --using the--.
Line 38, "22," should read --22.--.

COLUMN 37
Line 56, "value a" should read --value $\alpha$--.

MAILING ADDRESS OF SENDER:
FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
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PATENT NO. 6,993,148 B1

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UNITED STATES PATENT AND TRADEMARK OFFICE

# CERTIFICATE OF CORRECTION

PATENT NO. : 6,993,148 B1

DATED : January 31, 2006

INVENTOR(S) : Tomoyuki Miyashita, 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 38

Line 6, "Inf" should read --$Inf_2$--.

Line 8, "signal:" should read --signal.--.

COLUMN 39

Line 16, "information" should read --information;--.

Line 29, "por-" should read --posi- --.

Line 38, "information" should read --information;--.

Line 54, "information" should read --information;--.

Line 56, "an" should read --and--.

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# CERTIFICATE OF CORRECTION

PATENT NO. : 6,993,148 B1

DATED : January 31, 2006

INVENTOR(S) : Tomoyuki Miyashita, 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 40

Line 4, "information" should read --information;--.

Line 19, "information" should read --information;--.

Line 36, "information" should read --information;--.

MAILING ADDRESS OF SENDER:

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
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PATENT NO. 6,993,148 B1

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00862.021952 (862.C1952) PATENT

OIPE JUN 23 2006 PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|---|---|---|
| In re Patent of: | ) | |
| | : | Examiner: Shervin Nakhjavan |
| TOMOYUKI MIYASHITA, ET AL. | ) | |
| | : | Group Art Unit: 2621 |
| Appln. No.: 09/615,577 | ) | |
| | : | Patent No.: 6,993,148 B1 |
| Filed: July 13, 2000 | ) | |
| | : | Issued: January 31, 2006 |
| For: IMAGE PROCESSING APPARATUS AND METHOD, AND STORAGE MEDIUM | ) : | June 23, 2006 |

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

Certificate JUN 28 2006 of Correction

**Attention: CERTIFICATE OF CORRECTION BRANCH**

REQUEST FOR CERTIFICATE OF CORRECTION
UNDER RULES 322 AND 323

Sir:

It is respectfully requested 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 clerical, typographical, or minor character, which were not the fault of the Patent and Trademark Office. A Certificate of Correction form (Form PTO-1050), in duplicate, is enclosed.

06/26/2006 SZEWDIE1 00000085 6993148
01 FC:1811 100.00 OP

JUN 30 2006

Accompanying this letter is a check for $100.00 to cover the statutory fee for issuing a Certificate of Correction to correct errors of the patentees. Any deficiency should be charged, or any overpayment credited, to Deposit Account No. 06-1205. A duplicate of this paper is enclosed for this purpose.

Patentees' undersigned attorney may be reached by telephone in our Washington, D.C. office at (202) 530-1010. All correspondence should be directed to our address given below.

Respectfully submitted,

Daniel S. Glueck
Attorney for Patentees
Registration No. 37,838

FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, New York 10112-3800
Facsimile: (212) 218-2200

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MINNEAPOLIS, MN 55402

Mail Date: 04/20/2010

| | | |
|---|---|---|
| **Applicant** | : Jason W. May | : DECISION ON REQUEST FOR |
| **Patent Number** | : 7610216 | : RECALCULATION of PATENT |
| **Issue Date** | : 10/27/2009 | : TERM ADJUSTMENT IN VIEW |
| **Appliction No** | : 09/615,638 | : OF WYETH AND NOTICE OF INTENT TO |
| **Filed** | : 07/13/2000 | : ISSUE CERTIFICATE OF CORRECTION |
| | | : |

The Request for Recalculation is **GRANTED** to the extent indicated.

The patent term adjustment has been determined to be **0** 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

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APR 16 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

ROBERT E. BUSHNELL
1522 K STREET NW
SUITE 300
WASHINGTON DC 20005-1202

In re Application of :
Yang-Yeon Lee : DECISION GRANTING PETITION
Application No. 09/615,652 : TO RESET PERIOD FOR REPLY
Filed: July 13, 2000 :
For: **METHOD FOR INFORMING A TRANSMITTING MODULE OF ERROR OCCURRENCE IN A RECEIVING PART OF A FACSIMILE** :

This is a decision on the petition filed on March 31, 2005, requesting that the shortened statutory period for reply set forth in the Office communication mailed on March 22, 2005 be reset and restarted.

Petitioner states that the non-final Office action relied upon a reference, i.e., Hwang (U.S. Pat. No. 5,822,084), but that the Hwang reference was not listed on either an 892 or form 1449 submitted by applicant.

MPEP §710.06 [R-2] Situations When Reply Period Is Reset or Restarted, states in part:

> Where the citation of a reference is incorrect or an Office action contains some other defect and this error is called to the attention of the Office within 1 month of the mail date of the action, the Office will restart the previously set period for reply to run from the date the error is corrected, if requested to do so by applicant. If the error is brought to the attention of the Office within the period for reply set in the Office action but more than 1 month after the date of the Office action, the Office will set a new period for reply, if requested to do so by the applicant, to substantially equal the time remaining in the reply period. For example, if the error is brought to the attention of the Office 5 weeks after mailing the action, then the Office would set a new 2-month period for reply. The new period for reply must be at least 1 month and would run from the date the error is corrected. See MPEP § 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

37 C.F.R. § 1.104 Nature of examination, states in part:

> (a) Examiner's action ...
>
> (2) The applicant, or in the case of a reexamination proceeding, both the patent owner and the requester, will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated in an Office action and such information or references will be given as may be

> useful in aiding the applicant, or in the case of a reexamination proceeding the patent owner, to judge the propriety of continuing the prosecution. [emphasis added]

Although current Office practice is not to provide copies of U.S. Patents or U.S. Publications with Office communications, and even though examiner did indicate the Patent No. of the Hwang reference that was being relied upon in the Office action, the examiner did not list the Hwang reference on the citation of art (i.e., form 892) which accompanied the action. Therefore, the Office action mailed March 22, 2005 was deficient.

