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RICK MATOS PHD
2200 ALL SAINTS LANE
PLANO TX 75025

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JAN 06 2006
OFFICE OF PETITIONS

In re Application of	:	
Yosef Freedland	:	
Application No. 09/753,128	:	ON PETITION
Filed: December 30, 2000	:	
Attorney Docket No. JST-15	:	

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed June 3, 2005 (supplemented on June 20, 2005).

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".

As set forth in MPEP 711.03(c)(I), a petition to withdraw the holding of abandonment is appropriate in those instances where an applicant contends that the application is not in fact abandoned. However, where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment), the appropriate remedy is a petition to revive the abandoned application under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay).

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed September 9, 2003, which set a shortened statutory period for reply of three (3) months. This final Office action was properly mailed to the correspondence address of record at that time. Applicant does not deny having received the final Office action. On November 24, 2003, applicant filed an amendment, together with a "Revocation of Existing Power of Attorney and New Power of Attorney", signed by applicant Yosef Freedland. The power of

attorney was not entered by the Office. The Office mailed an Advisory Action to the old correspondence address on January 9, 2004, informing applicant that the November 24, 2003 amendment would not be entered because it failed to place the application in condition for allowance. In addition, the Advisory Action informed applicant that the period for reply remained from the date set forth in the September 9, 2003 Office action. No further proper reply with an appropriate extension of time having been received, the application became abandoned on December 10, 2003. A Notice of Abandonment was mailed on February 7, 2005.

Applicant requests that the holding of abandonment be withdrawn and that the finality of the September 9, 2003 Office action be changed to non-final status. Both requests are dismissed.

As set forth above, the September 9, 2003 final Office action was properly mailed by the Office to the correspondence address of record. As set forth in the Manual of Patent Examining Procedure MPEP 711.03(c)(II):

> 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 actin or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment [or advisory action]."[1]

37 CFR 1.135(b), the regulation relevant to the abandonment of this application, provides that (A) the admission of, or refusal to admit, any amendment after final rejection, or any related proceedings, will not operate to save the application from abandonment; and (B) the admission of, or refusal to admit, any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113. 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.

Applicant should have ensured that the amendment had been entered or applicant should have filed either a Request for Continued Examination (RCE), continuing application, or Notice of Appeal. The last day an RCE, continuing application, or Notice of Appeal could have been filed, with the maximum allowed three month extension of time, would have been March 9, 2004.

With respect to applicant's argument that the finality of the September 9, 2003 Office action be changed to non-final status, applicant is directed to MPEP 706.07(c), which states that "any question as to the prematureness of a final rejection should be raised, if at all, while the application is still pending before the primary examiner". It is noted that applicant did not raise

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[1] MPEP 711.03(c)(II) (emphasis added).

this issue in his November 24, 2003 response. Furthermore, applicant is directed to MPEP 706.07(a), which states that an examiner may introduce a new ground of rejection in a final Office action where it was "necessitated by applicant's amendment of the claims".

Alternate Venues:

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l) - currently $250 for a small entity; (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 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m) - currently $750 for a small entity; (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

The change of correspondence address filed May 22, 2005 has been entered. A courtesy copy is being mailed to the address on the petition.

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

By mail: Mail Stop Petitions
Commissioner for Patnes
PO Box 1450
Alexandria VA 22313-1450

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

Telephone inquiries concerning this decision may be directed to the undersigned at 571-272-3207.

Cliff Congo
Petitions Attorney
Office of Petitions

cc: Yosef Freedland
64/6 Trumpeldor St
Petach Tikvah 49403 Israel

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United States Patent and Trademark Office
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BRINKS HOFER GILSON & LIONE
PO BOX 10395
CHICAGO IL 60610

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FEB 09 2007

OFFICE OF PETITIONS

In re	:
Shanklin, et al.	: DECISION REGARDING
Application No. 09/753,136	: PATENT TERM ADJUSTMENT
Filed: December 29, 2000	: AND NOTICE OF INTENT
Patent No. 7,115,273	: TO ISSUE CERTIFICATE
Issued: October 3, 2006	: OF CORRECTION

This decision is in response to the "REQUEST FOR REVIEW OF PATENT TERM ADJUSTMENT", filed August 21, 2006, requesting correction of the patent term adjustment (PTA) indicated on the patent.

The request is **GRANTED**.

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 **four hundred and seventeen (417) days.**

Applicants have 30 days to respond to this agreement if applicant disagrees with this decision. No extensions of time are available under 37 CFR 1.136.

The Office determined a patent term adjustment of seven hundred fifty-seven (757) days based on an adjustment for PTO delay of thirteen (13) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), three hundred seventy (370) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. § 1.703(a)(4), and

six hundred twenty-six (626) days pursuant to 35 U.S.C. 154(b)(1)(B) and 37 C.F.R. § 1.703(b) reduced by thirty-five (35), forty-one (41), eighty-nine (89), and eighty-seven (87) days of applicant delay pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(b).

A review of the record indicates that applicants should have been assessed a delay from the date of the initial filing of an appeal brief(2/11/05) until the date the correct brief was filed (1/17/06). See 37 CFR 1.704(c)(8). The amount of delay pursuant to 37 CFR 1.704(c)(8) is 340 days. The Office notes that additional USPTO delay is failing to reply to the filing of the appeal brief on 2/11/05 until December 16, 2005. See 37 CFR 1.702(a)(2). The amount of delay 188 days. Furthermore, the 370 day assessment against the Office is in error because the Office replied to the applicant amendment of 5/9/06 on 5/22/2006, within four months under 37 CFR 1.702(a)(2). Accordingly, the correct amount of PTA at the time of the issuance of the patent is 417(1009-(340+87+89+41+35)=417)days.

No fee has been charged. The Office thanks applicants for their good faith and candor in bringing this matter to the Office's attention.

The matter is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 C.F.R. § 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **four hundred and seventeen (417)** days, subject to any disclaimers.

Telephone inquiries specific to this letter 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

UNITED STATES PATENT AND TRADEMARK OFFICE

DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,115,273 B2

DATED : October 3, 2006

INVENTOR(S) : Shanklin, 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 (757) days

Delete the phrase "by 757 days" and insert – by [redacted] 417 days—

Day : Thursday

PALM INTRANET

Date: 2/8/2007
Time: 12:34:24

PTA Calculations for Application: 09/753136			
Application Filing Date:	12/29/2000	PTO Delay (PTO):	1009
Issue Date of Patent:	10/03/2006	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	252
Post-Issue Petitions:	0	Total PTA (days):	417
PTO Delay Adjustment:	-340		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
65	02/08/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		60	
64	02/08/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		280	
60.5	09/13/2006	PTA 36 MONTHS	626		
60	10/03/2006	PATENT ISSUE DATE USED IN PTA CALCULATION			
59	08/29/2006	EXPORT TO FINAL DATA CAPTURE			
58	08/28/2006	DISPATCH TO FDC			
57	08/25/2006	APPLICATION IS CONSIDERED READY FOR ISSUE			
56	08/21/2006	ISSUE FEE PAYMENT VERIFIED			
55	08/21/2006	ISSUE FEE PAYMENT RECEIVED			
54	07/17/2006	FINISHED INITIAL DATA CAPTURE			
53	05/26/2006	EXPORT TO INITIAL DATA CAPTURE			
52	05/22/2006	MAIL NOTICE OF ALLOWANCE	370		36
51	05/17/2006	ISSUE REVISION COMPLETED			
50	05/17/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
49	04/02/2001	REFERENCE CAPTURE ON IDS			
48	05/17/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
47	12/13/2002	REFERENCE CAPTURE ON IDS			
46	05/15/2006	NOTICE OF ALLOWABILITY			
45	05/17/2006	DATE FORWARDED TO EXAMINER			
44	05/09/2006	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
42	04/02/2001	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
		EXAMINER INTERVIEW SUMMARY RECORD			

41	04/25/2006	(PTOL - 413)			
40	04/02/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
39	04/18/2006	CASE DOCKETED TO EXAMINER IN GAU			
38	04/17/2006	CASE DOCKETED TO EXAMINER IN GAU			
37	01/31/2006	DATE FORWARDED TO EXAMINER			
36	01/17/2005	APPEAL BRIEF FILED			
35	12/16/2005	NOTICE -- DEFECTIVE APPEAL BRIEF			
34	03/16/2005	DATE FORWARDED TO EXAMINER			
33.1	02/11/2005	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
33	02/11/2005	APPEAL BRIEF FILED			
32	02/11/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
31	11/12/2004	NOTICE OF APPEAL FILED		87	29
30	11/12/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
29	05/17/2004	MAIL FINAL REJECTION (PTOL - 326)			
28	05/14/2004	FINAL REJECTION			
27	03/04/2004	IFW AMENDED CASE PROCESSING COMPLETE			
26	03/04/2004	DATE FORWARDED TO EXAMINER			
25	02/09/2004	RESPONSE AFTER NON-FINAL ACTION		89	23
24	02/09/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
23	08/12/2003	MAIL NON-FINAL REJECTION			
22	08/11/2003	NON-FINAL REJECTION			
21	05/06/2003	DATE FORWARDED TO EXAMINER			
20	04/30/2003	APPEAL BRIEF FILED			
19	04/30/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
18	02/12/2003	NOTICE OF APPEAL FILED		41	14
17	02/12/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
16	12/13/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	12/11/2002	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
14	10/02/2002	MAIL NON-FINAL REJECTION			
13	10/01/2002	NON-FINAL REJECTION			
12	07/27/2002	DATE FORWARDED TO EXAMINER			

11	07/18/2002	RESPONSE AFTER NON-FINAL ACTION		35	9
10	07/18/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
9	03/13/2002	MAIL NON-FINAL REJECTION	13		-1
8	03/11/2002	NON-FINAL REJECTION			
7	05/30/2001	CASE DOCKETED TO EXAMINER IN GAU			
6	05/14/2001	APPLICATION DISPATCHED FROM OIPE			
5	02/15/2001	APPLICATION IS NOW COMPLETE			
4	02/15/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	02/14/2001	CORRESPONDENCE ADDRESS CHANGE			
2	01/19/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	12/29/2000	INITIAL EXAM TEAM NN			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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C/O BLAKELY, SOKOLOFF,
TAYLOR & ZAFMAN LLP
12400 WILSHIRE BLVD, 7TH FLOOR
LOS ANGELES, CA 90025

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NOV 23 2005

OFFICE OF PETITIONS

In re Patent of :	
Joshua l. Coates :	
Application No. 09/753,141 :	DECISION
Filed: December 29, 2000 :	ON PETITION
For: METHODS AND APPARATUS FOR :	
OFF-LOADING CONTENT SERVERS :	
THROUGH DIRECT FILE TRANSFERS :	
FROM A STORAGE CENTER :	
TO AN END-USE :	

This is a decision in response to the Renewed Petition Under 37 CFR § 1.137(b), filed October 11, 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 July 9, 2004. 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 October 10, 2004. A Notice of Abandonment was mailed on September 8, 2005.

With the instant petition, Petitioner has satisfied the requirements of a grantable petition under 37 CFR 1.137(b). A response to the July 9, 2004 Office action is filed with the instant petition. Accordingly, the petition is granted.

This application is being referred to Technology Center Art Unit 2142 for processing of the Amendment and Response to Office Action, filed October 11, 2005 (Certificate of Mailing dated October 6, 2005), in due course.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

JOHN P WHITE
COOPER & DUNHAM LLP
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

COPY MAILED

JUN 1 0 2002

OFFICE OF PETITIONS

In re Application of
Stein, et al.
Application No. 09/753,169
Filed: January 2, 2001
Attorney Docket No.
55669-A-PCT-US/JPW/GJC

DECISION ON PETITION

This is a decision on the petition filed March 1[illegible], 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 properly reply to the Notice to File Missing Parts of Nonprovisional Application, mailed March 7, 2001. This Notice set a period for reply of two months from the mail date of the Notice to submit: (1) an executed oath or declaration (and the surcharge for its late filing); (2) a copy of the "Sequence Listing" in computer readable form as required by 37 CFR 1.821(e), and (3) a statement that the contents of the sequence listing information recorded in computer readable format is identical to the written sequence listing. On September 28, 2001, petitioner submitted an executed declaration, together with the surcharge for its late filing.[1] However, as petitioner did not submit items (2) or (3) above, the application became abandoned on October 8, 2001. A Notice of Incomplete Reply was mailed on November 28, 2001. The mailing of this decision precedes the mailing of a Notice of Abandonment.

With the instant petition, petitioner submitted the required items as set forth in the Notice of Incomplete Reply, paid the $640 petition fee, and made the proper statement of unintentional delay.

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 $915 extension of time fee submitted with the petition on March 13, 2002 was subsequent to the maximum period obtainable for reply (October 7, 2001), this fee has been refunded to Deposit Account No 03-3125. In addition, as the $65 surcharge for late filing of the declaration was already submitted on September 28, 2001, the $65 submitted on March 1[illegible], 2002 has also been refunded to petitioner's deposit account.

The application file is being forwarded to the Office of Initial Patent Examination for completion of pre-examination processing.

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

Cliff Congo
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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[1] This filing was made timely by obtaining a five month extension of time.

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Paper No. None

WINDY STRICKLAND
2012 BOB WHITE CT
MARY ESTHER FL 32569

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DEC 0 4 2006

OFFICE OF PETITIONS

In re Application of :
Gopal Chillariga et al. :
Application No. 09/753,182 :
Filed: January 2, 2001 :
Attorney Docket Number: SPECT-01039US1 DEL :
Title: DYNAMIC CHANNEL ALLOCATION IN MULTIPLE-ACCESS COMMUNICATION SYSTEMS :

DECISION ON PETITION
UNDER 37 C.F.R. §1.137(B)

This is a decision on the petition filed on August 4, 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 submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Issue Fee Due, mailed, June 28, 2005, which set a shortened statutory period for reply of three months. No extensions of time are permitted for transmitting issue or publication fees[2]. Accordingly, the above-identified application became abandoned on September 29, 2005. A Notice of Abandonment was mailed on February 10, 2006.

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

2 See MPEP §710.02(e).

With the present petition, Petitioner has submitted the petition, issue, and publication fees, along with the proper statement of unintentional delay. A terminal disclaimer is not required.

As such, the petition is **GRANTED**.

The Office of Patent Publication will be notified of this decision so that the present application can be processed into a patent.

It is noted that the address listed on the petition differs from the address of record. The application file does not indicate a change of correspondence address has been filed in this case, although the address given on the petition differs from the address of record. If petitioner desires to receive future correspondence regarding this application, the change of correspondence address must be submitted. A courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. Petitioner will not receive future correspondence related to this application unless Change of Correspondence Address, Patent Form (PTO/SB/122) is submitted for the above-identified application. For petitioner's convenience, a blank Change of Correspondence Address, Patent Form (PTO/SB/122), may be found at http://www.uspto.gov/web/forms/sb0122.pdf.

It is not apparent whether the person signing the statement of unintentional delay was in a position to have firsthand or direct knowledge of the facts and circumstances of the delay at issue. Nevertheless, such statement is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay[3]. In the event that such an inquiry has not been made, petitioner must make such an inquiry. If such inquiry results in the discovery that the delay was intentional, petitioner must notify the Office.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[4]. All other inquiries

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3 See 37 CFR 10.18(b); cf. Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53178 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 103 (October 21, 1997).
4 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

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: Gregory Ranieri
1700 NW 167TH PLACE
SUITE 240
BEAVERTON, OR 97006

---

reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

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DIW 10-01

Paper No. 5

GEORGE R. SCHULTZ
STRASBURGER & PRICE, LLP.
SUITE 4300
901 MAIN STREET
DALLAS, TX 75202-3794

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OCT 1 5 2001

OFFICE OF PETITIONS

In re Application of	:
Neuse al.	:
Application No. 09/753,192	: DECISION DISMISSING
Filed: 2 January, 2001	: PETITION
Attorney Docket No. 044601.0164	:

This is a decision in reference to the "Request for Corrected Filing Date" filed on 25 April, 2001, which is being treated as a petition under 37 CFR 1.10(c), requesting that the above-identified application be accorded a filing date of 30 December, 2000, rather than the presently accorded filing date of 2 January, 2001.

The petition is dismissed.

Petitioners assert that the application was deposited in Express Mail service on 30 December, 2000. In support, the petition is accompanied by a copy of Express Mail receipt No. EL597197443US, showing a USPS postmark dated 30 December, 2000.

Paragraph (c) of 37 CFR 1.10 states that:

Any person filing correspondence under 37 CFR 1.10 that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show 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 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 papers or fees 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.

The instant petition lacks the showing required by item (3).

In this case, a review of the official file reveals that no Express Mail label number was placed on the application papers prior to the original mailing. The placement of the Express Mail label number on a paper ties the paper to a single, identifiable Express Mail receipt. Where questions are later raised concerning the filing date of the paper, the PTO may require the applicant to supply a copy of the Express Mail receipt identified on the paper in order to verify the mailing date. Where no Express Mail label number is identified on a paper, the PTO has no way of independently associating the paper with any particular Express Mail receipt. As such, the PTO has nothing in its control from the filing date of the papers to independently corroborate the applicants' assertion that the application was filed on 30 December, 2000.

Petitioners should also note that the requirement of 37 CFR 1.10(c) for a certificate of mailing by "Express Mail" has been waived by the Commissioner.[1]

The application is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of 2 January, 2001.

Telephone inquiries specific to this matter should 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

---

[1] See 1174 O.G. Pat. Of. 92 (May 16, 1995).

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THE WEBB LAW FIRM, P.C.
700 KOPPERS BUILDING
436 SEVENTH AVENUE
PITTSBURGH PA 15219

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MAR 16 2006

OFFICE OF PETITIONS

In re Application of :
Tiley et al :
Application Number: 09/753,211 :
Patent: 6,950,803
Attorney Docket Number: 3520-002268-H :
Filing Date: January 2, 2001 :
Issue Date: September 27, 2005 : DECISION ON PETITION
:

This is a decision on the petition filed January 17, 2006 under 37 CFR 3.81 (b)[1] to print the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **Granted**.

Petitioner has submitted a $400.00 petition fee. Pursuant to petitioner's request deposit account 23-0650 is being refunded $270.00. A petition fee is no longer required. A certificate of correction fee in the amount of $100.00 (37 CFR1.20(a)) and a processing fee of $130.00 (37 CFR 1.17(i)) is being retained.

This application is being forwarded to the Certificate of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3215. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificate of Correction Branch at (703) 305-8309.

Charlema R. Grant
Petitions Attorney
Office of Petitions

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[1]See 69 Fed. Reg. 29865 (May 26, 2004).

PTO/SB/66 (03-09)
Approved for use through 03/31/2012. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6952737	2005-10-04	09/753,221	2000-12-29	P19172X3

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	/Jeffrey S. Draeger/	Date (YYYY-MM-DD)	2009-12-30
Name	Jeffrey S. Draeger	Registration Number	41000

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. 6952737
Issue Date: October 4,2005
Application No. 09753221
Filed: December 29,2000
Attorney Docket No. SCAL.P0005

:

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

:

This is a decision on the electronic petition, filed December 30,2009 ,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 December 30,2009 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Arlington, VA 22313-1450
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Paper No. 10

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

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JUN 2 7 2003

OFFICE OF PETITIONS

In re Application of
Engwer et al.
Application No. 09/753,227
Filed: December 28, 2000
Attorney Docket No. 3239P071

ON PETITION

This is a decision on the petition under 37 CFR 1.137(f), filed June 2, 2003, which is being treated as a petition under 37 CFR 1.137(b), to revive the application under the unintentional provisions of 37 CFR 1.137(f).

The petition is Granted.

Petitioner states that the instant nonprovisional application is the subject of a counterpart international application filed on August 17, 2001. However, the U.S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the international application.

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 Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(f) must be accompanied by:

(1) the 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(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 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 rescinded. A Notice Regarding Rescission of Non-publication Request which sets forth the projected publication date of October 2, 2003 accompanies this decision on petition.

The application file is being forwarded to Technology Center AU 2665 for further examination in due course.

Telephone inquiries regarding 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

Attachment: Notice Regarding Rescission of Non-Publication Request

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

Paper No. 14

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JAN 13 2003

OFFICE OF PETITIONS

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
LOS ANGELES CA 90025

In re Application of :
Valery M. Dubin, et al :
Application No. 09/753,256 :
Filed: December 28, 2000 :
Attorney Docket No. 42390P10254 :

ON PETITION

This is a decision on the petition, filed January 10, 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 November 18, 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 2813 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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[1] The request to apply the issue fee to the new Notice 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.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 2/15/2007

TO SPE OF : ART UNIT 2100 (2135)

SUBJECT : Request for Certificate of Correction on Patent No.: 7,162,034

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

Please complete this form and return with file ***(PFW)**, within **7** days to:
Certificates of Correction Branch – 2900 South Tower ste.9A43A
Palm location **7580** or forward ***(IFW)** to scanning using document code **COCX**.

***Ok to change dep. of claim 22, from 21 to 19 as req. in COCIN?**

Ernest C. White, LIE (703) 308-9390x122

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 — 2135 **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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www.uspto.gov

STEPHEN T. NEAL
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLP
SEVENTH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES, CA 90025-1030

MAILED

AUG 31 2009

OFFICE OF PETITIONS

In re Application of	:	
Pankaj Kedia, et al.	:	
Application No. 09/753,326	:	DECISION GRANTING PETITION
Filed: December 29, 2000	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 42390P10227	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 26, 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 July 21, 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 regarding this decision should be directed to undersigned at (571) 272-1642. All other inquiries regarding the examination or status of this application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2116 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed information disclosure statement.

/AMW/
April M. Wise
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 PATENT AND TRADEMARK OFFICE

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SEP 14 2007

OFFICE OF PETITIONS

VAN PELT, YI & JAMES LLP
10050 N. FOOTHILL BLVD #200
CUPERTINO, CA 95014

In re Application of
Shane M. Tulloch, et al.
Application No. 09/753,328
Filed: December 29, 2000
Attorney Docket No. ARIBP040

ON PETITION

This is a decision on the petition, filed May 22, 2007, under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to pay the issue fee on or before March 6, 2007. A Notice of Abandonment was mailed on May 8, 2007. In response, on May 22, 2007 the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of the $1,400 issue fee and the $300 publication fee; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay[1].

The application is being referred to the Office of Publications to be processed into a patent.

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at Publishing Division should be directed to (571) 272-4200.

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. While 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, 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.

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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JAN 29 2007

OFFICE OF PETITIONS

Christopher K. Gagne
c/o Blakely, Sokoloff, Taylor & Zafman LLP
12400 Wilshire Boulevard, Seventh Floor
Los Angeles CA 90025

In re Application of	:	
Coates et al.	:	DECISION ON PETITION
Application No. 09/753,336	:	
Filed: 12/29/2000	:	
Attorney Docket No. SCAL.P0004	:	

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

The above-identified application became abandoned for failure to file a timely response to the nonfinal Office Action, mailed January 2, 2004, which set a three-month shortened statutory period for reply. The above-identified application became abandoned on April 3, 2004. On January 24, 2006, the Office mailed a Notice of Abandonment.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Petitioner submitted the required reply, paid the petition fee, and made the proper statement of unintentional delay. Accordingly, the petition is **granted.**

This matter is being referred to Technology Center Art Unit 2114.

Telephone inquiries specific to this decision may be directed to the undersigned at (571) 272-3211. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

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
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WILLIAM, MORGAN & AMERSON
10333 RICHMOND, SUITE 1100
HOUSTON TX 77042

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JUN 16 2005

OFFICE OF PETITIONS

In re Application of	:
Jin Li	:
Application No. 09/753,343	: DECISION GRANTING PETITION
Filed: December 29, 2000	: UNDER 37 CFR 1.137(b)
Attorney Docket No. 2069.009900	:

This is a decision on the petition under 37 CFR 1.137(b), filed February 9, 2005, 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 a Notice of Appeal; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Office action is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 2644.

Karen Creasy

Karen Creasy
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. 11

MAIL

NOV 24 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

KURT G. HAMMERLE
NASA LANGLEY RESEARCH CENTER
MAIL STOP 212
3 LANGLEY BOULEVARD
HAMPTON VA 23681-2100

In re Application of :
WOODARD :
Application No. 09/753,370 :
Filed: January 2, 2001 :
For: PIEZOELECTRIC TRANSDUCER FOR :
VIBRATIONAL ALERT AND SOUND IN A :
PERSONAL COMMUNICATION DEVICE

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw all attorneys/agents of record associated with customer service number 23,351, filed on October 3, 2003 (paper No. 10).

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw,
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf,
(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.

Accordingly, the request is **GRANTED**

The attorney/agent of record, Mr. Hammerle is granted the request to withdraw. However, customer number 23,351 is not associated with the file.

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.

The file is being returned to TC 2600 Technical Support Staff to update the correspondence address and then will be forwarded to the Technology Center's central files to await action by the examiner in appropriate time

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

cc: Mr. Stanley E. Woodard
P.O. Box 7976
Hampton VA 23666

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
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LOWRIE, LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE MA 02142

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MAR 2 0 2009

OFFICE OF PETITIONS

In re Patent No. 6,858,578	:	
Issue Date: February 22, 2005	:	
Application No. 09/753,385	:	NOTICE
Filed: January 3, 2001	:	
Attorney Docket No. S2071-701642	:	

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 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.

Liana Walsh
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
P.O. Box 1450
Alexandria, Virginia 22313-1450
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,417	01/02/2001	Eric R. Fossum	06816/019004/CIT2363-D2	1857

7590 03/31/2009

SCOTT C. HARRIS
Fish & Richardson P.C.
4350 La Jolla Village Drive, Suite 500
San Diego, CA 92122

EXAMINER
HO, TUAN V

ART UNIT	PAPER NUMBER
2622	

MAIL DATE	DELIVERY MODE
03/31/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090325

DATE : March 31, 2009

TO SPE OF : ART UNIT 2622

SUBJECT : Request for Certificate of Correction on Patent No.: 6,570,617

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: /Sinh Tran/ **Art Unit** 2622

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SENNIGER POWERS
ONE METROPOLITAN SQUARE
16TH FLOOR
ST LOUIS, MO 63102

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In re Application of	:	
Kung-Liang Kevin Sung, et al.	:	
Application No. 09/753,428	:	ON PETITION
Filed: January 3, 2001	:	
Attorney Docket No. IPC-109A, Case 25	:	

This is a decision in response to the petition under 37 CFR 1.137(b), filed March 13, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The application is revived for consideration of a submission under 37 CFR 1.114 (request for continued examination) filed March 13, 2006.

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 1732 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

WILLIAM D. GILL
INTERNATIONAL BUSINESS MACHINES CORPORATION
Dept. L2PA
5600 Cottle Road
San Jose CA 95193

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AUG 1 0 2004

OFFICE OF PETITIONS

In re Application of John Westwood Application No. 09/753,433 Filed: January 2, 2001 Atty Docket No. SJO990037US10	DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. 1.705(b)," filed January 26, 2004. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from two hundred thirty-one (231) days to two hundred thirty-three (233) 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 two hundred thirty-three **(233)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On December 11, 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 231 days. On January 26, 2004, applicant timely[1] submitted an application for patent term adjustment (with required fee). The Office determined entitlement to a period of adjustment of 233 days for the Office mailing a first notice under 35 U.S.C. 132, fourteen months and 233 days after the filing date of this application. However, the PTA was reduced by 2 days for applicant's filing of a terminal disclaimer on October 10, 2003, which was 2 days after applicant had filed an initial response after non-final Office action. Applicant states that the application is not subject to a terminal disclaimer and there are no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application.

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[1] PALM records indicate that the Issue Fee was received in the Office with a mailroom date of March 2, 2004.

Applicant is incorrect inasmuch as a terminal disclaimer was filed (and entered) in this application, and thus, the patent issuing from this application is subject to a terminal disclaimer.

Yet, applicant is correct that, as of the mailing of the notice of allowance, there were no circumstances constituting a failure to engage within the meaning of § 1.704. The filing of the terminal disclaimer did not occur under circumstances that constitute a failure to engage in reasonable efforts to conclude prosecution of the application. The terminal disclaimer was not filed either as a supplemental response (or a response correcting an omission) to applicant's response after non-final filed October 8, 2003. Both papers are present in the application file with dates of receipt thereon of October 8, 2003; the date of filing of the terminal disclaimer was incorrectly entered as October 10, 2003.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is two hundred thirty-three (233) days.

The $200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 09-0466, as authorized. No additional fees are required.

The Office will forward the file 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 (703) 305-0309.

Kery A. Fries
for

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

Enclosure: Revised PAIR Screen

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

SEP - 5 2001

#6

In re Application of	:	
Sherman et. Al.	:	NOTICE OF WITHDRAWAL
Serial No. 09/753495	:	FROM ISSUE
Filed: January 2, 2001	:	UNDER 37 CFR 1.313(b)
For: METHOD OF REMOVING	:	
CONTAMINANTS FROM USED OIL	:	

The above-identified application is withdrawn from issue after payment of the issue fee due to a mistake on the part of the Office. See 37 CFR 1.31(b)(1).

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. This 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 Marian Knode at (703) 308-4311.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Richard V. Fisher

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

Thomason, Moser & Patterson, L.L.P.
Suite 1500
3040 Post Oak Boulevard
Houston, TX 77056

Cc: Allowed Files

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OCT 10 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

David L. Feigenbaum
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804

In re application of
Neil Hudd et.al.
Application No. 09/753,507 :
Filed: January 3, 2002 :
For: WIRELESS FINANCIAL TRANSACTIONS :

DECISION ON REQUEST FOR WITHDRAWAL OF ATTORNEY

This is a decision on the request filed on august 7, 2002, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. For approval of such a request the following conditions must be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;
B) There must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a);
C) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided;
D) The applicant or patent owner must have been notified of the withdrawal as provided for in 37 CFR 1.36.

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition (A) above. The attorneys listed in the request to withdraw do not match those originally appointed. Requestor has not requested to withdraw Lawrence K. Kododney.

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(703) 308-0866
Facsimile No.: (703) 605-0586

Rjb:10/3/02

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

Charles W. Peterson, Jr.
FITCH, EVEN, TABIN & FLANNERY
Suite 1600
120 South Lasalle Street
Chicago, IL 60603-3406

MAILED

MAY 1 5 2002

Technology Center 2100

In re Application of:	)	
Nimrod MEGIDDO	)	
Application No. 09/753,556	)	
Filed: January 4, 2001	)	**DECISION ON REQUEST FOR**
For: SYSTEM, METHOD AND	)	**WITHDRAWAL AS ATTORNEY**
PROGRAM PRODUCT FOR	)	
IMPROVING BROKER'S PROFITS	)	
IN ELECTRONIC COMMERCE		

This is a decision on the Request To Withdraw from Representation filed March 18, 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 signed by Charles W. Peterson, Jr. alone and does not contain a clear indication that Mr. Peterson 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.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No. 15

Hugh D. Jaeger
Suite 302
1000 Superior Blvd.
Wayzata, MN 55391-1873

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OCT 15 2004

OFFICE OF PETITIONS

In re Application of	:	
Jesse A. Jurrens	:	
Application No. 09/753,591	:	ON PETITION
Filed: January 3, 2001	:	
Attorney Docket No. JURRENS	:	

This is a decision on the petition under 37 CFR 1.137(b), filed October 22, 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 July 22, 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 October 22, 2002.

In response, petitioner submitted with the instant petition $665 for the petition to revive fee, an amendment, and a Request for Continued Examination (RCE) along with the $385 filing fee.

The petition is **GRANTED**.

The application file is being forwarded to Technology Center Art Unit 3613, for processing the RCE 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) 272-3226.

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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Alexandria, VA 22313-1450
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Paper No. 15

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

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OFFICE OF PETITIONS

In re Application of	:	
Forsell, Peter	:	
Application No. 09/753,656	:	ON PETITION
Filed: January 4, 2001	:	
Attorney Docket No. SPC-5008	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed April 27, 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 August 15, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on November 16, 2003. A Notice of Abandonment was mailed on April 6, 2004.

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

The Terminal Disclaimer filed on April 27, 2004 is not required since the application was not filed prior to June 8, 1995. Therefore, the Terminal Disclaimer has not been accepted and will not be entered, but will be placed in the application file. The fee for filing the Terminal Disclaimer will be credited to petitioner's deposit account.

The file is now being forwarded to Technology Center 3700 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Telephone inquiries should be directed to the undersigned at (703) 306-0482.

Liana Chase

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

Pet. Dec

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

BC
Paper Number __

Mailed: JUL 14 2004

In re application of
Shigeto Fujimura et al.
Serial No. 09/753,662
Filed: January 4, 2001
For: PROCESS FOR PRODUCING COMPOUND SEMICONDUCTOR CRYSTAL

DECISION ON PETITION

This is a decision on PETITION UNDER 37 C.F.R. 1.59(b), filed on November 21, 2003, requesting that the Office Action mailed on August 21, 2003 be withdrawn. The Petitioner submits that the examiner abused his discretion in reopening prosecution in the above-identified application when no new issue was presented in the Office Action to warrant pulling the above-identified application from appeal. As detailed on pages 2 and 3 of the pending Petition, this is the second occasion in which the examiner reopened prosecution after an Appeal Brief was filed. In the later instance, the examiner applied the same art in essentially the same manner, except for the addition of a nominal sentence in the rejection body on page 4 of the Office Action. The Petitioner contends that no new issue was presented in the August 21, 2003 Office Action.

DECISION

37 CFR 1.59(b) allows for an Applicant to request that the Office expunge and return information, other than what is excluded by paragraph 37 CFR 1.59(a)(2), i.e. information forming part of the original disclosure, by filing a petition. MPEP 724.05 provides examples of such papers that may be expunged from the official record, which includes proprietary/trade secret information, information unintentionally submitted in an application and information submitted in an incorrect application. In the present case, the Petitioner is requesting that a paper that was clearly intended to be made part of the official record be expunged, which does not fall within the guidelines set forth in MPEP 724.05. Accordingly, the Office Action mailed on August 21, 2003 cannot be expunged.

The Petition under 37 CFR 1.59(b) is **DENIED**.

It is agreed that the second reopening of prosecution with the issuance of the August 21, 2003 Office action was inappropriate, as it simply clarified the examiner's position regarding the pending art rejections. As the Applicants have filed a supplemental Appeal Brief concurrent

with this Petition, such will be promptly addressed by the examiner. The examiner is herein directed to prepare and Examiner's Answer in this application as the next order of business.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Marc S. Weiner
BIRCH, STEWART, KOLASCH AND BIRCH, LLP
P.O. Box 747
Falls Church, VA 22040-0747

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Technology Center 2100

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Paper No. 8

BLANK ROME COMISKY & McCAULEY LLP
900 17th Street, N.W., Suite 1000
Washington D.C. 20006

In re Application of: Gary Keorkunian et al. Application No. 09/753,714 Attorney Docket No. 109246.00103 Filed: January 4, 2001 For: SYSTEM AND METHOD FOR ANONYMOUS OBSERVATION AND USE OF PREMIUM CONTENT	**DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER 37 CFR §1.102(d) and MPEP § 708.02(VIII), Accelerated Examination**

This is a decision on the petition, filed January 14, 2003 under 37 CFR § 1.102(d) and MPEP § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

The petition is **DISMISSED**.

MPEP § 708.02, Section VIII that sets out the prerequisites for a grantable petition for Accelerated Examination under 37 CFR §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, 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.
> The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed.
> If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.
> If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.
> Divisional applications directed to the non-elected inventions will not automatically be given special status based on papers filed with the petition in the parent application. Each such application must meet on its own all requirements for the new 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.* (Italics added.)

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.

Petitioners have submitted a petition to make special accompanied by the fee set forth in 37 CFR § 1.17(h); a statement the claims are directed to a single invention or applicants will elect without traverse; one copy of each of the references most closely related to the subject matter encompassed by the claims; a statement regarding a search made by a foreign patent office listing the field of search by class and subclass; and a statement regarding a key word search made through online patent databases by applicants' attorney. Therefore, the petition complies with items (A), (B), (C), and (D) of the items mentioned above. However, petitioners' submission is deficient regarding the detailed description requirement outlined in item (E) above.

Petitioners rely upon a search made for the PCT international patent application PCT/US01/00192, which is not claimed by applicants in their priority statement. From petitioners' statements, it would appear the International Preliminary Examination Report only addresses eight claims. In the current U.S. application, there are twelve claims pending. Therefore, without a copy of the international application, the Office cannot assume the claimed inventions are identical between the two applications.

In discussing the art cited in the international search report, petitioners indicate seven references were cited in the International Search Report. Petitioners appear to rely upon the International Preliminary Examination Report to support the requirement of providing a discussion of how the claimed subject matter is patentable over the references (Part (E) of MPEP § 708.02 (VIII)). However, since petitioners have not provided a copy of the claims that were the subject of the international examination report, no weight is being given to any comments made during the international examination regarding the patentability of the claims in the PCT application for the purpose of this decision.

Regarding petitioners' detailed discussion of the first three references cited in the International Search Report, it is impossible to determine in what manner "[a]pplicants agree with the finding of the IPEA/US." As an example, on page 2 of the petition, it appears that the reference of Scholl *et al.* may have been cited as an "X" reference, while on the petition's page 3, last paragraph, applicants state: "*Scholl et el.* is cited against claim 5 for teaching...". It is not clear how an "X" reference is cited against a dependent claim, and if it is in combination with another reference, what reference was being used for the combination. Since "X" is defined as a "**document of particular relevance**"; the claimed invention **cannot** be considered to involve **an inventive step** when the document is taken alone. In discussing the reference Gabber et al., the discussion is only for Claims 1-8 with no discussion of pending Claims 9-12. In addition,

Hassett et al. is only discussed relative to Claim 2 and Scholl et al. is only discussed relative to Claim 5. The record remains unclear as to whether Hassett et al. or Scholl et al. are readable on independent Claim 1.

Finally, in regards to the petitioners' discussion of the prior art found through the keyword search, the discussion is not adequate because it fails to discuss the cited prior art relative to the ***claimed*** invention. Petitioners discuss what is the nature of the prior art, but the discussion fails to point out with the particularity required by 37 CFR § 1.111(b) and (c) how the claimed subject matter is patentable over the references.

Accordingly, the Petition is **DISMISSED**. The application file is being forwarded to Technology Center 2100's Central Files to await examination in its proper turn based on its effective filing date. Petitioner is entitled to one opportunity to perfect the request in a renewed petition to make special. Any request for reconsideration must be filed within TWO MONTHS of the mailing date of this decision. Telephone inquiries regarding this decision should be directed to the undersigned.

Josie A. Ballato
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 308-0269

MB

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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	:
Shingo Iwasaki et al	:
Application No. 09/753,722	: DECISION GRANTING PETITION
Filed: January 4, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 041514-5103	:

This is a decision on the petition, received in the Office of Petitions on February 1, 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 December 15, 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]

The present petition is not signed by an attorney of record. However, in accordance with 37 CFR 1.34, the signature of Mr. Peter J. Sistare 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. If Mr. Sistare 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. Sistare. However, until otherwise instructed, all future correspondence

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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) (along with any balance due at the time of payment), 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).*

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 (571) 272-3218.

This matter is being referred to Technology Center AU 2815 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

cc:

Drinker Biddle & Reath LLP
1500 K Street, N.W., Suite 1100
Washington, DC 20005-1209

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NIKOLAI & MERSEREAU, P.A.
900 SECOND AVENUE SOUTH
SUITE 820
MINNEAPOLIS MN 55402

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OFFICE OF PETITIONS

In re Application of	:	
Zhang et al.	:	
Application No. 09/753,738	:	ON PETITION
Filed: January 2, 2001	:	
Attorney Docket No. 970663.CIP	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed October 13, 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 and 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 3700 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

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WINSTON & STRAWN
PATENT DEPARTMENT
1400 L STREET N.W.
WASHINGTON, DC 20005-3502

MAIL

MAR 1 4 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Alma K. Schurig :
Application No. 09/753,747 : DECISION ON REQUEST TO
Filed: December 27 2000 : WITHDRAW AS ATTORNEY
For: COMBINATION POWER AND FULL :
DUPLEX DATA CABLE :
:

This is a decision on the Request to Withdraw as Attorney/Agent of record received October 18, 2004.

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.

Attorney/Agent requesting the withdrawal is not of record.

For the reason stated above the request is **DISMISSED AS MOOT.**

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

Kenneth Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: Kenneth R. Allen
TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834

UNITED STATES PATENT AND TRADEMARK OFFICE

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CARR & FERRELL LLP
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PALO ALTO, CA 94303

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OFFICE OF PETITIONS

In re Application of
Scott D. REDMOND
Application No. 09/753,768
Filed: January 2, 2001
Attorney Docket No. PA4181US

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March 29, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed, August 16, 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 November 17, 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 $750; and (3) an adequate 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.

Telephone inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735.

This application is being referred to Technology Center AU 2617 for appropriate action by the Examiner in the normal course of business on the reply received

April Wise
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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NORTH OAKS PATENT AGENCY
45 ISLAND ROAD
NORTH OAKS, MN 55127

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FEB 04 2009

OFFICE OF PETITIONS

In re Application of :
Cyrus Kurosh Samari :
Application No.: 09/753,792 : ON PETITION
Filed: January 3, 2001 :
Attorney Docket No. S99-002-02-US :

This is a decision on the petition under 37 CFR 1.182, filed September 18, 2008, to change the name of sole inventor "Kurosh Samari-Kermani" to – Cyrus Kurosh Samari --.

The petition is **GRANTED**.

Office records have been updated to reflect the inventor's name change. A corrected Filing Receipt, which correctly reflects the inventor's name, accompanies this decision on petition.

As authorized, the $400 fee for the petition under 37 CFR 1.182 has been assessed to petitioner's credit card.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204. Any questions concerning the examination procedures or status of the application should be directed to the Technology Center.

This application is being referred to Technology Center AU 2625 for further prosecution.

/SDB/

Sherry D. Brinkley
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
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
09/753,792	01/03/2001	2625	355	S99-002-02-US	14	2

CONFIRMATION NO. 1961

CORRECTED FILING RECEIPT

54092
NORTH OAKS PATENT AGENCY
45 ISLAND ROAD
NORTH OAKS, MN 55127

OC000000034372716

Date Mailed: 02/03/2009

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 submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Applicant(s)

Cyrus Kurosh Samari, Eagan, MN;

Power of Attorney: The patent practitioners associated with Customer Number 54092

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/205,751 05/19/2000

Foreign Applications

If Required, Foreign Filing License Granted: 04/26/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 09/753,792**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No
**** SMALL ENTITY ****

Title

Medical data recording system

Preliminary Class

358

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

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Alexandria, VA 22313-1450
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AGILENT TECHNOLOGIES, INC.
INTELLECTUAL PROPERTY ADMINISTRATION, LEGAL DEPT.
P.O. BOX 7599
M/S DL429
LOVELAND CO 80537-0599

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MAY 04 2005

OFFICE OF PETITIONS

In re Patent No. 6,433,780	: DECISION GRANTING PETITION
Issued: August 13, 2002	: UNDER 37 CFR 1.78(a)(3) AND
Application No. 09/753,805	: REQUEST FOR CERTIFICATE OF
Filed: January 2, 2001	: CORRECTION
Attorney Docket No. 10980359-6	:

This is a decision on the petition filed November 26, 2004, which is being treated as a petition under 37 CFR 1.78(a)(3) seeking to add a claim for priority on the front page of the Letters Patent by way of a Certificate of Correction to prior-filed nonprovisional Application No. 08/540,355, filed October 6, 1995.