Accordingly, the petition is **GRANTED**.

Given that the error was brought to the attention of the Office within 1 month of the mail date of the action, in accordance with MPEP §710.06, the time period will be reset and restarted with the re-mailing of the Office action.

The application record will be forwarded to the examiner to complete a supplemental Notice of References Cited, specifically listing the Hwang reference. From there, the application will be forwarded to the Technology Center's technical support staff for remailing the Office action with the supplemental Notice of References Cited prepared by the examiner.

Dwayne D. Bost
Special Program Examiner
Technology Center 2600
Communications

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AUG 18 2005

OFFICE OF PETITIONS

| | | |
|---|---|---|
| In re Application of | : | |
| James Stockman | : | LETTER REGARDING |
| Application No. 09/615,683 | : | PATENT TERM ADJUSTMENT |
| Filed: July 14, 2000 | : | |
| Attorney Docket No. 4554/87215 | : | |

This letter is in response to the "PATENT TERM ADJUSTMENT CHANGE REQUEST," filed July 1, 2004. Therein, applicant attempted to notify the Office of an error in applicant's favor in the initial determination of patent term adjustment. Applicant states that the patent term adjustment for this case should be "562" days, not "565" days (using a commercial software program).

The request for correction of the initial determination of patent term adjustment (PTA) is **DISMISSED**. However, for the reasons set forth herein, correction of the initial determination is required.

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 three hundred sixty-seven **(367)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On April 15, 2004, 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 to date is 565 days. Applicant submits no basis for their assertion that the PTA should be 562 days.

A review of the record reveals no basis for a change of the initial determination of patent term adjustment from 565 days to

562 days. Pursuant to 35 U.S.C. 154(b)(1)C(iii) and 37 CFR 1.702(e), a patent is entitled to patent term adjustment if the issuance of the patent was delayed by successful appellate review under 35 U.S.C. 134, 141 or 145. 37 CFR 1.703(e) provides that the period of adjustment under § 1.702(e) is the sum of:

> the number of days, if any, in the period beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 1.191 and ending on the date of 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. 141 or a civil action under 35 U.S.C. 145.

A review of the record confirms that a notice of appeal was filed on May 14, 2002. A final decision by the Board of Patent Appeals and Interferences, reversing all grounds for rejection of at least one claim was issued on January 30, 2004. Accordingly, the period of adjustment delay caused by successful appellate review is 626 days (e.g., beginning on May 14, 2002, and ending on January 30, 2004).

Moreover, pursuant to § 1.704(b), the period of adjustment was reduced by 61 days. The Office did not receive a response to the non-final Office action mailed June 27, 2001, until November 27, 2001, three months and 61 days later. Accordingly, the determination accompanying the notice of allowance indicated a patent term adjustment of 565 days (626 - 61).

However, upon further review of the record, an additional basis for reduction of the patent term adjustment is revealed. 37 CFR § 1.704(c)(7) provides that:

> Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed.

In this instance, a defective appeal brief was filed on September 16, 2002. See Notice of Defective Appeal Brief mailed December 3, 2002. An appeal brief correcting the defect was not filed until April 2, 2003. Thus, the period of reduction

pursuant to § 1.704(c)(7) is 198 days, beginning on the day after the date the reply having an omission was filed, September 17, 2002, and ending on the date that the reply correcting the omission was filed, April 2, 2003.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is three hundred sixty-seven (367) days (626 - (61 + 198)).

Applicant is advised that any additional period of adjustment for Office delay pursuant to 1.703(a)(6) will be reflected in the PTA shown in the Issue Notification letter (and in the patent).

As this letter was submitted as an advisement to the Office of an error in Applicant's favor, the Office will not assess the $200.00 application fee under 37 CFR 1.705(b). The Office thanks applicant for their good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to the Office of Patent Publication for issuance of the application.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

/Karin A Ferriter/
per

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of REVISED PAIR screen

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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**PORTLAND, OR 97205**

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NOV 25 2005

OFFICE OF PETITIONS

In re Application of :
Stephen R. Carter et al :
Application No. 09/615,726 : ON PETITION
Filed: July 13, 2000 :
Attorney Docket No. 6647-13 :

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 23, 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 July 28, 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 2654 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

[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** : 03/09/2006

**TO SPE OF** : ART UNIT 2600 (2671)

**SUBJECT** : Request for Certificate of Correction on Patent No.: 6,954,213

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 3-922**
Palm location **7580** - Tel. No. 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.

**Ok to add/delete the references as requested in COCIN?**

*Ernest C. White, LIE305-8339*
**Certificates of Correction Branch**

**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 change specified in page 2 of 2 of the Certificate of Correction Does not apply.

Mark Fin — SPE
2628 — Art Unit

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OFFICE OF PETITIONS
ON PETITION

In re Application of :
Michael S. Battaglia et al :
Application No. 09/615,838 :
Filed: July 13, 2000 :
Attorney Docket No. 2694-200

This is a decision on the petition, filed November 14, 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 30, 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 Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2616 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Irvin Dingle
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).