The petition is **granted**.

A review of the file record fails to disclose that a claim for the benefit of priority to the above-noted, prior-filed nonprovisional application was made within the time period set forth in 37 CFR 1.78(a)(2)(ii) and further failed to include a proper reference to the prior-filed application as required by 37 CFR 1.78(a)(2)(i) and 1.78(a)(2)(iii).

The instant application was filed January 2, 2001. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3), along with submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed nonprovisional application after issuance of the application into a patent. *See* MPEP 1481, Rev. 2, May 2004, page 1400-85, second column.

As the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

A corrected Filing Receipt, which includes the priority claim to the above-noted, prior-filed nonprovisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Senior Petitions Attorney Christina Tartera Donnell at (571) 272-3211.

This matter is being referred to the Certificates of Correction Branch for processing the request for a Certificate of Correction.

Frances Hicks

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

ATTACHMENT: Corrected Filing Receipt

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : October 29, 2007

TO SPE OF : ART UNIT 2637

SUBJECT : Request for Certificate of Correction for Appl. No. 09/753913 patent No.: 6954489

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: _____

Chris Kelley

SPE

2611

Art Unit

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. 9

Stephan V. Stein
HOLLAND & KNIGHT LLP
P.O. Box 1288
Tampa, Florida 33601-1288

MAILED

FEB 17 2004

Technology Center 2100

In re Application of:	)	
David Allen Peterson	)	
Application No. 09/753,934	)	**DECISION ON REQUEST FOR**
Filed: January 3, 2001	)	**WITHDRAWAL AS ATTORNEY**
For: THIN CLIENT COMPUTER OPERATING SYSTEM	)	

This is a decision on the Request To Withdraw from Representation filed January 09, 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 January 09, 2004 meets all the requirements. Accordingly the request is **GRANTED**.

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

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

cc: David A. Peterson
TEKRESOURCE SERVICE CORPORATION
123 N. Orchard Avenue, Suite 1C
Ormond Beach, Florida 32174

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)
6594050	2003-07-15	09753979	2001-01-03	100.195

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)	2007-10-04
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.

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. 6594050
Issue Date: July 15,2003
Application No. 09753979
Filed: January 3,2001
Attorney Docket No. 100.195

:

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

:

This is a decision on the electronic petition, filed October 4,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 4,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

NOTICE RE: CERTIFICATES OF CORRECTION

DATE : 5/19/05 **Paper No.:** _____

TO : **Supervisor, Art Unit** 2127

SUBJECT : Certificate of Correction Request in Patent No.: 09/753,998 6,868,447 B2

A response to the following question is requested with respect to the accompanying request for a certificate of correction.

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

G Green

PLEASE COMPLETE THIS FORM AND RETURN WITH FILE, WITHIN 7 DAYS, TO CERTIFICATES OF CORRECTION BRANCH - PK 3-915/922 PALM LOCATION 7580 - TEL. N0. 305-8309

THANK YOU FOR YOUR ASSISTANCE!

Note your decision by placing a check mark in the appropriate box below, indicating whether all changes requested in the Request for Certificate of Correction should be applied. Please specify which changes should not be applied and indicate the reason(s) for denial, in the "Comments" section below.

☒ **YES** ☐ **NO**

☐ **Comments:** _____

C. Rones — **Supervisor**

2164 — **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. : 6,868,414 B2

DATED : Mar. 15, 2005

INVENTOR(S) : Khanna, Sanjay 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 7,
Line 29, change "the CD" to – the CS –;
Line 57, change "research" to – re-search –.

Column 15,
Line1, change "modification" to – modifications –;
Line 2, change "date" to – data –;
Line 7, change "fist" to – first –;
Line 45, change "preforming" to – performing –.

Column 16,
Line 51, change "serializing the update tree" to
– serialing a record describing the update to the update tree;
switching the update tree –;
Line 59, change "preformed" to – performed –.

MAILING ADDRESS OF SENDER:
IBM Corporation / IP Law Dept.
Dept. T81B/Bldg. 503
P. O. Box 12195
Research Triangle Park, NC 27709

PATENT NO. 6,868,414

No. of additional copies

Page 1 of 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.

US006868414B2

(12) United States Patent
Khanna et al.

(10) Patent No.: US 6,868,414 B2
(45) Date of Patent: Mar. 15, 2005

(54) TECHNIQUE FOR SERIALIZING DATA STRUCTURE UPDATES AND RETRIEVALS WITHOUT REQUIRING SEARCHERS TO USE LOCKS

(75) Inventors: **Sanjay Khanna**, Cary, NC (US); **Lori Ann Napoli**, Cary, NC (US)

(73) Assignee: **International Business Machines Corporation**, Armonk, NY (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 231 days.

(21) Appl. No.: **09/753,992**

(22) Filed: **Jan. 3, 2001**

(65) **Prior Publication Data**

US 2002/0087564 A1 Jul. 4, 2002

(51) **Int. Cl.**[7] **G06F 17/30**
(52) **U.S. Cl.** **707/3**; 707/2; 707/8; 707/201
(58) **Field of Search** 707/2, 3, 8, 201

(56) **References Cited**

U.S. PATENT DOCUMENTS

4,627,019	A	* 12/1986	Ng	707/8
5,497,487	A	* 3/1996	Fortier	707/8
5,852,715	A	* 12/1998	Raz et al.	709/201
6,006,216	A	* 12/1999	Griffin et al.	707/2
6,199,069	B1	* 3/2001	Dettinger et al.	707/202
6,353,820	B1	* 3/2002	Edwards et al.	707/2
6,360,219	B1	* 3/2002	Bretl et al.	707/8
6,377,959	B1	* 4/2002	Carlson	707/202
6,480,854	B1	* 11/2002	Gross et al.	707/10
6,535,869	B1	* 3/2003	Housel, III	707/2
2002/0004799	A1	* 1/2002	Gorelik et al.	707/201

OTHER PUBLICATIONS

"Serialization of AVL–Binary Tree Element Retrieval via Duplexed Pointers", Mar. 1992, IBM Technical Disclosure Bulletin, No. 10B, pp. 138–139.*

IBM Technical Disclosue Bulletin, "Serialization of AVL Binary Tree Element Retrieval via Duplexed Pointers", Mar. 1992, pp. 138–139.

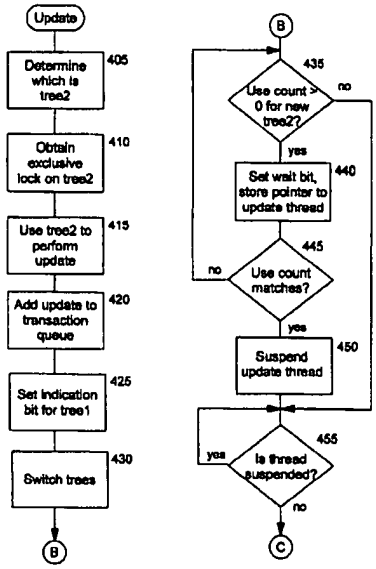
* cited by examiner

Primary Examiner—Shahid Alam
Assistant Examiner—Chongshan Chen
(74) *Attorney, Agent, or Firm*—Marcia L. Doubet; Jerry W. Herndon

(57) **ABSTRACT**

The present invention provides a method, system, and computer program product for reliably and efficiently serializing access to data structures (i.e. updates and retrievals) without requiring searchers to use locks. The disclosed technique ensures that the contents of the data structure remain valid during access operations, yet does not require searchers to perform compute-intensive comparison operations to determine validity. Two trees are used at all times. Searches proceed against a first tree, while the second tree is used for performing updates. The steps required to carry out a particular update operation are stored as a queued transaction. When the update to the second tree completes, the trees are switched. The queued transaction is applied to the now-out-of-date tree, such that the nodes of this tree do not need to be searched or otherwise evaluated in order to perform the update, thereby optimizing the process of bringing this tree into synchronization with the tree that is now being used by the searchers. The two trees are repeatedly switched as additional update operations are performed. Atomic operations are used to ensure proper synchronization between the search and update processing on the trees.

19 Claims, 6 Drawing Sheets



SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : July 7, 2006

TO SPE OF : ART UNIT 3617

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/753998 Patent No.: 6,996,578 B2

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: The foreign patent number (DE 19632499 A1) at page 1, column 1, line 2 is correct. No correction is required.

[signature] AU 2166

SPE **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

July 24, 2006

FILE COPY

Patent No. : 6,996,578 B1
Ser. No. : 09/753998
Inventor(s) : Okada, et al.
Issued : February 7, 2006
Title : **WORK STANDARD CREATION SYSTEM AND METHOD, DISTRIBUTED CLIENT/SERVER SYSTEM, AND COMPUTER AND COMPUTER PROGRAM STORAGE MEDIUM**
Docket No. : 1232-4670

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.

Comparison of the patent in column 2, line 2, (under FOREIGN PATENT DOCUMENTS), with the corresponding location in the application file reveals that there is no discrepancy. The foreign patent number DE 19632499 A1 at page 1, column 2, line 2 is correct. No correction is required.

In view of the foregoing, your request is hereby denied.

Elisha Evans
For Cecelia Newman, Supervisor
Decisions & Certificates
of Correction Branch
(703) 308-9390 ext. 110

MORGAN & FINNEGAN, L.L.P.
3 WORLD FINANCIAL CENTER
NEW YORK NY 10281-2101

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

John F. A. Earley III
86 The Commons At Valley Forge East
1288 Valley Forge Road
P.O. Box 750
Valley Forge PA 19482-0750

COPY MAILED

MAR 3 1 2005

OFFICE OF PETITIONS

In re Application of
Mark E. Dillon
Application No. 09/754,010
Filed: January 3, 2001
Attorney Docket No. E-1950
Title: NOVEL WOUND DRESSING, PROCESS OF MANUFACTURE AND USEFUL ARTICLES THEREOF

DECISION GRANTING PETITION UNDER 37 C.F.R. §1.137(b)

This is a decision on the petition filed December 27, 2004, 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 21, 2003, which set a shortened statutory period for reply of three (3) months. On May 27, 2003, an amendment was received, which contained a certificate of mailing dated May 21, 2003. On June 2, 2003, an advisory action was mailed, indicating that the amendment failed the place the application in condition for allowance. On October 31, 2003, a second after-final amendment was received[2] along with a two-month extension of time, and a second advisory action was mailed November 24, 2003. No further extensions of time were received. Accordingly, the above-identified application became abandoned on July 28, 2003. A notice of abandonment was mailed March 24, 2004.

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.

2 The second after-final amendment contained a certificate of mailing dated June 27, 2003.

With the instant petition, petitioner has filed the petition fee, a Request for Continued Examination (RCE) under 37 C.F.R. §1.114, as well as the associated fee, and has made the proper statement of unintentional delay. The RCE has been accepted as the required reply under 37 C.F.R. §1.137(b)(1). The amendment, previously filed on October 31, 2003, shall serve as the required submission.

As such, the petition is **GRANTED**.

After this decision is mailed, the application will be forwarded to Technology Center 1600 for consideration of the submission under 37 C.F.R. §1.114, the previously filed amendment.

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

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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 7

Hickman Palermo Truong & Becker, LLP
1600 Willow Street
San Jose, California 95125-5106

MAILED

NOV 1 3 2001

Technology Center 2100

In re Application of: Mallik Kotamarti)
Application No. 09/754,012)
Filed: January 2, 2001) **DECISION ON REQUEST FOR**
For: INCORPORATING NON-NATIVE) **WITHDRAWAL AS ATTORNEY**
USER INTERFACE MECHANISMS)
INTO A USER INTERFACE)

This is a decision on the Request To Withdraw from Representation filed September 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

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

cc: Mr. Mallik Kotamarti
7804 Robindell Way
Cupertino, California 95014

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

PERKINS COIE
POST OFFICE BOX 1208
SEATTLE, WA 98111-1208

COPY MAILED

APR 3 0 2003

OFFICE OF PETITIONS

In re Application of	:	
Jeff Nordstrom et al	:	
Application No. 09/754,014	:	NOTICE
Filed: January 3, 2001	:	
Attorney Docket No. 260/056	:	

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 1636.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
WASHINGTON, D.C. 2023
www.uspto.go

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK NY 10023

COPY MAILED

MAR 0 6 2003

OFFICE OF PETITIONS

In re Application of
De Fabrega
Application No. 09/754,021
Filed: January 3, 2001
Attorney Docket No. U 012900-8

:DECISION ON PETITION
:UNDER 37 CFR 1.182

This is a decision on the petition filed June 18, 2001, to delete the priority claim to Panamanian Patent Application No. PI/PA00/084971 filed June 16, 2000, and U.S. Provisional Application 60/219,827 filed on July 21, 2000, to recalculate the publication date and Paris convention time periods and to expunge the certified copy of the Panamanian Patent Application from the file wrapper of the instant application. The petition included a copy of a new declaration which omits the foreign priority claim so as to delete the claim for priority.

The petition is **granted-in-part**.

The request to delete the priority claim to Panamanian Patent Application No. PI/PA00/084971 filed June 16, 2000, and the benefit claim to U.S. Provisional Application 60/219,827, filed on July 21, 2000, is granted. It is noted that applicant had not amended the first sentence of the specification to claim the benefit of the provisional application as required by 35 U.S.C. 119(e), so no amendment is necessary to cancel the reference. A replacement filing receipt is attached showing that the claims have been removed. The publication date has not been recalculated, however, since the application published on December 20, 2001 as United States Patent Application 2001/0054019 A1.

The certified copy of the Panamanian Patent Application will not be expunged from the file wrapper of the instant application because there is no showing that the priority document was submitted in the wrong application, or that it contains proprietary information. Furthermore, since the application has already published, the prior application has already been made public and it would not be appropriate to expunge the document from the patent application. See MPEP §§ 724.02, 724.05 and 724.06.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(c)(7). The required $130 petition fee was required for consideration of this petition, and will not be refunded.

Any inquiries concerning this decision may be directed to Mark Polutta at (703) 308-8122.

This application is being forwarded to Technology Center Art Unit 2624 to await further examination in due course.

KF

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

Approved for use through 04/30/2009. OMB 0651-0016
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays valid OMB control number.

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6,783,812	2004-08-31	09754033	2001-01-03	DISP-000900US

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	/Don D. Cha/	Date (YYYY-MM-DD)	2008-12-11
Name	Don D. Cha	Registration Number	40945

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. 6783812
Issue Date: August 31,2004
Application No. 09754033
Filed: January 3,2001
Attorney Docket No. 85-00

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

This is a decision on the electronic petition, filed December 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 December 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 the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 15

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO,CA 94111-3834

COPY MAILED
AUG 24 2004
OFFICE OF PETITIONS

In re Application of :
Iwanczyk, et al. :
Filed: January 3, 2001 : ON PETITION
Application No. 09/754,103 :
Docket No.: 020039000310 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 15, 2004, to revive the above-identified application.

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

This application became abandoned June 10, 2003 for failure to timely file a proper response to the Office communication mailed May 9, 2003. The Office communication set a one (1) month shortened statutory period of time for response. No extensions of time in accordance with 37 CFR 1.136(a) were timely obtained. Notice of Abandonment was mailed November 18, 2003.

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 reply to the Office communication mailed May 9, 2003 is accepted as having been unintentionally delayed.

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 request for three month extension of time submitted herewith was filed

subsequent to the maximum period obtainable for reply, this fee is unnecessary. Petitioner may request a refund of the previously submitted $1,005.00 extension of time fee by writing to the Finance Office, Refund Section. A copy of this decision should accompany any request for refund.

This application file is being forwarded to Technology Center 3700 for further processing.

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 9/19/07 Paper No.: ____

TO SPE OF : ART UNIT 3726

SUBJECT : Request for Certificate of Correction on Patent No.: 6880244 B2

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

Please complete this form and return with file, within 7 days to:
Palm location **7580, Certificates of Correction Branch – South Tower – 9A22**
If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**
With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction (COCIN)? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Valerie Jackson

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 114

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

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

Comments:
Requested Corrections change the scope of the claims.

David P. Bryant 9/24/07
DAVID P. BRYANT
SUPERVISORY PATENT EXAMINER
SPE

3726
Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 09/26/08

TO SPE OF : ART UNIT 2628

SUBJECT : Request for Certificate of Correction for Appl. No.: 09754147 Patent No.: 7362331 B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

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: _____

_____

_____

_____

_____

SPE Michael Razavi Art Unit 2628

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

WENDI R. SCHEPLER
CARR & FERRELL
2225 EAST BAYSHORE ROAD
SUITE 200
PALO ALTO, CA 94303

COPY MAILED
MAY 24 2002
OFFICE OF PETITIONS

In re Application of	:	
Yoram Nelken et al	:	
Application No. 09/754,179	:	NOTICE
Filed: January 3, 2001	:	
Attorney Docket No. PA1438US	:	

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 2121.

Wan Layton
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

MAIL

FEB 12 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 4

Winston Hsu
SF. 389, FU-HO ROAD
YUNGHO CITY, tAIPEI
TAIWAN

In re Application of:
Shye-Lin Wu
Application No.: 09/754,220
Filed: January 5, 2001
For: OPTICAL PROXIMITY CORRECTION ALGORITHM FOR PATTERN TRANSFER

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request to Withdraw from Representation filed August 18, 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 agnet.

The singer of the petition, Mord Michael Lewis is not appointed as an attorney or agent of record. Therefor he is not authorized to act on behalf of the attorneys or record, nor can he effect a change of address.

For the above stated reasons, the request is **DISMISSED AS MOOT**.

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

James R. Matthews
7m Vincent N. Trans
Special Programs Examiner
Technology Center 2100
Computer Architectureand 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

PILLSBURY WINTHROP, LP
P.O. BOX 10500
MCLEAN VA 22102

COPY MAILED

DEC 3 0 2003

OFFICE OF PETITIONS

In re Application of
Van Benthem et al 154
Application No. 09/~~545~~,243
Filed: January 5, 2001
Attorney Docket No. 030268-0275922

DECISION GRANTING PETITION
UNDER 37 CFR 1.182

This is a decision on the petition filed November 10, 2003, requesting under 37 CFR 1.182 that the acceptance of the terminal disclaimer filed July 17, 2002, be withdrawn The $130 petition fee has been received.

The petition is **granted**.

Petitioners assert that as the claims for which the aforementioned terminal disclaimer was originally proffered have now been amended to remove the basis for the previous obviousness-type double patenting rejection, there is no further need for the disclaimer to remain recorded against this application. The undersigned has consulted with the examiner in charge of this application, and has found that the examiner concurs with petitioners' assertion. Accordingly, the terminal disclaimer is withdrawn. USPTO records for the above-identified application have been changed consistent with this decision.

Telephone inquiries related to this decision should be addressed to the undersigned at (703) 305-1820.

Brian Hearn

Brian Hearn
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

PTO/SB/66 (03-09)
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PETITION TO ACCEPT UNINTENTIONALLY DELAYED PAYMENT OF MAINTENANCE FEE IN AN EXPIRED PATENT (37 CFR 1.378(c))

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6875098	2005-04-05	09754322	2001-01-05	201184USMF

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	/Marvin J. Spivak/	Date (YYYY-MM-DD)	2009-06-08
Name	Marvin J. Spivak	Registration Number	24913

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. 6875098
Issue Date: April 5,2005
Application No. 09754322
Filed: January 5,2001
Attorney Docket No. 201184US3

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

This is a decision on the electronic petition, filed June 8,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

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

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

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 20231

4/16/06

Patent No. :7053475
Inventor(s) : Masastoshi AKAGAWA
Issued : 5/30/06
Title : SEMICONDUCTOR DEVICE AND MANUFACTURING METHOD THEREFOR
Atty.doc./File No.

Request for Certificates of Correction

Consideration has been given to your request for the issuance of a Certificate of Correction, for the above – identified patent under the provisions of CFR 1.322.

Inspection of the application for the patent reveals that the columns 12, line 3, is printed in accordance with the record. Therefore being no fault on the Patent and Trademark Office, It has no authority to issue a certificate of correction under the provision of 1.322.

In view of the forgoing, your request in this matter, is hereby denied. However the remaining of the corrections will be corrected.

Future written correspondence concerning this matter should be filed and directed to Decisions & Certificates of Correction Branch.

Henry Randall
Cecelia Newman
Decisions & Certificates
of Correction Branch
(703) 308-9390 Ext. 108

STAAS & HALSEY LLP
1201 New York Avenue, N.W.
7th Floor
Washington, DC 20005

HR/CBN

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www.uspto.gov

Paper No. 11

John S Beulick
Armstrong Teasdale LLP
One Metropolitan Square
St. Louis MO 63102

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OCT 1 1 2002

OFFICE OF PETITIONS

In re Application of
Daum,
Application No. 09/754,419
Filed: January 5, 2001
Attorney Docket No. 9D-RG-19394-Daum
For: ARBITRATING CLOCK SYNCHRONIZATION SYSTEM

ON PETITION

This is a decision on (1) the petition under 37 CFR 1.181 for withdrawal of the holding of abandonment and (2) the petition under 37 CFR 1.137(b) for revival of an unintentionally abandoned application. Both petitions were filed on June 26, 2002 in the same paper.

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

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

The above-identified application became abandoned for failure to timely submit filing fees, a signed oath or declaration, and a $130.00 surcharge for the late filing of the signed oath or declaration in reply to the April 3, 2001 Notice to File Missing Parts of Nonprovisional Application (Notice), which set an extendable two month period for reply. No reply being received by the Office, the above-identified application became abandoned on June 4, 2001. The mailing of this decision precedes the mailing of A Notice of Abandonment.

An allegation that an Office action was not received may be considered as a petition for the withdrawal of the holding of abandonment. If the allegation is adequately supported, the petition may be granted and a new Office action mailed. The showing required to establish nonreceipt of an Office communication must include:

1. A statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.
2. 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.[1]

A review of the record indicates no irregularity in the mailing of the April 3, 2001 Notice, and in the absence of any irregularity there is a strong presumption that the communication was properly mailed to applicants at the correspondence address of record. This presumption may be overcome by a showing that the aforementioned communication was not in fact received.

---

[1] See notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993). *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

The showing presented in the instant petition is not sufficient to withdraw the holding of abandonment because a party with first hand knowledge of the alleged non-receipt of the April 3, 2001 Notice has not made a statement as to whether or not the Notice was received. The current attorney of record in St. Louis, Missouri attests to the fact that a thorough search of the application file was conducted. However, it is the staff at General Electric, located in Louisville, Kentucky, who actually would have received and processed the communication at issue. General Electric is the only party that can explain the docketing procedure and attest to the fact that the April 3, 2001 Notice was not received. A statement by General Electric is required in order to show non-receipt at the correspondence address of record around the time the Notice was mailed.

Accordingly, the petition under 37 CFR 1.181 is **dismissed**.

The petition under 37 CFR 1.137(b) is **granted**. The Offices acknowledges receipt a signed declaration and the surcharge for the late filing of the signed declaration.

Regarding the issue of Figures 5 and 6 being omitted from the original filing, applicants have not shown that Figures 5 and 6 were present on filing. Thus, the application will not be processed with Figures 5 and 6 as part of the original disclosure. The Amendment entitled, "REQUEST FOR APPROVAL OF DRAWING CHANGES," filed June 26, 2002 will be reviewed by the examiner of record for new matter.

The application will be returned to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
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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LOWRIE, LANDO & ANASTASI, LLP
ONE MAIN STREET, SUITE 1100
CAMBRIDGE MA 02142

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AUG 26 2008

In re Application of	:	
G. Stephen Legraw	:	
Application No. 09/754,492	:	ON PETITION
Filed: January 4, 2001	:	
Attorney Docket No. S144.101.102	:	

This is a decision on the petition under 37 CFR 1.137(b), filed October 30, 2007, to revive the above-identified application, with a supplemental petition filed July 25, 2008..

The petition is **GRANTED.**

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed December 5, 2006, 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 1.197(b). As no claim was allowed, the application became abandoned on February 6, 2007. See MPEP 1215.04.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE), fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $770; and (3) an adequate statement of unintentional delay.

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

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 Terri Williams at (571) 272-2991.

The application file is being referred to Technology Center AU 3692 for appropriate action on the concurrently filed RCE and amendment.

Chris Bottorff
Petitions Examiner
Office of Petitions

cc: **G. Stephen LeGraw**
DICKE, BILLIG, & CZAJA, PLLC
Fifth Street Towers, Suite 2250
100 South Fifth Street
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 10

John S Beulick
Armstrong Teasdale LLP
One Metropolitan Square
St. Louis MO 63102

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OCT 1 1 2002

OFFICE OF PETITIONS

In re Application of
Tupis
Application No. 09/754,541
Filed: January 5, 2001
Attorney Docket No. 9D-HR-19690-Tupis
For: SEALED DAMPER ASSEMBLY

ON PETITION

This is a decision on (1) the petition under 37 CFR 1.181 for withdrawal of the holding of abandonment and (2) the petition under 37 CFR 1.137(b) for revival of an unintentionally abandoned application. Both petitions were filed on May 17, 2002 in the same paper.

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

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

The above-identified application became abandoned for failure to timely submit substitute drawings, a signed oath or declaration, and a $130.00 surcharge for the late filing of the signed oath or declaration in reply to the February 15, 2001 Notice to File Missing Parts of Nonprovisional Application (Notice), which set an extendable two month period for reply. No reply being received by the Office, the above-identified application became abandoned on April 16, 2001. The mailing of this decision precedes the mailing of A Notice of Abandonment.

An allegation that an Office action was not received may be considered as a petition for the withdrawal of the holding of abandonment. If the allegation is adequately supported, the petition may be granted and a new Office action mailed. The showing required to establish nonreceipt of an Office communication must include:

1. A statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received.
2. 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.[1]

A review of the record indicates no irregularity in the mailing of the February 15, 2001 Notice, and in the absence of any irregularity there is a strong presumption that the communication was properly mailed to applicants at the correspondence address of record. This presumption may be overcome by a showing that the aforementioned communication was not in fact received.

---

[1] See notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993). *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

The showing presented in the instant petition is not sufficient to withdraw the holding of abandonment because a party with first hand knowledge of the alleged non-receipt of the February 15, 2001 Notice has not made a statement as to whether or not the Notice was received. The current attorney of record in St. Louis, Missouri attests to the fact that a thorough search of the application file was conducted. However, it is the staff at General Electric, located in Louisville, Kentucky, who actually would have received and processed the communication at issue. General Electric is the only party that can explain the docketing procedure and attest to the fact that the February 15, 2001 Notice was not received. A statement by General Electric is required in order to show non-receipt at the correspondence address of record around the time the Notice was mailed.

Accordingly, the petition under 37 CFR 1.181 is **dismissed**.

The petition under 37 CFR 1.137(b) is **granted**. The Offices acknowledges receipt of a sheet of substitute drawings, a signed declaration, and the surcharge for the late filing of the signed declaration.

The application will be returned to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 5

David H. Blount
6728 Del Cerro Blvd.
San Diego, CA 92120

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NOV 1 2 2003

OFFICE OF PETITIONS

In re Application of :
David H. Blount :
Application No. 09/754,580 : ON PETITION
Filed: January 5, 2001 :
Attorney Docket No. n/a :

This is a decision on the petition under 37 CFR 1.137(b, filed October 24, 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 to File Missing Parts of Application (Notice) mailed April 5, 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 have been obtained. Accordingly, the application became abandoned on June 6, 2001.

Any further petition to revive 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 "Petition under 37 CFR 1.137." 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;[1] (2) the petition fee as set forth in 37 CFR 1.17(l); (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 pursuant to 37 CFR 1.137(c). The instant petition lack(s) item(s) (1).

As to item (1), Petitioner has submitted a petition to revive on the grounds of unintentional delay accompanied by a $55 petition fee. Effective October 1, 2003, the small entity petition fee

[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.

required for revival of an application under the unintentional provisions of 37 CFR 1.137(b) is $665. Accordingly, a balance due of $610 is required before revival of the application can be effected.

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

By mail: Mail Stop Petitions
PO 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 concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond

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

DA 8 #6

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Paper No. 5

David H. Blount
6728 Del Cerro Blvd.
San Diego, CA 92120

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NOV 1 2 2003
OFFICE OF PETITIONS

In re Application of
David H. Blount
Application No. 09/754,580
Filed: January 5, 2001
Attorney Docket No. n/a

ON PETITION

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OFFICE OF PETITIONS

This is a decision on the petition under 37 CFR 1.137(b, filed October 24, 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 to File Missing Parts of Application (Notice) mailed April 5, 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 have been obtained. Accordingly, the application became abandoned on June 6, 2001.

Any further petition to revive 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 "Petition under 37 CFR 1.137." 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;[1] (2) the petition fee as set forth in 37 CFR 1.17(l); (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 pursuant to 37 CFR 1.137(c). The instant petition lack(s) item(s) (1).

As to item (1), Petitioner has submitted a petition to revive on the grounds of unintentional delay accompanied by a $55 petition fee. Effective October 1, 2003, the small entity petition fee

[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.

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required for revival of an application under the unintentional provisions of 37 CFR 1.137(b) is $665. Accordingly, a balance due of $610 is required before revival of the application can be effected.

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

By mail: Mail Stop Petitions
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Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

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

Latrice Bond

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

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Paper No. 9

John S. Beaulick
Armstrong Teasdale LLP
One Metropolitan Square
Suite 2600
St. Louis, MO 63102

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SEP 1 1 2002

OFFICE OF PETITIONS

In re Application of :
Holmes et al. :
Application No. 09/754,592 :
Filed: January 5, 2001 :
Attorney Docket No. 9D-HR-19412 :

ON PETITION

This is a decision on the petition under 37 CFR 1.181, filed May 20, 2002, to withdraw the holding of abandonment. This is a decision on the alternative petition under 37 C.F.R. § 1.137(b), filed May 20, 2002, to revive the above-identified application.

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

The petition under 37 CFR 1.137(b) 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 February 21, 2001. 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 April 22, 2001.

In order for the holding of abandonment to be withdrawn, petitioner must establish that the Notice was not received at General Electric Company, which was located at the correspondence address of records when the Notice was mailed. If the Notice was lost or misplaced after being received at General Electric Company or during a transfer of the file, then withdrawal of the holding of abandonment is improper.

In the absence of any irregularity in the mailing of the Office action, there is a strong presumption that the Office action was properly mailed. In order to overcome this presumption, a petition alleging non-receipt of an Office action must:
(1) include a statement from practitioner stating that the Office action was not received,
(2) attest that a search of the file jacket has been made,
(3) attest that a search of all relevant docket records has been made,
(4) include a copy of the docket record where the Office action would have been entered had it been received, and
(5) include any additional information which may be required by the Commissioner.
See MPEP 711.03(c)(II).

As to (1), a statement from General Electric has not been supplied. The issue is not whether the current law firm received the Notice, but is whether General Electric ever received the Notice. A statement from General Electric is essential evidence.

As to (3) and (4), the record fails to address whether or not General Electric maintains docket records or a mail log. The record fails to state whether or not all docket records or mail logs maintained by General Electric have been examined. The record fails to supply a copy of such documentation.

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 the Office of Initial Patent Examination for further processing.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

Charles Steven Brantley
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 14

COPY MAILED
FEB 28 2003
OFFICE OF PETITIONS

JOHN S. BEULICK
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102

In re Application of Holmes et al. Application No. 09/754,600 Filed: January 5, 2001 Attorney Docket No. 9D-HR-19406	: : : : :	ON PETITION

This decision concerns the "Petition for Withdrawal of Holding of Abandonment or, in the Alternative, for Revival of an Unintentionally Abandoned Patent Application," filed on May 30, 2002, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment for the above-identified application and, alternatively, a petition under 37 CFR 1.137(b) to revive this application.

The petition under 37 CFR 1.181 is **DISMISSED.**
The alternative petition under 37 CFR 1.137(b) is **DISMISSED.**

This application became abandoned on April 22, 2001 for failure to timely respond to the February 21, 2001 Notice to File Missing Parts of Nonprovisional Application ("2/21/01 Notice"), which provided an extendable 2-month reply period. No extension of time under 37 CFR 1.136(a) was obtained.[1]

§1.181 petition

The petition requests withdrawal of the holding of abandonment on the basis that the 2/21/01 Notice was not received by General Electric Company ("GE").

A grantable petition to withdraw the holding of abandonment, alleging non-receipt of an Office action which is the cause of the abandonment, must overcome a strong presumption that the Office action at issue, duly addressed and indicated as mailed, was timely delivered to the addressee.[2]

The showing required to overcome this presumption consists of:[3]

---

[1] The due date, 4/21/01, was a Saturday. Under 37 CFR 1.7(a), a proper response filed on or before 4/23/01 (Monday) would have been considered "timely." However, failure to do so renders the application abandoned as of 4/22/01.

[2] 1156 OG 53 (Oct. 25, 1993).

[3] *Id.*

(1) a statement from the practitioner:

-stating that the Office action was not received by the practitioner;
-attesting, by referencing the docket record in (2) below, that a search of the relevant file jacket and docket records indicates that the Office action was not received; and

(2) a copy of the docket record where the allegedly non-received Office action would have been docketed had it been received.

Notwithstanding the fact that the instant petition contains essentially the requisite showing as delineated above, the 2/21/01 Notice was addressed and mailed to GE at the correspondence-address-of-record at that time: Appliance Park, 2-225, Louisville, KY 40225.[4] If the file was subsequently transferred to GE's outside counsel, that the 2/21/01 Notice is not presently in the transferred file does not establish GE's non-receipt of the 2/21/01 Notice; nor does it rule out the possibility that the 2/21/01 Notice had been received by GE but was never docketed.[5] The §1.181 petition is thus dismissed and the holding of abandonment in this application will not be withdrawn. No petition fee is owed.

§1.137(b) petition

Under 37 CFR 1.137(b), a grantable petition to revive an abandoned application must be accompanied by: **(1) the required reply,** unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m);[6] (3) a statement that the entire delay in filing the required reply from its due date until the filing of a grantable §1.137(b) petition was unintentional;[7] and (4) a terminal disclaimer for a utility application filed before June 8, 1995.[8]

In reply to the 2/21/01 Notice, the petition encloses a signed Declaration and Power of Attorney, and 71 sheets of substitute drawings. However, some of the substitute drawings do not comply with the requirements of 37 CFR 1.84 as explained in the attached Notice of Draftsperson's Patent Drawing Review. The petition is thus dismissed for failing to meet the threshold requirement of 37 CFR 1.137(b).

---

[4] A request to change the correspondence address for this application to the current outside counsel was not filed until 12/18/01, 10 months later.

[5] See MPEP section 711.03(c)(II) (Aug. 2001).

[6] Enclosed with petition.

[7] Included in petition.

[8] Not applicable to this application.

A renewed §1.137(b) petition (**no fee**) must be:

-accompanied by:
-necessary substitute drawings in compliance with 37 CFR 1.84;[9] **and**
-a **statement** that the entire delay in filing the required drawings from the due date until the filing of a grantable §1.137(b) petition was unintentional;
-filed within **TWO MONTHS** of the mailing date of this decision unless proper extension(s) of time is (are) obtained under 37 CFR 1.136(a);[10]

and should be addressed **(by mail or by hand)** to:[11]

Assistant Commissioner for Patents
USPTO, Office of Petitions
Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

Finally, the Office acknowledges receipt with the instant petition of the $130 surcharge for late filing of the declaration.

Telephone inquiries may be directed to the undersigned at (703) 308-0763.

RC Tang
Petitions Attorney
Office of Petitions

Attachment: 2/27/03 Notice of Draftsperson's Patent Drawing Review (courtesy copy)

---

[9] **Only the sheets of drawings that were objected to by the draftsperson need to be substituted for.**

[10] 37 CFR 1.137(e)(1).

[11] **Filing by facsimile is not an option since drawings are involved.**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 18

JOHN S. BEULICK
ARMSTRONG TEASDALE LLP
ONE METROPOLITAN SQUARE
SUITE 2600
ST. LOUIS, MO 63102

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APR 1 0 2003

OFFICE OF PETITIONS

In re Application of
Holmes et al.
Application No. 09/754,600
Filed: January 5, 2001
Attorney Docket No. 9D-HR-19406

ON PETITION

This decision concerns the March 24, 2003 renewed petition under 37 CFR 1.137(b).

The petition is **GRANTED.**

This application became abandoned on April 22, 2001. A May 30, 2002 petition to revive under 37 CFR 1.137(b) was dismissed on February 28, 2003, in that, some of the substitute drawings in response to a Notice of Missing Parts and submitted with that petition did not comply with the margins requirements of 37 CFR 1.84.

The new set of substitute drawings enclosed with the instant petition have been approved by the draftsperson. The petition is thus granted.

No fee is owed.

The application is now complete.

In addition, receipt on December 12, 2002 of an Information Disclosure Statement is acknowledged.

The application file is being returned to the Office of Initial Patent Examination for further processing, and for issuance of a filing receipt if one has not yet been mailed. Thereafter, The file will be forwarded to the appropriate Technology Center for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 308-0763.

RC Tang
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

KODA & ANDROLIA
2029 CENTURY PARK EAST
SUITE 1140
LOS ANGELES, CA 90067-2983

COPY MAILED

AUG 1 6 2005

OFFICE OF PETITIONS

In re Application of :
Shuzo Yoshii :
Application No. 09/754,625 : ON PETITION
Filed: January 4, 2001 :
Attorney Docket No. 250A 3009 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 21, 2005, to revive the above-identified application.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action mailed May 19, 2004. A Notice of Abandonment was mailed December 8, 2004.

The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee as required by 37 CFR 1.17(b), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) under 37 CFR 114 or the filing of a continuing application. See MPEP 711.03(c)(III)(A)(2).

The amendment submitted with the present petition does not *prima facie* place the application in condition for allowance. See the attached Advisory Action.

Accordingly, 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.

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

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

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

The centralized facsimile number is **(571) 273-8300**.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3204.

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

Attachment: Advisory Action

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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JAN 20 2006

OFFICE OF PETITIONS

KODA & ANDROLIA
2029 CENTURY PARK EAST
SUITE 1140
LOS ANGELES, CA 90067-2983

In re Application of :
Shuzo Yoshii :
Application No. 09/754,625 : ON PETITION
Filed: January 4, 2001 :
Attorney Docket No. 250A 3009 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed October 5, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The application is revived for consideration of a submission under 37 CFR 1.114 (request for continued examination).

Since the requisite petition fee was paid with the original petition on March 21, 2005, no further petition fee is required. Accordingly, the $750 petition fee erroneously charged for the treatment of the present petition is being refunded to counsel's deposit account.

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 3621, for further processing of the request for continued examination under 37 CFR 1.114 filed October 5, 2005.

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
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JAN 2 6 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

OPTV/FENWICK
SILICON VALLEY CENTER
801 CALIFORNIA STREET
NOUNTAIN VIEW, CA 94041

In re application of:
Eric E. Del Sesto, et al.
Application No. 09/754,650
Filed: January 3, 2001
For: ENSURING RELIABLE DELIVERY OF INTERACTIVE CONTENT

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request for withdrawal as attorney/agent and change of correspondence address filed on September 1, 2004

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

Petitioner has satisfied the requirements for successfully requesting withdrawal. Accordingly, the request is **GRANTED.**

All of the attorneys/agents of record have been withdrawn.

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 A. Wieder
Special Program Examiner
Technology Center 2600
Communications
(571) 272-2986

cc: Michael Swift
Ice Miller
One Square, P.O. Box 82001
Indianapolis, IN 46282

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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SCHWEGMAN, LUNDBERG & WOESSNER/OPEN TV
P.O. BOX 2938
MINNEAPOLIS, MN 55402-0938

Mail Date: 05/20/2010

Applicant	: Eric E. Del Sesto	: DECISION ON REQUEST FOR
Patent Number	: 7631338	: RECALCULATION of PATENT
Issue Date	: 12/08/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 09/754,650	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/03/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **933** 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
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Paper No. 8

DOUGLAS J. HURA, ESQUIRE
DENTSPLY INTERNATIONAL INC.
570 WEST COLLEGE AVENUE
YORK PA 17405

COPY MAILED

AUG 2 7 2002

OFFICE OF PETITIONS

In re Application of :
Rinaldi et al :
Application No. 09/754,663 : ON PETITION
Filed: January 4, 2001 :
Attorney Docket No. GEN-802 :

BEST AVAILABLE COPY

This is a decision on the petition under 37 CFR 1.137(b), filed May 13, 2002, to revive the above-identified application.

The petition is GRANTED.

This application became abandoned for failure to respond in a timely manner to the Notice to File Missing Parts of Nonprovisional Application (Notice) mailed April 27, 2001. The Notice set a period for response of Two (2) months from the date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) having been obtained, the date of abandonment of this application is June 28, 2001.

Pursuant to 37 CFR 1.136, an extension of time must be filed prior to the expiration of the maximum period obtainable for reply to avoid abandonment. Accordingly, since the request for an extension of time fee submitted with the petition was subsequent to the maximum period obtainable for reply, the $920 fee is unnecessary and will be credited to petitioner's deposit account 04-0780.

Additionally, the filing of a terminal disclaimer is unnecessary as a condition for revival pursuant to the provisions of 37 CFR 1.137(d)(3) in effect at time of filing the instant petition. Therefore, the terminal disclaimer filed with the petition will not be processed.

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

The application file is being forwarded to Office of Initial Patent Examination Division for further processing.

Karen Creasy

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

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Vorys, Sater, Seymour & Pease
1828 L Street, NW
Eleventh Floor
Washington, D.C. 20036

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OFFICE OF PETITIONS

In re Application of
Christian M. Hoebener
Application No.: 09/754,716
Filed: January 4, 2001
Attorney Docket No.: DAL0002.01
For: MOUNT FOR TV MONITOR

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 February 21, 2006.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit formal drawings in a timely manner in reply to the Notice of Allowance mailed December 21, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-entitled application became abandoned at midnight on March 21, 2005.

On February 21, 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) petition fee; (2) the required statement of unintentional delay; and (3) the required reply in the form of the corrected drawing sheets. Accordingly, the corrected drawing sheets 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.

Anthony Smith
Attorney-Advisor
Office of Petitions/Office of PCT Legal Administration
Telephone: (571) 272-3298
Facsimile: (703) 273-6459

#9
DW

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

JUN 11 2003

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JUN 11 2003

OFFICE OF THE DIRECTOR
TC 3600

Marshall, Gerstein & Borun
6300 Sears Tower
233 South Wacker
Chicago, IL 60606-6357

In re Application of
Jimmy Randolph Lewis et al.
Application No. 09/754,762
Filed: January 4, 2001
For: METHOD AND APPARATUS FOR FILLING STOCK ORDERS

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in response to applicants' petition to withdraw the holding of abandonment, filed in the United States Patent and Trademark Office on February 20, 2003 and supplemented on June 4, 2003.

The petition is **GRANTED**.

A review of the file record indicates that an Office action was mailed to applicants on August 15, 2002 wherein a one-month shortened statutory period for response was set. Since no timely response to the August 15, 2002 Office action was received, the application was held to be abandoned, although a Notice of abandonment has not yet been mailed.

Applicants' petition includes a copy of a response bearing a Certificate of Facsimile Transmittal date of September 16, 2002. A statement by Brent E. Matthias was received on June 4, 2003, which attests to the personal knowledge of the transmission of the response on the date indicated on the Certificate of Facsimile Transmittal. This is sufficient evidence of a timely response.

Since a timely response to the Office action was filed, the holding of abandonment is withdrawn and the application is restored to pending status. The application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response filed with the petition, and then to the Examiner for prompt action on the merits of the application.

Randolph A. Reese

Randolph A. Reese, Special Programs Examiner
Patent Technology Center 3600
Telephone No.: (703) 308-2121
Facsimile No.: (703) 605-0586

RAR/tpl: 6/9/03

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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ROCHELLE K. SEIDE
BAKER BOTTS LLP
30 ROCKERFELLER PLAZA
NEW YORK, NY 10112

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JUL 0 9 2007

OFFICE OF PETITIONS

In re Application of	:	
GRAINGER, et al.	:	
Application No. 09/754,775	:	DECISION ON PETITION
Filed: January 4, 2001	:	TO WITHDRAW
Attorney Docket No. **295.009US3**	:	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 December 21, 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 Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). The reasons set forth in the request "file transferred" does not meet any of the conditions set forth in 37 CFR 10.40.

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 the undersigned at 571-272- 7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **SCHWEGMAN LUNDBERG WOESSNER & KLUTH**
1600 TCF TOWER
121 S. EIGHTH STREET
MINNEAPOLIS, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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MAY 11 2004

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON MA 02110

In re Application of	:
Herman Oppermann et al.	:
Serial No.: 09/754,831	: PETITION TO MAKE SPECIAL
Filed: January 3, 2001	:
Attorney Docket No.: STK-008CN	:

This is in response to applicants' petition filed June 17, 2003, to make the above-identified application special under the provisions of 37 CFR 1.102(d) and M.P.E.P 708.01(H). The delay in acting on this petition is regretted.

This application satisfies the provisions set forth in M.P.E.P. 708.01(H) in that it the subject matter has been pending in this and its parent application for more than 5 years. Therefor 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 William R. Dixon, Jr. by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0519 or by facsimile transmission to the Office general facsimile number.

William R. Dixon, Jr.
Special Program Examiner
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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K&L GATES LLP
STATE STREET FINANCIAL CENTER
ONE LINCOLN STREET
BOSTON, MA 02111-2950

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FEB 11 2009

OFFICE OF PETITIONS

In re Patent No. 7,078,221
Issue Date: July 18, 2006
Application No. 09/754,831
Filed: January 3, 2001
Attorney Docket No. STK-008CN

: DECISION GRANTING PETITION
: UNDER 37 CFR 1.78(a)(3) AND
: REQUEST FOR CERTIFICATE OF
: CORRECTION
:

This is a decision on the petition, filed November 4, 2008, which is being treated as a petition under 37 CFR 1.78(a)(3), seeking to add a claim for priority under 35 U.S.C. § 120 to the nonprovisional application set forth in the concurrently filed certificate of correction.

The petition is **granted**.

A review of the file record fails to disclose that a claim for the benefit of priority to the above-noted, prior-filed nonprovisional application was made within the time period set forth in 37 CFR 1.78(a)(2)(ii) and further failed to include a proper reference to the prior-filed application as required by 37 CFR 1.78(a)(2)(i) and 1.78(a)(2)(iii).

The instant application was filed January 3, 2001. Therefore, since this application was filed after November 29, 2000, a petition under 37 CFR 1.78(a)(3), along with submission of a Certificate of Correction, is the appropriate avenue of relief to accept a late claim for the benefit of priority to a prior-filed nonprovisional application after issuance of the application into a patent. *See* MPEP 1481.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of 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)(2)(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.

As the petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

A corrected Filing Receipt, which includes the priority claim to the above-noted, prior-filed nonprovisional application, accompanies this decision on petition.

Petitioner is advised that the granting of this petition and the mailing of a corrected Filing Receipt should not be viewed as an indication that a determination has been made that this application is entitled to claim benefit of the prior-filed application. A determination that applicant is entitled to claim benefit of the prior-filed application will be made by the Examiner prior to the mailing of a certificate of correction.

As authorized, the $1,410 surcharge fee, as well as the $100 certificate of correction fee, has been charged to petitioner's Deposit Account.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3204.

This application is being referred to the Certificates of Correction Branch for processing the request for a certificate of correction in accordance with this decision on the petition under 37 CFR 1.78(a)(3).

Sherry D. Brinkley
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
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APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
09/754,831	01/03/2001	1646	1720	STK-008CN	11	4

CONFIRMATION NO. 3498

CORRECTED FILING RECEIPT

22832
K&L Gates LLP
STATE STREET FINANCIAL CENTER
One Lincoln Street
BOSTON, MA 02111-2950

OC000000034380198

Date Mailed: 02/04/2009

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 submit a written request for a Filing Receipt Correction. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections**

Applicant(s)

Hermann Oppermann, Medway, MA;
Thangavel Kuberasampath, Medway, MA;
David C. Rueger, West Roxbury, MA;
Engin Ozkaynak, Milford, MA;

Power of Attorney: The patent practitioners associated with Customer Number 022832

Domestic Priority data as claimed by applicant

This application is a CON of 08/375,901 01/20/1995 PAT 6,261,835
which is a DIV of 08/145,812 11/01/1993 PAT 5,750,651
which is a DIV of 07/995,345 12/22/1992 PAT 5,258,494
which is a DIV of 07/315,342 02/23/1989 PAT 5,011,691
and is a CON of 07/621,988 12/04/1990 ABN
which is a DIV of 07/315,342 02/23/1989 PAT 5,011,691
which is a CIP of 07/232,630 08/15/1988
which is a CIP of 07/179,406 04/08/1988 PAT 4,968,590

Foreign Applications

If Required, Foreign Filing License Granted: 03/06/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 09/754,831**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

NUCLEIC ACID MOLECULES ENCODING OSTEOGENIC PROTEINS

Preliminary Class

536

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).

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Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

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NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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Vacated 7-26-04

Paper No. 17

Arnold & Porter
555 Twelfth Street, NW
Washington, DC 20004-1206

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FEB 06 2004
OFFICE OF PETITIONS

In re Application of
Brian M. Hauge et al.
Application No. 09/754,853
Filed: January 5, 2001
Attorney Docket No. 16517.187

ON PETITION

This is a decision on the petition under 37 CFR 1.1.137(b), filed December 30, 2003, to accept the delayed payment of a maintenance fee for the above-identified patent.

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 11, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 12, 2003.

The patent file is being forwarded to Technology Center AU 1638 for further processing.

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

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Paper No.19

ARNOLD & PORTER LLP
ATTN: IP DOCKETING DEPT.
555 TWELFTH STREET, N.W.
WASHINGTON DC 20004-1206

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JUL 2 6 2004

OFFICE OF PETITIONS

In re Application of
Brian M. Hauge et al
Application No. 09/754,853
Filed: January 5, 2001
Attorney Docket No. 16517.187

: CORRECTED DECISION ON
: PETITION

This is a corrected decision on the petition under 37 CFR 1.137(b), filed December 30, 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 11, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on March 12, 2003.

The Office letter mailed February 6, 2004, incorrectly stated that the petition was being revived to accept the delayed payment of a maintenance fee for the above-identified patent.

In view of the above, the Office letter mailed February 6, 2004 is hereby **VACATED**.

The Office sincerely apologize for any inconvenience caused petitioner in this matter.

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

The application file is being forwarded to Technology Center Art Unit 1638.

Karen Creasy

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

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Technology Center 2100

IBM CORPORATION
3039 CORNWALLIS RD.
DEPT. T81 /B503, PO BOX 12195
RESEARCH TRIANGLE PARK, NC 27709

In re application of: Ims et al.	)	
Serial No.: 09/754,891	)	DECISION ON PETITION FOR
Filed: 1/5/2001	)	SUPERVISORY REVIEW
For: TECHNIQUE FOR AUTOMATED	)	UNDER *37 CFR §1.181*
E-BUSINESS SERVICES	)	
	)	

This is a decision on the petition under 37 CFR § 1.181, filed December 12, 2006 requesting the Commissioner to invoke his supervisory authority and enter the Amendment After Final Rejection filed November 21, 2006 which was refused entry in the Advisory action mailed on November 21, 2006.

The petition is **GRANTED**.

RELIEF REQUESTED

The instant petition filed under 37 CFR 1.181 requests the following relief: entry of the Amendment After Final Rejection filed November 21, 2006 which was refused entry in the Advisory action mailed on November 21, 2006.

REQUIREMENTS

A petition under 37 CFR §1.181 must include: (1) a statement of facts involved and (2) the point or points to be reviewed and the action requested. Note, 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. In addition § 1.181(f) sets forth: 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.

The petition initially filed on November 21, 2006 includes elements (1) and (2) above. The petition was filed within two months of the Advisory Office action from which the relief is requested.

ANALYSIS

Comparing claim1,2,3 and 5 before the final rejection of 7/27/06 to claims 1,2, 3 and 5 after the final rejection as presented in amendments after final rejection on 10/4/06 and 11/1/06 it is seen that the scope of claim 1
has narrowed after final rejection.

Claims 1,2 and3 before Final Rejection 5/5/06	Claims 1,2 and3 after 1st amendment after Final Rejection 10/4/06	Claims 1,2 and3 after 2nd amendment after Final Rejection 11/1/06
I. (Currently amended) A computer program product for automated e-business services, the computer program product embodied on one or more computer-readable media of a first computing system and comprising:	1, (Currently amended) A computer program product for automated e-business services, the computer program product embodied on one or more computer-readable media of a first computing system and comprising:	1. (Currently amended) A computer program product for automated e-business services, the computer program product embodied on one or more computer-readable media of a first computing system and comprising:
computer-readable program code ~~means~~ configured for reading a specification of an e-business service; and	computer-readable program code ~~configured for reading~~ to read a specification of an e-business service, wherein the specification is encoded in a structured markup language; and	computer-readable program code ~~configured for reading~~ to read a specification of an e-business service, wherein the specification is encoded in a structured markup language; and
computer-readable program code ~~means~~ configured for processing the specification to carry out the e-business service, further comprising:	computer-readable program code ~~configured for processing~~ to process the specification to carry out the e-business service, further comprising:	computer-readable program code ~~configured for processing~~ to process the specification to carry out the e-business service, further comprising:
computer-readable program code ~~means~~ configured for receiving at least one ~~or more~~ input ~~documents~~ document for the e-business service; and	computer-readable program code ~~configured for receiving~~ to receive at least one input document for the e-business service, wherein the at least one input document is encoded in the structured markup language; and	computer-readable program code ~~configured for receiving~~ to receive at least one input document for the e-business service wherein the at least one input document is encoded in the structured markup language; and
computer-readable program code ~~means~~ configured for performing ~~at least~~ one ~~or more~~ of: ~~(1)~~ transforming the input documents into other documents, according to transformation information	computer-readable program code ~~configured for performing~~ to perform at least one of: transforming the input documents into other documents, according to transformation information	computer-readable program code ~~configured for performing~~ to perform at least one of: transforming the input documents into other documents, according to transformation information

that may be provided in the specification, and ~~(2)~~ operating upon the input documents ~~and/or~~ or the other documents to create one or more new documents, according to operating actions that may be provided in the specification.	that may be provided in the specification, and operating upon the input documents or the other documents to create one or more new documents, according to operating actions that may be provided in the specification.	that may be provided in the specification, and operating upon the input documents or the other documents to create one or more new documents, according to operating actions that may be provided in the specification.
2. (Currently amended) The computer program product according to Claim 1, further comprising computer-readable program code ~~means~~ ~~configured~~ for forwarding the other documents ~~and/or~~ or the new documents to a computing system other than the first computing system.	2. (Currently amended) The computer program product according to Claim 1, further comprising computer-readable program code ~~configured for forwarding~~ to forward the other documents or the new documents to a computing system other than the first computing system.	2. (Currently amended) The computer program product according to Claim 1, further comprising computer-readable program code ~~configured for forwarding~~ to forward the other documents or the new documents to a computing system other than the first computing system.
3. (Original) The computer program product according to Claim 1, wherein the specification and the input documents are encoded in a structured markup language.	3 (Deleted)	3 (Deleted)
5. (Currently amended) The computer program product according to Claim 3 ~~or Claim 4~~, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.	5. (Currently amended) The computer program product according to Claim ~~3~~ 1, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.	5. (Currently amended) The computer program product according to Claim ~~3~~ 1, wherein the structured markup language is a language known as "the Extensible Markup Language (XML)" or a derivative thereof.

The scope of claim 5 appears unchanged because it further limits the structured markup language to a language known as "the Extensible Markup Language (XML)" or a derivative thereof. With regard to the examiner's statement (see advisory action of 11/21/06) that:

> "Specifically, original claim 3 specified that all of the input documents be encoded in a structured markup language, whereas in the amendment, amended claim 1 now requires less restrictively that "at least one" input document be encoded in a structured markup language."

The language "at least one" input document was already introduced into claim 1 before the final rejection. Claim 3 was dependent on claim 1 and thus specified only the input documents of claim 1 which included one document. Furthermore the language is less restrictive as suggested by the examiner, however the "e"speak Tutorial, Version: Beta 20.2" Hewlett-Packard Company, December 1999 reference covers such language and as such no new issues are raised and no new consideration is required by the examiner. If the reference receives input documents it also

receives at least one input document. The scope to claim 1 has been narrowed and claim 3 has been canceled, thus reducing issues for appeal and incorporating all the subject matter of claim 3 into claim 1.

CONCLUSION

For the above stated reasons, the petition for supervisory review seeking entry of the Amendment After Final Rejection filed November 21, 2006 which was refused entry in the Advisory action mailed on November 21, 2006, is **GRANTED**.

The application is being forwarded to the Examiner for appropriate action. A new Appeal Brief should be required by the examiner to reflect the changes caused by this decision.

Any inquiries related to this decision may be directed to Pat Salce at (571) 272-3610.

Pat Salce
Workgroup 2170 Quality Assurance Specialist, Tech. Center 2100
Computer Architecture, Software and Information Security
571-272-3610

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DEPT. T81 / B503, PO BOX 12195
RESEARCH TRIANGLE PARK, NC 27709

Mail Date: 04/20/2010

Applicant	: Steven D. Ims	: DECISION ON REQUEST FOR
Patent Number	: 7634726	: RECALCULATION of PATENT
Issue Date	: 12/15/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/754,891	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/05/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2842** 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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LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

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OFFICE OF PETITIONS

In re Application of :
Sharad K. Govil, et al. :
Application No. 09/754,909 :
Filed: January 5, 2001 :
Attorney Docket No. BERTEK 3.0-025 DIV :

ON PETITION

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 April 8, 2004, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (703) 305-9220.

The application is being referred to Technology Center AU 1617 for further processing of the request for continued examination under 37 CFR 1.114 filed May 28, 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).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: ——

DATE : 11/20/06

TO SPE OF : ART UNIT 1616

SUBJECT : Request for Certificate of Correction for Appl. No.: 9/754909 Patent No.: 7070808B2

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

Comments: _____

JOHANN RICHTER
SUPERVISORY PATENT EXAMINER
GROUP 1600

SPE — Art Unit 1616

PTO/SB/44 (04-05)
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UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO. : 7,070,808

APPLICATION NO. : 09/754,909

ISSUE DATE : July 4, 2006

INVENTOR(S) : Sharad K. Govil and Ludwig J. Weimann

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:

(57) ABSTRACT, line 3, delete "the" and insert therefor --they--.
Column 2, line 21, "problem" should read --problems--.
Column 2, line 44, delete ",".
Column 4, line 5, delete ",".
Column 6, line 10, delete ",".
Column 6, line 21, delete "is" and insert therefor --are--.
Column 6, line 35, delete "it's" and insert therefor --its--.
Column 8, line 11, "Des-methyl" should read --des-methyl--.
Column 12, line 18, delete "is" and insert therefor --are--.
Column 14, line 9, delete "or" and insert therefor --are--.
Column 15, line 42, delete "are" and insert therefor --is--.
Column 16, line 9, delete "A" and insert therefor --In a--.
Column 19, line 42, delete ",".
Column 20, line 40, delete "is" and insert therefor --to be--.
Column 20, line 67, "heatsealable" should read --heat-sealable--.
Column 21, line 47, delete "were" and insert therefor --was--
Column 22, line 58, after "adhesive" insert --,--.
Column 25, line 5, "Des-methyl" should read --des-methyl--.
Column 25, line 12, delete "&".
Column 25, line 1, after "weight" insert --,--.

MAILING ADDRESS OF SENDER (Please do not use customer number below):
Arnold H. Krumholz
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090

OCT 24 2006

US007070808B2

(12) **United States Patent**
Govil et al.

(10) **Patent No.: US 7,070,808 B2**
(45) **Date of Patent: Jul. 4, 2006**

(54) **ADHESIVE MIXTURE FOR TRANSDERMAL DELIVERY OF HIGHLY PLASTICIZING DRUGS**

(75) Inventors: **Sharad K. Govil**, Essex, VT (US); **Ludwig J. Weimann**, Burlington, VT (US)

(73) Assignee: **Mylan Technologies, Inc.**, St. Albans, VT (US)

(*) Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 318 days.

(21) Appl. No.: **09/754,909**

(22) Filed: **Jan. 5, 2001**

(65) **Prior Publication Data**

US 2001/0006628 A1 Jul. 5, 2001

Related U.S. Application Data

(62) Division of application No. 08/883,075, filed on Jun. 26, 1997.

(51) **Int. Cl.**

A61K 9/10	(2006.01)
A61K 47/32	(2006.01)
A61L 37/00	(2006.01)
A61L 15/24	(2006.01)
A61M 37/00	(2006.01)

(52) **U.S. Cl.** **424/486**; 424/448; 424/449; 424/487

(58) **Field of Classification Search** 424/486–487, 424/448–449, 481

See application file for complete search history.

(56) **References Cited**

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(Continued)

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(Continued)

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Patent Abstracts of Japan, vol. 018, No. 400 (C-1230), Jul. 26, 1994 & JP 06 116145 A (T T S Gijutsu Kenkyusho:KK).

Primary Examiner—Edward J. Webman
(74) *Attorney, Agent, or Firm*—Lerner, David, Littenberg, Krumholz & Mentlik, LLP

(57) **ABSTRACT**

Transdermal drug delivery patches and methods of their production are described. The patches can be made such that the accommodate highly plasticizing drugs such as selegiline and/or the use of protonated forms of various drugs.

17 Claims, 1 Drawing Sheet

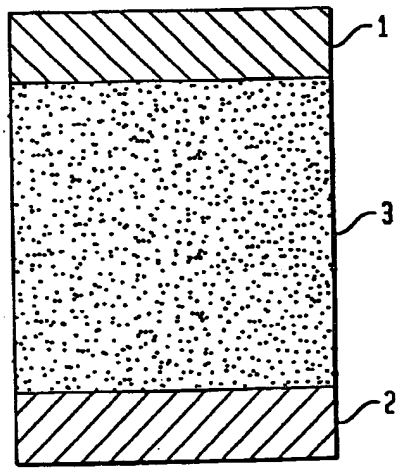

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FIG. 1

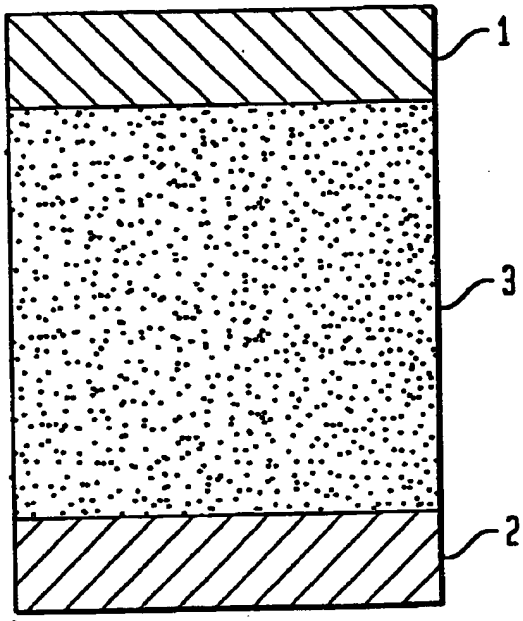
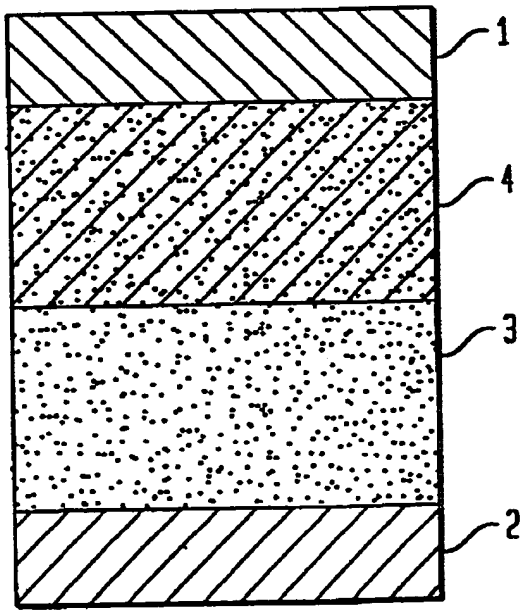


FIG. 2



ADHESIVE MIXTURE FOR TRANSDERMAL DELIVERY OF HIGHLY PLASTICIZING DRUGS

CROSS REFERENCE TO RELATED APPLICATIONS

The present application is a divisional of U.S. application Ser. No. 08/883,075 filed on Jun. 26, 1997, the disclosure of which is incorporated by reference herein.

The present invention relates to the field of pharmaceutical delivery devices and dosage forms and in particular, transdermal delivery vehicles as well as methods of making same.

BACKGROUND OF THE INVENTION

Most pharmaceutical formulations are available in salt forms. In fact, many formulations are only available in the form of a pharmaceutically acceptable salt. Salts have long been considered advantageous because of their high stability, ease of handling and formulation and generally high water solubility. Unfortunately, salt formulations do not tend to be useful in transdermal drug delivery systems. Because of the growing acceptance of such drug delivery systems by the general public, the inability to conveniently produce transdermal patches utilizing various pharmaceutical formulations is a great disadvantage.

There are many possible explanations for the general incompatibility of salt forms of drugs and transdermal performance. For example, protonated pharmaceutically active compounds (basic salts) are generally relatively high in polarity. It is known, however, that non-polar drugs, in general, are transmitted through the skin easily because of a high degree of compatibility with lipophillic layers of the skin. Highly polar substances such as salt forms of drugs and indeed some free forms of drugs, by virtue of their incompatibility with such lipophillic layers, are generally very slow in permeating skin.

One approach to forming a transdermal patch to overcome such problems was suggested in Yoshida et al., U.S. Pat. No. 4,738,848 and Nakano et al., U.S. Pat. No. 4,740,374. According to these patents, compounds such as diclofenac sodium and non-steroidal anti-inflammatory analgesic agents, when present in their salt forms, are difficult to dissolve into a pressure sensitive adhesive material having relatively high lipophillic properties. It is also difficult to maintain the active ingredient therein. If large amounts of drugs are added to the adhesive, in some cases, the drug cannot be dissolved or crystallization of the drug may occur. This makes it impossible to deliver a sufficient amount of the drug into the skin.

According to Yoshida et al. and Nakano et al., these difficulties can be overcome by concurrently using an organic acid during the formulation of the adhesive material. The organic acid apparently increases the solubility of the active ingredient in the pressure sensitive adhesive material and also increases the percutaneous absorption properties thereof. These references express their belief that the reason for the increased absorption properties is that the drug is converted to its free form having a higher oleophilicity (lipophilicity) resulting in the higher solubility of the drug.

Another approach was taken in Heiber et al., U.S. Pat. No. 4,917,676, which relates to a user-activated transdermal therapeutic system. The transdermal drug delivery system described therein includes separate compartments for various formulations in "pre-activated states". Just prior to use,

the patient or other person applying the system allows the partitioned ingredients to commingle, thus activating the system. The user generally bursts a burstable barrier separating the two reservoirs. Then the therapeutic agent, usually in the form which must be altered for the desired transdermal delivery, and the activating substance combine and transform the therapeutic agent to a suitable species.

Inactive forms of therapeutic agents in accordance with Heiber et al. can include, for example, an acidic drug which, as an ionized species, penetrates skin to a slight degree, but in a free acid form, permeates freely through the skin. Activating substances may include pH regulators such as buffers, acids or bases.

Such transdermal systems, however, suffer from several disadvantages. First, they require a rather complex arrangement of two or more compartments separated by, for example, a burstable but otherwise nonpermeable material. In addition to the complexity of such a structure and the potential difficulties in separately filling and maintaining discretely the individual compartments, there is also the problem of premature bursting of the burstable layer and the premature intermingling of the various components. Clearly, the ability to manufacture a transdermal device wherein all of the necessary ingredients can be intermixed and intermingled from the start and added together to each and every cavity in a transdermal patch would be a great advantage. Finally, the Heiber et al. patent considers the complexities of forming a patch where the therapeutic and activity agents are mixed and maintained together at the time of manufacture or the subsequent storage stability problems attendant such a mixture.

Moreover, resolving the question of the physical state of a drug does not resolve all of the issues surrounding the production of transdermal patches from certain highly plasticizing drugs. In fact, providing these drugs in a free base form could actually raise additional problems. It comes as no surprise that a drug or solvent loaded into an adhesive system will have an effect on the adhesive properties of the resulting mixtures. In certain cases, with certain drugs, the effect on the hardness and tackiness of the resulting adhesive mixture is minimal. However, in certain other instances, drugs such as, for example, nitroglycerin or nicotine may act as plasticizers for many conventional adhesive systems. Plasticizing drugs such as these, can have a significant deleterious effect on the physical properties of the resulting adhesive matrix depending upon the type of drug, and the amount used. Generally, plasticizing drugs act to soften or disturb the structural integrity of the adhesive making it more fluid like and can, in certain cases, negatively effect the degree of adhesivity.

A number of companies have introduced either high molecular weight or highly crosslinked adhesive systems. It is known that these systems can generally be used almost interchangeably with plasticizing drugs. Typical examples of such adhesives include, without limitation, GELVA 737, GELVA 2655, and GELVA 1753 self crosslinkable acrylic adhesives from Monsanto's Chemical Group, 730 Worcester Street, Springfield, Mass. 01151 and DUROTAK 87-2516, DUROTAK 87-2194 and DUROTAK 87-2852 self crosslinkable acrylic adhesives available from National Starch and Chemical Company, 10 Finderne Ave., P.O. Box 6500, Bridgewater, N.J. 08807-0500. All of these crosslinked adhesives find wide spread use in the pharmaceutical industry in the formulation of transdermal drug delivery systems. When liquid, lipophillic drugs are added to these adhesives at amounts of between 30 and about 40% the resulting material would generally not suffer deterioration in

physical properties so as to render many of these acrylic based adhesives unusable. While many of these adhesives are virtually interchangeable, of course, some combinations of a specific drug and a specific adhesive may provide marginally better properties.

When the inventors attempted to construct a transdermal delivery vehicle for selegiline, a particularly highly plasticizing drug, they too expected that selegiline patches produced with any of the foregoing class of adhesives could be accomplished without a problem. This was particularly true as loading levels were anticipated at only between about 10 and about 20%; not particularly challenging for these adhesives.

As illustrated in Table 1, when mixtures of selegiline (15 wt %) and various adhesive materials were tested using conventional performance tests, they all demonstrated comparable and generally acceptable results.

TABLE 1

POLKEN TACK OF VARIOUS TRANSDERMAL ADHESIVES WITH 15% SELEGILINE

ADHESIVE	POLKEN TACK
GELVA 1753	346
DUROTAK 87-2194	453
GELVA 737	333
DUROTAK 87-2516	286

Yet when these formulations were tried on skin, the results were quite surprising. While some of the formulations worked, others unexplainably exhibited significant cohesive failure whereby adhesive remained on the skin after a transdermal patch was peeled-away. The disparity in the results obtained between conventional "bench-top" testing and actual field application was truly discouraging. It essentially placed a whole host of established tests in a highly compromised state.

The inventors were also taken aback by the degree of disparity observed. When they formulated a selegiline containing transdermal patch with, for example, DUROTAK 87-2194, those patches exhibited cohesive failure and adhesive transfer. Formulations made with GELVA 2655 exhibited total adhesive failure. Neither result could have been predicted based on results such at that reported in Table 1. This problem was only amplified by the use of other traditional tests such as a measure of shear strength. As shown in Table 1A, a number of formulations including selegiline were measured in terms of shear strength.

TABLE 1A

SHEAR STRENGTH OF DIFFERENT ADHESIVE SYSTEMS WITH SELEGILINE BASE

ADHESIVE	SHEAR (MIN)	SELEGILINE
GELVA 737	4.31	13%
GELVA 788	3.1	13%
DUROTAK 87-2516	1174	13%
DUROTAK 87-2194	36	13%
GELVA 1753	1440	4%
GELVA 1753	1440	8%
GELVA 1753	1440	13%

Typically, shear values of greater than about a half an hour to one hour would be considered acceptable adhesive systems. As one can see from Table 1A, GELVA 1753 produced relatively high shear rates, which should indicate an acceptable adhesive system. However, DUROTAK 87-2516 also exhibited acceptable shear, and the formulations made from this adhesive were totally unacceptable when applied to skin. In addition, selegiline with 10% propylene glycol as a solvent, provided shear values of greater than 800 minutes when formulated with GELVA 1753. However, while such results are generally indicative of good adhesion characteristics, this particular formulation exhibited very poor adhesion.

Much to their dismay, the inventors discovered that with a certain class of particularly highly plasticizing drugs, only selected adhesives would work. They also found that, based on the state of the art, they could not predict which adhesives would work and which would not.

SUMMARY OF THE INVENTION

One aspect of the present invention is the creation of a free base material in an adhesive and or in a transdermal patch, or just prior to mixing with the adhesive. The result is the creation of a transdermal patch including the converted free base of the drug material. Another aspect of the present invention involves the creation of certain transdermal formulations which include a highly plasticizing drug, in free base form, whether the free base was created in situ or not.

Therefore, in accordance with one aspect of the present invention, a method of producing an adhesive formulation for a therapeutic drug delivery patch adapted for the percutaneous or transdermal delivery of a drug is provided. The method includes the step of providing a pharmaceutically active agent in protonated form, whose corresponding free base has a given pK_b which ranges from between about 4.75 and about 11. Then, the protonated pharmaceutically active agent is dissolved in a nonaqueous solvent, the nonaqueous solvent being capable of dissolving the pharmaceutically active agent in both a protonated and unprotonated forms.

The dissolved pharmaceutically active agent is reacted with a biocompatible deprotonating agent which can substantially deprotonate the pharmaceutically active agent without causing irritation upon prolonged exposure to the skin. The deprotonated agent will have a pK_b which is at least about 0.75 lower than the pK_b of the pharmaceutically active agent. The deprotonated agent thereby becomes protonated. The deprotonating agent may be selected and apportioned such that some excess of unreacted deprotonating agent remains. Finally, the deprotonated pharmaceutically active agent is incorporated into an adhesive material. In a particularly preferred embodiment, these methods also include the steps of separating at least a portion of the now protonated deprotonating agent from the mixture of deprotonated pharmaceutically active agent, solvent and protonated deprotonating agent prior to incorporating the pharmaceutically active agent into the adhesive material. The now protonated deprotonating agent can also be removed after it has been added to an adhesive as well.

In addition, in accordance with another aspect of the present invention, it is possible to actually undertake the deprotonation of the protonated pharmaceutically active agent, in situ, within the adhesive material. Moreover, in accordance with still another aspect of the present invention, it is possible to construct a patch in such a way that the protonated pharmaceutically active agent and the deprotonating agent are disposed in discrete but adjacent dry layers. Over time, the deprotonation reaction occurs in situ such that

the resulting patch includes a deprotonated pharmaceutically active agent or drug which is capable of enhanced skin penetration.

Of course, the designing of an acceptable adhesive formulation for incorporation into a transdermal patch, one which allows for the conversion of a protonated drug to its free form and can accommodate the presence of deprotonating agent, can be extremely demanding. For example, many polymer based adhesive systems are fairly incompatible with the drug in its salt form. Finding a way of introducing the salt to the adhesive must therefore be developed. In doing so, however, it must be realized that after conversion the resulting free form of the drug must also be compatible with the adhesive. Similarly, a patch in accordance with the present invention or an adhesive formulation in accordance herewith would require the incorporation of some agent which would convert the protonated form of the drug, such as a protonated amine form, to its free form. This deprotonating agent, like the therapeutic pharmaceutically active agent itself, will undergo transformation. It is important, therefore, to ensure that both the deprotonating agent, and that agent in its later protonated form, are also compatible with the adhesive base in terms of stability. This means finding a system where either the protonated deprotonating agent will remain dissolved in the solvent/adhesive material system, or the crystallized protonated deprotonating agent will not have an adverse effect on the transdermal device or the patient.

When highly plasticizing drugs are being formulated into transdermal patches, the interaction of the drug and the adhesive system can become even more complex. Not only must the system be able to accommodate the various states of the drug and deprotonating agent, but they must also meet some rather unique criteria for the use of highly plasticizing drugs as well.

Surprisingly, formulations which address and balance all of the often competing requirements of converting a protonated drug to its free form, in situ, in a percutaneous dosage form or transdermal patch and accommodating highly plasticizing drugs have been developed. The resulting patches have long term storage stability, reliable release profiles, high levels of skin permeation and, best of all, are easy and economical to manufacture. Additionally, it has been discovered that, by the practice of the present invention, it may be possible to tailor the rate of release of the free form of the drug, and thereby its permeation through the skin, by controlling the rate of reaction of the various reactive components within the patch.

In accordance with a particularly preferred aspect of the present invention there are provided methods of producing transdermal delivery vehicles for highly plasticizing drugs. These methods involve providing between about 97% and about 65%, by weight, of a very specific class of acrylic polymeric adhesives. This acrylic polymeric adhesive includes between about 40% and about 90% by weight of a C_4–C_{12} alkyl acrylate, between about 10% and about 40% by weight of a C_1–C_4 alkyl acrylate hardening monomer; between about 1% and about 15% by weight of a functionalizing monomer which facilities crosslinking; and, in many instances, a crosslinking agent. The acrylic polymeric adhesive is mixed with a highly plasticizing drug provided in an amount of between about 3% and about 35% by weight based on the dry weight of the mixture. The therapeutic adhesive formulations and transdermal patches using same are also contemplated.

Most preferably, the highly plasticizing drug is selegiline which is provided in an amount of between about 3 and about 18% by weight, based on the dried mixture. Also preferably, the only solvents used in the production of therapeutic adhesive formulations including a highly plasticizing drug provided in a free base form are relatively high volatility solvents, such as ethanol, which will be removed upon drying as well as those solvents found in the acrylic polymeric adhesive which prevent in situ cross-linking and maintain the adhesive in liquid form until removed. Solvents which will remain after drying, such as propylene glycol used for deprotonation are preferably not used in these adhesive formulations.

After observing the unexpected failure of certain highly crosslinked acrylic based adhesives to maintain their advantageous properties following the incorporation of moderately low doses of selegiline, the inventors discovered that a relatively small class of acrylic based adhesive formulations can be used with particularly aggressively plasticizing drugs. The reasons why these particular acrylic based adhesives work with certain highly plasticizing drugs and why other very closely related adhesive formulations fail is not fully appreciated. However, from amongst the numerous commercially available adhesive formulations of which those of ordinary skill in the art traditionally look to solve these sorts of problems, only a few have been identified as being useful in these cases, and these adhesives do have some common properties.

In another preferred aspect of the present invention, there is provided a method of producing a therapeutic adhesive formulation for use in a transdermal patch. The method includes the step of selecting an acrylic polymeric adhesive which is suitable for use with highly plasticizing drugs. This decision is not based upon the bench-tested properties of the adhesive but rather upon it's content of between about 40% and about 90% of a C_4–C_{12} alkyl acrylate and between about 10% and about 40% by weight of a C_1–C_4 alkyl acrylate hardening monomer. Once the acrylic polymeric adhesive is selected, it is mixed with the highly plasticizing drug in an amount of between about 3% and about 35% by weight based on the weight of said mixture and on a liquid basis.

Often the selection process for the adhesive also involves consideration of the content of a functionalizing monomer which facilitates crosslinking; and/or a crosslinking agent. This method may therefore also include the step of crosslinking the acrylic polymeric adhesive to form a matrix capable of controlling the release of the highly plasticizing drug when used in a transdermal patch and applied to the skin of a patient. The proper selection and formulation of this adhesive material will result in a transdermal patch and which will not ooze, suffer from adhesive failure, fall off of a patient prematurely or be difficult to remove when necessary.

Applicants have also discovered that the traditional bench-top methods of gauging the performance of such adhesives are unreliable with particularly highly plasticizing drugs like selegiline. Therefore while tests like shear strength, peel tests from a steal plate and tack tests may eliminate certain candidates, they will not reliably identify successful candidates. Instead, it was discovered that the acrylic polymeric adhesives that worked the best in these application all have similar compositions. Generally, they include a C_4–C_{12} alkyl acrylate, a lower alkyl acrylate (C_1–C_4) hardening monomer such as methyl acrylate and a functionalizing monomer such as acrylic acid which facilities crosslinking. A crosslinking agent is also often useful.

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 is a side planar view of a drug delivery patch in accordance with the present invention.

FIG. 2 is a side planar view of a drug delivery patch having plural layers in accordance with the present invention.

DETAILED DESCRIPTION

The terms pharmaceutically active agent and drug are used synonymously, and these terms include any drug or biologically active substance which is available in protonated form. These pharmaceutically active agents must be capable of transdermal application and must be susceptible to inclusion in a patch in accordance with the present invention, both in protonated and nonprotonated forms. Additionally, the drug must be compatible with the other ingredients that are components of the therapeutic adhesive formulation. Generally, the content of the formulation will be tailored around the pharmaceutically active agent. However, if the pharmaceutically active agent cannot be stored in contact with, for example, any of the biocompatible deprotonating agents in accordance with the present invention, then that drug is not a candidate for use in some of the therapeutic adhesive formulations discussed herein. That is, of course, unless the drug can be provided in a free base form without any of the deprotonating agent. In addition, the drug should not cause irritation to the skin of the patient in either protonated or deprotonated form. Similarly, the drug should be susceptible of deprotonation by an agent which itself will not cause any irritation, unless the drug will be provided as a free base. This will further limit and define the class of the drugs capable of use in accordance with the present invention.

Without limitation, pharmaceutically active agents in accordance with the present invention may include selegiline-HCl, propranolol-HCl, ketorolac-HCl, buprenorphine-HCl, scopolamine-HCl, terbutaline-HCl, clonidine-HCl, morphine-HCl, terazosin-HCl, prazosine-HCl, diliazem-HCl, verapamil-HCl and Ciprofloxacin-HCl. The amount of the pharmaceutically active agent will vary widely. Some drugs are active in dosages of a few milligrams per day while others may require thousands of milligrams per day. However, in general, the pharmaceutically active agents in accordance with the present invention are provided in an amount which ranges from between about 0.1 to about 45 percent by weight based on the total formulation. More preferably, the amount of drug ranges from between about 2 to about 20 percent by weight based on the weight of the total formulation.

The pharmaceutically active agent has a pK_b of at least about 4.5–5.0 and no more than about 11–11.5. The deprotonating agent should have a pK_b of at least about 3.5–4.0 and no more than about 10.0–10.5. References to the pK_b of the pharmaceutically active agent are always to the pK_b of the free base form of the drug. In addition, the pK_b of the deprotonating agent should be at least about 0.75, preferably 1.0 and more preferably 2.0 less than the pK_b of the drug.

The term highly plasticizing drug generally means, a pharmaceutical or biologically active agent having a low molecular weight (under 300 MW), being liquid at normal process temperatures, and of an oily or lipophillic nature such that it fluidizes the adhesive and would cause viscous cold flow at adhesive during normal stage. The result would be ooziness and eventually, cohesive failure or splitting of the adhesive material. If the highly plasticizing drug can be provided as a free base, then its pK_b will not be an issue. Typically, the highly plasticizing drug in accordance with the present invention would be provided in an amount ranging from between about 3% to about 35% based on the weight of the finished adhesive and drug mixture (dry weight). More preferably, the amount of drug will range from between about 3% to about 25%. Most preferably, the amount will range from between about 3% and about 18%. Preferred particularly highly plasticizing drugs in accordance with the present invention include: selegiline, fluoxetine, Des-methyl selegiline, tetracaine and chlorpheniramine.

As used herein, a therapeutic adhesive formulation includes an adhesive formulation which can be utilized as part of a percutaneous or transdermal drug delivery patch or the like. The therapeutic adhesive formulation may be provided as one or more thin adhesive layers in a patch, can be placed in a recess or cavity within a patch as a monolithic structure or as a relatively viscous gel-like substance.

The therapeutic adhesive formulation in accordance with the present invention generally includes at least two components: at least one adhesive formulation and a pharmaceutically active agent. If the drug used is in a protonated form, then it will be necessary to include a solvent capable of dissolving the drug, in both protonated and deprotonated form. Such solvents may remain in the formulation after drying. If the drug used is a highly plasticizing drug provided in protonated form, then the amount of this type of solvent should be minimized as it may affect the adhesion characteristics of the resulting therapeutic adhesive formulation. If the highly plasticizing drug is provided as a free base, then there is most often no need for such a solvent at all. In fact, under such circumstances, it is desirable to avoid using a low-volatility solvent which will not be driven off during drying, if possible. This lowers the amount of drying required which reduces the loss of drug. It also reduces the cost of the formulations and eliminates a potential source of adhesion problems. In cases where a protonated form of the drug is used, the therapeutic adhesive formulation also includes at least some amount of a biocompatible deprotonating agent. Each of these components, as well as any others that may be used such as dyes, permeation enhancers, crosslinkers, adhesion promoters, gelling agents, crystallization inhibitors, anti-inflammatory agents and the like are mixed together in a generally homogeneous mixture. This mixture is then formed into a film, block or where appropriate, poured into a mold, or poured directly into the cavity or recess of a patch.

While, as discussed in late passages, the adhesive formulations useful with highly plasticizing drugs are defined more restrictively, the adhesive formulation useful in accordance with the present invention may include any adhesive useful in accordance with the creation of transdermal patches. Broadly, these include acrylics, silicones, polyisoalkylenes, rubbers, vinyl acetates, polyisobutylene rubber, polybutadiene, styrene-butadiene (or isoprene)-styrene block copolymer rubber, acrylic rubber and natural rubber; vinyl-based high molecular weight materials such as polyvinyl alkyl ether, polyvinyl acetate, a partially saponified product of polyvinyl acetate, polyvinyl alcohol and polyvinyl pyrrolidone; cellulose derivatives such as methyl cellulose, carboxylmethyl cellulose and hydroxypropyl cellulose; polysaccharides such as pullulan, dextrin and agar; polyurethane elastomers; and polyester elastomers. Of course, the adhesives must be biocompatible and nonirritating. They must also allow for a patch to adhere firmly to the skin of a patient in need of treatment by a patch but not be so adhesive

so as to injure the patient as the patch is removed. It is also important that the adhesive be selected such that it is compatible with the other components of the therapeutic adhesive formulation of the present invention. It has been found that, as a group, the acrylic adhesives are particularly useful and compatible in this regard and therefore, it is preferred that the adhesive used be acrylic based. More specifically, acrylic adhesives in accordance with the present invention may preferably be (meth)acrylic acid such as butyl (meth)acrylate, pentyl (meth)acrylate, hexyl (meth)acrylate, heptyl (meth)acrylate, octyl (meth)acrylate, nonyl (meth) acrylate, decyl (meth)acrylate, undecyl (meth)acrylate, dodecyl (meth)acrylate, and tridecyl (meth)acrylate, and copolymers of at least one of the above esters and other monomers copolymerizable therewith.

Examples of the copolymerizable monomer include carboxyl group-containing monomers such as (meth)acrylic acid, itaconic acid, crotonic acid, maleic acid, maleic anhydride and fumaric acid; sulfoxyl group-containing monomers such as styrenesulfonic acid, arylsulfonic acid, sulfopropyl acrylate, (meth)acryloyloxynaphthalenesulfonic acid, acrylamidomethylpropanesulfonic acid and acryloyloxybenzenesulfonic acid; hydroxyl group-containing monomers such as hydroxyethyl (meth)acrylate and hydroxypropyl (meth)acrylate; amide group-containing acrylic monomers such as (meth)acrylamide, dimethyl(meth)acrylamide, N-butylacrylamide, tetramethylbutylacrylamide and N-methylol(meth)acrylamide; alkylaminoalkyl group-containing acrylic monomers such as aminoethyl (meth)acrylate, dimethylaminoethyl (meth)acrylate, diethylaminoethyl (meth)acrylate and tertbutyl (meth)acrylate; alkyl esters of acrylic acid containing an ether bond in the molecule thereof such as methoxyethyl (meth)acrylate, ethoxyethyl (meth) acrylate, butoxyethyl (meth)acrylate, tetrahydrofurfuryl (meth)acrylate, methoxyethylene glycol (meth)acrylate, methoxydiethylene glycol (meth)acrylate, methoxypolyethylene glycol (meth)acrylate and methoxypolypropylene glycol (meth)acrylate; vinyl monomers such as N-(meth)acryloylamino acid; functional monomers such as acrylic monomers such as urethane, urea or isocyanate ester of acrylic acid; and vinyl monomers such as (meth)acrylonitrile, vinyl acetate, vinyl propionate, vinyl pyrrolidone, vinyl pyridine, vinyl pyrazine, vinyl piperadine, vinyl piperidone, vinyl pyrimidine, vinyl pyrrole, vinyl imidazole, vinyl caprolactam, vinyl oxazole, vinyl thiazole, vinyl morpholine, styrene, a-methylstyrene and bis(N,N'-dimethylaminoethyl) maleate.

The above alkyl esters of (meth)acrylic acid and copolymerizable monomers include isomers in which the alkyl portion is straight or branched, and isomers and derivatives in which the position of substituents is different.

It is desirable from a standpoint of the balance between adhesive properties to the skin and cohesion that the ratio of the alkyl ester of (meth)acrylic acid to the copolymerizable monomer in the acrylic pressure-sensitive adhesive material is 50:50 to 99:1 by weight. When alkyl esters of (meth) acrylic acid containing an ether bond in the molecule thereof are used from the standpoint of the low skin irritating properties, it is desirable that the ratio of the alkyl ester of (meth)acrylic acid/the alkyl ester of (meth)acrylic and containing an ether bond in the molecule/the other copolymerizable monomer is 40 to 80/59 to 10/1 to 40.

It is preferred that the adhesive formulations be subjected to suitable chemical crosslinking treatment (e.g., copolymerization of crosslinkable monomers and addition of a crosslinking agent) or physical crosslinking treatment (e.g., irradiation with ultraviolet rays and ionizing radiations such as electron beam).

In accordance with the present invention, the amount of adhesive generally utilized ranges from between about 30 to about 85 percent by weight based on the total weight of the resulting formulation. Preferably, the amount of adhesive used ranges from between about 45 to about 75 percent by weight based on the total weight of the formulation.

When the transdermal patch in accordance with the present invention will be used to deliver highly plasticizing drugs, a more specific group of acrylic based adhesives has been found to be useful. These are identified herein as acrylic polymeric adhesives.

Acrylic polymeric adhesives in accordance with this aspect of the present invention include between about 40% and about 90% of a C_4–C_{12} alkyl acrylate as the principal monomeric component. Any alkyl acrylate having between 4 and 12 carbons which has been used for the formulation of transdermal adhesives can be used, although, of course, other acrylates are also contemplated. Traditional C_4–C_{12} alkyl acrylates useful in accordance with the present invention include, for example, 2-ethylhexyl acrylate, butyl acrylate, n-decyl, n-nonyl, 2 ethyoctyl, isooctyl and dodecylacrylate Generally, the C_4–C_{12} alkyl acrylate in accordance with the present invention will be used in a matter of between about 40 and about 90% based on the weight of the finished adhesive material. More preferably, however, the amount of the C_4–C_{12} alkyl acrylate will range from between about 60% to about 80% by weight, based on the weight of the adhesive.

The properties of the acrylic polymeric adhesive can be dramatically altered depending upon whether or not a hardening monomer is used and the type of hardening monomer used. It has been found that the use of between about 10% and about 40% by weight of a C_1–C_4 alkyl acrylate hardening monomer, in combination with the C_4–C_{12} alkyl acrylate, is the key to providing an acrylic polymeric adhesive system capable of providing desirable therapeutic delivery, as well as structural integrity, for transdermal application of highly plasticizing drugs as discussed herein. Examples of C_1–C_4 alkyl acrylate hardening monomers useful in accordance with the present invention include methyl acrylate, methyl methacrylate, ethylacrylate, ethyl methacrylate, hydroxyethyl acrylate and hydroxy propyl methacrylate. More preferably, the amount of C_1–C_4 alkyl acrylate hardening monomer useful in accordance with the present invention ranges from between about 15% to about 30% based on the weight of the adhesive.

It has been discovered that the attributes of the acrylic polymeric adhesive when used with highly plasticizing drugs are largely a function of the C_4–C_{12} alkyl acrylate and the hardening monomer selected. The compositions of various commercially available transdermal adhesives are provided below in Table 2.

TABLE 2

COMPOSITIONS OF VARIOUS TRANSDERMAL ADHESIVES

	GELVA 788	GELVA 737	DURO-TAK 2194	GELVA 753	DURO-TAK 2516	DURO-TAK 2852
2-Ethyl Hexyl Acrylate	67	67	75	61	70	65

TABLE 2-continued

COMPOSITIONS OF VARIOUS TRANSDERMAL ADHESIVES

	GELVA 788	GELVA 737	DUROTAK 2194	GELVA 753	DUROTAK 2516	DUROTAK 2852
Methyl Acrylate				33		27.5
Vinyl Acetate	28	28	20		25	
Acrylic Acid			5	6		7.5
Hydroxy Ethylacrylate	5	5			5	
Glycidyl Methacrylate	<0.5	<0.5		<0.1	Yes	
X-Linker	No	Butyl Titinate	Aluminum Isopropoxide	Aluminum Isopropoxide	Polybutyl Titinate	Aluminum

These materials all have similar amounts of 2-ethyl hexyl acrylate (A C_4–C_{12} alkyl acrylate) and similar amounts of a functionalizing monomer which facilitates crosslinking. (Three of the formulations have between about 6 and about 7.5% acrylic acid, and the remaining formulations have about 5% hydroxy thylacrylate.) Two of the compositions, both of which have been found to be effective in accordance with the present invention, GELVA 1753 and DUROTAK 87-2852 each contain a hardening monomer which is methyl acrylate. The remaining formulations contain vinyl acetate as the hardening monomer. Vinyl acetate is a widely employed monomer for this purpose.

In accordance with the present invention, it is also desirable to use a functionalizing monomer which facilitates crosslinking. Functionalizing monomers provide functional groups for crosslinking. Such functionalizing monomers are well known in the art and include, for example, acrylic acid, hydroxy ethylacrylate, methacrylic acid, and acrylamide. It should be noted, however, that when using an acrylate hardening monomer in an acid form, it is preferred to use a functionalizing monomer, such as acrylic acid, whereas, where the hardening monomer is an alcohol, compounds such as hydroxy ethylacrylate should be chosen. Functionalizing monomers are generally provided in the range and between about 1% and about 20%.

It is also desirable to include a crosslinking agent. Crosslinking agents can include butyl titanate, polybutyl titanate, aluminum zinc acetate and other multivalent metals, methylol ureas and melamines. Generally the crosslinking agent is provided in an amount of between about 0.005 and about 2% the adhesive.

Crosslinking can be effected in many ways depending upon a number of factors. Most importantly, crosslinking depends upon the mode of action of the crosslinking agent. Most of the acrylic polymeric adhesive formulations commercially available use crosslinking agents which will be activated upon the drying of the formulation. It is not the heat which activates these agents but rather the removal of the solvent by, for example, evaporation or drying. Drying to remove these solvents can by done under completely conventional conditions such as 100 to 140° F. It should be noted that certain formulations are commercially available without crosslinkers. For example, GELVA 1430 is identical to GELVA 1753 except that it does not include a crosslinker. This allows one to accommodate situations where no crosslinking is needed (such as when very low concentrations of drug are used) or to custom select a crosslinker that has a different mode of action.

It should also be noted that the solvents found in the adhesives which maintain the liquid form of the adhesive and generally prevent the activation of the crosslinkers are not to be confused with the low-volatility solvents which can be added as part of the dissolution system for patches using a protonated drug. Solvents normally found in commercial adhesive formulations, solvents included merely to prevent premature crosslinking, or relatively high volatility solvents such as ethanol, used only during mixing and processing, which are evaporated during drying are generally not a problem with regard to the properties of the adhesives.

As shown in Table 3, quite unexpectedly, the properties of the resulting adhesive vary greatly with relatively minor variations and the relative amounts of the various ingredients. It is clear, therefore, that the unique combinations of monomers is primarily responsible for dictating whether or not a particular adhesive formulation will be successful with a highly plasticizing drug discussed herein.

TABLE 3

EFFECT OF SELEGILINE AND PLASTICIZER COMBINATION ON VARIOUS PHYSICAL PROPERTIES OF VARIOUS ADHESIVES

ADHESIVE	PLASTICIZER	SELEGILINE	PEL FROM SS (gm/in)	PHYSICAL OBSERVATIONS
GELVA 1753	- 0 -	~18%	—	
	- 0 -	~15%	1110	No Adhesive Transfer
	- 0 -	~10%	933	No Oozing
	10% PG	8%	527	
DUROTAK 87-2194	10% PG	8%	2217	Adhesive Transfer (Cohesive Failure)
GELVA 788	10% PG	8%	1267	Adhesive Transfer
DUROTAK 87-2516	10% PG	8%	960	Adhesive Transfer
GELVA 2655	- 0 -	18%	—	Total Adhesive Failure
DUROTAK 87-2852	- 0 -	12%	—	No Adhesive Transfer No Oozing
	- 0 -	18%	—	Somewhat Soft

Only those adhesive/drug formulations which included a C_1–C_4 alkyl acrylate hardening monomer as discussed above provided the necessary performance in terms of adhesive transfer and oozing to allow it to be useful for transdermal applications without adhesive transfer on skin.

It is interesting to note from Table 3 that GELVA 1753 provided acceptable results in terms of adhesive transfer and oozing. However, the formulation which included 10% propylene glycol ("PG"), a relatively low-volatility solvent used in systems involving protonated drugs, also exhibited relatively poor adhesive characteristics. It has been found that the use of these types of solvent only amplifies the plasticizing effects of highly plasticizing drugs. Therefore, when a free base form of a highly plasticizing drug is used, it is desirable to reduce, if not eliminate, the use of such low-volatility solvents. Of course, this has other processing advantages, as it reduces costs, exposes a patient to fewer chemicals, reduces chemical waste and reduces process time, both in terms of preparation and in terms of drying the formulation.

Other acrylic polymeric adhesives containing the proper combination of ingredients include GELVA 2873 (similar to 1753, but without residual monomers) and DUROTAK 87-2852.

When the pharmaceutically active agent used is a protonated form, it must be converted to its free form, before, during or after being mixed with the adhesive thereby rendering it more readily permeable through the skin of a patient. Protonated forms of pharmaceutically active agents, including highly plasticizing drugs, are generally incompatible with the adhesive materials described above. However, the present inventor has found that this problem can be overcome by dissolving the usually solid salt in a nonaqueous solvent which is capable of maintaining the pharmaceutically active agent in both its protonated and nonprotonated form. Again, there are trade-offs based on the use of this type of solvent and highly plasticizing drugs, particularly if the solvent used has a relatively low-volatility such as PG.

In accordance with the present invention, the nonaqueous solvent is preferably an alcohol. Alcohols in accordance with the present invention can include monoalcohols, such as ethanol, propanol, isopropanol, butanol, and tertbutyl alcohol. The alcohol may also be a generally low molecular weight polyols, i.e., glycols such as propylene glycol and polyalkylene glycol having an average molecular weight of less than about 400. For example, the nonaqueous solvent may be polyethylene glycol having an average molecular weight of between about 200 and about 400.

Most preferably, a nonaqueous solvent in accordance with the present invention is a normal short chain polyol of between about 2 and about 4 carbons in length. Such polyols may include 1,4 butanediol, glycerol, ethylene glycol, propylene glycol, and the like. Also useful in accordance with the present invention are acetates such as, for example, ethyl acetate, cellulose acetate, vinyl acetate and the like.

It is important that the nonaqueous solvents not only be compatible with the adhesive material and the pharmaceutically active agent, both in its protonated and nonprotonated forms, but also that it be compatible with the biocompatible deprotonating agent as well. Moreover, the nonaqueous solvent must be compatible with the biocompatible deprotonating agent in both its protonated and nonprotonated forms. The nonaqueous solvent must also be biocompatible such that it will not cause irritation or discomfort when in contact with the skin of a patient.

The amount of nonaqueous solvent used in accordance with the present invention must be sufficient to completely dissolve both the pharmaceutically active agent and the biocompatible deprotonating agent. Thus the amount may vary widely with the amount of each such ingredient used. However, in general, the therapeutic adhesive formulation in accordance with the present invention may include an amount of nonaqueous solvent ranging from between about 5 to about 30 percent by weight based on the total weight of the formulation. More preferably, the nonaqueous solvent is provided in an amount of between about 10 and about 20 percent by weight based on the weight of the total formulation.

When the pharmaceutically active agent is a highly plasticizing drug, then it may be necessary to reduce the amount of nonaqueous solvent used, particularly those which do not evaporate during drying. As previously noted, certain solvents can accentuate the highly plasticizing nature of the drug, or can reduce the adhesive characteristics of the resulting patch, if they remain. In such cases, it is preferable to use only solvents which will volatilize or evaporate during drying and to use other solvents in amounts of less than about 10% by weight. Preferably as little solvent is used as possible. The exact amount of solvent useful in accordance with this aspect of the invention, will vary considerably, depending upon the exact acrylic polymeric adhesive system selected, the specific highly plasticizing drug used and the amount of the highly plasticizing drug provided. Generally though, the more highly plasticizing the drug, and the greater the overall content, the lower the amount of non-volatile solvent which can be accommodated before yielding undesirable properties.

Of course, during the normal drying process, at temperatures ranging from 100–200° F., any solvents in the system, whether provided as part of the adhesive or added or evaporated or dried. The high-volatility solvents are driven off and lower-volatility solvents are dried. However, this process can also cause the loss of drug, particularly when using highly plasticizing drugs. Therefore, to provide a formulation or patch containing between about 3% and about 35% dry as desired, one might need to add as much as 100% (70% by weight) additional drug to the adhesive prior to drying. The amount of additional drug will vary with the drug or drugs used, the type of adhesive and the amount and types of solvents and the drying conditions. By lowering drying temperatures and eliminating additional solvents (those not found in the commercial adhesive) the amount of drug lost can be reduced. By consistent formulation and drying conditions, it is possible to determine the amount of drug lost so as to provide full compensation therefore. The result will be patches having the desired amount of drug.

Finally, the biocompatible deprotonating agent provided must be strong enough to substantially deprotonate the pharmaceutically active agent, but must not be so aggressive so as to cause irritation upon prolonged exposure to the skin. The biocompatible deprotonating agent must also be selected so that it is storage compatible with the drug and soluble, in both protonated and nonprotonated forms, in both the adhesive material and the nonaqueous solvent.

In order to be strong enough to substantially deprotonate the pharmaceutically active agent, it should be generally understood that the biocompatible deprotonating agent should have a pK_b which is at least 0.75 lower than the pK_b of the deprotonated form of the pharmaceutically active agent. More preferably, the pK_b differential is 1.0 or 2.0, or even greater. For example, if the active drug in free form has a pK_b of about 9.0, then the deprotonating agent in accordance with the present invention should have a pK_b of about 8.25 and, more preferably 8 or less. At the same time, the biocompatible deprotonating agent should not be so aggressive so as to cause irritation upon prolonged exposure to skin. Thus the pK_b of the deprotonating agent should not be under at least about 3.5–4.0 or over about 10.0–10.25. More, preferably, the pK_b of the drugs (in deprotonated form) will range from between about 5 and about 11 and the pK_b of the deprotonating agents will range from between 4 and about 10. Of course, in some cases, it may be possible to use a lower pK_b, but the risk of irritation grows accordingly.

By prolonged exposure to skin, it should be understood that certain patches may only be in contact with skin for a matter of hours, while others may be left on for a matter of days. In the context of longer term patches left in contact with the skin for greater than about 8 hours, the meaning of the term should be readily apparent. However, as to shorter exposure patches, the term prolonged exposure to the skin contemplates irritation caused by repeated administration of a patch to the same area of skin.

The biocompatible deprotonating agent in accordance with the present invention may be any compound which is capable of deprotonating the drug, and which is compatible with the formulations in the present invention. Preferably, the biocompatible deprotonating agent can be polymeric

imines, aromatic imines, alkanol imines, polymeric amines, aromatic amines, alkanolamines, alkyl-aryl amines, and the like.

Particularly preferred deprotonating agents in accordance with the present invention include alkanolamines such as, for example, triethanolamine, diethanolamine, ethanolamine, propanolamine, ammonia and the like. Other biocompatible deprotonating agents in accordance with the present invention include polymeric imines such as, for example, polyethylene imine ("PEI"), polydimethylaminoethyl methacrylate such as Eudragit E100 from Rohm Pharmacy and polyacryloamin. PEI is a particularly interesting biocompatible deprotonating agent as it tends to form a sphere or cage which may encapsulate or entrap some of the pharmaceutically active agent. The rate of reaction between the PEI and protonated drugs will depend largely upon the molecular weight of the PEI. Therefore, by tailoring the size of the PEI, it may be possible to control, at least to some degree, the rate of deprotonation.

It is also possible to use a second drug as a deprotonating agent. For example, if drug X has a pK_b of 9 and drug Y has a pK_b of at least about 8.25, drug Y could be used to deprotonate drug X. Drug X would then have an enhanced rate of penetration into the skin. This can be particularly useful where drug Y is intended to act topically, is intended to be administered over a relatively longer period of time such that the salt form created is not a problem, or where the salt form of drug Y retains a relatively high rate of skin penetration. It may also be desirable to use two drugs with a pK_b differential of less than about 0.75 so as to setup a competitive deprotonating reaction between them.

Again, the amount of biocompatible deprotonating agent in accordance with the present invention will vary with a number of factors. The amount will be very dependent upon the amount of pharmaceutically active agent utilized. Moreover, the strength or pK_b differential between the deprotonating agent and the pharmaceutically active agent may also play a role in determining how much deprotonating agent is necessary. The range of deprotonating agent used will also vary with the stoichiometry of the deprotonation reaction. Generally, once the amount of protonated pharmaceutically active agents are selected, a stoichiometrically corresponding amount of deprotonating agent should be used. It may be desirable to add an excess of deprotonating agent relative to the amount of deprotonated pharmaceutically active agent so as to ensure a complete reaction.

Any of the formulations discussed herein may also include a viscosity modifier such as Fumed Silica such as Cabosil, adhesive compatible acrylic polymers such as Elvacite from DuPont, and vinyl polymers such as Polyvinyl Pyrrolidone (Plazdone C-30 from ISP), Ammonium Polyacrylates (such as Acrysol G-110 from Rohm and Haas), Hydroxy Propylcellulose (such as Klucel from Aqualon). The viscosity modifier may play a role in controlling release of the drug and/or the rate of the deprotonation reaction. Cross linkers such as: Metal Alkoxides (such as Isopropoxide), Melamine-based Polyols (such as Cylink HPC resins from Cytec Industries, Inc.), Organic Titanates (such as Tyzor from DuPont Chemicals) may also be used. The composition of the present invention may further include one or more Permeation Enhancers such as: Propylene Glycol, Polyethylene Glycol, unsaturated long-chain fatty acids (such as Oleic Acid), short-chain alcohols (such as Ethanol, Isopropanol, n-Butanol), Dimethylsulfoxide, Azone, N-Methyl-2-Pyrrolidone, Decylmethylsulfoxide, Anionic Surfactants (such as Sodium Lauryl Sulfate), Nonionic Surfactants (such as Polyoxyethylene (20) Sorbitan Monoleate), Cationic Surfactants (such as N, N-Bis (2-Hydroxyethyl)-Oleylamine), Zwitteronic Surfactants (such as Dodecyl-Dimethylammoniopropane Sulfate), Terpenes. These may be particularly useful when using a drug as a deprotonating agent as the delivery profile of the later protonated drug may be significantly enhanced. Anti-irritants such as Hydrocortisone, Flurbiprofen, and Indomethecin may also be useful.

The therapeutic formulation in accordance with the present invention can be made in a number of ways. A particularly preferred method, the deprotonating agent such as, for example, TEA or PEI, is mixed with a small amount of nonaqueous solvent such as, for example, 1,2 propanediol. This solution is then mixed into the acrylic adhesive base material. Thereafter, a pharmaceutically active agent in protonated form, such as, for example, selegiline-HCl, is dissolved in a nonaqueous solvent, and, preferably, the same nonaqueous solvent used to dissolve the deprotonating agent. Thereafter, the drug-containing solution is added to the mixture of the adhesive base and the dissolved deprotonating agent. While within the acrylic adhesive base, the selegiline-HCl and the deprotonating agent, i.e., TEA, react such that TEA-HCl and free selegiline are formed. The reaction kinetics of this reaction strongly favor these end products. Of course, the order of the addition of ingredients can vary. For example, the TEA solution can be added to the selegiline-HCl solution and then the resulting mix can be added to the adhesive.

Generally, all mixing is done at room temperature. However, the deprotonating reaction may be somewhat exothermic and, therefore, it may be advantageous to cool the mixture to prevent degradation of the drug. After the mixture in accordance with the present invention has been formed and while the deprotonating reaction is taking place, the material may be directly forwarded and introduced into a transdermal patch.

A typical patch is shown in FIG. 1. It includes a baking layer 1, a release layer 2 and a therapeutic adhesive formulation including both adhesive and drug in free form 3, disposed therebetween. In use, the release layer is peeled away exposing a surface of the adhesive which is then applied to the skin. The backing layer helps contain the material and prevent contamination. Any material useful in the production of transdermal patches can be used herein and almost any construction is appropriate.

In accordance with another aspect of the present invention, it is possible to deprotonate the protonated pharmaceutically active agent prior to its introduction into an admixture with the adhesive material. In this case, the pharmaceutically active agent and the deprotonating agent, as previously described herein, are mixed in a solvent until the reaction between the two components is complete. Generally, a stoichiometric or slightly greater amount of deprotonating agent is used relative to the amount of pharmaceutically active agent so as to insure that the equilibrium drives the deprotonating reaction to completion. Often, the consequence of this reaction will be the formation of crystals or a precipitate of the now protonated deprotonating agent. While there is generally no adverse consequence because of the inclusion of such crystals, it is preferred to minimize or entirely eliminate such crystals if possible. Accordingly, before the mixture is mixed into the adhesive material base, the mixture is centrifuged, filtered, or otherwise processed such that the solid crystals or precipitate are removed. The remaining solution comprising mainly solvent and deprotonated pharmaceutically active agent, along with some residual liquid deprotonating agent, is then mixed into the

adhesive mixture and then used in the production of transdermal patches as previously described. It is also possible to remove any crystals or other solids from the adhesive before the adhesive is used to construct a transdermal patch. This is accomplished as previously discussed.

In accordance with another aspect of the present invention, it may also be desirable to control the rate of the deprotonating reaction and, therefore, the conversion of the protonated pharmaceutically active agent to the free form thereof. By this statement, it should be understood that the present invention is nonetheless different than the Heiber et al. patent previously discussed. In Heiber et al., a physical barrier is provided to stop substantially any reaction between the therapeutic agent and an activating agent therefor until just prior to use. The materials must be maintained completely separately starting from manufacture and continuing through storage up until the moment of use. In the present invention, even if steps are taken to control the rate of reaction, nonetheless, some reaction between the protonated form of the pharmaceutically active agent and the biocompatible deprotonating agent will take place during manufacture or not long thereafter. Additional conversion will take place during storage prior to use.

One method of controlling the rate of reaction was described previously and involves the use of PEI. Other cage-like deprotonating agents may also be used. Similarly, it may be possible to place either the pharmaceutically active agent or the biocompatible deprotonating agent inside of a microcapsule, microsphere, or matrix microparticle which somewhat restricts but does not completely eliminate the interaction of the two reactive species. The degree of permeability or the degree of dissolution of the microcapsule material will, at least in part, be rate controlling. Alternatively, the viscosity and/or degree of crosslinking of the adhesive material and/or the totality of the formulation can be increased or decreased. The greater the viscosity and/or molecular weight of the adhesive mixture, the greater the diffusion time for the various ingredients and the slower the time of reaction. Patches in accordance with the present invention can also be stored at generally lower temperatures which can also control the reaction of kinetics.

Another interesting method in accordance with the present invention involves separate formation of two or more layers of adhesive material in accordance with the present invention. One of the adhesive layers would include mixed therein the protonated form of the pharmaceutically active agent dissolved in a nonaqueous solvent. A second layer (adhesive or not) would include the biocompatible deprotonating agent dissolved in a nonaqueous solvent. These two layers could then be superimposed or placed in intimate contact with one another. Some reaction between the deprotonating agent in one layer and the pharmaceutically active agent in the adjacent layer will take place substantially immediately or shortly after contact. However, depending upon the design, the ratio of continued reaction may depend upon diffusion through the various layers. Eventually, the entirety of the pharmaceutically active agent will be deprotonated.

As shown in FIG. 2, a transdermal patch of this type includes a baking layer **1**, a release layer **2** a first adhesive layer **3** adjacent the release layer and a second layer **4** disposed between the adhesive layer **3** and the backing layer **1**. Second layer **4** may be an adhesive layer, but it need not be adhesive. The protonated drug is initially disposed in either layer **3** or layer **4** and the deprotonating agent is disposed in the other layer. Over time, as the drug is converted to free form, the distribution of the drug may vary within the layers. In use, the release layer **2** is peeled away exposing a surface of the first adhesive layer **3** which is then applied to the skin. The backing layer **1** helps contain the material and prevent contamination. Any material useful in the production of transdermal patches can be used herein and almost any construction is appropriate

This later arrangement has additional benefits. Specifically, during the manufacture of an adhesive patch as described herein, after the adhesive mixture including the pharmaceutically active agent have been introduced into the patch or formed into a mold, the material is dried. During that drying, it is not uncommon for some of the pharmaceutically active agent to evaporate. This can cause the dosage form to be underweight in terms of the amount of therapeutic material delivered, or may force a manufacturer to incur additional costs by producing a wet mixture containing an excess of pharmaceutically active agent with the expectation that a percentage thereof will evaporate away. In accordance with one aspect of the present invention, however, the deprotonating agent and the pharmaceutically active agent are dissolved into two different layers, each of which is separately dried. Neither the deprotonating agent nor the protonated drug are as sensitive to the heat used in drying as the deprotonated pharmaceutically active agent. After drying, the individual layers can be brought into intimate contact with each other such that the deprotonating reaction can begin.

Finally, when the drug used is a highly plasticizing drug as defined herein, it may be added to the adhesive as either a free base form or as a protonated drug. In the case of the former, deprotonating agents, and possibly solvents, will not be necessary. In the case of the latter, as with any other protonated pharmaceutically active agent as defined herein, both solvent and deprotonating agent may be necessary.

Formulating patches including highly plasticizing drugs in free form tends to be a far simpler operation. The drug is merely mixed with an acrylic polymeric adhesive, as well as any other additional excipients, and then treated as any other material, using methods conventional in the manufacturing of transdermal patches. The material can be made into a film, dried into a block poured into a mold and the like.

EXAMPLES

Example 1

Three formulations were produced in accordance with the present invention. The formulations are shown in Table 4 below.

TABLE 4

INGREDIENTS	WET BASIS	DRY BASIS*
Selegiline Base	3.5	5
GELVA 1753	119	85
Selegiline Base	6.74	10
GELVA 1753	134.4	80
Selegiline Base	9.45	15
GELVA 1753	105	15

*parts

Each formulation was prepared with the same protocol. An amount of liquid drug as indicated in Table 4 was weighed out. The indicated amount of dry adhesive was also weighed. The drug was slowly added to the adhesive while agitation continued moderately to create a homogenous blend. A thin film of the drug/adhesive blend was produced

in a controlled thickness of between 70–95 mg/ 10 cm^2 to a thickness of onto a release-coated plastic/paper substrate using a knife-over-roll technique. The coating was then dried in an oven at between 110° and 140° F. to remove the solvents. The dry drug-polymer film was then laminated to a backing material made of PET/PE and die-cut into patches.

Example 2

Analytical Study of Conversion of Selegiline-HCl to Selegiline Free Base.

Selegiline-HCl and one of the following deprotonating agents were added to water and analyzed for turbidity using standard protocols. The results are reported below in Table 5.

TABLE 5

DEPROTONATING AGENT	pK_b	TURBIDITY
Diethylamine	3.07	Yes
Triethylamine	3.28	Yes
Ethanolamine	4.5	Yes
Ammonia	4.75	Yes
Triethanolamine	6.2	Yes
Imidazole	7.05	Yes
Pyridine	8.77	Yes - Slight
Aniline	9.34	No

Selegiline free base, i.e., in its deprotonated form is only sparingly soluble in water. For this reason it is important that the solvent used in accordance with the present invention be a nonaqueous solvent. Visual observations of the resulting mixtures indicated turbidity in most of the tested cases. Turbidity is attributable to the conversion of the selegiline-HCl which is readily soluble in water to the free base form which is not.

Selegiline free form or free base has a pK_b value of approximately 9.0. As will be apparent from Table 5, pyridine having a pK_b of 8.77 produced some slight turbidity indicating some level of conversion of the selegiline-HCl to selegiline free base. However, aniline having a pK_b higher than selegiline, produced no turbidity indicating no conversion to the free base form. Imidazole having a pK_b of 7.05 produced strong turbidity indicating significant conversion.

Diethylamine and triethylamine also produced significant turbidity indicating conversion of the selegiline-HCl to the free base form. However, because of their low pK_b, and their resulting high pH, these deprotonating agents would generally be inappropriate for use in accordance with the present invention. Of course, it is possible that certain patch formulations which will require only brief exposure to the skin or very low concentrations of active ingredient may allow for the use of such agents.

The test was repeated using propylene glycol as the test medium. Selegiline free base concentration was measured by UV absorbency of cyclohexane extract and compared with a stoichiometric value of selegiline free base. The results are illustrated in Table 6.

TABLE 6

List	pK_b	Selegiline Free Base Conversion
Imidazole	7.05	100%
Pyridine	8.77	15%
Aniline	9.34	0%

Imidazole having a pK_b of 7.05 produced a selegiline conversion of approximately 100%. Pyridine having a pK_b of 8.77 produced a selegiline free base conversion of 15%. Aniline having a pK_b of 9.34 produced no conversion. This data strongly supports the visual observances of turbidity described above.

Example 3

Additional Analytical Testing

Additional testing was undertaken by dissolving various pharmaceutically active agents in a 25% solution of propylene glycol and analyzing them as described in Example 2. Triethylamine having a pK_b of approximately 3.28 was capable of converting phenylpropranolol-HCl and propranolol-HCl (the free base forms having a pK_b of 4 and 5 respectively). UV testing indicated that conversions were substantially complete. This shows that a pK_b differential of about 0.75 (in the case of phenylpropranolol, a differential of 0.72) is necessary for complete conversion from the hydrochloride salt to the free base form.

Of course, triethylamine had a measured pH of approximately 11.7 and a calculated pH of approximately 13.7. Such material would generally be too caustic for use in accordance with the present invention, especially of the calculated pH value, except under specialized circumstances. An actual pH of 11.7 is acceptable, an actual pH of 13.7 is not. Similarly, phenylpropranolol-HCl generally requires the use of a deprotonating agent having a pK_b which is so low that it may cause irritation. In addition, the free base form of this pharmaceutical itself has a pH of approximately 13 which is generally too caustic for use in accordance with the present invention.

Ammonia having a pK_b of 4.75 was able to completely deprotonate verapamil-HCl (free base having a pK_b of 6) and, partially deprotonate propanol (free base form having a pK_b of 5). This also demonstrates that the pK_b differential between the drug and the deprotonating agent needs to be approximately 0.75 or greater is useful to insure a complete reaction. Triethanolamine having a pK_b of 6 was fully able to convert scopolamine-HCl and clonidine-HCl to their respective free base forms (pK_b of 7–8 and 7 respectively).

Example 4

0.6 kg of selegiline HCl was dissolved in 1.17 kg of 1,2 Propanediol in a 2 gallon container, under mild agitation, using an air mixer. In a separate 2 liter container, 0.407 kg of TEA was mixed with 0.4 kg of Ethanol at ambient temperature using mild agitation from air mixer. In a separate 5 gallon container, 3.55 kg of liquid adhesive GELVA 1753 was placed and 0.5 kg of Ethanol was mixed in using a high shear mixer. After all the Ethanol was dissolved, the Ethanol solution of TEA from the 2 liter container was gradually mixed into the adhesive while continuously mixing using a high shear mixer (Sharr mixer). After complete addition of TEA solution, 1.2 Propanediol solution of selegiline HCl, from a 2 gallon container, was gradually added to the continuously mixed adhesive. The mixing continued until a homogenous mixture was realized (about 30 minutes). Final adhesive mixture was coated (using knife-over-roll coating method) on a siliconized release liner and dried continuously in the 3 zone oven and "in line" laminated to a backing layer such as 1 mil Polyester. This laminate was subsequently die cut into round 10 cm^2 patches and packaged in heatsealable pouches.

Example 5

The procedure used in example 4 was repeated. However, 3.6 kg of selegiline HCl was dissolved in 6.3 kg of 1,2 Propanediol. Accordingly, the amount of TEA was increased from 0.407 kg to 2.44 kg and mixed with 2.4 kg of Ethanol. The amount of GELVA 1753 adhesive was increased to 21.0 kg and diluted with 3.0 kg of Ethanol. The adhesive mixture was agitated using Sharr Mixer while both solutions of selegiline HCl and TEA were subsequently added into mix as described in Example 4. The coating, drying, laminating was done as described in Example 4. Die cutting of the laminate and pouching of the patches were done as described in Example 4.

Example 6

17.773 kg of selegiline HCl was dissolved in 34.55 kg 1,2 Propanediol under mild agitation using an air mixer. In a separate container, 12.046 kg of TEA was mixed with 12.046 kg of Ethyl Alcohol and mixed using an air mixer. In a separate 10 gallon mixer, 16.05 kg of GELVA 1753 was placed and 5.7 kg of Ethanol was mixed in. While mixing 3.65 kg of the TEA solution was added to the adhesive mix and mixed very well using Sharr mixer. 7.926 kg of selegiline HCl solution was added. The mixing was continued until an homogenous mixture was obtained. The final mixture was pumped into the centrifuge and crystals of TEA HCl were separated from the clear adhesive mix at 17,000 rpm. The clear adhesive mix containing Selegiline Free Base was collected in a separate container. The clear adhesive mixture was coated, dried and laminated as described in Example 4. Die cutting of the laminate and pouching of the patches were done as described in Example 4.

Example 7

8.82 kg of selegiline HCl was dissolved in 16.92 kg of Propanediol in a stainless steel container under mild agitation using air mixer. 5.98 kg of TEA was mixed with 5.98 kg of Ethyl Alcohol in a stainless steel container under mild agitation using air mixer at 600 rpm. The contents of the two containers were then mixed together while mixing the selegiline HCl solution, the TEA solution was added gradually for about 10 minutes and then allowed to stand for a minimum of 8 hours. The above solution containing slurries of TEA HCl crystals were pumped to a centrifuge at a low rate. The centrate was separated and collected in a 10 gallon stainless steel container. The 10.91 kg of the centrate was dispersed in 59.3 kg of GELVA 1753 in a separate container using Sharr mixer. The mixing was continued until a homogenous adhesive mixture was realized. The adhesive mixture was coated, dried and laminated as described in Example 4. Die cutting of the laminate and pouching of the patches were done as described in Example 4.

Example 8

18 grams of selegiline HCl was dissolved in 35 grams of 1.2 Propanediol at about 40° C. in a 100 ml beaker under mild agitation using a magnetic stirrer. In a separate 150 ml beaker, 48.35 grams of GELVA 1753 adhesive was mixed with 17.33 grams of 1,2 Propanediol solution of selegiline HCl. After completion of mixing the adhesive mixture containing selegiline HCl was coated on a siliconized release liner using a laboratory knife-over-roll coater, dried in the oven and laminated to 1 mil polyester film. The coat weight of adhesive was about 100 mg per 10 cm^2. This was "Part A" of the final patch. 24.4 grams of TEA were mixed with 20 ml of 1.2 Propanediol in a 100 ml beaker. In a separate 150 ml beaker 42.9 g of GELVA 1753 adhesive was mixed with 11.1 g of 1,2 Propanediol solution of TEA. After completion of mixing, the adhesive mixture containing TEA was coated on a siliconized release linear using a laboratory knife-over-roll coater, and dried in the oven. The coat weight of adhesive was 50 mg per 10 cm^2. This was "Part B" of the final patch. After removing the release liner, the adhesive layer of "Part A" was laminated to adhesive layer "Part B". This laminate was allowed to age at room temperature for 3 days. After that, 10 cm^2 round patches were die cut and extracted in cyclohexane. The resulting free base of selegiline was analyzed. the conversion rate of selegiline HCl into selegiline free base was found to be 83%.

(Examples 9 through 18 relate to the formulations described in Table 3.)

Example 9

1.07 kg of selegiline free base was added to 10.9 kg of GELVA 1753 acrylic polymeric adhesive; both were in liquid form. The resulting therapeutic adhesive formulation was coated onto a polyester release liner using a knife-over-roll technique at 93 mg/10 cm^2 target coat weight and the result was dried. The resulting therapeutic adhesive formulation included 18 mg/10 cm^2 (dry) of selegiline and 72 mg/cm^2 (dry) of adhesive. The dried film was then laminated onto a clear PET/EVA backing material. The resulting patches exhibited acceptable drug storage stability as defined by the U.S. Food and Drug Administration for this class of transdermal patches and drug delivery profile. The resulting patches were able to remain on skin for at least 24 hours, exhibited no peeling or oozing, left no adhesive residue on the skin when removed and were removable without injury to the skin. Note that this therapeutic adhesive formulation does not include solvents other than those which are part of the commercially available adhesive and that the system is anhydrous. Substantially, all liquids in the system are removed by drying. However, some trace amounts of either liquid or solvent may still be present.

Example 10

130.5 parts of GELVA 1753 were mixed with 7.41 parts of selegiline free base and 20 parts of ethanol. The resulting therapeutic adhesive formulation was coated onto a polyester release liner and dried at 130° F. for 4 minutes. The dried film was then laminated on a PET backing. The resulting patches included approximately 15 mg/10 cm^2 (dry). The resulting patches were able to remain on skin for at least 24 hours, exhibited no peeling or oozing, left no adhesive residue on the skin when removed and were removable without injury to the skin. This therapeutic adhesive formulation was produced with ethanol as an added solvent. That solvent, as well as the solvents found in the commercial adhesive were evaporated during drying. The resulting formulation contains substantially no water or non-volatile liquids after drying. However, some trace amounts of either liquid or solvent may still be present.

Example 11

4.91 parts of selegiline free base and 20 parts by weight of ethanol were mixed with 136.75 parts of GELVA 1753 using the process described immediately in Example 10. The

resulting patches contained a therapeutic formulation including approximately 10 mg/10 cm^2 (dry) of selegiline. The resulting patches were able to remain on skin for at least 24 hours, exhibited no peeling or oozing, left no adhesive residue on the skin when removed and were removable without injury to the skin.

Example 12

109 parts of GELVA 1753 were mixed for one hour with 10 parts of propylene glycol, 5 parts of selegiline base and 20 parts of ethanol. The resulting therapeutic adhesive formulation was then coated onto a polyester release liner using a bench-top knife-over-roll coater and dried in an oven at 130° F. for four minutes. The dried film was laminated onto a PET backing. The dried film had a composition of approximately 8% selegiline and 10% PG, i.e., approximately 8 mg/10 cm^2 (dry). Like all of the other formulations including GELVA 1753, this formulation was acceptable in terms of adhesive transfer and oozing. However, unlike the 10% and 15% formulations (each of which were formulated with a volatile solvent), the adhesive properties of the patches resulting from this batch were found to be unacceptable. The PG remained as part of the formulation after drying and acted with the selegiline in such a way that it retarded adhesion.

Example 13

10 parts of PG, 5 parts of selegiline free base, 20 parts of ethanol, and 77.8 parts of DUROTAK 87-2194 were mixed and processed as described above in Example 10. As shown in Table 3, the formulation exhibited cohesive failure and adhesive transfer.

Example 14

83.33 parts of DUROTAK 87-2516 adhesive, 10 parts of PG and 5 parts of selegiline base, as well as 20 parts of ethanol were mixed as previously discussed and coated, using a bench-top knife-over-roll device, on a polyester release liner and dried in an over at 130° F. for four minutes. The dried film was then laminated to make PET backing. The resulting formulation contained approximately 8 mg/10 cm^2 (dry) of selegiline. As demonstrated in Table 3, patches made from this formulation exhibited adhesive transfer when applied to the skin.

Example 15

85.37 parts of GELVA 788 adhesive, 10 parts of PG, 5 parts of selegiline base and 20 parts of ethanol were mixed an processed as described in Example 14. Again, the therapeutic adhesive formulation included approximately 8 mg/10 cm^2 (dry) of selegiline and again adhesive transfer was found to result when these patches were applied to skin.

Example 16

1.07 kg of selegiline was added to 8.78 kg of GELVA 655 liquid adhesive with constant mixing. The resulting therapeutic adhesive formulation was then coated onto a silicone coated polyester release liner using a knife-over-roll technique at 93 mg^{+4}/10 cm^2 target coat weight and dried. The dried film was laminated to a PET/EVA backing. The resulting patches included 18 mg/10 cm^2 (dry) of selegiline. As demonstrated in Table 3, this formulation exhibited total adhesive failure.

Example 17

0.7 kg of selegiline was mixed with 11.1 kg of DUROTAK 87-2852 liquid adhesive and processed as above in Example 16. A polyester release liner was used. The resulting therapeutic adhesive formulation included 12 mg/10 cm^2 (dry) of selegiline. As shown in Table 3, no adhesive transfer or oozing was realized. This material was made without any solvent other than that provided as part of the adhesive and it exhibited acceptable adhesion results as described in Example 9

Example 18

1.07 kg of selegiline was added to 10.29 kg of adhesive and processed as above in Example 16. The resulting therapeutic adhesive formulation included 18 mg/10 cm^2 (dry) of selegiline. The release liner used was a silicone coated release liner. As shown in Table 3, this formulation, by virtue of the higher concentration of highly plasticizing drug, showed some softness.

Although the invention herein has been described with reference to particular embodiments, it is to be understood that these embodiments are merely illustrative of the principles and applications of the present invention. It is therefore to be understood that numerous modifications may be made to the illustrative embodiments and that other arrangements may be devised without departing from the spirit and scope of the present invention as defined by the appended claims.

The invention claimed is:

1. A therapeutic adhesive formulation comprising:

between about 65% and about 97%, by weight, of an acrylic polymeric adhesive which includes between about 40% and about 90% of a C_4–C_{12} alkyl acrylate, between about 10% and about 40% by weight of a C_1–C_4 alkyl acrylare hardening monomer; between about 1% and about 20% by weight of a monomer which provides functional groups for crosslinking; and a crosslinking agent; and

between about 3% and about 35% by weight, based on the weight of said mixture, of a highly plasticizing drug.

2. The therapeutic adhesive formulation of claim 1 wherein said C_4–C_{12} alkyl acrylare is selected from the group consisting of 2-ethylhexyl acrylate, butyl acrylate, n-decyl, n-nonyl, 2 ethyoctyl, isooctyl and dodecyl-acrylate.

3. The therapeutic adhesive formulation of claim 1 wherein said C_4–C_{12} alkyl acrylate is provided in an amount of between about 60% and about 80% by weight based on the weight of the adhesive.

4. The therapeutic adhesive formulation of claim 2 wherein said C_1–C_4 alkyl acrylate hardening monomer is selected from the group consisting of methyl acrylate, methyl methacrylate, ethylacrylate, ethyl methacrylate, hydroxyethyl acrylate and hydroxy propyl methacrylate.

5. The therapeutic adhesive formulation of claim 1 wherein said C_1–C_4 alkyl acrylate hardening monomer is provided in an amount of between about 15% and about 30% by weight based on the weight of the adhesive.

6. The therapeutic adhesive formulation of claim 1 wherein said functionalizing monomer which facilitates crosslinking is selected from the group consisting of acrylic acid, hydroxy ethylacrylate, methacrylic acid and acrylamide.

7. The therapeutic adhesive formulation of claim 1 wherein said functionalizing monomer which facilitates

crosslinking is provided in an amount of between about 3% and about 8% by weight based on the weight of the adhesive.

8. The therapeutic adhesive formulation of claim 1 wherein said highly plasticizing drug is selected from the group consisting of selegiline, fluoxetine, Des-methyl selegiline, tetracaine and chlorpheniramine.

9. The therapeutic adhesive formulation of claim 8 wherein said highly plasticizing drug is selegiline.

10. The therapeutic adhesive formulation of claim 1 wherein said highly plasticizing drug is provided in an amount of between about 3% and about 25% by weight of the finished adhesive& and drug mixture.

11. The therapeutic adhesive formulation of claim 10 wherein said highly plasticizing drug is provided in an amount of between about 3% and about 18% by weight of the finished adhesive and drug mixture.

12. The therapeutic adhesive formulation of claim 11 wherein said crosslinking agent is selected from the group consisting of butyl titinate, polybutyl titinate, aluminum isopropoxide, butyl titinate, aluminum zinc acetate, multivalent metals, methylol ureas and melamines.

13. The therapeutic adhesive formulation of claim 12 wherein said crosslinking agent is provided in an amount of between about 0.005% and about 2.0% based on the weight of the adhesive.

14. The therapeutic adhesive formulation of claim 1 wherein said formulation is anhydrous and substantially free of volatile solvents after drying.

15. A drug containing and releasing adhesive mixture comprising:

between about 65% and about 97%, by weight of an acrylic polymeric adhesive which includes between about 60% and about 80% of a C_4–C_{12} alkyl acrylate selected from the group consisting of 2-ethylhexyl acrylate, butyl acrylate, n-decyl, n-nonyl, 2 ethyoctyl, isooctyl and dodecyl-acrylate; between about 15% and about 30% by weight of a C_1–C_4 alkyl acrylate hardening monomer selected front the group consisting of methyl acrylate, methyl methacrylate, ethylacrylate, ethyl methacrylate, hydroxyethyl acrylate and hydroxy propyl methacrylate; between about 1% and about 20% by weight of a functionalizing monomer which facilitates crosslinking selected from the group consisting of acrylic acid, hydroxy ethylacrylate, methacrylic acid and acrylamide; and a crosslinking agent provided in an amount of between about 0.005% and about 2.0%; and

between about 3% and about 35% by weight, based on the weight of said mixture, of a highly plasticizing drug selected from the group consisting of selegiline, fluoxetine, des-methyl selegiline, tetracaine and chlorpheniramine.

16. The therapeutic adhesive formulation of claim 15 wherein said highly plasticizing drug is selegiline.

17. The therapeutic adhesive formulation of claim 15 which does not include a solvent after drying.

* * * * *

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Paper No.

MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE
SUITE 500
SAN DIEGO, CA 92130-2332

COPY MAILED

FEB 28 2005

OFFICE OF PETITIONS

In re Application of	:	
McCarthy et al.	:	
Application No. 09/754,949	:	DECISION ON PETITION
Filed: January 4, 2001	:	
Attorney Docket No. SCIOS.012A	:	

This is a decision on the "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNAVOIDABLY UNDER 37 CFR 1.137(a)," filed August 24, 2004. For the reasons set forth herein, the petition is properly considered as a petition under § 1.181 to withdraw the holding of abandonment.

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

By notice mailed July 2, 2003, the above-identified application was held abandoned for failure to timely submit new drawings in response to the Notice of Allowability mailed December 12, 2002[1]. On August 28, 2003, applicants filed a petition to withdraw holding of abandonment. Having received no response to the petition, petitioners filed the instant petition (and petition fee) under § 1.137(a).

The petition has been considered, and the prosecution history reviewed, and it has been determined that withdrawal of the holding of abandonment is warranted. Petitioners did not fail to timely respond to either the notices mailed December 12, 2002 or

[1] PALM records indicate that the Issue Fee was timely received on March 17, 2003 (with certificate of mailing dated March 11, 2003).

the subsequent requirement mailed April 21, 2003. Specifically, the record confirms that:

1. In response to the Notice of Allowance and Notice of Allowability both mailed December 12, 2002, the corrected drawings, issue fee, publication fee and notice of loss of entitlement to small entity status were timely filed on March 17, 2003. These papers are of record with a date of receipt thereon of March 17, 2003. The papers received include a properly itemized transmittal with a certificate of mailing pursuant to § 1.8(b) thereon signed by attorney of record James Mullen and dated March 11, 2003.

2. The responses filed March 17, 2003 constitute a complete reply to the notices. It is specifically noted that the new drawings have been found acceptable by the draftsman.

3. Likewise, in response to the Notice To File Corrected Application Papers mailed April 21, 2003, applicants timely filed a response on May 9, 2003. By Office action mailed May 21, 2004, the examiner advised applicants that the amendment had been entered.

In view thereof, the notice of abandonment mailed July 2, 2003 is hereby **vacated**, and the holding of abandonment is hereby **WITHDRAWN**.

Since consideration of the petition under § 1.137(a) is unnecessary for the reasons cited, the petition fee ($110) will be refunded to Deposit Account No. 03-1952, as authorized.

Receipt of notification of loss of small entity status filed March 17, 2003 is acknowledged and made of record.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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

Paper No. 4

Joe Zheng
SILICON VALLEY PATENT AGENCY, INC.
7394 WILDFLOWER WAY
CUPERTINO , CA 95014

JUN - 8 2001

In re Application of : Even S. Huang
Application No. 09/754,969
Filed: January 5, 2001
For: METHOD AND APPARATUS FOR GENERATING STRUCTURED DOCUMENTS FOR VARIOUS PRESENTATIONS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition, filed April 25, 2001 under 37 C.F.R. §102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination, to make the above-identified application special.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(A) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);

(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status...;

(C) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(D) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(E) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given one opportunity to perfect the request in a renewed petition to make special. If perfected, the request will then be granted. If not perfected in the first renewed petition, any additional renewed petitions to make special may or may not be considered at the discretion of the Group Special Program Examiner.

Applicant's submission meets the criteria set forth above. Accordingly the petition is **GRANTED**.

The application file is being forwarded to the Examiner for accelerated examination in accordance with M.P.E.P. '708.02. If the application is subsequently allowed, it will be given priority for printing. See M.P.E.P. '1309.

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

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JAN 11 2006

TECHNOLOGY CENTER 2100

Steven Schad
Banner & Witcoff, Ltd.
1001 G. Street, N.W.
Eleventh Floor
Washington, DC 20001-4597

In re Application of: Jan FORSLOW	)	
Application No. 09/755,027	)	*SUA SPONTE*
Attorney Docket No. 0254.00012	)	WITHDRAWAL OF HOLDING OF
Filed: January 8, 2001	)	ABANDONMENT *under 37 CFR 1.181*
For: EXTRANET WORKGROUP	)	
FORMATION ACROSS MULTIPLE	)	
MOBILE VIRTUAL PRIVATE		
NETWORKS		

The petition for withdrawal of the holding of abandonment, filed April 28, 2005, is being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

The petition is **GRANTED.**

A review of the application reveals that a Notice of Abandonment was mailed to the Applicant on April 8, 2005. The notice incorrectly indicated that the instant application was being held abandoned for failure to respond to the Restriction Requirement mailed on May 26, 2004. Applicant timely filed an extension of time for five (5) months, an election and remarks and bearing a central fax receipt date of November 26, 2004, wherein the election, remarks and extension of time are currently located in the file.

The amount indicated by Applicant authorized to be charged to Deposit Account No. 19-0733 for the extension of time for five (5) months, necessary to timely respond to the Restriction Requirement, is indicated to be $1040.00 (small entity). The Office charged the amount of $1020.00 for the extension of time on November 26, 2004. The correct amount to be charged on November 26, 2004 was in fact $1040.00. Therefore, the difference between the amount charged by the Office and that which was due at the time of the response is $20.00. This amount will be charged to deposit account No. 19-0733.

In view of these facts, the abandonment of the application was clearly in error and has been **VACATED**. The Office regrets any inconvenience this may have caused.

The application is being forwarded to the Supervisory Legal Instruments Examiner with instructions to charge $20.00 to Deposit Account No. 19-0733 (for the five months extension of time as indicated above) and to **REFUND** the revival fee of $1,500.00, charged on August 18, 2005.

Note, in response to the election filed November 26, 2004, a Non-Final Office action was mailed to Applicant on September 13, 2005. The shortened statutory period for response expired on December 13, 2005 and the statutory period for response expires on March 13, 2006 (with a three-months extension of time).

Inquiries to this decision may be directed to Special Programs Examiner Brian Johnson at (571) 272-3595.

Brian L. Johnson
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

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JUN 1 1 2001
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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:	)	
	)	
Arnold J. LEVINE	)	BOX: MISSING PARTS
	)	
Serial No.: 09/755,028	)	
	)	Docket No. 03848.00061
Filed: January 8, 2001	)	
	)	
For: P53-REGULATED GENES	)	

RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS

Assistant Commissioner of Patents
Washington, D.C. 20231
Attn: Box Missing Parts

Dear Sir:

In response to the Notice to File Corrected Application Papers, dated February 14, 2001, enclosed is the substituted specification. Applicants petition for a two month extension of time.

The Commissioner is authorized to charge Deposit Account No. 19-0733 in the amount of $390.00 to cover the petition for extension fee. It is believed that these fees as calculated are correct. However, if an additional fee is required, please charge Deposit Account No. 19-0733.

06/12/2001 TGEDAMU1 00000133 190733 09755028
01 FC:116 390.00 CH

Respectfully submitted,

06/12/2001 TGEDAMU1 00000133 09755028
01 FC:116 390.00 CH

By: Sarah A. Kagan
Sarah A. Kagan
Registration No. 32,141

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Dated: June 11, 2001

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JUN 1 1 2001
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APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUM
09/755,028	01/08/2001	Arnold L. Levine	03848.00061

CONFIRMATION NO. 4950

FORMALITIES LETTER

OC000000005765203

22907
BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON, DC 20001

Date Mailed: 02/14/2001

NOTICE TO FILE CORRECTED APPLICATION PAPERS

Filing Date Granted

This application has been accorded an Application Number and Filing Date. The application, however, is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given TWO MONTHS from the date of this Notice within which to correct the informalities indicated below. 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 required item(s) identified below must be timely submitted to avoid abandonment:

- A substitute specification in compliance with 37 CFR 1.52 because:
  - Papers contain improper margins. *Each sheet must have a left margin of at least 2.5 cm (1") and top, bottom and right margins of at least 2.0 cm (3/4")*

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

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MAY 22 2003

Paper No. 6

In re Application of
Mamoru Susaki
Application No. 09/755,058
Filed: January 8, 2001
Attorney Docket No. IIZ 120

: DECISION ON PETITION

The paper filed on December 16, 2002 is construed as a petition under 37 CFR 1.181 by which petitioner requests withdrawal of the holding that this application stands abandoned for failure to file a reply to the Office letter dated February 1, 2002. No fee is required for the petition.

The petition is granted.

Petitioner alleges that the application is not abandoned because a timely reply to the Office letter in question was in fact filed. Petitioner supports this allegation by including a copy of the reply, and a copy of a filing receipt for the reply which shows that the reply was actually received in the Office on February 15, 2002. It is clear from this showing that the application is 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 February 15, 2002.

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

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United States Patent and Trademark Office

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Paper No. 7

Pillsbury Madison & Sutro LLP
Intellectual Property Group
Ninth Floor, East Tower
1100 New York Avenue, N.W.
Washington, DC 20005-3918

MAR 6 2002

In re Application of	)	
WILKIN	)	DECISION ON PETITION TO
Application No. 09/755,114	)	RESET PERIOD FOR REPLY
Filed: January 8, 2001	)	
For: ROTOR DISC	)	

This is a decision on the petition filed via facsimile transmission on February 11, 2002, to reset the period for reply to an Office action due to late receipt of the action.

The petition is **granted**.

Petitioner states the date of receipt of an Office action at the correspondence address was January 16, 2002. The petition includes a copy of the cover sheet of the Office action mailed on December 6, 2001, having a date of receipt of "JAN 16 2002" stamped thereon.

Petitions to reset the period for reply to an Office action due to late receipt of the action are treated in MPEP § 710.06. As set forth in MPEP § 710.06, a petition to restart the previously set period for reply should be filed within two weeks of the date of receipt of the Office action at the correspondence address. In view of the fact that the Office action 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, this requirement will be waived. Petitioner is advised that any future petition to reset the period for reply to an Office action may not receive favorable consideration unless filed within two weeks of the date of receipt.

Accordingly, the shortened statutory period that was originally set forth in the Office action originally mailed on December 6, 2001 is hereby reset to run FROM THE RECEIPT DATE OF January 16, 2002.

The application file is being forwarded to the Central Files of Technology Center 2800 to await a response to the Office communication. No fee is required for the petition.

Edward Glick, Special Program Examiner
Technology Center 2800 - Semiconductors, Electrical
and Optical Systems and Components
(703) 308-4858

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BROMBERG & SUNSTEIN LLP
125 SUMMER STREET
BOSTON MA 02110-1618

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OFFICE OF PETITIONS

In re Application of	:	
Globerson	:	
Application No. 09/755,131	:	ON PETITION
Filed: January 8, 2001	:	
Attorney Docket No. 2639/B31	:	

This is a decision on the petition under 37 CFR 1.137(b), filed May 5, 2006 (certificate of mailing date May 2, 2006), to revive the above-identified application.

This application became abandoned for failure to timely pay the issue fee and publication fee within three (3) months of the mailing of the Notice of Allowance and Fee(s) Due, mailed January 13, 2005. Accordingly, this application became abandoned on April 14, 2005. A Notice of Abandonment was mailed on May 25, 2005.

Applicant has submitted a proper reply in the form of the issue fee, the publication fee and a completed PTOL-85, an acceptable statement of the unintentional nature of the delay in responding to the January 13, 2005 Notice of Allowance and Fee(s) Due, and the petition fee.[1]

The petition is **granted**.

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

[1] The statement of unintentional delay was not signed by a person who would have been in a position of knowing that the delay in filing a timely response was unintentional. In the event that practitioner has no knowledge that the delay was in fact unintentional, practitioner should make a reasonable inquiry to ascertain that, in fact, the delay was unintentional. If practitioner discovers that the delay was intentional, practitioner must so notify the Office.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

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Paper No. 15

PPG INDUSTRIES INC
INTELLECTUAL PROPERTY DEPT
ONE PPG PLACE
PITTSBURGH, PA 15272

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OFFICE OF PETITIONS

In re Application of :
Welch et al. :
Application No. 09/755,147 : ON PETITION
Filed: January 8, 2001 :
Attorney Docket No. 1582A1 :

This is a decision on the petition filed June 11, 2003, to accord a previously filed RCE a filing date of May 27, 2003, instead of May 28, 2003.

The petition is **dismissed**.

37 CFR 1.10(c) states,

> 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.

As to (2), the Express Mail mailing label number was not placed on the RCE.

Although the relief requested will not be granted, petitioner should note that the RCE will be considered to be a timely response to the February 27, 2003 final Office action. The RCE was filed in compliance with 37 CFR 1.8. The Certificate of Mailing date is May 27, 2003.

The file is now being forwarded to the examiner in Technology Center 1700 for consideration of the RCE and amendment.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

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)
6865221	2005-03-08	09/755,172	2001-01-08	5550-2-CON3

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	/Jason H. Vick/	Date (YYYY-MM-DD)	2009-04-21
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.

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

In re Patent No. 6865221
Issue Date: March 8,2005
Application No. 09755172
Filed: January 8,2001
Attorney Docket No. 081513.00003

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

This is a decision on the electronic petition, filed April 21,2009 ,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 April 21,2009 . 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.

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ALEXANDRIA, VA 22313-1450
WWW.USPTO.GOV

Paper No. 16

PILLSBURY WINTHROP
P.O. BOX 10500
MCLEAN VA 22102

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OFFICE OF PETITIONS

In re Application of
Mike Farwick et al
Application No. 09/755,187
Filed: January 8, 2001
Attorney Docket No. 021123-0275573

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 1, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/503,189, filed February 14, 2000 set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;[1]
> **(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)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on January 8, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) 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 instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 1652 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to prior-filed nonprovisional Application No. 09/503,189, filed February 14, 2000.

Frances Hicks

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

ATTACHMENT: Corrected Filing Receipt

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OFFICE OF PETITIONS

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

In re Application of	:	
Chen et al.	:	
Application No. 09/755,207	:	DECISION ON PETITION
Filed: January 5, 2001	:	
Attorney Docket No. PA010098	:	

This is a decision on the petition under 37 CFR §1.137(b), filed July 5, 2005.

This above-identified application became abandoned for failure to timely file a proper response to a final Office Action which was mailed on June 3, 2004. The final Office Action set a three (3) month shortened statutory period for reply. A response to the final Office Action was filed on September 14, 2004 with a one month extension of time . An Advisory Action was mailed on December 27, 2004 informing applicant the response filed did not place the application in condition for allowance. Accordingly, this application became abandoned on October 4, 2004. This decision precedes the mailing of a Notice of Abandonment.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

Pursuant to petitioner's request deposit account No. 17-0025 will be charged the $1500.00 petition fee.

The RCE and the amendment previously submitted will be forwarded to Technology Center 2600 for further processing.

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

Charlema R. Grant
Petitions Attorney
Office of Petitions

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 6

Martin L. Stern
MICHAEL BEST & FRIEDRICH LLP
401 North Michigan Avenue, Suite 1900
Chicago, IL 60611

In re Application of:	)	
David P. Harris et al.	)	
Application No. 09/755,208	)	**DECISION ON REQUEST FOR**
Filed: January 05, 2001	)	**WITHDRAWAL AS ATTORNEY**
For: "METHOD FOR PREDICTING MACHINE OR PROCESS FAULTS AND AUTOMATED SYSTEM FOR IMPLEMENTING SAME"	)	

This is a decision on the Request To Withdraw from Representation filed February 17, 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 February 17, 2004 meets all the requirements. Accordingly the request is **GRANTED**.

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

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

cc: Mr. David Harris
ZERO MAINTENANCE INTERNATIONAL CORPORATION
689 N. Milwaukee Avenue
Chicago, IL 60622

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

SEP 13 2002

Oral Sekendur
399 W. Fullerton Pkwy
Chicago IL 60614

Paper No. 9

In re Application of Oral Sekendur Serial No. : 09/755,231 Filed : January 8, 2001 For : One-Piece Disposable Dental Articulator	: DECISION ON PETITION : TO WITHDRAW : HOLDING OF : ABANDONMENT

This is a decision on petitioner's request filed July 30, 2002 (certificate of mailing dated July 24, 2002), to review the holding of abandonment mailed July 16, 2002, for failure to timely file a response to the Office letter of April 24, 2002. There is no fee required for this petition.

Although not specifically stated, the basis for the request is that the period for response to the Office letter of April 24, 2002 had not yet expired as of July 16, 2002. The letter of April 24, 2002 set a new time period for response of one month and included a statement that extensions of time for that period were grantable under 37 CFR 1.136(a). The deadline for responding to the Office action of April 24, 2002, was May 24, 2002, with extensions possible through October 24, 2002. With the petition, a response to the letter of April 24, 2002 and a two-month extension were filed. Clearly, in view of the above, the abandonment of this application was premature and in error and is hereby withdrawn.

Upon the mailing of this decision the application will be forwarded to the Examiner via the Legal Instruments Examiner for entry and processing of the response filed July 30, 2002.

Summary: Holding of Abandonment Withdrawn.

John E. Kittle, Director
Groups 3730 & 3760
Phone: (703) 308-0873

ak/8/21/02

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

John A. Caccuro
9 Ladwood Dr.
Holmdel NJ 07733

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APR 0 2 2003

OFFICE OF PETITIONS

In re Application of		
Corrado P. Dragone	:	
Application No. 09/755,243	:	ON PETITION
Filed: January 5, 2001	:	
Attorney Docket No. 68	:	

This is a decision on the petition under 37 CFR § 1.137(b), filed March 17, 2003, to revive the above-identified application.

The petition is **granted**.

This application became abandoned for failure to respond in an appropriate and timely manner to the " Notice to File Corrected Application Papers" (the "Notice") mailed March 30, 2001, which set forth a two (2) month period for reply. The Notice required that substitute drawings being filed. No response was received within the allowable period and the application became abandoned on May 31, 2001.

The substitute drawings filed March 17, 2003, are noted and made of record.

The application is being forward to the Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0010.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

#8
4-16-03

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APR 1 6 2003

TECHNOLOGY CENTER 2100

Paper No. 8

John W. Ryan
WILMER CUTLER & PICKERING
2445 M Street, N.W.
Washington, DC 20037

In re Application of:	)	
Brian WYLD	)	
Application No. 09/755,283	)	**DECISION ON REQUEST FOR**
Filed: January 8, 2001	)	**WITHDRAWAL AS ATTORNEY**
For: EXTERNAL FAULT TOLERANT SHARED MEMORY UNIT IN A DISTRIBUTED MULTIPROCESSING SYSTEM	)	

This is a decision on the Request To Withdraw from Representation filed April 10, 2003.

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

The request filed April 10, 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: HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, Colorado 80527-2400

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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PO Box 1450
Arlington, VA 22313-1450
www.uspto.gov

Paper No. 6

Dirk Coldeway
828 Western Drive
Santa Cruz, CA 95060

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OFFICE OF PETITIONS

In re Application of	:	
Dirk Coldewey	:	
Application No. 09/755,286	:	ON PETITION
Filed: January 3, 2001	:	
Attorney Docket No. n/a	:	

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

The petition is granted.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the Notice to File Corrected Application Papers (Notice) mailed February 22, 2001, which set a shortened statutory period for reply of (2) months. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on April 23, 2001.

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

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United States Patent and Trademark Office
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Anne Vachon Dougherty
3173 Cedar Road
Yorktown Heights NY 10598

In re Application of	:	
TADOKORO, MIZUHO	:	
Application No.: 09/755308	:	DECISION ON
Filing or 371(c) Date: January 2, 2001	:	PETITION
Attorney Docket Number: **JP920000027-US1**	:	

This is a decision in response to the "Petition to Withdraw Holding of Abandonment," filed January 30, 2006.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance, mailed August 8, 2005.

In view of the foregoing, the holding of abandonment for failure to timely submit Formal Drawings is hereby withdrawn and the application restored to pending status.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 756 - 1499.

Kendrick Sprull
Application Assistance Unit
Office of Data Management

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 10

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

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MAR 29 2004

OFFICE OF PETITIONS

In re Application of
Maloney et al.
Application No. 09/755,312
Filed: December 19, 2000
Attorney Docket No. PA000190

ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), filed March 18, 2004. This petition is being treated under 37 CFR 1.181 as a petition to withdraw the holding of abandonment.

The petition to withdraw the holding of abandonment is **GRANTED**.
The petition under 37 CFR 1.137(b) is **DISMISSED AS MOOT**.

This application became abandoned for failure to timely submit a response to the Office Action mailed July 10, 2003. The Notice set an extendable 1 month period for reply. No extensions of time pursuant to 37 CFR 1.136(a) were obtained. Accordingly, this application was held abandoned on August 11, 2003. A Notice of Abandonment was mailed on February 19, 2004.

Petitioner maintains the a Response to the Office Action was timely submitted on July 28, 2003. In support, petitioner has provided a copy of an stamped post card receipt. The postcard acknowledges receipt of an Amendment on July 28, 2003. The postcard receipt serves as prima facie evidence the documents listed were received at the USPTO. However, a review of the file indicates Amendment cannot be located. Accordingly the copy of the amendment submitted with the petition will be used for examination purposes.

Based on the facts stated in the instant petition, and the corroborative evidence provided, it is concluded that the holding of abandonment was improperly imposed.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

Since the petition has been granted under 37 CFR §1.181, the Petitioner's request to have the petition considered under 37 CFR §1.137(b) is dismissed as moot.

This application is being forwarded to Technology Center 2600 for further processing of the amendment.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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United States Patent and Trademark Office
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Paper No. 7

Alston & Bird
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000

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OFFICE OF PETITIONS

In re Application of
D. Demille et al.
Application No. 09/755,313
Filed: December 27, 2000
Attorney Docket No. EXT.462C1

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 19, 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 February 20, 2001. 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 April 21, 2001.

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

cc: Eric W. Cernyar
Kinetic Concepts, Inc.
PO Box 659508
San Antonio, TX 78265

UNITED STATES PATENT AND TRADEMARK OFFICE

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Michael E. Mauney
Attorney at Law
P. O. 10266
Southport NC 28461

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JUL 1 0 2006

OFFICE OF PETITIONS

In re Application of	:
Goodwin	:
Application No. 09/755,317	: DECISION ON PETITION
Filed: January 5, 2001	: UNDER 37 CFR 1.181
Attorney Docket No. N/A	:
For: NETWORK METHOD SYSTEM AND APPARATUS FOR RECORDING AND MAINTAINING RECORDS	

This is a decision on the petition under 37 CFR 1.181, filed May 11, 2006 (certificate of mailing date May 8, 2006), to withdraw the holding of abandonment of the above-identified application.

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

This application was held abandoned due to applicant's alleged failure to reply within an extendable three month period to the non-final Office mailed July 21, 2005. Having received no extension of time or reply, the Office contended that this application became abandoned on October 22, 2005. A Notice of Abandonment was mailed on May 4, 2006.

Petitioner asserts that a reply was timely filed on certificate of mailing date October 4, 2005 and received in the Office on October 6, 2005. In support of this assertion, petitioner has provided a copy of applicant' response that contains a proper certificate of mailing bearing a October 4, 2005 date of deposit.

Under 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 Certificate of Service bears a proper certificate of mailing, dated October 4, 2005, in compliance with the requirements of 37 C.F.R. § 1.8(a)(1) as set forth above. In addition, the attorney signing the certificate, Michael E. Mauney, had reasonable basis to expect that the correspondence would be mailed on October 4, 2005.

In addition, petitioner has submitted an itemized postcard receipt showing an Office of Initial Patent Examination date stamp, citing October 6, 2005 as the date of receipt, affixed thereto. The postcard lists that the filing included a "Response to Office Action" in application no. 09/755,317. The return postcard constitutes *prima facie* evidence that the items listed thereon were received in the Office on October 6, 2005, 2005. MPEP 503.

Accordingly, the petition under 37 CFR 1.181 is **GRANTED**, the holding of abandonment is withdrawn, and the May 4, 2006 Notice of Abandonment is vacated.

After the mailing of this decision, the application file will be returned to Technology Center AU 2143 for consideration of the amendment filed on certificate of mailing date October 4, 2005 and resubmitted with the present petition.

Any 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

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SEP 25 2006

OFFICE OF PETITIONS

In re Patent No. 7,024,473 :
Issued: April 4, 2006 :
Application No. 09/755,348 : NOTICE
Filed: January 5, 2001 :
Docket No.: 1353 P :

This is a notice regarding the "Statement of Facts in Accord with 37 CFR §1.28(c)(1) filed April 20, 2006.

As set forth at 37 CFR 1.28(c), the deficiency is based on the amount of the fee, for other than a small entity, in effect at the time the deficiency is paid in full. Accordingly, the fee deficiency submission under 37 CFR 1.28 is hereby **accepted.**

The change of status to a large entity has been entered and made of record.

This file is being forwarded to the Files Repository.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

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John J. Karasek
Associate Counsel (Intellectual Property)
Code 1008.2 Naval Research Laboratory
4555 Overlook Ave. S.W.
Washington DC 20375-5320

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AUG 30 2005

OFFICE OF PETITIONS

In re Application of
JASBINDER S. SANGHERA et al.
Application No.: 09/755,375
Attorney Docket No.:NC 82.919

: DECISION on PETITION
:
: UNDER 37 CFR 1.137(b)
:

This is a decision on the petition under 37 CFR 1.137(b), filed August 24, 2004 and refiled on April 13, 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 22, 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, by operation of law, the above-identified application became abandoned at midnight on August 22, 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 August 24, 2004 is accepted as having been unintentionally delayed.

It is noted that the transmittal letter, amendment and petition, submitted on August 24, 2004, sets forth "Shyam Bayya" as the inventor for this application. However, there is no indication that Bayya was ever named as an inventor in this application. Further, the combined Declaration and Power of Attorney submitted does not list Bayya as an inventor. Therefore, all future papers filed in this case should denote Jasbinder S. Sanghera and Ishwar D. Aggarwal (or Sangera et al.) as the inventors in this application.

The application is being referred to Technology Center AU 2855.

Telephone inquiries concerning this decision should be directed to Cynthia Kratz at (571) 272-3286 or in her absence, the undersigned at (571) 272-3217.

Frances Hicks for
Brian Hearn
Petitions Examiner
Office of Petitions

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ALEXANDRIA, VA 22313-1450
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AUG 18 2004

In re Application of :
Robert I. Nurse : DECISION ON PETITION
Application No. 09/755,408 :
Filed: January 5, 2001 :
Attorney Docket No. 7903M

This is a decision on the petition filed on February 26, 2004 by which petitioner requests withdrawal of the abandoned status of this application. A Notice of Abandonment has not been mailed. However, it appears that the application stands abandoned for failure to timely file a proper reply to the final Office action dated August 5, 2003. The petition is being considered pursuant to 37 CFR 1.181, and no fee for the petition is required.

The petition is dismissed.

Petitioner alleges that a reply to the Office action in question, a final rejection, was in fact timely filed on October 9, 2003, but was not properly entered in the record, but was never acted upon. Apparently, petitioner takes the position the response placed the application in condition for allowance, and requests that the application be processed to issue.

It appears from the record that a reply to the final Office action was facsimile transmitted to the Office on October 6, 2003, but received no action. The record also shows that a copy of the reply was filed on February 26, 2004. Both the originally filed reply and the copy of the reply to the Office action in question have been associated with the application file. As noted, the reply is entitled to a 37 CFR 1.8(a) certificate date of October 6, 2003, making the reply timely. However, under 37 CFR 1.113 and 1.116, only certain replies to a final Office action are considered to be a **proper** reply to a final rejection. Therefore, the reply has been forwarded to the examiner for consideration as to whether the reply filed on considered the reply filed on October 6, 2003 was proper under the above mentioned regulations. The examiner reports that the reply does not place the application in condition for allowance because the newly proposed limitations in claims 1 raise a question of new matter as to whether upstanding strut 42 is "articulably" connected to the sidewall according to the original application disclosure. The examiner is also of the opinion that even aside from that issue, the proposed amendment would not, *prima facie*, place the application in condition for allowance over the prior art Artusi reference.

Petitioner was under an obligation imposed by 37 CFR 1.113 and 1.116 to file a proper reply to the final within the meaning of these regulations. Petitioner had, therefore, a duty to monitor the status of the application and the status of the reply that was filed, and to make inquiries as necessary regarding the reply and the application. Ultimately, even in the absence of any information regarding the reply, petitioner had a duty to file a timely reply that was in compliance with the regulations in order to forestall abandonment. As stated in MPEP § 711.03(c):

> "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." (Emphasis supplied.)

In this instance, it appears that abandonment has resulted from the failure to file a reply meeting the requirements of 37 CFR 1.113 and 1.116, coupled with the failure to monitor the status of the application so as to take action appropriate under these regulations prior to the expiration of the maximum time permitted by 35 USC § 133 for doing so. In the absence of the filing a reply as required by 37 CFR 1.113 and 1.116, the application has been properly held to have become abandoned under 35 USC § 133 for failure to file a timely and proper reply to the final rejection.

For the foregoing reasons, it appears that there was no error on the part of the Office in holding that this application has become abandoned. It further appears that petitioner's remedy is to proceed pursuant to 37 CFR 1.137. However, petitioner is entitled to file a request for reconsideration of this decision, without

fee, provided that such request is filed within two months of the date of this Decision. See 37 CFR 1.181(f).

The file is being forwarded to the attention of the Supervisory Patent Examiner of Art Unit 3727 to have a Notice of Abandonment mailed in this application.

PETITION DISMISSED.

E. Rollins-Cross, Director
Technology Center 3700

Stephen T. Murphy
The Procter & Gamble Company
Winton Hill Technical Center
6100 Center Hill Avenue
Cincinnati, OH 45224

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Winton Hill Technical Center
6100 Center Hill Avenue
Cincinnati, OH 45224

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OFFICE OF PETITIONS

In re Application of
Robert Nurse
Application No. 09/755,408
Filed: January 5, 2001
Attorney Docket No. 7903M

DECISION ON PETITION

This is a decision on the petition filed September 20, 2004, pursuant to 37 C.F.R. § 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 C.F.R. § 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. § 1.137(b)."

The above-identified application became abandoned for failure to file a timely and proper reply to the final Office action mailed August 5, 2003. This Office action set a shortened statutory period for reply of three (3) months. By petition filed February 26, 2004, applicant requested withdrawal of the abandoned status of the application. By decision mailed August 18, 2004, the petition was dismissed. It was stated that the record established that an amendment was timely filed with a certificate of mailing dated October 6, 2003; however, the amendment was determined by the examiner not to place the application in condition for allowance.

The provisions of 37 C.F.R. § 1.137(b) provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent. A petition filed 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 Director 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.

The instant petition does not satisfy requirement (1) above. With this petition, petitioner stated that the required reply was previously filed on October 6, 2003. However, as previously stated and for the reasons set forth therein, on decision mailed August 18, 2004, applicant was advised that the response considered timely filed with a certificate of mailing dated October 6, 2003, did not place the application in condition for allowance.

The proposed reply required for consideration of a petition to revive must be either (1) a Notice of Appeal (and fee required by law), (2) an amendment that prima facie places the application in condition for allowance, (3) the filing of a continuing application, (4) a request for continuing examination under §1.114, or (5) if applicable, a §1.129(a) submission.

A required reply must be submitted with any renewed petition if the application is to be revived.

The petition fee has been charged to Deposit Account No. 16-2480, as authorized.

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: (703) 872-9306
ATTN: Office of Petitions

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

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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Stephen T. Murphy
The Procter & Gamble Company
Winton Hill Technical Center
6100 Center Hill Avenue
Cincinnati, OH 45224

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OFFICE OF PETITIONS

In re Application of	:	
Robert Nurse	:	
Application No. 09/755,408	:	DECISION ON PETITION
Filed: January 5, 2001	:	
Attorney Docket No. 7903M	:	

This is a decision on the renewed petition filed February 15, 2005, pursuant to 37 C.F.R. § 1.137(b).

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 August 5, 2003. A petition to withdraw the holding of abandonment filed February 26, 2004 was dismissed (Decision mailed August 18, 2004). The initial petition under § 1.137(b) filed September 20, 2004 was dismissed for failure to submit the reply required pursuant to § 1.137(b)(1)(Decision mailed February 1, 2005).

On instant renewed petition, petitioner has submitted the reply required in the form of a Request for Continued Examination (RCE), RCE fee and submission under § 1.114. Petitioner has now met all requirements for revival.

The application is being forwarded to Technology Center 3727 for consideration of the RCE and amendment by the examiner.

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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MERCHANT & GOULD (MICROSOFT)
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

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In re Application of	:	
WONG, et al.	:	
Application No. 09/755,433	:	DECISION GRANTING PETITION
Filed: January 05, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 60001.0029US01	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 21, 2006, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on November 06, 2006 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 regarding this decision should be directed to Patricia Volpe at 571-272-6825.

This application is being referred to Technology Center AU 3621 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.*

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MERCHANT & GOULD (MICROSOFT)
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

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In re Application of	:	
WONG, et al.	:	
Application No. 09/755,433	:	DECISION GRANTING PETITION
Filed: January 05, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 60001.0029US01	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed November 21, 2006, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on November 06, 2006 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 regarding this decision should be directed to Patricia Volpe at 571-272-6825.

This application is being referred to Technology Center AU 3621 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.*

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JUL 31 2006

OFFICE OF PETITIONS

SCOTT C. HARRIS
P O BOX 927649
SAN DIEGO, CA 92192

In re Application of
Harris
Application No. 09/755,452
Filed: January 5, 2001
Atty. Dkt. No.: FILE-DOMAIN/SCH

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This decision is in response to the petition under 37 CFR 1.137(b), filed April 18, 2006.

The petition is **GRANTED**.

The above-identified application became abandoned November 27, 2005 for failure to timely submit a proper reply to the final Office action mailed August 26, 2005. The final Office action set a three month shortened statutory period of time for reply. Notice of Abandonment was mailed March 27, 2006.

A grantable petition under 37 CFR 1.137(b) requires submission of: (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 Director 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 37 CFR 1.137(d).

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 is accepted as having been unintentionally delayed.

This application is being forwarded to Technology Center 2100 for processing of the request for continued examination submitted herewith.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

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Paper No. 8

JORDAN M. BECKER
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SEVENTH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES CA 90025-1026

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OFFICE OF PETITIONS

In re Application of	:
Curtis G. Yarvin	:
Application No. 09/755,482	: DECISION ON PETITION
Filed: January 5, 2001	: UNDER 37 CFR 1.137(b)
Attorney Docket No. 3399P039	:

This is a decision on the petition, filed May 14, 2003, under 37 CFR 1.137(f), which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application.

The petition is dismissed as **MOOT**.

An applicant who makes a nonpublication request under 35 U.S.C. 122(b)(2)(B)(i) and then rescinds (pursuant to 35 U.S.C. § 122(b)(2)(B)(ii)) the nonpublication request **before or on the date a counterpart application is filed in an eighteen-month publication country**, the nonpublication request will be treated as annulled and the application will be treated as if the nonpublication request were never made. *See* Notice published on www.USPTO.gov on June 6, 2003, which clarifies the USPTO's interpretation of the provisions of 35 U.S.C. § 122(b)(2)(B)(ii)-(iv).

In the instant application, a notice to rescind was filed prior to the filing date of a corresponding application in a foreign country. Therefore, since the filing of the request to rescind prior to the filing date of a corresponding application in a foreign application resulted in the annulling of the nonpublication request, this application is not regarded as abandoned. As such, the filing of a petition to revive is unnecessary and is dismissed as involving a moot issue.

Since this application is not in fact abandoned for the reason stated above, the petition fee of $1300 is being credited to Deposit Account No. 02-2666 as authorized.

This application is being forwarded to Technology Center Art Unit 2173 for examination in due course.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8859.

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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Paper No. 6

Tarek N. Fahmi
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
7th Floor
12400 Wilshire Boulevard
Los Angeles CA 90025

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OFFICE OF PETITIONS

ON PETITION

In re Application of
Song, et al.
Application No. 09/755,483
Filed: January 5, 2001
Attorney Docket No. 5416P001

This is a decision on the petition under 37 CFR 1.137(f), filed February 13, 2002, to revive the instant nonprovisional application.

The petition is **GRANTED.**

The above-identified application became abandoned pursuant to 35 USC 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(f) must be accompanied by: (1) the 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 Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(f). The nonpublication request has been rescinded.

Accordingly, the failure to timely notify the Office of a foreign filing within 45 days as provided by 35 USC 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

A Corrected Filing Receipt which sets forth the projected publication date accompanies this decision on petition.

As per petitioner's request deposit account 02-2666 has been charged the $1,280.00 petition to revive fee.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Philip M. Weiss, Esq.
Weiss & Weiss
300 Old Country Road, Ste. 251
Mineola, NY 11501

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OFFICE OF PETITIONS

In re Application of	:	
Roger P. Hoffman	:	
Application No. 09/755,488	:	ON PETITION
Filed: January 5, 2001	:	
Attorney Docket No. P/2-87	:	

This is a decision on the petition under 37 CFR 1.137(b), 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(b)." Petitioner is advised that this is not a final agency decision.

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) mailed January 16, 2004, which set a shortened statutory period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned after midnight February 16, 2004.

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

Since petitioner asserts that the Notice of Non-Compliant Amendment mailed January 16, 2004 was never received, a courtesy copy of the Notice is being mailed concurrently with this decision on petition for completion of petitioner's records. Accordingly, the above-identified application cannot be revived until the proper response has been submitted.

The Change of Correspondence Address filed November 22, 2004, has been entered and made of record.

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
220 20th Street S
Customer Window, Mail Stop Petitions
Crystal Plaza Two Lobby, Room 1B03
Arlington, VA 22202

By Fax: (703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may 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

Enclosure: Courtesy Copy of the Notice of Non-Compliant Amendment under 37 CFR 1.121 Mailed January 16, 2004.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Donna Jo Coningsby
Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd., Seventh Floor
Los Angeles, CA 90025-1026

MAIL

APR 0 9 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:Michael Yip	)	
Application No. 09/755,498	)	
Filed: January 5, 2001	)	
For: METHOD AND SYSTEM TO AGGREGATE MULTIPLE VLANS IN A METROPOLITAN AREA NETWORK	)	**DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER M.P.E.P. §708.02(VIII)**

This is a decision on the petition, filed March 4, 2002, suplimented with the paper filed April 8, 2002, requesting the grant of special status based on M.P.E.P. §708.02, Section VIII.

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, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

(c) Submits a statement(s) that a pre - examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office satisfies this requirement;

(d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and

(e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references.

Applicant's combination of submissions meets all the criteria set out above, accordingly, the Petition is **GRANTED**.

The application file is being forwarded to the Examiner of Record for accelerated examination according to the procedures set forth in M.P.E.P. §708.02, Section VIII.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

SILICON VALLEY IP GROUP
P O BOX 721120
SAN JOSE, CA 95172-1120

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JUL 1 0 2003

OFFICE OF PETITIONS

In re Application of
Daniel Malcione et al
Application No. 09/755,525
Filed: January 5, 2001
Attorney Docket No. NAI1P272/00.139.01

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed May 12, 2003, 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 (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**.

The instant nonprovisional application is the subject of an application filed in an eighteen month publication country on January 2, 2002. 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 Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 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 USPTO 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 rescinded.

As authorized by the petition, the required petition fee of $1,300 will be charged to Deposit Account No. 50-1217.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 2143 for examination in due course.

Frances Hicks

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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WALL MARJAMA & BILINSKI
101 SOUTH SALINA STREET
SUITE 400
SYRACUSE, NY 13202

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SEP 06 2005

OFFICE OF PETITIONS

In re Patent No. 6,299,793	:	
Issue Date: October 9, 2001	:	
Application No. 09/755,587	:	NOTICE
Filed: January 5, 2001	:	
Attorney Docket No. 781_002CIP	:	

This is in response to the paper filed May 3, 2005 under 37 CFR 1.27(c) seeking status as a small entity.

The statement claiming small entity status has been accepted and made of record. Therefore, small entity status has been accorded.

The application file is being referred to Files Repository.

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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ROPES & GRAY, LLP
PATENT DOCKETING 39/361
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

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NOV 10 2008

In re Application of	:	
Stewart Harris, et al.	:	
Application No. 09/755,591	:	DECISION ON PETITION
Filed: January 5, 2001	:	TO WITHDRAW
Attorney Docket No. CF/012	:	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 February 19, 2008.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Ropes & Gray, LLP has been revoked by the assignee of the patent application on April 23, 2008. 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 undersigned at 571-272- 1642.

/April M. Wise/
April M. Wise
Petitions Examiner
Office of Petitions

cc: DEAN P. ALDERUCCI
CANTOR FITZGERALD, LP
110 EAST 59TH STREET
6TH FLOOR
NEW YORK, NY 10022

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

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

Mail Date: 04/20/2010

Applicant	: Robin B. Hutchison	: DECISION ON REQUEST FOR
Patent Number	: 7606355	: RECALCULATION of PATENT
Issue Date	: 10/20/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/755,657	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/05/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1055** 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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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www.uspto.gov

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO, CA 92121

Mail Date: 04/20/2010

Applicant	: Tao Chen	: DECISION ON REQUEST FOR
Patent Number	: 7590095	: RECALCULATION of PATENT
Issue Date	: 09/15/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/755,659	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/05/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **773** 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.

#18

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 18

CHRISTENSEN, O'CONNOR, JOHNSON,
KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

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JUN 30 2003
OFFICE OF PETITIONS

In re Application of :
Allan S. Hoffman, et al. :
Application No. 09/755,701 : ON PETITION
Filed: January 5, 2001 :
Attorney Docket No. UWOTL119001 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 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 July 16, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 17, 2002.

The statement claiming small entity status in accordance with 37 CFR 1.27 embodied in the petition under 37 CFR 1.137(b) has been made of record and small entity status has been accorded.

Receipt is acknowledged of the Information Disclosure Statement filed June 24, 2003, with the instant petition.

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

The application file is being forwarded to Technology Center 1600, Art Unit 1639 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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Paper No. 11

MURRAY SCHAFFER
JASPAN SCHLESINGER HOFFMAN LLP
300 GARDEN CITY PLAZA
GARDEN CITY NY 11530

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OFFICE OF PETITIONS

In re Application of
Hanson
Application No. 09/755,702
Filed: January 5, 2001
Attorney Docket No. P-1015-27

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed March 10, 2003, to revive the above-identified application. In the alternative, petitioner requests consideration 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 timely reply to the Restriction Requirement, mailed July 31, 2001, which set an extendable 1 month period for reply. Petitioner filed an election, a $55.00 check for a one month extension of time, and authorization to charge petitioner's deposit account for any required fees on November 28, 2001. A three month extension of time fee costed $460.00. Thus, petitioner owed $460 - $55 = 405. Petitioner's deposit account did not contain enough funds to pay the balance due. Thus, the application became abandoned on October 1, 2001, as was pointed out in the Notice of Abandonment, mailed March 12, 2002.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by (1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof; (2) the petition fee as set forth in § 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section. This petition does not satisfy requirement (3).

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

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

In the instant case, petitioner has failed to provide adequate evidence that the delay was unavoidable. An adequate showing of diligence in prosecution is the touchstone of a successful petition to revive under an unavoidable standard. As stated above, petitioner's deposit account did not have sufficient funds to cover the $405 balance owed to the Office. A review of Office financial records indicates that the closing balance for petitioner's deposit account in November 2001 was $135. The closing balance for petitioner's deposit account in December 2001 was $10.00. The Office informed petitioner that there was an insufficient deposit account balance to charge the required fee on January 28, 2002. The Office did not receive further written communications regarding a request for an extension of time.

Petitioner did not meet his responsibility to monitor and maintain his deposit account. It was petitioner's responsibility to ensure that an adequate amount of money was present in the deposit account to pay patent related bills. Petitioner did not fulfill this responsibility.

The Office informed petitioner that there was an insufficient deposit account balance to charge the required fee on January 28, 2002. The Office did not receive further written communications regarding a request for an extension of time. Had petitioner proved that on February 28, 2002 petitioner again applied for an extension of time, as petitioner alleges in the instant petition, petitioner would have been charged $925.00 and the application would not have been abandoned. However, petitioner has not proved that an extension of time was filed on February 28, 2002. Thus, petitioner's deposit account will be charged the $650 petition fee for filing a petition 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 statement of unintentional delay presented in the petition does not comply with the current rule. 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" be submitted. However, the statement presented will be accepted and construed as meaning 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 this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

The application will be returned to Technology Center 3700.

The application will be returned to Technology Center 3700.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 8

Paul E. Hodges
Pitts & Brittian, P.C.
1319 Old Weisgarber Road
P. O. Box 51295
Knoxville, TN 37950

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APR 1 9 2002

OFFICE OF PETITIONS

In re Application of :
Harold F. Beal :
Application No. 09/755,703 : ON PETITION
Filed: January 5, 2001 :
Attorney Docket No. 26006.00 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 14, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 5, 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 application became abandoned on October 6, 2001.

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 Technology Center 3641 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
For Patent Examination Policy

Latrice Bond

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, DC 20231
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Paper No. 7

MAILED

FEB 1 1 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON MA 02110

In re Application of :
Ray Jimenez et al :
Application No. 09/755,706 :
Filed: January 5, 2001 :
For: **METHODS AND APPARATUS FOR AN AUDIO WEB RETRIEVAL TELEPHONE SYSTEM** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on January 13, 2003.

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

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

All attorneys and agents of record in this application are removed from record.

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

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

cc: Alfred L. Browne, III
Browne Rosedale & Lanouette
100 Brickstone Square, 1st Floor
Andover, MA 01810

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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Paper No. 5

TESTA, HURWITZ & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON MA 02110

MAILED

FEB 2 8 2003

Technology Center 2600

In re Application of :
Ray Jimenez et al :
Application No. 09/755,710 :
Filed: January 5, 2001 :
For: **METHODS AND APPARATUS FOR EXECUTING AN AUDIO ATTACHMENT USING AN AUDIO WEB RETRIEVAL TELEPHONE SYSTEM** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on January 13, 2003.

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

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

All attorneys and agents of record in this application, including all attorneys and agents associated with Customer No. 21323 are removed from record.

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

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

cc: Alfred L. Browne, III
Browne Rosedale & Lanouette
100 Brickstone Square, 1st Floor
Andover, MA 01810

UNITED STATES DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09/755,717			

EXAMINER

ART UNIT	PAPER
	1

DATE MAILED: JUL 15 2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

In response to the petition submitted 11/30/04, the abandonment is withdrawn and a new office action will be mailed in response to applicants' submission of 7-3-03.

Nadine Norton
Supervisory Patent Examiner 1765
(571) 272-1465

Nadine Norton

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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Ano

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,723	01/05/2001	Ron Goodman	017002022500	3728

40032 7590 04/11/2006

CREATIVE LABS, INC.
LEGAL DEPARTMENT
1901 MCCARTHY BLVD
MILPITAS, CA 95035

EXAMINER
RONES, CHARLES

ART UNIT	PAPER NUMBER
2164	30

DATE MAILED: 04/11/2006

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

In re Patent No. GOODMAN ET AL.	:	
Issue Date: August 9, 2005	:	**DECISION GRANTING**
Appl No.: 09/755,723	:	**PETITION**
Filed: January 05, 2001	:	*37 CFR 1.324*
For: **AUTOMATIC HIERARCHICAL CATEGORIZATION OF MUSIC BY METADATA**	:	

This is a decision on the petition under 37 CFR 1.48, filed July 9, 2004. In view of the fact that the patent has already issued, the request under 37 CFR 1.48 has been treated as a petition to correct inventorship under 37 CFR 1.324.

The petition is granted.

The patented file is being forwarded to Certificate of Corrections Branch for issuance of a certificate naming only the actual inventor or inventors.

C. Rones

Charles Rones
Supervisory Patent Examiner
Art Unit 2164
Patent Examining Group 2100

CREATIVE LABS, INC.
LEGAL DEPARTMENT
1901 MCCARTHY BLVD
MILPITAS, CA 95035

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : March 8, 2010

TO SPE OF : ART UNIT 2121 - Albert Decady.

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/755,751 Patent No.: 7,062,540 B2

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
Randolph Square Building
2800 South Randolph Street
Arlington, VA 22206

Antonio Johnson

Should the patent be amended to add the Related U.S. Application Data as requested by applicant ?

Certificates of Correction Branch

(571)272-0483

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 RESPONSE FOR CERTIFICATE OF CORRECTION

/Albert DeCady/ SPE TC-2100

SPE **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper 4

Dirk Coldewey
828 Western Dr.
Santa Cruz, CA 95060

COPY MAILED

AUG 1 8 2003

OFFICE OF PETITIONS

In re Application of
Dirk Coldewey
Application No. 09/755,754
Filed: January 3, 2001
Title of Invention: METHOD AND APPARATUS FOR PREFETCHING RECURSIVE DATA STRUCTURES

DECISION ON PETITION

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

This petition is hereby **Dismissed.**

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 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 above-identified application became abandoned for failure to file a response to a Notice to file Corrected Application Papers of a Nonprovisional Application which was mailed on February 22, 2001. The Notice to File Corrected Application Papers set an extendable two (2) month period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on April 23, 2001. A Notice of Abandonment was mailed on July 7, 2003.

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 (2) and (3).

As to item (2), although applicant submitted $100.00 with the petition, the current unintentional petition to revive fee is $650.00. To revive this application petitioner will

need to submit $550.00.

As to item (3) , The statement of unintentional delay presented in the petition does not comply with the current rule. Pursuant to 37 CFR 1.137(b)(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*" is required.

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) 308-6916
By hand:	Office of Petitions 2201 South Clark Place Crystal Plaza 4, Suite 3C23 Arlington, VA 22202
By delivery service: (FedEx, UPS, DHL, etc.)	U.S. Patent and Trademark Office 2011 South Clark Place Customer Window, Mail Stop Petition Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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 6

Dirk Coldewey
828 Western Dr.
Santa Cruz, CA 95060

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SEP 3 0 2003

OFFICE OF PETITIONS

In re Application of
Dirk Coldewey
Application No. 09/755,754
Filed: January 3, 2001
Title of Invention: METHOD AND APPARATUS FOR PREFETCHING RECURSIVE DATA STRUCTURES

DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR §1.137(b) filed August 29, 2003 to revive the above-identified application.

This above-identified application became abandoned for failure to file a response to a Notice to file Corrected Application Papers of a Nonprovisional Application which was mailed on February 22, 2001. The Notice to File Corrected Application Papers set an extendable two (2) month period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on April 23, 2001. A Notice of Abandonment was mailed on July 7, 2003.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

The Office acknowledges receipt of the abstract submitted on August 8, 2003.

This application is being forwarded to the Office of Initial Patent Examination for further processing of the application.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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 7

Dirk Coldewey
828 Western Dr.
Santa Cruz, CA 95060

COPY MAILED

DEC 1 2 2003

OFFICE OF PETITIONS

In re Application of
Dirk Coldewey
Application No. 09/755,754
Filed: January 3, 2001
Title of Invention: METHOD AND APPARATUS FOR PREFETCHING RECURSIVE DATA STRUCTURES

CORRECTED DECISION ON PETITION

This is a decision on the renewed petition under 37 CFR §1.137(b) filed August 29, 2003 and supplemented on November 10, 2003 to revive the above-identified application.

This above-identified application became abandoned for failure to file a response to a Notice to file Corrected Application Papers of a Nonprovisional Application which was mailed on February 22, 2001. The Notice to File Corrected Application Papers set an extendable two (2) month period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on April 23, 2001. A Notice of Abandonment was mailed on July 7, 2003.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

The Office acknowledges receipt of the abstract submitted on August 8, 2003. The Office acknowledges receipt of the claims on a separate sheet submitted on November 10, 2003.

This application is being forwarded to the Office of Initial Patent Examination for further processing of the application.

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 306-0251.

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

LYON & LYON LLP
633 WEST FIFTH STREET
SUITE 4700
LOS ANGELES CA 90071

MAIL

APR 2 2 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of	:	
Williams et al.	:	
Application No. 09/755,763	:	DECISION ON REQUEST TO
Filed: January 5, 2001	:	WITHDRAW AS ATTORNEY
For: PEN-BASED HANDWRITTEN	:	
CHARACTER RECOGNITION AND STORAGE	:	
SYSTEM		

This is a decision on the request to withdraw as attorney/agent of record filed on March 4, 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 attorneys associated with Customer No. 22249 are granted the request for withdraw of attorney/agent. 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 A. Wieder

Kenneth Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: Leon J. Gladstone, Esq.
Zen Optical Technology
4215 Glencoe Avenue
Marina Del Rey, CA 90292

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

Michael C. Barrett
Fulbright & Jaworski
600 Congress Avenue, Suite 2400
Austin, Texas 78701

SEP - 6 2002

In re Application of:	:	
Husar, Stephen F.	:	
Application No. 09/755,775	:	DECISION ON REQUEST TO WITHDRAW
Filed: January 4, 2001	:	FROM RECORD
Attorney Docket No. BYRD:002USD1	:	

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed August 16, 2002.

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 the 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).

In this case, there is less than thirty days remaining between the date of this decision and the expiration date of the maximum time period for response set by the Office action mailed on March 18, 2002. Consequently, the request cannot be accepted.

For the above reasons, the request is **disapproved.**

All future communications from the Office will continue to be directed to, Michael C. Barrett.

Inquiries related to this decision should be directed to Ed Glick at (703) 308-4858.

Clayton T. Bell

for Edward J. Glick, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: David C. Boyd
33 Caryville Crossing
Bellingham, MA 02019

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

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NOV 20 2006

OFFICE OF PETITIONS

In re Application of

YOSHIDA, et al.
Application No. 09/755,815
Filed: January 5, 2001
Attorney Docket No. 11314/3

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 August 28, 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 applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272- 7253.

Monica A. Graves
Petitions Examiner
Office of Petitions

cc: **MICHAEL W. ALVANO**
KUTAK ROCK LLP
THE OMAHA BUILDING
1650 FAMAM STREET
OMAHA, NE 68102-2186

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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DIW 11-01

Paper No. 5

DAVID L. FEIGENBAUM
FISH & RICHARDSON P.C.
225 FRANKLIN STREET
BOSTON MA 02110-2809

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NOV 2 6 2001

OFFICE OF PETITIONS

In re Application of	:	
Singh et al.	:	DECISION GRANTING
Application No. 09/755,881	:	PETITION
Filed: 5 January, 2001	:	
Attorney Docket No. 8325-0026P	:	

This is a decision on the paper styled "Resubmission of Request for Corrected Official Filing Receipt" filed on 5 October, 2001, which is treated as a petition under 37 CFR 1.10(c) requesting that the above-identified application be accorded a filing date of 5 January, 2001, rather than the presently accorded filing date of 3 January, 2001.

Petitioner alleges that the application was deposited in Express Mail service on 5 January, 2001. In support, on 5 October, 2001, petitioner supplied a copy of Express Mail Label No. EL270011442US (the same Express Mail number found on the provisional application cover sheet accompanying the original application papers located in the official file). Although the "date-in" on the Express Mail label appears to be "01/03/01", the Express Mail label also contains a USPS postmark dated 5 January, 2001. Furthermore, a search of the USPTO's USPS Express Mail Information Database reveals that this Express Mail Label No. was accepted by the USPS on 5 January, 2001.

In view of the above, the petition is granted. No petition fee is required and none has been charged.

The application is being returned to the Office of Initial Patent Examination (OIPE) for correction of the filing date to 5 January, 2001, and for issuance of a corrected Filing Receipt.

Telephone inquiries specific to this matter should 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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RATHE PATENT & IP LAW
10611 W. HAWTHORNE FARMS LANE
MEQUON, WI 53097

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FEB 28 2007

OFFICE OF PETITIONS

In re Application of	:	
Mark M. Chesser	:	
Application No. 09/755,898	:	DECISION ON PETITION
Filed: January 5, 2001	:	
Attorney Docket No. 051273-0126	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 18, 2006, 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, February 27, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on May 31, 2006.

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.

Telephone inquiries concerning this decision should be directed to April Wise at (571) 272-1642.

This application is being referred to Technology Center AU 2152 for appropriate action by the Examiner in the normal course of business on the reply received

Irvin Dingle
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
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
09/755,898	01/05/2001	Mark Miller Chesser	360115/24

CONFIRMATION NO. 5026

OC000000022583230

OC000000022583230

26371
FOLEY & LARDNER LLP
777 EAST WISCONSIN AVENUE
MILWAUKEE, WI 53202-5306

Date Mailed: 02/21/2007

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 09/18/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

APRIL M WISE
OP (571) 272-1642

FORMER ATTORNEY/AGENT COPY

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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ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR C11
PLANO, TX 75024

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APR 19 2006
OFFICE OF PETITIONS

In re Application of	:	
Bhatia et al.	:	DECISION
Application No. 09/755,948	:	ON PETITION
Filed : January 5, 2001	:	
Attorney Docket Number:	:	
27943-00403USPT	:	

This is a decision in response to the petition under 37 CFR 1.137(b), filed September 21, 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 final Office action, mailed November 19, 2004. 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). No reply having been received, the application became abandoned February 20, 2005. A Notice of Abandonment was mailed August 23, 2005.

With the instant petition, Applicant has filed a Request for Continued Examination ("RCE") and a submission in the form of an Amendment.

This application is being returned to Technology Center 2116 for processing of the RCE and Amendment in due course.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Attorney
Office of Petitions

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Christensen, O'Connor, Johnson, Kindness, PLLC
1420 Fifth Avenue
Suite 2800
Seattle, WA 98101-2347

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AUG 0 2 2004
OFFICE OF PETITIONS

In re Application of :
Mohamed A. H. Hassanin, et al. :
Application No. 09/755,982 :
Filed: January 5, 2001 :
Attorney Docket No. MSFT116572 :

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed May 13, 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 (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 applications filed in an eighteen-month publication country on January 3, 2002 and January 4, 2002. 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 Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 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 USPTO 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 rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of November 11, 2004 accompanies this decision on petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

This application is being referred to Technology Center Art Unit 2174 for examination in due course.

Marianne E. Jenkins

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

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

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE WA 98101-2347

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DEC 1 2 2005

OFFICE OF PETITIONS

In re Application of :
Mohamed Abdel Hamid HASSANIN et al. :
Application No. 09/755,982 :
Filed: January 5, 2001 :
Attorney Docket No. MSFT116572 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 3, 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 April 20, 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) was obtained. Accordingly, the above-identified application became abandoned on October 21, 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 and amendment; (2) the petition fee of $1500; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office Action of April 20, 2004 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7099.

The application file is being referred to Technology Center AU 2174 for appropriate action on the concurrently filed amendment.

David Bucci
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. 110204

David H. Hitt
Hitt, Gaines & Boisbrun, PC
PO Box 832570
Richardson, TX 75083

DEC - 8 2004

In re Application of:	:	
Flowers	:	
Serial No.: 09/755,991	:	DECISION ON REQUEST TO WITHDRAW FROM RECORD
Filed: January 5, 2001	:	
Attorney Docket No.: **CSAY-0020**	:	

This is a decision on the request to withdraw as attorney/agent of record under 37 C.F.R. § 1.36, filed October 1, 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 David H. Hitt, on behalf of himself and all the attorneys/agents of record. The request is **APPROVED**.

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

All future communications from the Office will be directed to Scott M. Seidel, at the below address, until otherwise notified by applicant.

Inquiries related to this decision should be directed to Edward Westin at (571) 272-1638.

Edward Westin

Edward Westin, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

cc: Scott M. Seidel
Passman & Jones, PC
1201 Elm St., Suite 2500
Dallas, TX 75270

OIPE JC171
JUL 0 2 2001
PATENT & TRADEMARK OFFICE

COPY OF PAPERS
ORIGINALLY FILED

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
09/756,070	01/06/2001	Paul D. Taylor	P-514

CONFIRMATION NO. 6470

FORMALITIES LETTER

OC000000005863809

JOHN F. BRADY
TRANSGENOMIC, INC.
2032 CONCOURSE DRIVE
SAN JOSE, CA 95131

Date Mailed: 03/15/2001

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant is given TWO MONTHS FROM THE DATE OF THIS NOTICE within which to file the items indicated below to avoid abandonment. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing", an initial paper or compact disc copy of the "Sequence Listing", as well as an amendment directing its entry into the application. Applicant must also provide a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821 (f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

For questions regarding compliance to these requirements, please contact:

- **For Rules Interpretation, call (703) 308-4216**
- **To Purchase PatentIn Software, call (703) 306-2600**
- **For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov**

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

03CO

Response To Notice To File Missing Parts Of Application Filing Date Granted (PTO-1533)(Small Entity)	Docket No. P-514

OIPE JC71 JUL 0 2 2001 PATENT & TRADEMARK OFFICE

In Re Application Of: **PAUL D. TAYLOR**

Serial No.	Filing Date	Examiner	Group Art Unit
09/756,070	01/06/2001	N/A	N/A

Invention: **DETECTION OF NUCLEIC ACID HETERODUPLEX MOLECULES BY ANION EXCHANGE CHROMATOGRAPHY**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

This is a response to the Notice to File Missing Parts of Application - Filing Date Granted (PTO-1533) mailed on 03/15/2001 (*Date*).

Enclosed herewith for filing are the following:

- ☒ A copy of the Notice to File Missing Parts of Application - Filing Date Granted (PTO-1533). **(REQUIRED)**
- ☐ An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and Filing Date.
- ☐ A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date.
- ☐ An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date.
- ☐ A verified English translation of the non-English language application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the United States Patent and Trademark Office.
- ☒ _____ verified small entity declaration(s)
  - ☒ is/are attached.
  - ☐ was/were filed on _____

Applicant claims small entity status.

John F. Brady

John F. Brady, Reg. No. 39,118

- ☐ A separate request for refund.
- ☒ Other (list):

SEQUENCE LISTING (PAPER READABLE)
SEQUENCE LISTING (COMPUTER READABLE)

P31SMALL/REV03

Response To Notice To File Missing Parts Of Application Filing Date Granted (PTO-1533)(Small Entity)	Docket No. P-514

In Re Application Of: **PAUL D. TAYLOR**

Serial No.	Filing Date	Examiner	Group Art Unit
09/756,070	01/06/2001	N/A	N/A

Invention: **DETECTION OF NUCLEIC ACID HETERODUPLEX MOLECULES BY ANION EXCHANGE CHROMATOGRAPHY**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Attention: Manager, Application Branch

☒ Completion of application fees as calculated below:

- ☐ Utility application filing fee _____
- ☐ Design application filing fee _____
- ☐ Total number of independent claims = _____ _____
- ☐ Total number of claims = _____ _____
- ☐ Multiple dependent claims _____
- ☐ Surcharge for late payment of filing fee and/or late filing of original declaration or oath _____
- ☐ Petition and fee for filing by other than all the inventors or a person not the inventor _____
- ☐ Fee for processing an application filed with a non-English language specification _____
- ☐ Fee for processing and retention of application _____

Total completion of application fees _____

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the above-identified Notice to File Missing Parts of Application. The requested extension is as follows (check time period desired). If an additional time extension is required, please consider this a petition therefor.

☐ One month ☐ Two months ☒ Three months ☐ Four months ☐ Five months

from: 03/15/2001 (*Date*) until: 07/15/2001 (*Date*)

Total time extension fees **$445.00**

Total fees due **$445.00**

P31SMALL/REV02

Response To Notice To File Missing Parts Of Application Filing Date Granted (PTO-1533) (Small Entity)	Docket No. P-514

OIPE JUL 0 2 2001 PATENT & TRADEMARK OFFICE

In Re Application Of: **PAUL D. TAYLOR**

Serial No.	Filing Date	Examiner	Group Art Unit
09/756,070	01/06/2001	N/A	N/A

Invention: **DETECTION OF NUCLEIC ACID HETERODUPLEX MOLECULES BY ANION EXCHANGE CHROMATOGRAPHY**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Attention: Manager, Application Branch

The fee of **$445.00** is to be paid as follows:

- ☒ A check in the amount of the fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. **50-0821**
  A duplicate copy of this sheet is enclosed.
- ☒ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. **50-0821**
  A duplicate copy of this sheet is enclosed.

John F. Brady

Signature

Dated: 6/27/01

JOHN F. BRADY
REGISTRATION NUMBER: 39,118
TRANSGENOMIC, INC.
2032 CONCOURSE DRIVE
SAN JOSE, CA 95131

I certify that this document and fee is being deposited on 6-28-01 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Jennifer R. Cobb

Signature of Person Mailing Correspondence

JENNIFER R. COBBp

Typed or Printed Name of Person Mailing Correspondence

cc:

P31SMALL/REV02

CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8) Applicant(s): PAUL D. TAYLOR			Docket No. P-514
Serial No. 09/756,070	Filing Date 01/06/2001	Examiner N/A	Group Art Unit N/A

Invention: DETECTION OF NUCLEIC ACID HETERODUPLEX MOLECULES BY ANION EXCHANGE CHROMATOGRAPHY

OIPE JC71
JUL 0 2 2001
PATENT & TRADEMARK OFFICE

I hereby certify that this AMENDMENT LETTER
(Identify type of correspondence)

is being deposited with the United States Postal Service as first class mail in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231 on 6-28-01
(Date)

JENNIFER R. COBB
(Typed or Printed Name of Person Mailing Correspondence)

Jennifer R. Cobb
(Signature of Person Mailing Correspondence)

Note: Each paper must have its own certificate of mailing.

OIPE JC144 MAR 0 5 2002 PATENT & TRADEMARK OFFICE

Boxseq 700 ~~04-20~~ 02-13-02

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
09/756,070	01/06/2001	Paul D. Taylor	P-514

CONFIRMATION NO. 6470

FORMALITIES LETTER

OC000000007473471

JOHN F. BRADY
TRANSGENOMIC, INC.
2032 CONCOURSE DRIVE
SAN JOSE, CA 95131

RECEIVED

APR 0 4 2002

TECH CENTER 1600/2900

Date Mailed: 02/14/2002

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file the items indicated below to avoid abandonment. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d). Applicant must provide a substitute computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

For questions regarding compliance to these requirements, please contact:

- **For Rules Interpretation, call (703) 308-4216**
- **To Purchase PatentIn Software, call (703) 306-2600**
- **For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov**

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

OIPE JC144 MAR 0 5 2002 PATENT & TRADEMARK OFFICE

OIPE JC161
JAN 0 9 2002
PATENT & TRADEMARK OFFICE

Please type a plus sign (+) inside this box → [+]

PTO/SB/21 (08-00)
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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	09/756,070
Filing Date	January 6, 2001
First Named	Paul D. Taylor
Group Art Unit	Not Assigned
Examiner Name	Not Assigned
Total Number of Pages in This Submission: 5	Attorney Docket Number: P-514

25732
PATENT & TRADEMARK OFFICE

ENCLOSURES *(check all that apply)*

- [ ] Fee Transmittal Form
  - [ ] Fee Attached
- [x] Amendment / Response
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [x] 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
- [ ] Petition to Convert a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence
- [ ] 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
- [x] Other Enclosure(s) *(please identify below)*:
  - *** Sequence Listing (Computer Readable).**
  - *** Sequence Listing (Paper Readable - 2 pages).**
  - *** Copy of Notice.**
  - *** Postage Paid Postcard.**

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	**John F. Brady, Registration No. 39,118** **Transgenomic, Inc.**
Signature	John F. Brady
Date	10 Dec 01

25732
PATENT & TRADEMARK OFFICE

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: Commissioner for Patents, Washington, D.C. 20231 on this date: **December 10, 2001**

Typed or printed name	**E. Tina Domingo**		
Signature	E. Domingo	Date	12-10-2001

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.

5300 B

CERTIFICATE OF MAILING BY FIRST CLASS MAIL (37 CFR 1.8) Applicant(s): TAYLOR, Paul D.				Docket No. P-514
Serial No. 09/756,070	Filing Date January 6, 2001		Examiner Not Assigned	Group Art Unit Not Assigned

OIPE
JAN 0 9 2002
PATENT & TRADEMARK OFFICE

Invention:

DETECTION OF NUCLEIC ACID HETERODUPLEX MOLECULES BY ANION EXCHANGE CHROMATOGRAPHY

25732
PATENT & TRADEMARK OFFICE

I hereby certify that this **Response to Notice to Comply with Requirements for Patent Application**
(Identify type of correspondence)

is being deposited with the United States Postal Service as first class mail in an envelope addressed to: The Commissioner of Patents and Trademarks, Washington, D.C. 20231-0001 on **December 10, 2001**
(Date)

E. Tina Domingo
(Typed or Printed Name of Person Mailing Correspondence)

(Signature of Person Mailing Correspondence)

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COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/756,070	01/06/2001	Paul D. Taylor	P-514

CONFIRMATION NO. 6470

FORMALITIES LETTER

OC000000006946553

25732
WILLIAM B. WALKER
TRANSGENOMIC, INC.
2032 CONCOURSE DRIVE
SAN JOSE, CA 95131

Date Mailed: 10/22/2001

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file the items indicated below to avoid abandonment. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing." Applicant must provide a substitute computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b), or 1.825(d).

For questions regarding compliance to these requirements, please contact:

- **For Rules Interpretation, call (703) 308-4216**
- **To Purchase PatentIn Software, call (703) 306-2600**
- **For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov**

A copy of this notice MUST be returned with the reply.

BS

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Initial Patent Examination Division (703) 308-1202
PART 2 - COPY TO BE RETURNED WITH RESPONSE

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ARENT FOX KINTNER PLOTKIN & KAHN
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

COPY MAILED

MAR 17 2005

OFFICE OF PETITIONS

In re Application of :
Lloyd G. Mitchell, et al. :
Application No. 09/756,095 : ON PETITION
Filed: January 8, 2001 :
Attorney Docket No. A31304-B-A-A072874.0134 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 12, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 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 at midnight on June 4, 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, the $490 extension of time submitted with the petition on November 12, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account number 02-4377 as authorized.

The statement claiming small entity status in accordance with 37 CFR 1.27 embodied in the petition under 37 CFR 1.137(b) has been made of record and small entity status has been accorded.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 1600, Art Unit 1636 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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Paper No. 11

BAKER & BOTTS
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

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APR 24 2002

OFFICE OF PETITIONS

In re Application of
Mitchell, et al.
Application No. 09/756,096
Filed: January 8, 2001
Docket No. A31304-B-A-B

DECISION ON PETITION

This is a decision on the "Petition for Question Not Specifically Provided For", filed September 24, 2001, with is being treated as a petition under 37 CFR 1.53 to accord the above-identified application a filing date of January 8, 2001, with Figure 11B of the drawings as a part of the original disclosure.

Application papers in the above-identified application were filed on January 8, 2001. However, on April 24, 2001, the Initial Patent Examination Division mailed applicant a "Notice to File Missing Parts of Nonprovisional Application." Applicant was notified that the application papers had been accorded a filing date; however, Figure 11B of the drawings appeared to have been omitted. In addition, applicant was informed that the oath or declaration was unsigned, that substitute drawings must be submitted, and that the application failed to comply with the Sequence Listing rules.[1]

Preliminarily, applicant is advised that a petition under 37 CFR 1.53 filed more than two months after the action complained of may be dismissed as untimely without consideration on the merits.[2] The instant petition was filed more than two months after the mailing of the "Notice to File Missing Parts of Nonprovisional Application." However, in this instance, the Commissioner's discretion will be exercised in favor of applicant and the petition will be considered on the merits.

Applicant asserts that Figure 11B was with the application as originally filed on January 8, 2001. A review of the record reveals that a drawing sheet labeled Figure 11B was submitted with the application on January 8, 2001.

Accordingly, the petition is **GRANTED**.

---

[1] The instant application became abandoned on July 25, 2001 for failure to submit a timely and proper reply to the "Notice to File Missing Parts of Nonprovisional Application." On December 27, 2001, applicant filed a petition to revive under 37 CFR 1.137(b), which was granted in a decision mailed March 26, 2002. Upon revival, the application file was forwarded for consideration of the instant petition to accord a filing date.

[2] See 37 CFR 1.181(f).

Figure 11B submitted with the application on January 8, 2001 will be entered in the prosecution of the application. However, the record also reveals that the Figure 11B submitted with the application on January 8, 2001 was a blank drawing sheet, different from the Figure 11B submitted with the instant petition on September 24, 2001. Applicant may resubmit the matter included in the Figure 11B submitted with the instant petition as a Preliminary Amendment for consideration by the examiner before a first Office action on the merits.

Given the basis for granting this petition, the petition fee has been refunded to Deposit Account No. 02-4377, as authorized.

The application file is being returned to the Office of Initial Patent Examination for further processing with a filing date of January 8, 2001, using the drawings submitted on that date, and for processing of the substitute drawings (with the exception of Figure 11B) filed December 27, 2001.

Telephone inquiries related to this decision should be directed to Petitions Attorney Cliff Congo 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
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ALEXANDRIA, VA 22313-1450
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Paper No. 6

FARKAS & MANELLI P.L.L.C.
2000 M Street, NW Suite 700
Washington DC 20036-3307

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NOV 1 9 2003

OFFICE OF PETITIONS

In re Application of
Stefano Boscaro
Application No. 09/756,108
Filed: January 9, 2001
Attorney Docket No. 84464 3534.01/US/B1

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 16, 2003, to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to submit substitute specification in a timely manner in reply to the Notice To File Corrected Application Papers mailed February 27, 2001, which set a shortened statutory period for reply of two(2) months. Accordingly, the application became abandoned on April 28, 2001.

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 Cheryl Gibson-Baylor at (703)308-5111.

The application file is being forwarded to Office of Initial Patent Examination for further processing.

Cheryl Gibson-Baylor

Cheryl Gibson-Baylor
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. 11

DORITY & MANNING P.A.
P.O. BOX 1449
GREENVILLE, SC 29602

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AUG 1 9 2003

OFFICE OF PETITIONS

In re Application of :
Niles A. Fleischer et al :
Application No. 09/756,133 : ON PETITION
Filed: January 9, 2001 :
Attorney Docket No. 196/36 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 11, 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 16, 2002, which set a shortened statutory period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 17, 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 1745.

Wan Laymon

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

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Christian S. Rode
c/o RODE CONSULTING, INC.
2412 Stearns Hill Road
Waltham, Massachusetts 02451

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AUG 0 4 2005

OFFICE OF PETITIONS

In re Application of :
Christian Stig Rode :
Application No.: 09/756,157 :
Filing Date: 06 January 2001 :
Attorney Docket No.: RCI003V2R :

DECISION ON
PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed 30 June 2005, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." Petitioner is advised that this is **not** a final agency action decision.

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 15 March 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on 16 June 2005.

The present petition does not satisfy the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the Issue Fee and Publication Fee under 37 CFR 1.18(a) and 1.18(d), and (2) the full petition fee of $750.00 for a small entity under 37 CFR 1.17(m) have not been received. Accordingly, the application remains ABANDONED.

Telephone inquiries concerning this decision should be directed to Nguyen Ngoc-Ho at (571) 272-3290.

Wan Laymon
Wan Laymon
Petitions Examiner
Office of Petitions

Office of the Deputy Commissioner
for Patent Examination Policy
NNH/WL:hn

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

Christian S. Rode
c/o RODE CONSULTING, INC.
2412 Stearns Hill Road
Waltham, Massachusetts 02451

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OCT 0 3 2005

OFFICE OF PETITIONS

In re Application of :
Christian Stig Rode :
Application No.: 09/756,157 :
Filing Date: 06 January 2001 :
Attorney Docket No.: RCI003V2R :

DECISION ON
RENEWED PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the renewed petition under 37 CFR 1.137(b), filed 13 August 2005, to revive the above-identified application.

The petition is **GRANTED**, as follows:

Applicant's petition to revive the present application filed 30 June 2005 was dismissed in an Office decision of 04 August 2005 for failure to provide the Issue Fee and Publication Fee under 37 CFR 1.18(a) and 1.18(d), and the full petition fee of $750.00 for a small entity under 37 CFR 1.17(m).

The present renewed petition under 37 CFR 1.137(b) satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the Issue Fee under 37 CFR 1.18(a), (2) the Publication Fee under 37 CFR 1.18(d), (3) the petition fee, and (4) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice of Allowance of 15 March 2005is accepted as having been unintentionally delayed.

This matter is being referred to the Office of Publications.

Telephone inquiries concerning this decision should be directed to Nguyen Ngoc-Ho at (571) 272-3290.

Wan Laymon
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy
NNH/WL:hn

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Commissioner for Patents
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14TH FLOOR
8000 TOWERS CRESCENT
TYSONS CORNER VA 22182

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NOV 09 2005

OFFICE OF PETITIONS

In re Application of	:	
Le et al.	:	
Application No. 09/756,232	:	ON PETITION
Filed: January 9, 2001	:	
Attorney Docket No. 59864.00633	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed October 18, 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 (and requisite fee) and 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 2100 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
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Paper No. 5

HONEYWELL INTERNATIONAL, INC.
101 COLUMBIA ROAD
P.O. BOX 2245
MORRISTOWN, NJ 07962-2245

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APR 1 4 2003

OFFICE OF PETITIONS

In re Application of	:	
Jarrett, et al.	:	
Application No. 09/756,246	:	ON PETITION
Filed: January 8, 2001	:	
Attorney Docket No. A11-17146US	:	

This is a decision on the petition under 37 CFR 1.137(b), filed March 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 to the Notice to File Corrected Application Papers (Notice) mailed March 15, 2001. 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 May 16, 2001. A Notice of Abandonment was mailed on March 10, 2003.

The file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries 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

COPY

United States Patent and Trademark Office

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

OIPE JC28 MAY 0 1 2003 PATENT & TRADEMARK OFFICE

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Paper No. 7

PETRINA S. HS
HYSEQ, INC.
670 ALMANOR AVENUE
SUNNYVALE, CA 94085

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MAR 1 8 2003

OFFICE OF PETITIONS

In re Application of
Shubhada Godbole, Bryan Boyle,
Nancy Mize, Cenhua Deng,
Ryle Goodrich, Matthew Arterburn,
Ping Zhou, Y. Tom Tang,
Chenghua Liu, George Yeung and
Radoje Drmanac
Application No. 09/756,247
Filed: January 8, 2001
Title: INFORMATION PROCESSING
APPARATUS AND METHOD, AND RECORDING
MEDIUM THEREFOR

DECISION REFUSING STATUS
UNDER 37 C.F.R. § 1.47(a)

Docket No.: HYS-31CIP
Action: Response
Date Due: 5/18/03
Critical Date: 5/13/03
Docketed By/Date: AD 3/26
Responsible Attorney: RP

This is in response to the "Petition under 37 C.F.R. § 1.47(b)," filed May 8, 2002 (certificate of mailing April 29, 2002). This petition is properly treated as a petition under § 1.47(a)[1].

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 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on January 8, 2001, with an unexecuted declaration. Shubhada Godbole, Bryan Boyle, Nancy Mize, Cenhua Deng, Ryle Goodrich, Matthew Arterburn, Ping Zhou, Y. Tom Tang, Chenghua Liu, George Yeung and Radoje Drmanac were named as joint inventors. Accordingly, on December 18, 2001, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

In response, applicants filed four separate declarations, identifying all inventors and executed in combination by all of the joint inventors, except inventor Godbole; the surcharge under

[1] Filing under 37 C.F.R. § 1.47(b) is only proper where no inventor can be are available to join in the application.

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OFFICE OF PETITIONS

§ 1.16(l); and the instant petition under § 1.47(a). This response was made timely by an accompanying petition for extension of time within the third month. Applicants assert that status under § 1.47 is proper because inventor Godbole refuses to join in the application. Applicants request that patent attorney Luisa Bigornia be allowed to make application on behalf of the non-signing inventor. In support of the petition, applicants submit a statement of facts of attorney Bigornia.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, 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. The instant petition does not satisfy requirement (1).

As to requirement (1), petitioner has not shown that inventor Godbole has refused to join in the application as required by § 1.47. Before a refusal can be alleged, applicants must demonstrate 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. See MPEP 409.03(d). The statement of facts of attorney Bigornia, and supporting copy of cover letter of transmittal, only indicate that a declaration and power of attorney were presented to inventor Godbole. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). Petitioners have not provided evidence that the application papers (specification, including claims, drawings, and oath or declaration) were all presented to inventor Godbole for his signature.

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Godbole and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

As to requirement (2), applicants request that attorney Bigornia be allowed to made application on behalf of the non-signing

inventor[2]. However, 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

> (A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP §602, §605.01, and §1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated.
>
> (Emphasis added).

The declarations submitted on petition are signed, in combination, by all of the available joint inventors with the signature block for inventor Godbole left blank. Despite the assertions that the application was being made by attorney Bigornia, the declarations do not bear the signature of attorney Bigornia. Accordingly, it is concluded that the declaration filed May 8, 2002 may be accepted as signed by the available

---

[2] As this is properly a petition under § 1.47(a), application by attorney Bigornia is not appropriate. (If this were a 1.47(b), a further showing by attorney Bigornia would be required. In this regard, petitioner's attention is directed to MPEP 409.03(b)(A):

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. Staeger v. Commissioner, 189 USPQ 272 (D.D.C. 1976), In re Striker, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

joint inventors on behalf of themselves and on behalf of non-signing inventor Godbole. This declaration has been reviewed and found in compliance with § 1.63.

On renewed petition, applicants must correct the following deficiency:

> Provide adequate proof of presentation of all of the application papers to inventor Godbole and of his subsequent refusal, consistent with the guidance set forth in MPEP 409.03(d)[3].

The change of correspondence address filed August 12, 2002, is acknowledged and made of record.

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

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

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

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

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

Nancy Johnson
Petitions Attorney
Office of Petitions

[3] 8th ed. (Rev. Aug 1, 2001).

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

PETRINA S. HSI
HYSEQ, INC.
670 ALMANOR AVENUE
SUNNYVALE, CA 94085

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MAR 1 8 2003

OFFICE OF PETITIONS

In re Application of :
Shubhada Godbole, Bryan Boyle, :
Nancy Mize, Cenhua Deng, :
Ryle Goodrich, Matthew Arterburn, :
Ping Zhou, Y. Tom Tang, :
Chenghua Liu, George Yeung and :
Radoje Drmanac :
Application No. 09/756,247 :
Filed: January 8, 2001 :
Title: INFORMATION PROCESSING :
APPARATUS AND METHOD, AND RECORDING:
MEDIUM THEREFOR :

DECISION REFUSING STATUS
UNDER 37 C.F.R. § 1.47(a)

This is in response to the "Petition under 37 C.F.R. § 1.47(b)," filed May 8, 2002 (certificate of mailing April 29, 2002). This petition is properly treated as a petition under § 1.47(a)[1].

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 C.F.R. §1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. § 1.136(a).

The above-identified application was filed on January 8, 2001, with an unexecuted declaration. Shubhada Godbole, Bryan Boyle, Nancy Mize, Cenhua Deng, Ryle Goodrich, Matthew Arterburn, Ping Zhou, Y. Tom Tang, Chenghua Liu, George Yeung and Radoje Drmanac were named as joint inventors. Accordingly, on December 18, 2001, applicants were mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)," requiring an executed oath or declaration and a surcharge for its late filing. This Notice set a two-month period for reply with extensions of time obtainable under § 1.136(a).

In response, applicants filed four separate declarations, identifying all inventors and executed in combination by all of the joint inventors, except inventor Godbole; the surcharge under

[1] Filing under 37 C.F.R. § 1.47(b) is only proper where no inventors are available to join in the application.

§ 1.16(l); and the instant petition under § 1.47(a). This response was made timely by an accompanying petition for extension of time within the third month. Applicants assert that status under § 1.47 is proper because inventor Godbole refuses to join in the application. Applicants request that patent attorney Luisa Bigornia be allowed to make application on behalf of the non-signing inventor. In support of the petition, applicants submit a statement of facts of attorney Bigornia.

A grantable petition under 37 C.F.R. § 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or found, after diligent effort, 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. The instant petition does not satisfy requirement (1).

As to requirement (1), petitioner has not shown that inventor Godbole has refused to join in the application as required by § 1.47. Before a refusal can be alleged, applicants must demonstrate 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. See MPEP 409.03(d). The statement of facts of attorney Bigornia, and supporting copy of cover letter of transmittal, only indicate that a declaration and power of attorney were presented to inventor Godbole. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956). Petitioners have not provided evidence that the application papers (specification, including claims, drawings, and oath or declaration) were all presented to inventor Godbole for his signature.

Thus, on renewed petition, applicants must establish that the entire application package, including specification, claims and drawings, was presented to non-signing inventor Godbole and he subsequently refused to sign. If they have not already been sent, a copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

As to requirement (2), applicants request that attorney Bigornia be allowed to made application on behalf of the non-signing

inventor[2]. However, 37 CFR 1.47(a) and 35 U.S.C. 116, second paragraph, require all available joint inventors to file an application "on behalf of" themselves and on behalf of a joint inventor who "cannot be found or reached after diligent effort" or who refuses to "join in an application." Thus, in addition to other requirements of law (35 U.S.C. 111(a) and 115), in an application deposited in the U.S. Patent and Trademark Office pursuant to 37 CFR 1.47(a):

> (A) All the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR 1.63 or 1.175 (see MPEP §602, §605.01, and §1414) and (2) make oath or declaration on behalf of the non-signing joint inventor as required by 37 CFR 1.64. An oath or declaration signed by all the available joint inventors with the signature block of the non-signing inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the non-signing inventor(s), unless otherwise indicated.
>
> (Emphasis added).

The declarations submitted on petition are signed, in combination, by all of the available joint inventors with the signature block for inventor Godbole left blank. Despite the assertions that the application was being made by attorney Bigornia, the declarations do not bear the signature of attorney Bigornia. Accordingly, it is concluded that the declaration filed May 8, 2002 may be accepted as signed by the available

---

[2] As this is properly a petition under § 1.47(a), application by attorney Bigornia is not appropriate. (If this were a 1.47(b), a further showing by attorney Bigornia would be required. In this regard, petitioner's attention is directed to MPEP 409.03(b)(A):

The 37 CFR 1.47(b) applicant must make the oath required by 37 CFR 1.63 and 1.64 or 1.175. Where a corporation is the 37 CFR 1.47(b) applicant, an officer (President, Vice-President, Secretary, Treasurer, or Chief Executive Officer) thereof should normally sign the necessary oath or declaration. A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation. Where the oath or declaration is being signed on behalf of an assignee, see MPEP § 324. An inventor may not authorize another individual to act as his or her agent to sign the application oath or declaration on his or her behalf. Staeger v. Commissioner, 189 USPQ 272 (D.D.C. 1976), In re Striker, 182 USPQ 507 (Comm'r Pat. 1973). Where an application is executed by one other than the inventor, the declaration required by 37 CFR 1.63 must state the full name, residence, post office address, and citizenship of the nonsigning inventor. Also, the title or position of the person signing must be stated if signing on behalf of a corporation under 37 CFR 1.47(b).

joint inventors on behalf of themselves and on behalf of non-signing inventor Godbole. This declaration has been reviewed and found in compliance with § 1.63.

On renewed petition, applicants must correct the following deficiency:

> Provide adequate proof of presentation of all of the application papers to inventor Godbole and of his subsequent refusal, consistent with the guidance set forth in MPEP 409.03(d)[3].

The change of correspondence address filed August 12, 2002, is acknowledged and made of record.

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

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

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

By hand: Crystal Plaza Four, Suite CP4-3C23
2201 South Clark Place
Arlington, VA 22202

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

Nancy Johnson
Petitions Attorney
Office of Petitions

[3] 8th ed. (Rev. Aug 1, 2001).

United States Patent and Trademark Office

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

Paper No. 10

PETRINA S. HSI
HYSEQ, INC.
670 ALMANOR AVENUE
SUNNYVALE, CA 94085

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MAY 06 2003

OFFICE OF PETITIONS

In re Application of Shubhada Godbole, Bryan Boyle, Nancy Mize, Cenhua Deng, Ryle Goodrich, Matthew Arterburn, Ping Zhou, Y. Tom Tang, Chenghua Liu, George Yeung and Radoje Drmanac Application No. 09/756,247 Filed: January 8, 2001 Title: INFORMATION PROCESSING APPARATUS AND METHOD, AND RECORDING MEDIUM THEREFOR	DECISION NOTING JOINDER OF INVENTOR AND PETITION UNDER 37 C.F.R. § 1.47(a) MOOT

This is a decision on the "Request for Reconsideration of Petition under 37 CFR 1.47(a)," filed May 1, 2003.

The petition is **DISMISSED AS MOOT**.

The above-identified application was filed on January 8, 2001, with an unexecuted declaration. Shubhada Godbole, Bryan Boyle, Nancy Mize, Cenhua Deng, Ryle Goodrich, Matthew Arterburn, Ping Zhou, Y. Tom Tang, Chenghua Liu, George Yeung and Radoje Drmanac were named as joint inventors. In response to a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted (Notice)" mailed December 18, 2001, applicants timely filed the initial petition asserting that status under § 1.47 was proper because inventor Godbole refused to join in the application. Accompanying the petition was four separate declarations, identifying all inventors and executed in combination by all of the joint inventors, except inventor Godbole. However, the petition was dismissed for failure to provide adequate proof of the unavailability of inventor Godbole. (Decision mailed March 18, 2003).

On instant request for reconsideration, applicants timely replied with a declaration executed by previously non-signing inventor Godbole. This declaration (considered in combination with the declarations previously filed May 8, 2002) has been reviewed and found in compliance with 37 CFR 1.63 and 1.64.

In view of the joinder of the joint inventor, further consideration under 37 CFR 1.47(a) is not necessary and the petition is considered moot. This application does not have any Rule 1.47(a) status and no such status should appear on the file wrapper. This application need not be returned to this Office for further consideration under 37 CFR 1.47(a).

The application file is being returned to the Office of Initial Patent Examination for completion of pre-examination processing.

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

Nancy Johnson
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

STERNE KESSLER GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, NW
WASHINGTON DC 20005

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DEC 2 2 2004

OFFICE OF PETITIONS

In re Application of	:
Yuti Chernajovsky et al	:
Application No. 09/756,283	: DECISION GRANTING PETITION
Filed: January 9, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 0623.100000	:

This is a decision on the petition, filed December 21, 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 Novvember 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) 272-3218.

This matter is being referred to Technology Center AU 1646 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
www.uspto.g

Date Mailed :November 6, 2007
Patent No. :6,790,444 B2
Ser. No. :09/756301
Inventor(s) :Junming Le, et al.
Issued :September 14, 2004
Title: ANTI-TNF ANTIBODIES AND PEPTIDES OF HUMAN NECROSIS FACTOR

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 is hereby denied.

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

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

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

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

Magdalene Talley
Decisions & Certificates
of Correction Branch
(703) 308-9390 ext. 116

Hamilton, Brook, Smith & Reynolds
530 Virginia Rd.
P.O. Box 9133
Concord, MA 01742-9133

/mt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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OFFICE OF PETITIONS

HAMILTON BROOK SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

In re Patent No. 6,790,444	:	
Issue Date: September 14, 2004	:	
Application No. 09/756,301	:	ON PETITION
Filed: January 8, 2001	:	
Attorney Docket No. 0975.1005-008	:	

This is a decision on the petition filed May 27, 2008, under 37 CFR 3.81(b)[1] to correct the assignee's name 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) 272-3210. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

This application is being forwarded to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Irvin Dingle
Petitions Examiner
Office of Petitions

[1] See Official Gazette of June 22, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Robert Moll
@ Patent Planet
1173 St. Charles Court
Los Altos, CA 94024

MAILED

MAY 1 5 2002

Technology Center 2100

In re Application of: Robert E. Evans)
Application No. 09/756,311)
Filed: January 6, 2001)
For: METHOD AND SYSTEM FOR CHARACTERIZATION AND MATCHING OF ATTRIBUTES AND REQUIREMENTS)

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request to Withdraw from Representation filed February 15, 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. 37C.F.R. § 1.136 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

There is no indication that the applicant has been notified of Mr. Moll's request for withdrawal. Therefore, the request is **DENIED**.

All future communications from the United 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.

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

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. 25

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
STE 1750
100 GALLERIA PARKWAY, NW
ATLANTA GA 30339-5948

MAIL

NOV 0 8 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of)
Thomas D. Petite)
Application No. 09/756,386)
Filed: January 8, 2001)
For: **MULTI-FUNCTION GENERAL PURPOSE TRANSCEIVER**)

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the Request for Withdrawal as attorney or agent and change of address filed on September 28, 2004.

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

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

All attorneys/agents listed in the request, including those associated with customer number 24504 are withdrawn.

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

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

CC: Troutman Sanders LLP
Bank of America Plaza
600 Peachtree Street, N.E., Suite 5200
Atlanta, GA 30308-3000

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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NOV 09 2007

OFFICE OF PETITIONS

TROUTMAN SANDERS LLP
600 PEACHTREE STREET , NE
ATLANTA GA 30308

In re Application of	:	
Petite	:	
Application No. 09/756,386	:	ON PETITION
Filed: January 8,2 001	:	
Attorney Docket No. STAT1021	:	

This is a decision on the petition under 37 CFR 1.137(b), filed July 3, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned June 30, 2006 for failure to reply in a timely manner to the non-final Office action mailed March 29, 2006. The non-final Office action 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. Notice of Abandonment was mailed November 29, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) a reply to the non-final Office action; (2) the required petition fee; and (3) the required statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3205.

The application file is being directed to Technology Center 2600 for further processing.

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

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

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NOV 2 4 2004

OFFICE OF PETITIONS

In re Application of :
Jaiprakash et al. :
Application No. 09/756,415 :
Filed: January 8, 2001 :
Attorney Docket No. 01P7407 US :

ON PETITION

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

The petition is **GRANTED**.

This application became abandoned for failure to pay the issue fee as required by the Notice of Allowance and Fee(s) Due mailed on February 6, 2002, which set a three (3) month statutory period for reply. Accordingly, this application became abandoned on May 7, 2002. A Notice of Abandonment was mailed on July 8, 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).

The $300.00 publication and the $1,330.00 issue fee will be charged to Deposit Account No. 50-1065, as authorized.

This application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries concerning the issuance of the application into a patent should be directed to the Office of Patent Publication, Customer Service at (703) 305-8497.

Telephone inquiries specifically concerning this decision should be directed to the undersigned at (571) 272-3211.

Christina 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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Paper No.

Boyle Fredrickson Newholm
Stein & Gratz S.C.
250 E. Wisconsin Ave., Suite 1030
Milwaukee, WI 53202-4232

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APR 21 2004
OFFICE OF PETITIONS

In re Application of
Ola M. Johansson
Application No. 09/756,428
Filed: January 8, 2001
Attorney Docket No. 1174.064

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed February 17, 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 (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 January 2, 2002. 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 Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 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 USPTO 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 rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of July 29, 2004 accompanies this decision on petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

This application is being forwarded to Technology Center Art Unit 3700 for further processing.

Marianne E. Morgan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 11/22/04

TO SPE OF : ART UNIT 2827

9/756429

SUBJECT : Request for Certificate of Correction on Patent No.: 6765720 B2

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.

Virginia Tolbert

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.

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

Comments:

Approved.

SPE

2827
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

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MURAMATSU & ASSOCIATES
114 PACIFICA, SUITE 310
IRVINE CA 92618

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FEB 26 2008

OFFICE OF PETITIONS

In re Application of	:	
Masayuki Kimishima	:	
Application No. 09/756,442	:	DECISION ON PETITION
Filed: January 8, 2001	:	
Attorney Docket No. ADV	:	
A223.001 AUS	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 29, 2007, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to reply in a timely manner to the Nonfinal Rejection mailed September 16, 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 December 17, 2003.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by

37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (1) and (3).

The required reply to the Nonfinal Rejection mailed September 16, 2003, has not been received.

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but

provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (almost four years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on December 17, 2003. That party, in turn must explain what effort(s) was made to further reply to the outstanding Office action and, further, why no reply was filed. If no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). Likewise, as Muramatsu & Associates were counsel of record at the time of abandonment, Muramatsu & Associates should explain why this application became abandoned while it was under their control and what efforts Muramatsu & Associates made to further reply of itself and with whom this matter was discussed outside of Muramatsu & Associates. Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), Muramatsu & Associates and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons then at Muramatsu & Associates, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due

to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over three years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons then at Muramatsu & Associates and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

> (A) the date that the applicant first became aware of the abandonment of the application; and
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Any renewed petition may be addressed as follows:

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

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

The centralized facsimile number is **(571) 273-8300.**

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

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

Karen Creasy

Karen Creasy
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
www.uspto.gov

MURAMATSU & ASSOCIATES
114 PACIFICA, SUITE 310
IRVINE CA 92618

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SEP 0 3 2008

OFFICE OF PETITIONS

In re Application of	:	
Masayuki Kimishima	:	
Application No. 09/756,442	:	DECISION ON PETITION
Filed: January 8, 2001	:	
Attorney Docket No. ADV	:	
A223.001 AUS	:	

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed August 8, 2008, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to reply in a timely manner to the Nonfinal Rejection mailed September 16, 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 December 17, 2003.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by

37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (1) and (3).

The required reply to the Nonfinal Rejection mailed September 16, 2003, has not been received.

A review of the written records indicates no irregularity in the mailing of the Office action on September 16, 2003. The Office action was properly mailed to the address of record. It is noted that a change of address was submitted on June 29, 2007.

Petitioner is encouraged to provide a showing of a search of the file jacket and evidence of the docket record where the nonreceived Office action would have been entered had it been received.

Any renewed petition may be addressed as follows:

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

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

The centralized facsimile number is **(571) 273-8300.**

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

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

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

Attachment: Copy of the Office Action mailed September 16, 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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OFFICE OF PETITIONS

MURAMATSU & ASSOCIATES
114 PACIFICA, SUITE 310
IRVINE CA 92618

In re Application of	:	
Masayuki Kimishima	:	
Application No.09/756,442	:	DECISION ON PETITION
Filed: January 8, 2001	:	
Attorney Docket No. ADV A223.001	:	
AUS	:	

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed November 18, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinal rejection mailed September 16, 2003, is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 2685 for appropriate action by the Examiner in the normal course of business on the reply received November 18, 2008.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

Sam Pasternak
Choate, Hall & Stewart
Exchange Place
53 State Street
Boston, Massachusetts 02109-2891

MAILED

SEP 2 5 2002

Technology Center 2100

In re Application of: Arif Askerov et al. Application No. 09/756,456 Filed: January 8, 2001 For: R-CONVERSION ENCRYPTION METHOD AND SYSTEM	)))))	DECISION ON PETITION TO MAKE SPECIAL UNDER 37 C.F.R. §1.102(c) AND MPEP § 708.02 (IV): APPLICANT'S AGE

This is a decision on the petition, filed September 17, 2002, under 37 C.F.R. §1.102(c) and M.P.E.P. §708.02(IV): Applicant's Age, to make the above-identified application special.

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, Section IV must include a showing, as by a birth certificate or the applicant's statement, that the applicant is sixty five (65) years of age or more. No fee is required for this petition.

The petition includes a copy of Telman Askerov's passport establishing that Telman Askerov, one of the applicants, is sixty five (65) years of age or more. Accordingly, the petition is **GRANTED.**

The application is being forwarded to the examiner for expedited prosecution.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAR 24 2005

In re Application of	:	
Jonathan S. Stamler et al	:	NOTICE OF WITHDRAWAL
Serial No. 09/756,478	:	FROM ISSUE
Filed: January 8, 2001	:	UNDER 37 CFR 1.313(b)
For: THERAPIES USING HEMOPROTEINS	:	

The above-identified application is withdrawn from issue after payment of the issue fee due to a mistake on the part of the Office. See 37 CFR 1.313(b).

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. This 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 Bruce Campell at (571) 272-0974.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Bruce M. Kisliuk
Director, Technology Center 1600

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD MA 01742-9133

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 7

PHILIP J. ANDERSON
ANDERSON & MORISHITA LLC
2725 S. JONES BLVD
SUITE 102
LAS VEGAS NV 89146

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OFFICE OF PETITIONS

In re Application of
Mitchell J. NewDelman
Application No. 09/756,508
Filed: January 8, 2001
Attorney Docket No. INFINX00-01

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 GRANTED.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 1, 2001, which set a shortened statutory period for reply of three(3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 2, 2001.

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111.

The application file is being forwarded to Technology Center 3700, Art Unit 3713.

Cheryl Gibson-Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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WESTMAN CHAMPLIN (MICROSOFT CORPORATION)
SUITE 1400
900 SECOND AVENUE SOUTH
MINNEAPOLIS MN 55402-3319

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OFFICE OF PETITIONS

In re Application of	:	
Cung Ngoc Phan	:	
Application No. 09/756,591	:	ON PETITION
Filed: January 8, 2001	:	
Attorney Docket No. M61.12-0297	:	

This is a decision on the petition to revive an abandoned application under 37 CFR 1.137(b), filed April 12, 2006.

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

The above-identified application became abandoned for failure to timely file a response to the non-final Office action mailed April 30, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under 37 CFR 1.136(a) were purchased. Accordingly, no reply having received, the application became abandoned on July 31, 2004. A Notice of Abandonment was mailed on May 19, 2005.

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

The matter is being forwarded to Group Art Unit 2135 for consideration of the Amendment filed April 12, 2006.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6585609	2003-07-01	09756612	2001-01-05	

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	/ michael w. landry /	Date (YYYY-MM-DD)	2007-08-09
Name	Michael W. Landry	Registration Number	38216

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. 6585609
Issue Date: July 1,2003
Application No. 09756612
Filed: January 5,2001
Attorney Docket No. 5712PA01

:

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

:

This is a decision on the electronic petition, filed August 9,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of August 9,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 3

MAIL

AUG 3 0 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Paul L. Hickman
HICKMAN COLEMAN & HUGHES LLP
P.O. Box 52037
Palo Alto CA 94303-0746

In re Application of :
Rosenberg, et al. :
Application No. 09/756,617 :
Filed: January 8, 2001 :
For: PROVIDING FORCE FEEDBACK TO A USER OF AN INTERFACE DEVICE BASED ON INTERACTIONS OF A USER-CONTROLLED CURSOR IN A GRAPHICAL USER INTERFACE :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on May 28, 2002.

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

The request meets all of the requirements above. There is no outstanding Office Action to date.

The request is **GRANTED**.

All of the attorneys listed are withdrawn. It is noted that David P. Lentini, James R. Riegel and Raymis H. Kim are still of record.

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

Reinhard J. Eisenzopf
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4711

cc: Phil Albert, Esq.
Townsend & Townsend
Two Embarcadero Center, 8th 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

HAROLD D. MESSNER
1021 NEBRASKA ST.
VALLEJO, CA 94590

Paper No. 3

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OCT 0 5 2001

OFFICE OF PETITIONS

In re Application of
Lynne G. Jolitz
Serial No.09/756,668
Filed: January 8, 2001
Attorney Docket No. N/A

: DECISION GRANTING
: PETITION

This is a decision on the petition under 37 CFR 1.10(c) filed February 23, 2001, requesting that the above-identified application be accorded a filing date of January 8, 2001, instead of the presently accorded date of January 10, 2001.

Petitioner alleges that the application was deposited in "Express Mail" service with the United States Postal Service (USPS), on January 8, 2001. In support, petitioners provided a copy of the Express Mail label, receipt no. EF084891803US, showing a Date-In of January 8, 2001. The same Express Mail receipt number was referred to in the original itemized Application Transmittal Letter submitted with the instant petition. Petitioner requests that the application be accorded a filing date of January 8, 2001.

The Office considers the date the paper or fee is shown to have been deposited as "Express Mail" to be the "Date In" on the Express Mail label. MPEP 513. That is the date that verifies that the package was actually mailed. In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the USPS on January 8, 2001.

In view of the above, the petition is granted.

As a petition under 37 CFR 1.10 is a feeless petition, no fee has been or will be charged.

The application is being returned to the Office of Initial Patent Examination for correction of the filing date to **January 8, 2001.**

Thereafter, the application will be forwarded to Technology Center Art Unit 2100 for examination in due course.

Telephone inquiries concerning this matter should be directed to the undersigned at (703)308-6712.

E. Shirene Willis

E. Shirene Willis
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

Geoffrey R. Myers, Esq.
Zito, Myers & Sheets
Suite 203
26005 Ridge Road
Damascus MD 20872

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JUL 24 2008

In re Application of :
Richard Cam et al. :
Application No. 09/756,680 : ON PETITION
Filed: January 10, 2001 :
Attorney Docket No. 16337.870 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 2, 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 May 14, 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 extension of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is August 15, 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 $1540.00; and (3) a proper statement of unintentional delay.

The Revocation Power of Attorney submitted on June 2, 2008, is not accepted. The Revocation Power of Attorney was sign by only one applicant, Robert Yung. Communications received at the USPTO must be signed by all of the applicants. 37 CFR 1.33(b) states:

> "Amendments and other papers filed in the application must be signed by: (1) An attorney or agent of record appointed in compliance with § 1.34(b); (2) A registered attorney or agent not of record who acts in a representative capacity under the provisions of § 1.34(a); (3) The assignee of record of the entire interest,

if there is an assignee of record of the entire interest; (4) An assignee of record of an undivided part interest, and any assignee(s) of the remaining interest and any applicant retaining an interest, if there is an assignee of record of an undivided part interest; or (5) All of the applicants (§§ 1.42. 1.43 and 1.47) for patent, unless there is an assignee of record of the entire interest and such assignee has taken action in the application in accordance with §§ 3.71 and 3.73."

Telephone inquiries concerning this decision should be directed to JoAnne Burke at (571) 272-4584 .

This application is being referred to Technology Center AU 2619 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.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Clifford W. Vermette
Suite 320- 1177 West Hastings Street
Vancouver, BC V6E2K-3

Attachment: Blank 37 CFR 3.73(b)

PTO/SB/96 (01-08)
Approved for use through 07/31/2008. 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.: _____ Filed/Issue Date: _____

Entitled:

_____, a _____
(Name of Assignee) (Type of Assignee, e.g., 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 for which a copy thereof 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.

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ALEXANDRIA, VA 22313-145

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AUG 4 2004

OFFICE OF THE DIRECTOR
TC 3600

ARENT FOX KINTNER PLOTKIN & KAHN
1050 Connecticut Avenue, N.W.
Suite 400
Washington, DC 20036

In re application of
Kunwar C. Singh
Application No. 09/756,681
Filed: January 10, 2001
For: CREDIT CARD DUPLICATION PREVENTION SYSTEM AND METHOD

DECISION ON REQUEST FOR WITHDRAWAL OF ATTORNEY

This is a decision on the request filed on June 29, 2004, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition A) above.

As to condition A), the attorneys listed in the request do not correspond with those named in the Power of Attorney in the declaration (Customer Number 04372), thereby creating confusion as to who is withdrawing. The original Power of Attorney appointed several attorneys. Of these attorneys, Jonathan A. Kidney, Lynn A. Bristol, Monica Kitts and Charles D. Buskey are not associated with Customer No. 04372. To alleviate this problem, it is suggested that the request be resubmitted and that such request specifically state that the signing attorney is signing on behalf of all attorneys of record in this application.

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868

SNM/pav: 7/30/04

UNITED STATES PATENT AND TRADEMARK OFFICE
FROM DIRECTORS OFFICE

MAR 27 2006

TECHNOLOGY CENTER 3600

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

Albert W. Watkins
Quill & Disc Incorporated
30844 NE 1st Avenue
St. Joseph, MN 56374

In re Application of FISHER, RICHARD L. Appl. No.: 09/756,688 Filed: January 09, 2001 For: Removable Bearing Assemblies	**DECISION ON PETITON FOR SUPERVISORY REVIEW** *37 CFR 1.181*

This is a decision on the petition filed January 27, 2006 for supervisory review of an examiner's action under 37 CFR 1.181. Petitioner requests the relief of instituting interference proceedings in this application.

The petition is **Denied**.

Petitioner requests that the examiner's refusal to suggest an interference because of the presence of rejected claims be over-ruled. MPEP section 2303 states in part:

> An interference should rarely be suggested until examination is completed on all other issues. Each pending claim must be allowed, finally rejected, or canceled. Any appeal from a final rejection must be completed, including any judicial review. Any petition must be decided.

As noted above, any appeal from a final rejection *must* be completed. Since petitioner has a pending appeal, the examiner did not err or abuse discretion in refusing to declare an interference, and petitioner is not entitled to the relief requested. It is noted that petitioner has cited MPEP 2309.02 as support for petitioner's position. This section of the MPEP does not exist in the latest revision of the MPEP (Eight Edition, October 2005 revision). Petitioner should refer to this current edition when referencing the above-cited section 2003.

Telephone inquiries regarding this decision should be directed to S. Joseph Morano, Supervisory Patent Examiner for Art Unit 3617, at (571) 272-6684. Telephone inquiries regarding the status of the claims and other examination related issues should be directed to the examiner of record, Stephen P. Avila, at (571) 272-6678.

John Love
Director, Technology Center 3600

SJM: 3/21/06

SM

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

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SEP 0 8 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE)
P.O. BOX 506
MERRIFIELD VA 22116

In re Application Serial No.:

09/756,738

ON REQUEST TO
WITHDRAW AS ATTORNEY

The Request to Withdraw as Attorney is **GRANTED**.

The correspondence address is not affected by the withdraw. Further communications will continue to be directed to the address listed above until such a time as applicant properly notifies the Patent and Trademark Office of a change of address.

KENNETH WIEDER
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 2600

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

DEVINE, MILLIMET & BRANCH, P.A.
111 AMHERST STREET
BOX 719
MANCHESTER, NH 03105

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MAR 1 1 2003

OFFICE OF PETITIONS

In re Application of
Short
Application No. 09/756,814
Filed: January 9, 2001
Attorney Docket No. 9815/55092

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed November 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 Notice to File Corrected Application Papers (Notice) mailed May 24, 2001. 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 July 25, 2001.

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 the Office of Initial Patent Examination.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Mailed: NOV - 7 2003

thm
Paper Number 10

In re application of
Lannie Bolde
Serial No: 09/756,832
Filed: January 9, 2001
For: KNOWN GOOD DIE REMOVAL METHOD AND APPARATUS

DECISION ON PETITION

This is a decision on the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed June 19, 2003, for failure to respond to the Notice of Non-Compliant Amendment mailed September 4, 2002.

DECISION

Since petitioner asserts that the Notice was never received by Petitioner, and hence is accepted 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 and is evaluated under the procedures regarding an acceptable showing of non-receipt of an office action. See MPEP 711.03(c)(II).

The evidence provided includes a statement by the petitioner that the Notice of Non-Compliant Amendment was not received, a statement that a search of the file and docket records was made, and a statement that the search revealed these papers were not received. Also provided is a copy of the attorney's application docket records where the letter would have been posted had it been timely received. Additionally, it is noted that the Change of Address submitted June 28, 2002 was never properly entered.

In light of this evidence, the abandonment is hereby withdrawn, and the application is returned to pending status. The application shall be forwarded to the LIE for prompt entry of the change of address and remailing of the Notice of Non-Compliant Amendment and restarting of the period of response from the remail date thereof.

The Petition is **GRANTED**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

IRA David Blecker, Sr. Attorney
IBM Corporation
Intellectual Property Law, M/D 482
2070 Route 52
Hopewell Junction, NY 12533

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OCT 18 2006

OFFICE OF PETITIONS

Robert E. Bushnell
Suite 300
1522 K Street, N.W.
Washington DC 20005-1202

In re Patent No.: 6,940,850 :
Issue Date: September 26, 2005 :
Application No. 09/756,866 : DECISION ON PETITION
Filed: January 10, 2001 :
Inventor: Park :

The above-captioned patent has been referred to this office in view of the untreated petition filed July 19, 2004, requesting under 37 CFR 1.181 review of the examiner's requirement that Figure 1 be labeled as "Prior Art."

The petition is dismissed as moot.

As the examiner expressly withdrew this requirement in the Notice of Allowability (at 3, ¶ 3) mailed May 5, 2005, there is no any requirement needing review.

Any inquiries concerning this decision may be directed to Petitions Examiner Brian Hearn at (571) 272-3217.

Charles Pearson
Director, 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
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TOWNSEND AND TOWNSEND AND CREW, LLP (018563)
TWO EMBARCADERO CENTER, EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

Mail Date: 04/21/2010

Applicant	: Muhammad Chishti	: DECISION ON REQUEST FOR
Patent Number	: 7580846	: RECALCULATION of PATENT
Issue Date	: 08/25/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/756,885	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/09/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2793** 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
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Paper No. 8

VENABLE, BAETJER, HOWARD AND CIVILETTI, LLP
P.O. BOX 34385
WASHINGTON DC 20043-9998

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FEB 06 2004

OFFICE OF PETITIONS

In re Application of
John R. Hess
Application No. 09/756,907
Filed: January 10, 2001
Attorney Docket Number: 38644-170537

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on January 29, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned May 14, 2001, for failure to timely reply to the Notice to File Missing Parts mailed on March 13, 2001, which set a two (2) month shortened period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Accordingly, a Notice of Abandonment was mailed January 13, 2004.

Receipt of the substitute oath or declaration and surcharge for its late filing is acknowledged.

The application is being forwarded to the Office of Initial Patent Examination for further processing.

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

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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[1]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

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

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

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OFFICE OF PETITIONS

PLATON N. MANDROS
BURNS, DOANE, SWECKER & MATHIS
P.O. BOX 1404
ALEXANDRIA VA 22313-1404

In re Application of :
Nobuhiro Mishima :
Application No. 09/756,924 :
Filed: January 10, 2001 :
Attorney Docket No. 018987-030 :

ON PETITION

This is a decision on the petition, filed June 29, 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 November 17, 2005, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2624 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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

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

JUL 24 2003

#20

ANDREW N. PARFOMAK
NORRIS, MCLAUGHLIN AND MARCUS, PA
220 EAST 42ND STREET, 30TH FLOOR
NEW YORK, NY 10017

In re Application of	:
Christian Quellet et al	:
Serial No.: 09/756,925	: PETITION DECISION
Filed: January 9, 2001	:
Attorney Docket No.: 102790.43	:

This is a decision on the petition under 37 CFR 1.144, filed May 2, 2003, by facsimile transmission, requesting review of a restriction requirement under 37 CFR 1.144.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 and contained claims 1-27. The examiner mailed a first Office action to applicants on August 29, 2001, rejecting all of claims 1-27 under 35 U.S.C. 112, second paragraph, for indefiniteness and under 35 U.S.C. 103(a) as unpatentable over van Lengerich in view of Saleeb et al and Bilbrey.

Applicants replied by canceling claim 1 and amending various other claims and arguing the rejections of record. The examiner mailed a Final Office action to applicants on April 10, 2002, rejecting claims 1-27 (sic 2-27) under 35 U.S.C. 103(a) as unpatentable over van Lengerich in view of Saleeb et al and Bilbrey and responded to applicants arguments.

Applicants filed an argument after Final rejection on July 9, 2002, which the examiner deemed unpersuasive in an Advisory action mailed July 25, 2002. A telephonic interview was conducted on September 9, 2002, but did not result in allowance of the claims. Applicants filed RCE papers on September 17, 2002 (Certificate of Mailing dated September 9, 2002), and an amendment and further response to the Final Office action. Claims 2-5, 11 and 25 were amended and claims 28-41 were added.

The examiner then mailed a new Office action to applicants on December 18, 2002, setting forth a restriction requirement as follows:

> Group I, claims 2-10 and 28-41, drawn to compositions;
> Group II, claims 11-27, drawn to a method of making.

The examiner reasoned that Groups I and II were related as process and product and that the product could be made in other ways and that the search for one group would not be required for the other group.

Applicants replied on January 15, 2003, electing Group I with traverse. Applicants argued that claims 25-27 should be included with Group I as they are essentially composition claims with a different preamble.

The examiner mailed a non-Final Office action to applicants on April 9, 2003, maintaining the restriction requirement for essentially the reasons previously set forth and making it Final. The examiner rejected claims 28-41 under 35 U.S.C. 112, second paragraph, as indefinite for lack of antecedent basis and claims 2-10 and 28-37 under 35 U.S.C. 103(a) as unpatentable over Carr et al in view of Tsuei et al, and claims 38-41 as unpatentable over Carr et al and Tsuei et al further in view of Bilbrey.

Applicants filed this petition on May 2, 2003, traversing the restriction requirement for various reasons and filed a full reply to the Office action on July 7, 2003.

DISCUSSION

Applicants argue that the restriction between Groups I and II is improper. Applicants first note that in the first two Office actions prior to the filing of RCE papers no restriction requirement on the same claims or same inventions was made. The subject matter of the claims now divided into two groups was examined together in previous Office actions by the same examiner. Thus there appears to be no serious burden on the examiner to examine both inventions at the same time.

Applicants further argue that claims 25-27 should be included, at a minimum, in Group I since they are also to a composition, the claim preamble being the only difference wherein a "system" comprising a composition rather than just a "composition" is recited. Thus the claims have an essentially identical scope.

Applicants' arguments are well taken. Consistency and compactness in prosecution are desirable in the Office. Thus to now separate into different groups claims which were previously examined together, without a good reason for doing so, is not considered consistent nor compact prosecution. In addition, claims of a similar scope, such as claims 25-27 and claims 2-10 and 28-41, should be examined together for the reason noted above. In vie of applicants' arguments the restriction requirement is withdrawn.

DECISION

Applicants' petition under 37 CFR 1.144 is **GRANTED.** Claims 2-41 will all be examined.

The application will be forwarded to the examiner for further prosecution, including consideration of the amendment filed July 7, 2003, not inconsistent with this decision.

Should there be any questions with respect to 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
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Alexandria, VA 22313-1450
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TERRY T. MOYER
P.O. BOX 1927
SPARTANBURG, SC 29304

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OFFICE OF PETITIONS

In re Application of :
James D. Cliver et al :
Application No. 09/756,956 :
Filed: January 9, 2001 :
Attorney Docket No. 2960 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 23, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed November 18, 2003, which set a shortened statutory period for reply of three (3) months. Three months extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on May 19, 2004.

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on November 23, 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 all future correspondence solely to the address of record.

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

The matter is being forwarded to Technology Center AU 1751 for further processing.

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

cc:

Sara M. Current
Milliken & Company
920 Milliken Road, M-495
Spartanburg, SC 29303

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 5

Davis Wright Tremaine, LLP
2600 Century Square
1501 Fourth Avenue
Seattle, Washington 98101-1688

MAIL

SEP 2 3 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Sajid Ahmed	)	
Application No. 09/757,015	)	**DECISION ON PETITION TO MAKE**
Filed: January 8, 2001	)	**SPECIAL UNDER 37 C.F.R. §1.102**
For: SYSTEM AND METHOD OF	)	**AND M.P.E.P. §708.02(XI)**
DECISION MAKING	)	

This is a decision on the petition to make special filed January 15, 2002 under 37 C.F.R. §102(d) and M.P.E.P. §708.02(XI): Inventions For Countering Terrorism.

The petition is **DISMISSED**.

M.P.E.P. §708.02 (XI), which sets out the prerequisites for a grantable petition for Inventions For Countering Terrorism under 37 C.F.R. § 1.102(d), states in relevant part:

> International terrorism as defined in 18 U.S.C. 2331 includes "activities that - (A) involve violent acts or acts dangerous to human life that are a violation of the criminal laws of the United States or of any State, or that would be a criminal violation if committed within the jurisdiction of the United States or of any State; [and] (B) appear to be intended - (I) to intimidate or coerce a civilian population; (ii) to influence the policy of a government by intimidation or coercion; or (iii) to affect the conduct of a government by assassination or kidnapping..." The types of technology for countering terrorism could include, but are not limited to, systems for detecting/identifying explosives, aircraft sensors/security systems, and vehicular barricades/disabling systems.
>
> Applicants who desire that an application relating to inventions for countering terrorism be made special should file a petition with the petition fee under 37 CFR 1.17(h) requesting the Patent and Trademark Office to make the application special. The petition for special status should be accompanied by a statement explaining how the invention contributes to countering terrorism.

Petitioner's submission fails to meet the criteria set out with respect to countering terrorism in M.P.E.P. §708.02(XI). The claimed invention is generally directed to a method and system for emulating human decision making. The specification particularly emphasizes an expert system for medical diagnosis. Diagnosis of medical conditions or general expert systems do not directly prevent "violent acts or acts dangerous to human life that are a violation of the criminal laws of the

United States or of any State" or activities "that would be a criminal violation if committed within the jurisdiction of the United States or of any State". Furthermore, emulating human decision making does not directly prevent acts that appear to be intended to intimidate or coerce a civilian population, influence the policy of a government by intimidation or coercion, or affect the conduct of a government by assassination or kidnapping.

As a result, no advancement in the technology of countering terrorism has been persuasively shown.

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.

It is suggested that Applicant review M.P.E.P. §708.02 regarding other grounds available for filing a petition to make special. In particular, note M.P.E.P. §708.02(VIII): Accelerated Examination, which does not place limitations on the subject matter of the application.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:

DATE :

TO SPE OF : ART UNIT

SUBJECT : Request for Certificate of Correction on Patent No.:

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

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

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

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

Note your decision on the appropriated box.

☐ **Approved** All changes apply.

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

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

Comments:

SPE: Art Unit

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Paper No. 7

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

JOHN M. CARSON
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH, CA 92660

In re Application of:
Paul D. Atkinson
Application No.: 09/757,087
Filed: January 08, 2001
For: SYSTEM AND METHOD OF SYNCHRONIZING OUTPUT OF MEDIA IN PUBLIC SPACES

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney of record filed May 29, 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**.

The following attorney(s) are withdrawn from the record: all the listed attorneys on page 3 of the petition, associated with the law firm of Knobbe, Martens, Olson & Bear.
All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. 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
for Special Program Examiner
Technology Center 2600
Communications

cc: Paul D. Atkinson
1810 Oak Avenue
Carlsbad, CA 92008

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. 24

Date : June 20, 2003

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Benjamin Englander
Application No. : 09/757,130
Filed : January 9, 2001

The above-identified application has been assigned Patent No. 6,582,086 and an issue date of June 24, 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 June 24, 2003:

> "All reference to Patent No. 6,582,086 to BENJAMIN ENGLANDER of NEW YORK for ANTI-GLARE VEHICULAR MIRROR appearing in the Official Gazette of June 24, 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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PAPER NO. 23

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

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OFFICE OF PETITIONS

In re Application of
Benjamin Englander
Application No. 09/757,130
Filed: January 9, 2001
Attorney Docket No. P/1123-53

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed by facsimile transmission on June 20, 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 May 6, 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]

After the application is received in the Office of Petition, the file will be forwarded to Technology Center AU 2872 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 Fee(s) Due (PTOL-85).

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OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

In re Application of	:	
Benjamin Englander	:	
Application No. 09/757,130	:	ON PETITION
Filed: January 9, 2001	:	
Attorney Docket No. P/1123-53	:	

This is a decision on the petition under 37 CFR 1.137(b), filed February 22, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely reply to a final Office action mailed June 14, 2004. A Notice of Abandonment was mailed on January 10, 2005.

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 2872 for further processing of the request for continued examination under 37 CFR 1.114 filed February 22, 2006.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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LAHIVE & COCKFIELD LLP
28 STATE STREET
BOSTON, MA 02109

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AUG 0 4 2005

OFFICE OF PETITIONS

In re Application of	:
Wilhelm Amberg et al	:
Application No. 09/757,142	: DECISION ON PETITION
Filed: January 9, 2001	: UNDER 37 CFR 1.313(c)(3)
Attorney Docket No. BB1-6026CPCN	:

This is a decision on the petition, filed July 29, 2005, under 37 CFR 1.313(c)(3) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

Petitioner requests that the above-identified application be withdrawn from issue for express abandonment in favor of a continuing application (Application No. 11/179,074, filed July 11, 2005). See 37 CFR 1.313(c)(3).

The application is hereby withdrawn from issue, and the abandonment is hereby recognized.

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

This abandoned matter is being referred to Files Repository.

Frances Hicks
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. 9

SIEMENS CORPORATION
Intellectual Property Department
186 Wood Avenue South
Iselin, New Jersey 08830

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APR 1 8 2002

OFFICE OF PETITIONS

In re Application of :
Martin Kiesel, et al. :
Application No. 09/757,146 :
Filed: January 9, 2001 :
Attorney Docket No. 2000 P 03001 US :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 16, 2002, with a certificate of mailing dated October 18, 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 February 26, 2001. The Notice set a period for reply of two (2) months from the mail date of the Notice. A four(4) month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on August 27, 2001.

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

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

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry Brinkley

Sherry Brinkley
Petitions Examiner

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

JAN 11 2005

Christopher J. Horgan
L-703
P.O. Box 808
Livermore, CA 94551

In re Application of:
Toshiki Tajima
Serial No.: 09/757,150
Filed: January 08, 2001
Attorney Docket No.: **IL-10626**

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the petition filed April 28, 2004, 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.**

A non-final Office action was mailed on July 17, 2003. A Notice of Abandonment was mailed on April 05, 2004.

Practitioner asserts that the Office action mailed on July 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 copy of the file docket where the Office action would have been entered was also included with the petition. Practitioner also asserts that upon contacting the examiner of the instant application, a copy of the Office action was faxed to the practitioner on April 07, 2004.

A review of the written record indicates no irregularity in the mailing of the Office action, and in the absence of any irregularity there is a strong presumption that the Office action was properly mailed to 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 action must include a statement from the practitioner stating that the Office action was not received by the practitioner, and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c).

The petition and supporting evidence is sufficient to establish a showing of non-receipt of the Office action mailed July 17, 2003.

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 response to the Office action filed with the petition is accepted as timely and will be entered into the file. The file will be forwarded to the examiner for further examination.

Inquiries regarding this decision should be directed to Clayton E. LaBalle at (571) 272-1594.

Janice A. Falcone

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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GENZYME CORPORATION
LEGAL DEPARTMENT
15 PLEASANT ST CONNECTOR
FRAMINGHAM MA 01701-9322

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JUL 05 2005
OFFICE OF PETITIONS

In re Application of	:	
Miller et al.	:	
Application No. 09/757,202	:	DECISION ON APPLICATION
Filed: January 9, 2001	:	FOR
Atty Docket No. GC-10.6-CON	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "Application under 37 CFR 1.705(b) For Patent Term Adjustment," filed February 17, 2005. Applicants request that the above-identified application be credited with 202 days of patent term adjustment. This request is 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 (and for failure to issue the patent within four months of payment of the issue fee and satisfaction of all outstanding requirements). 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. Patentees 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.

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 one hundred sixty-one (161) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On November 30, 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 0 days (including 2 periods of reduction of 60 and 325 days). Applicants timely filed the instant application for patent term adjustment[1]. Applicants dispute the reduction of 325 days. Furthermore, applicants assert entitlement to a period of adjustment of 262 days. Applicants assert that their response to the non-final Office action mailed February 7, 2002, was faxed to the Office within three months on May 6, 2002, not March 28, 2003. Thus, no period of reduction should have been entered. Further, given the date of receipt of May 6, 2002, applicants assert entitlement to an adjustment under § 1.703(a)(2) for Office delay. Specifically, applicants request a period of adjustment of 262 days for the delay in mailing a non-final Office action until May 28, 2003.

Applicants state that the patent issuing from the application is subject to a terminal disclaimer. Applicants state that both patents over which this application has been terminally disclaimed would expire later than the term of the instant application.

A review of the application history reveals that no response to the Office action mailed February 7, 2002 was considered timely

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[1] Office records show that the Issue Fee payment was received on February 23, 2004.

filed by the Office and the application became abandoned. Applicants were advised of the abandonment by notice mailed October 1, 2002. The record establishes that, in response, on October 8, 2002, applicants filed a petition to withdraw the holding of abandonment. It is specifically noted that the petition to withdraw the holding of abandonment was filed within two months from the mailing date of a notice of abandonment. See § 1.704(c)(4). Moreover, by decision mailed March 28, 2003, the petition was granted on the basis that applicants had shown that a proper response was filed on May 6, 2002.

In view thereof, it is concluded that applicants did not fail to engage in reasonable efforts to conclude processing or examination of the application by delaying in replying to the Office action within the meaning of § 1.704(b).

Moreover, applicants are correct that given the showing of receipt of applicants' response in the Office on May 6, 2002, the application is entitled to a period of adjustment for Office delay. The Office did not take action in response until May 28, 2003. Pursuant to § 1.702(a)(2) and § 1.703(a)(2), the period of adjustment is 264 (not 262) 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 7, 2002, and ending on the date of mailing of an action under 35 U.S.C. 132, May 28, 2003.

However, a review of the record also reveals further basis for reduction. Pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. It has been established that on May 6, 2002, applicants filed a response. Then, on June 18, 2002, applicants filed an Information Disclosure Statement (IDS). The record does not support a conclusion that this IDS was expressly requested by the examiner. Nor is the IDS accompanied by a § 1.704(d) statement. Accordingly, the PTA will be reduced by 43 days, the number of days beginning on the day after the date the initial reply was filed, November 7, 2002, and ending on the date that the supplemental reply or other such paper was filed, June 18, 2002 for the filing of the IDS.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is one hundred sixty-one (161) days (243 - (60 + 43)).

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). 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

Enclosure: Copy of REVISED PAIR Screen

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. 7

FIRASAT ALI
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
7TH FLOOR
12400 WILSHIRE BOULEVARD
LOS ANGELES, CA 90025

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SEP 0 1 2004

OFFICE OF PETITIONS

In re Application of	:	
Serenyi et al.	:	
Application No. 09/757,235	:	ON PETITION
Filed: January 8, 2001	:	
Attorney Docket No. 04860.P2535X	:	

This is a decision on the petition under 37 CFR §§ 1.78(a)(3), filed August 16, 2004, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 for the benefit of prior-filed nonprovisional Application No. 09/603,108, filed on June 22, 2000, set forth in the concurrently filed amendment.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR §§ 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR §§ 1.78(a)(3), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the above-noted, prior-filed application.

The instant pending nonprovisional application was filed on January 8, 2001, and was pending at the time of filing of the instant petition. While a reference to the prior-filed application was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the transmittal letter filed with the above-identified application.

The current procedure where a claim for priority under 37 CFR §§ 1.78(a)(3) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR §§ 1.78(a)(2)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR §§ 1.78(a)(3.[1] In the instant case, the Office noted the claim for

[1] *Note* MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004 and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

priority of the prior-filed nonprovisional application in both the transmittal letter and the oath or declaration filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the $1330.00 petition fee submitted is unnecessary and will be credited to petitioner's deposit account as authorized.

Any questions concerning this decision on petition may be directed to Paralegal Liana Chase at (703) 306-0482. After September 28, 2004, questions maybe directed to (571) 272-3206. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to the Examiner of Technology Center AU 2142 for appropriate action on the amendment filed August 16, 2004, including consideration of the claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) for benefit of the prior-filed nonprovisional application.

Frances Hicks

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 20090502

DATE : 04/24/09

TO SPE OF : ART UNIT 2442

SUBJECT : Request for Certificate of Correction for Appl. No.: 09757235 Patent No.: 7007062 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 Director's SPE response to 571-270-9990

LAMONTE NEWSOME
Certificates of Correction Branch
703-308-9390 ext. 112

Thank You For Your Assistance

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

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

Formatted: Bullets and Numbering

Comments: _____

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

/Andrew Caldwell/	2442
SPE, AU 2442	

SPE	Art Unit

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.: **7,007,062 B1**
APPLICATION NO.: **09/757,235**
ISSUE DATE: **February 28, 2006**
INVENTOR(S): **Serenyi et al.**

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

On the cover sheet at item (54): delete "Methods and Apparatuses for Transferring Data" and insert --Methods and Apparatuses for Representing and Transferring Various Types of Streaming Media Data--.

MAILING ADDRESS OF SENDER:
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

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)
6,561,184	2003-05-13	09757238	2001-01-08	3228-010

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	/BRUCE H. TROXELL/	Date (YYYY-MM-DD)	2009-03-07
Name	BRUCE H. TROXELL	Registration Number	26592

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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www.uspto.gov

In re Patent No. 6561184
Issue Date: May 13,2003
Application No. 09757238
Filed: January 8,2001
Attorney Docket No. 1701001

:

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

:

This is a decision on the electronic petition, filed March 7,2009 ,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 7,2009 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

Edmund P. Pfleger
GROSSMAN TUCKER PERREAULT & PFLEGER, PLLC
55 South Commercial Street
Manchester, New Hampshire 03101

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NOV 2 7 2002

OFFICE OF PETITIONS

In re Application of	:	
Yung-Lin LIN et al.	:	DECISION
Application No. 09/757,265	:	ON PETITION
Filed: January 9, 2001	:	37 CFR 1.183
Attorney Docket No. 02MICRO 00.09		

This is a decision is in response to the petition filed October 28, 2002 under 37 CFR 1.183 to waive 37 CFR 3.81(a) and to thereby correct assignment data on Form PTOL-85(b).

The petition is **granted**.

In accordance with this decision, the address of the assignee has been changed on the Issue Fee Transmittal form and the assignment data now reads as follows:

02 Micro International Limited **P.O. Box 32331 SMB**
Grand Cayman, Cayman Islands
British West Indies

In view of the expedited issuance of patents, the printing process of this application may have progressed to the point where the corrected assignee data cannot be included on the printed patent. If the corrected assignee data does not appear on the printed patent, petitioner may request a certificate of correction pursuant to the provisions of 37 CFR 1.323 and pay the $100 fee therefor.

The application is being returned to the Publishing Division.

Telephone inquiries concerning this matter may be directed to the undersigned at (703) 308-3865. Any questions concerning the issuance of this application into a patent should be directed to Customer Service at (703) 308-6789.

BethAnne C. Dayoan
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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WOOD HERRON & EVANS LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OHIO 45202

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JUL 2 8 2004

OFFICE OF PETITIONS

In re Application of	:
Samuel I. Achilefu et al	:
Application No. 09/757,333	: DECISION GRANTING PETITION
Filed: January 9, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. MRD-67	:

This is a decision on the petition, filed May 20, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on January 12, 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) 305-8680.

This matter is being referred to Technology Center AU 1616 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Frances Hicks

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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Paper No. 11

Fish and Richardson
225 Franklin Street
Boston, MA 02110

COPY MAILED
NOV 1 0 2003
OFFICE OF PETITIONS

In re Application of	:	
Michael Fabry	:	
Application No. 09/757,338	:	ON PETITION
Filed: January 9, 2001	:	
Attorney Docket No. 02103-399001	:	

This is a decision on the petition under 37 CFR 1.137(a), filed October 9, 2003, which is being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181.

The petition is **GRANTED.**

Petitioner states that the non-final Office action, which was mailed on February 14, 2003, was not received. A review of the application file discloses that the Office action was properly addressed to petitioner, but was returned to the USPTO for an unknown reason. As such, the correspondence did not, in fact, reach petitioner.

MPEP 707.13 states:

> "Office actions are sometimes returned to the Office because the United States Postal Service has not been able to deliver them. The examiner should use every reasonable means to ascertain the correct address and forward the action again, after stamping it "remailed" with the date thereof and redirecting it if there is any reason to believe that the action would reach applicant at such new address. If the Office action was mailed to an attorney, a letter may be written to the inventor or assignee informing him or her of the returned action. The period running against the application begins with the date of the remailing. *Ex parte Gourtoff*, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924).»

In view thereof, the appropriate procedure in the instant application was for the Office to remail the Office action restarting the period for reply. Since the Office action was not remailed following the procedure outlined in MPEP 707.13, this application is not deemed abandoned for failure to reply to the non-final rejection.

Accordingly, petitioner may request a refund of the $110 petition fee by writing to the Office of Finance, Refund Section. A copy of this decision should accompany such a request.

The application file is being forwarded to Technology Center 2600 for further examination.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

Marianne E. Morgan

Marianne E. Morgan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for 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

CHRISTIE, PARKER & HALE, LLP
350 WEST COLORADO BOULEVARD
SUITE 500
PASADENA, CA 91105

COPY MAILED

SEP 24 2001

OFFICE OF PETITIONS

In re Application of
Clear, Davis, Michels, Ganesh & Tallegas
Application No.:09/757,349
Filed: January 8, 2001
Attorney Docket No.: 40030/SAH/X2
For: PACKET PROCESSOR WITH PROGRAMMABLE APPLICATION LOGIC

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed July 24, 2001 (certificate of mailing date July 20, 2001).

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. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on January 8, 2001 without an executed oath or declaration. Accordingly, on February 21, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on July 24, 2001 (certificate of mailing date July 20, 2001), a petition for a three month extension of time and required fee, a declaration, the surcharge, the petition fee, and the instant petition were filed. A declaration of facts of Jun-Young E. Jeon, a patent attorney for the firm handling the prosecution of this case, accompanied the petition. Mr. Jeon sets forth the last known address of Mr. Sundara Ganesh, the non-signing inventor, and explains that he mailed a cover letter, a copy of the application, a declaration and power of attorney, and an assignment document to inventor Ganesh at his last known address. Mr. Jeon states that inventor Ganesh did not respond to the request that he sign the oath or declaration for the patent application.

A grantable petition under 37 CFR 1.47(a) requires

(1) a petition including proof of the pertinent facts establishing that the joint inventor refuses to join, or cannot be found or reached after diligent effort,
(2) a proper oath or Declaration executed by the available joint inventors,
(3) the fee of $130 as specified in 37 CFR § 1.17(h), and
(4) the last known address of the omitted inventor.

This petition lacks item (2) above.

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 still has not been presented. The declaration must contain the name, citizenship, residence, and mailing address of each inventor. A city and state is not sufficient for the mailing address requirement. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of inventor Ganesh or left blank in inventor Ganesh's signature block is REQUIRED. See MPEP 409.03(a).

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

By mail:	Commissioner for Patents Box DAC Washington, D.C. 20231
By facsimile:	(703) 308-6916 Attn: Office of Petitions
By hand:	Office of Petitions 2201 South Clark Place Crystal Plaza 4, Suite 3C23 Arlington, VA 22202

Telephone inquiries should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

CHRISTIE, PARKER & HALE, LLP
350 WEST COLORADO BOULEVARD
SUITE 500
PASADENA, CA 91105

COPY MAILED

APR 1 0 2002

OFFICE OF PETITIONS

In re Application of
Clear, Davis, Michels, Ganesh & Tallegas
Application No.:09/757,349
Filed: January 8, 2001
Attorney Docket No.: 40030/SAH/X2
For: PACKET PROCESSOR WITH PROGRAMMABLE APPLICATION LOGIC

DECISION ACCORDING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the reconsideration petition under 37 CFR 1.47(a), filed January 4, 2002 (certificate of mailing date November 8, 2001).

The petition is **GRANTED**.

Petitioner has shown that the non-signing inventor, Mr. Sundara Ganesh, has refused to join in the filing of the above-identified application after having been presented with the application papers. Specifically, the declaration of Jun-Young E. Jeon, a patent attorney representing the signing inventors, establishes that the inventor was mailed the application papers, including the specification, claims and drawings, several times, but the inventor failed to respond to the request that he sign the declaration. Petitioner has submitted a declaration in compliance with 37 CFR 1.63 and 1.64.

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

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.

After this decision is mailed, the above-identified application will be returned to the Office of Initial Patent Examination for further processing. Thereafter the application will be forwarded to Technology Center 2600 for examination in due course.

Telephone inquiries should be directed to the undersigned at (703) 308-6712.

E. Shirene Willis

E. Shirene Willis
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

GREENBERG TRAURIG LLP (LA)
2450 COLORADO AVENUE, SUITE 400E
INTELLECTUAL PROPERTY DEPARTMENT
SANTA MONICA CA 90404

MAILED

JUN 17 2010

OFFICE OF PETITIONS

In re Application of :
Zoran Falkenstein :
Patent No. 6,633,109 :
Application No. 09/757,352 :
Filed: January 8, 2001 :
Attorney Docket No. 0070450-0016

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 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.

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.

Inquiries related to this communication should be directed to the undersigned at (571) 272-2991.

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **PERKINS COIE LLP**
PATENT-LA
P.O. BOX 1208
SEATTLE, WA 98111-1208

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

Sheridan Ross PC
1560 Broadway
Suite 1200
Denver, CO 80202

COPY MAILED

SEP 2 6 2002

OFFICE OF PETITIONS

In re Application of :
Howard C. Chasteen, et al. :
Application No. 09/757,362 :
Filed: January 8, 2001 :
Attorney Docket No. 1604-373 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed September 9, 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 Corrected Application Papers mailed February 21, 2001. 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 April 22, 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 Office of Initial Patent Examination for further processing.

Cheryl Gibson Baylor

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Marianne Morgan for

Sherry Brinkley
Petitions Examiner

SCAN! **Please forward case and paper to address shown below.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5/23/07

TO SPE OF : ART UNIT 3711

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/757384 Patent No.: 6561512

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

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

HENRY RANDALL
Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

EUGENE KIM
~~SUPERVISORY PATENT EXAMINER~~
SPE

3711
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STEPTOE & JOHNSON, LLP
2121 AVENUE OF THE STARS
SUITE 2800
LOS ANGELES CA 90067

MAILED

OCT 22 2009

OFFICE OF PETITIONS

In re Application of	:	
Robert A. Luciano, et al.	:	
Application No. 09/757,384	:	NOTICE
Filed: January 8, 2001	:	
Attorney Docket No. 83336.1043	:	

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 the Terri Johnson at (571) 272-2991.

Chris Bottorff
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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FEB 0 4 2004

Technology Center 2100

Paper No. 13

Robert Moll
@PatentPlanet
1173 St. Charles Court
Los Altos, CA 94024

In re Application of
Brian S. KIM, et al.
Application No. 09/757,435
Filed: January 10, 2001
For: SYSTEMS AND METHODS OF RETRIEVING RELEVANT INFORMATION

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed December 30, 2003.

A Revocation And Substitution Of Power Of Attorney Under 37 CFR § 1. 36 was filed on October 9, 2001. The Power Of Attorney revoked all prior Powers Of Attorney and appointed PILLSBURY WINTHROP, LLP as the attorneys of record of the instant application. The Power Of Attorney of October 9, 20001 was accepted. Accordingly, all communications from the U.S. Patent and Trademark Office to applicant are to be conducted by PILLSBURY WINTHROP, LLP.

For the above stated reasons, the request is **DISMISSED AS MOOT**.

No further communication to you regarding this application will be made.

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

cc: PILLSBURY WINTHROP LLP
2475 Hanover Street
Palo Alto, CA 94304-1114

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. 16

Ross L. Franks
Pillsbury Winthrop LLP
2475 Hanover Street
Palo Alto, CA 94304-1114

MAILED
APR 30 2004
Technology Center 2100

In re Application of:
Brian S. KIM et al.
Application No. 09/757,435
Filed: January 10, 2001
For: SYSTEMS AND METHODS OF RETRIEVING RELEVANT INFORMATION

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

This is a decision on the petition filed 17 March 2004 under 37 CFR §1.181 to withdraw the holding of abandonment of the above-identified application.

A Notice of Abandonment was mailed 09 March 2004 (Paper No. 14).

A review of the file record indicates that the response was received on 14 October 2003 and has been associated with the file. Therefore, the record is clear that the application was ***not abandoned in fact*** and a Notice of Abandonment should not have been issued. Therefore, the petition is **GRANTED**. The Notice of Abandonment is withdrawn.

The Office regrets any inconvenience caused by the mailing of the Notice of Abandonment.

The application file is being forwarded to the Technology Center support staff for processing of the response filed 14 October 2003. The file will then be forwarded to the Examiner for appropriate action on the amendment and response filed 14 October 2003 and the Request to Correct Inventorship in accordance with 37 CFR §1.48(b), also filed 14 October 2003.

It is noted that the Petition Decision mailed 04 February 2004 was in response to a "Request to Withdraw from Representation" filed 30 December 2003, which was "Dismissed as Moot" since a "Revocation and Substitution of Power of Attorney Under 37 CFR §1.36" was previously filed revoking all prior Powers of Attorney and appointing PILLSBURY WINTHROP, LLP as attorneys of record.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mailed: DEC - 3 2004

spg
Paper Number _____

In re application of
Craig R. Horne et al..
Serial No. 09/757,519
Filed: August 23, 2003
For: METAL VANADIUM OXIDE PARTICLES

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. § 1.181, filed April 19, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of March 26, 2004, for failure to timely file a proper reply to the Office letter mailed May 15, 2003(it is noted that Applicant is correct in that such was an Advisory Action mailed May 15, 2003 not requiring a response by Applicant and should have been correctly identified in the Notice of Abandonment as that no response had been received to the FINAL action mailed January 27, 2003) be withdrawn since the applicants did timely file a reply on August 20, 2003. (Copies of the papers filed August 20, 2003 are attached to the instant petition as well as a copy of the USPTO date stamped postcard receipt dated August 22, 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 evidence presented reveals that applicant's reply was properly filed on August 20, 2003 as evidenced by the USPTO date stamped return receipt postcard indicating receipt of the reply at the USPTO on August 22, 2003. Accordingly, any holding of abandonment for failure to timely file a proper reply to the Office letter mailed January 27, 2003 is hereby vacated, and the application is returned to pending status.

The application shall be forwarded to the examiner for entry, processing and consideration of the reply originally filed August 20, 2003.

The Petition is **GRANTED**.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Peter S. Dardi, Ph.D.
Westman, Champlin, & Kelly
International Centre, Suite 1600
900 Second Avenue South
Minneapolis, MN 55402-3319

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Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DNW 02-05

THOMAS S. FERRILL
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD, 7TH FLOOR
LOS ANGELES CA 90025

COPY MAILED

FEB 08 2005

OFFICE OF PETITIONS

In re Application of	:	
James A. Munro	:	
Application No. 09/757,561	:	ON PETITION
Filed: 9 January, 2001	:	
Atty Docket No. 80398.P339	:	

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on 19 January, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on 3 April, 2004, for failure to timely reply to the final Office action mailed on 2 January, 2004, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37

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[1]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

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

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

CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 14 October, 2004.

Petitioners have filed a Request for Continued Examination (RCE) and an Information Disclosure Statement (IDS), and have indicated that the IDS is the submission required under 37 CFR 1.114.

Receipt is also acknowledged of the Petition for Suspension of Action under 37 CFR 1.103. The application will be referred to the Technology Center for a decision on the Petition for Suspension of Action.

The application is being referred to Technology Center Art Unit 2671 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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DIW Aug-05

THOMAS S. FERRILL
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD, 7TH FLOOR
LOS ANGELES CA 90025

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AUG 3 1 2005

OFFICE OF PETITIONS

In re Application of	:	
James A. Munro	:	CORRECTED DECISION
Application No. 09/757,561	:	ON PETITION
Filed: 9 January, 2001	:	
Atty Docket No. 80398.P339	:	

This is a corrected decision on the petition under 37 CFR 1.137(b),[1] filed on 19 January, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are

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[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

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

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

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

permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." This is not a final agency decision.

This application became abandoned on 3 April, 2004, for failure to timely reply to the final Office action mailed on 2 January, 2004, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 14 October, 2004.

Petitioners have filed a Request for Continued Examination (RCE) and an Information Disclosure Statement (IDS), and have indicated that the IDS is the submission required under 37 CFR 1.114.

The petition must be dismissed, however, because, upon further review, the RCE is not accompanied by a submission as required by 37 CFR 1.114. A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. *If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.*

As a reply to the Office action mailed on 2 January, 2004, is due, the reply must meet the requirements of § 1.111.

37 CFR 1.111(b) states:

> 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. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

As petitioner has not provided an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability, a proper submission does not appear to have been provided.

Any renewed petition should be accompanied by a proper submission in compliance with 37 CFR 1.111 and 1.114.

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
401 Dulany Street
Alexandria, VA 22314

Telephone inquiries related to this decision should 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW Nov-05

THOMAS S. FERRILL
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD, 7TH FLOOR
LOS ANGELES CA 90025

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NOV 07 2005

OFFICE OF PETITIONS

In re Application of	:	
James A. Munro	:	
Application No. 09/757,561	:	DECISION ON PETITION
Filed: 9 January, 2001	:	
Atty Docket No. 003551.P038	:	

This is a decision on the renewed petition filed on 28 October, 2005, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

---

[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)).

This application became abandoned on 3 April, 2004, for failure to timely reply to the final Office action mailed on 2 January, 2004, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 14 October, 2004.

Petitioner filed a Request for Continued Examination (RCE) on 19 January, 2005, but did not file a proper submission in accordance with 37 CFR 1.114.

The present petition is accompanied by an amendment directed to the claims, which will be treated as the required submission under 37 CFR 1.114.

The application is being referred to Technology Center Art Unit 2671 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
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HOWSON AND HOWSON
ONE SPRING HOUSE CORPORATION CENTER
BOX 457
321 NORRISTOWN ROAD
SPRING HOUSE, PA 19477

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NOV 01 2005

OFFICE OF PETITIONS

In re Application of	:	
James M. Wilson et al	:	
Application No. 09/757,673	:	ON PETITION
Filed: January 10, 2001	:	
Attorney Docket No. GNVPN.019B1USA	:	

This is a decision on the petition under 37 CFR 1.137(b), filed October 19, 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 April 18, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 19, 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 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 april18, 2005 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 $1,020 extension of time submitted with the petition on October 19, 2005 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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

This matter is being referred to Technology Center AU 1635.

Wan Laymon
Petitions Examiner
Office of Petitions

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SUITE 1400
ARLINGTON, VA 22201

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OFFICE OF PETITIONS

In re Application of	:	
Wolfgang Heil, et. al.	:	
Application No. 09/757,688	:	DECISION ON PETITION
Filed: January 11, 2001	:	
Attorney Docket No. PLOVIN-2A	:	

This is a decision on the petition under 37 CFR 1.137(b), filed on June 29, 2007, to revive the above-identified application.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) under 37 CFR 1.114 with the $790 filing fee and an amendment; (2) the petition fee of $1,500; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED.**

This application is being revived for consideration of the RCE.

The application file is being referred to Technology Center Art Unit 2811 for further processing.

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

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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APR 23 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

Paper No. 7

Covington & Burling
Attn: Patent Docketing
1201 Pennsylvania Avenue, N.W.
Washington, D.C. 20004-2401

In re Application of: Thomas Anderson et al.	)	
Application No. 09/757,700	)	
Filed: January 11, 2001	)	**DECISION ON REQUEST FOR**
For: SYSTEM AND METHOD FOR	)	**WITHDRAWAL AS ATTORNEY**
DETERMININGAND	)	
IMPLEMENTING BEST PRACTICE	)	
IN A DISTRIBUTED WORKFORCE	)	

This is a decision on the Request To Withdraw from Representation filed March 8, 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 by Thomas W. Krause to withdraw from representation is **GRANTED**. All other attorneys remain of record in the application.

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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Paper No. 10

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON MA 02110

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JAN 1 2 2004

OFFICE OF PETITIONS

In re Application of
JOHN ROZEN
Application No. 09/757,745
Filed: January 10, 2001
Attorney Docket No. 11125-017001

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed November 24, 2003, 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 (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 present nonprovisional application is the subject of an application filed in an eighteen month publication country on January 10, 2002. 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 Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 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 USPTO 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 present 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 rescinded. The Office records indicate that the application published on July 11, 2002.

This application is being forwarded to Technology Center Art Unit 2153.

Any inquiries concerning this decision may be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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Commissioner for Patents
United States Patent and Trademark Office
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P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

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SEP 13 2007

Technology Center 2100

In re Application of: John Rozen)
Application No. 09/757,745)
Filed: January 10, 2001)
For: **DISTRIBUTED SELECTION OF A CONTENT SERVER**)

DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on the petition under 37 CFR 1.181, filed January 26, 2007 requesting the Group Director to determine if there is a failure, by the examiner, to grant full faith and credit to the actions of a previous examiner as required by MPEP 704.01.

Case History

3/01/2004, Examiner Klinger sent out a non-final rejection, rejecting claims 1-4, 6, 7 and 9-13 as being anticipated by Hasebe et al. (U.S. Patent Number 6,212,570). Claims 5, 8, and 14 where rejected under 103(a) as being unpatentable over Hasebe in view of Stevens et al. (TCP/IP illustrated, Volume 1: The Protocols). As stated in the Applicant's Petition, claim 9's limitation "origin server" was rejected under Hasebe.

8/26/2004, Applicant responded with an amendment to the claims adding the feature "at an origin server separate from the autonomous system, receiving a request for a client for desired content". The newly added feature was not previously presented in any of the claims.

3/10/2005, Examiner Klinger sent out a second non-final rejection, rejecting claims 1-3, 6, 7 and 10-13 under 103(a) over Hasebe in view of Mockapetris. Claims 5, 8 and 14 were rejected further in view of Stevens. In rejected claim 1, the examiner failed to reject the above limitation the Petitioner argued (i.e., "at an origin server separate from the autonomous system, receiving a request for a client for desired content") and actually stated in the office action that "In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., an origin server that is separate from the content server) were not recited in the rejected claims." The Petitioner's statement of facts that Examiner Klinger "agreed that Hasebe failed

to teach the newly-added limitation" is incorrect. In fact Examiner Klinger simply failed to properly reject the claimed limitation "at an origin server separate from the autonomous system, receiving a request for a client for desired content".

9/14/2005, Applicant responded with similar arguments as presented in Applicant's response 8/26/2004.

12/15/2005, the new examiner, Examiner Barqadale sent out a non-final rejection, rejecting claims 1-3, 6 and 10-13 under 102(e) as being anticipated by Hasebe et al. (U.S. Patent Number 6,212,570) and specifically pointed out how Hasebe teaches the claimed limitations not previously addressed by the Examiner Klinger in the previous office action. Claims 5, 8, and 14 where rejected under 103(a) as being unpatentable over Hasebe in view of Stevens et al. (TCP/IP illustrated, Volume 1: The Protocols).

6/15/2006, Applicant filed a response to the office action mailed 12/15/2005 and subsequently filed a notice of appeal on December 27, 2006.

Statement of Action Requested

Petitioner requests that the new examiner (Yasin Barqadle) follow the guidelines set forth in MPEP 704.01 and recently followed by the district court in *Amgen v. Hoechst Marion Roussel*, 126 F. Supp. 2d 69, 139, 57 USPQ 2d 1449, 1449-1500 (D. Mass. 2001). The Petitioner states that "According to those guidelines, the present examiner must grant full faith and credit to the actions of Examiner Klinger unless Examiner Klinger's action were clearly erroneous."

The action which Applicant requests relief from was mailed September 28, 2006. Applicant filed the petition on January 26, 2007. Because Applicant did not file the petition within two months of the mailing date of the action or notice from which relief is requested the petition is hereby **DENIED** as untimely. Furthermore, it appears from the case history above that the issue the Petitioner presents with respect to MPEP 704.01 is deemed moot since the previous examiner failed to address the argued limitations that the new examiner addresses.

Paul Sewell, Group Director
Technology Center 2100

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P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

Mail Date: 04/20/2010

Applicant	: John Rozen	: DECISION ON REQUEST FOR
Patent Number	: 7587500	: RECALCULATION of PATENT
Issue Date	: 09/08/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/757,745	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/10/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2329** 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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HEWLETT PACKARD COMPANY
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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

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OFFICE OF PETITIONS

In re Application of	:	
Daniel J. Scales	:	
Application No. 09/757,764	:	ON PETITION
Filed: January 9, 2001	:	
Attorney Docket No. 9772-0268-999	:	

This is a decision on the petition under 37 CFR 1.137(b), filed April 29, 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 June 17, 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 18, 2004.

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

This matter is being referred to Technology Center AU 2122.

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

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6,740,133	2004-05-25	09/757,765	2001-01-10	P09522US00/BAS

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	/B. Aaron Schulman/	Date (YYYY-MM-DD)	2009-02-27
Name	B. Aaron Schulman	Registration Number	31877

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

Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent No. 6740133
Issue Date: May 25,2004
Application No. 09757765
Filed: January 10,2001
Attorney Docket No. P09522US00/BAS

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

This is a decision on the electronic petition, filed February 27,2009 ,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 February 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.

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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Date Mailed April 1, 2009

Patent No. :6740133
Inventor :Joseph W. Hundley, Jr.
Patent Issued :May 25, 2004
Title :CHEMICAL CHANGE AGENT FOR COAL AND METHOD OF USING SAME

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 1.322.

Granting of a petition under 37 CFR 1.183, requesting the requirements of 37 CFR 3.81 to be waived, is required to correct applicant's error in the Assignee, when the correct name of the assignee was not provided in accordance with either section 3.81(a) or (b) (either no name or an incorrect name was provided in item 5 of the Issue Fee Transmittal when the assignment had been recorded or submitted for recordation at the time the issue fee was paid, or an incorrect name was provided in the petition required by section 3.81(b) when the assignment submitted for recording after the date of payment of the issue fee, but prior to issuance of the patent). 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 petition to correct the Assignee, under 37 CFR 1.183 should include: (1) the petition fee set forth in 37 CFR 1.117(h) (currently $130); (2) the correct name and address of the assignee; (3) the reel and frame number where the assignment is recorded or proof of the date the assignment was submitted for recordation.

Any petition under 37 CFR 1.183 should be directed to the attention of the Assistant Commissioner for Patents, using the following mailing address or FAX number.

By Mail:	Mail Stop PETITONS Commissioner for Patents Box 1450 Alexandria, VA 22313-1450
By hand:	Customer Service Window Randolph Building 401 Dulany Street Alexandria, VA 22314
EFS web:	uspto.gov/ebc/index.html (must be registered as an e-filer to submit responses) Technical Support 1-866-217-9197
By Fax:	571-273-8300 Attn.: Office of Petitions

If, the petition under 37 CFR 1.183, is filed and granted, the patentee would be entitled to a certificate of correction under 37 CFR 1.323 (required fee currently $100), due to the mistake in not complying with CFR 3.81.

Any inquiry concerning this communication should be directed to Ms. A. Green at (703) 308-9380 ext. 123.

A. Green

Mary Diggs, Supervisor
Decisions & Certificates
of Correction Branch
(703) 308-9390 or (703) 308-9390 ext. 123

Aaron Schulman
Stites & Harbison PLLC
1199 North Fairfax St.
Ste 900
Alexandria, Va 22314

/arg

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ALEXANDRIA VA 22314

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OFFICE OF PETITIONS

In re Patent No. 6,740,133 :

Issue Date: May 25, 2004 :

Application No. 09/757,765 : ON PETITION

Filed: January 10, 2001 :

Attorney Docket No. P09522US00/BAS

This is a decision on the petition filed April 24, 2009, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee data on the front page of the above-identified patent and other typographical errors by way of a Certificate of Correction.

The request is **dismissed**.

Petitioner requests issuance of a certificate of correction in the name of "State Line Holdings, LLC." 37 CFR 3.81(a) permits the patent to issue to the assignee, provided that, at the time the issue fee is paid, the name of an assignee is provided. 37 CFR 3.81(b) permits the patent to issue in the name of an assignee if the assignment was submitted after payment of the issue fee but ***prior to issuance of a patent***. Patent and Trademark Office assignment records disclose that an assignment from Joseph W. Hundley to State Line Holdings, LLC was recorded on March 17, 2009, after the date of issuance of this patent. Accordingly, since the assignment was not submitted for recordation until after issuance of this patent, issuance of a certificate of correction would not be proper. *See* MPEP Section 307.

Any further requests may directed to the following:

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

[1] See *Official Gazette* of June 22, 2004.

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

Questions regarding this decision may be directed to the undersigned at (571)272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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OFFICE OF PETITIONS

In re Patent No. 6,740,133

Issue Date: May 25, 2004

Application No. 09/757,765

Filed: January 10, 2001

Attorney Docket No. **P09522US00/BAS**

ON PETITION

This is regarding the "Request for Issuance of Certificate of Correction for Patent" filed June 8, 2009, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee data on the front page of the above-identified patent and other errors by way of a Certificate of Correction.

The request is **dismissed**.

Petitioner requests that a Certificate of Correction be issued so as to remove "Clean Fuel Technologies, L.L.C" as an assignee on the above-cited patent. Section 1481 of the *Manual of Patent Examining Procedure* provides, in pertinent part, that:

> Mistakes in a patent which are not correctable by Certificate of Correction may be correctable via filing a reissue application (see MPEP § 1401 - § 1460). See *Novo Industries, L.P. v. Micro Molds Corporation*, 350 F.3d 1348, 69 USPQ2d 1128 (Fed. Cir. 2003) (The Federal Circuit stated that when Congress in 1952 defined USPTO authority to make corrections with prospective effect, it did not deny correction authority to the district courts. A court, however, can correct only if "(1) the correction is not subject to reasonable debate based on consideration of the claim language and the specification and (2) the prosecution history does not suggest a different interpretation...").
>
> *In re Arnott,* 19 USPQ2d 1049, 1052 (Comm'r Pat. 1991) specifies the criteria of 35 U.S.C. 255 (for a Certificate of Correction) as follows:
>
> Two separate statutory requirements must be met before a Certificate of Correction for an applicant's mistake may issue. The first statutory requirement concerns the nature, i.e., type, of the mistake for which a correction is sought. The mistake must be:
>
> (1) of a clerical nature,
>
> (2) of a typographical nature, or
>
> (3) a mistake of minor character.

[1] See *Official Gazette* of June 22, 2004.

The second statutory requirement concerns the nature of the proposed correction. The correction must not involve changes which would:

(1) constitute new matter or

(2) require reexamination.

If the above criteria are not satisfied, then a Certificate of Correction for an applicant's mistake will not issue, and reissue must be employed as the vehicle to "correct" the patent. Usually, any mistake affecting claim scope must be corrected by reissue.

A mistake is not considered to be of the "minor" character required for the issuance of a Certificate of Correction if the requested change would materially affect the scope or meaning of the patent. See also MPEP § 1412.04 as to correction of inventorship via certificate of correction or reissue.

It is noted that no assignment to Clean Fuel Technologies, L.L.C. is of record with the USPTO. However, petitioner has not established that the inclusion of Clean Fuel Technologies, L.L.C. as the assignee for the subject patent was a clerical or typographical that occurred in completing the issue fee transmittal sheet or some other clerical error. Neither has petitioner indicated that removing Clean Fuel Technologies, L.L.C. as an assignee would not constitute new matter or require reexamination.

Petitioner may file a renewed petition that established that the inclusion of Clean Fuel Technologies, L.L.C. as the assignee for the patent was a clerical or typographical error the correction of which would not constitute new matter or require reexamination.

Further communications regarding this request may directed as follows:.

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

By FAX: (571) 272-8300
Attn: Office of Petitions

Questions regarding this decision may be directed to the undersigned at (571)272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
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AUG 30 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

The Hecker Law Group
1925 Century Park East
Suite 2300
Los Angeles, CA 90067

In re application of	:	**DECISION ON PETITION**
Fadi B. Chehade et al.	:	**TO MAKE SPECIAL**
Application No. 09/757,771	:	**(ACCELERATED**
Filed: January 9, 2001	:	**EXAMINATION)**
For: METHOD AND APPARATUS FOR FACILITATTING BUSINESS PROCESSES	:	

This is in response to the petition filed on April 14, 2003 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) 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; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

Since all of the requirements for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

SUMMARY: Petition to Make Special **GRANTED.**

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

SNM/vdb: 8/26/04

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22 CENTURY HILL DRIVE
SUITE 302
LATHAM NY 12110

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OFFICE OF PETITIONS

In re Application of :
Fadi CHEHADE et al. :
Application No. 09/757,771 : DECISION ON PETITION
Filed: January 09, 2001 :
Attorney Docket No. END920060077US1 :

This is a decision on the petition, filed November 20, 2008, which is being treated as a petition under 37 CFR 1.59(b) requesting removal of an erroneously filed document from the incorrect file wrapper.

The petition is dismissed.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition filed under 37 CFR 1.59(b). In this instance, the fee required by law is $ 200. See 37 CFR 1.59(b).

The petition in the above-identified application was not accompanied by payment of the required fee. No consideration on the merits can be given to the petition until the required fee is received.

However, it is noted MPEP 724.06 states:

> Expungement of information that was inadvertently submitted to the Office is appropriate provided that items (A)-(F) set forth in MPEP § 724.05, paragraph II, are satisfied.

A courtesy copy of MPEP 724.05, paragraph II, is enclosed.

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) 272-7099.

David Bucci
Petitions Examiner
Office of Petitions

Encl: copy of MPEP 724.05, paragraph II

non-material information can be expunged. See item (C) above.<

(E) If a petition to expunge is not filed prior to>, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process),< the mailing of the NIRC, the materials submitted under MPEP § 724.02 will become a permanent part of the reexamination file and open to the public under 37 CFR 1.11(d). >In the event materials have already been made of record by a party, and it is subsequently determined that the materials are protected, the proper petition to submit would be a petition to seal the protected material under 37 CFR 1.182, with the requisite fee.<

(F) Any petition to expunge a portion or all of the submitted information under 37 CFR 1.59(b) will be treated in accordance with MPEP § 724.05.

724.05 Petition To Expunge Information or Copy of Papers in Application File [R-6]

I. INFORMATION SUBMITTED UNDER MPEP § 724.02

A petition under 37 CFR 1.59(b) to expunge information submitted under MPEP § 724.02, or that should have been submitted under MPEP § 724.02 (as where proprietary information is submitted in an information disclosure statement but inadvertently not submitted in a sealed envelope as discussed in MPEP § 724.02) will be entertained only if the petition fee (37 CFR 1.17(g)) is filed and the information has been found *not* to be **>material to< patentability. If the information is found to be **>material to< patentability, any petition to expunge the information will be denied. Any such petition to expunge information submitted under MPEP § 724.02 should be submitted at the time of filing the information under MPEP § 724.02 and directed to the Technology Center (TC) to which the application is assigned. Such petition must contain:

(A) a clear identification of the information to be expunged without disclosure of the details thereof;

(B) a clear statement that the information to be expunged is trade secret material, proprietary material, and/or subject to a protective order, and that the information has not been otherwise made public;

(C) a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(D) a statement that the petition to expunge is being submitted by, or on behalf of, the party in interest who originally submitted the information;

(E) the fee as set forth in 37 CFR 1.17(g) for a petition under 37 CFR 1.59(b).

Any such petition to expunge should accompany the submission of the information and, in any event, must be submitted in sufficient time that it can be acted on prior to the mailing of a notice of allowability or a notice of abandonment for original and reissue applications, or prior to>, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process),< the mailing of a Notice of Intent to Issue Reexamination Certificate (NIRC) for reexamination proceedings. Timely submission of the petition is, accordingly, extremely important. If the petition does not accompany the information when it is initially submitted, the petition should be submitted while the application or reexamination is pending in the Technology Center (TC) and before it is transmitted to the Publishing Division. If a petition to expunge is not filed prior to the mailing of a notice of allowability or a notice of abandonment for original and reissue applications, or prior to>, or shortly after (i.e., in time to be addressed before the reexamination proceeding enters the reexamination certificate printing process),< the mailing of a NIRC for reexamination proceedings, any material then in the file will remain therein and be open to the public in accordance with 37 CFR 1.14. Accordingly, it is important that both the submission of any material under MPEP § 724.02 and the submission of any petition to expunge occur as early as possible during the examination process. The decision will be held in abeyance and be decided upon the close of prosecution on the merits.

II. INFORMATION UNINTENTIONALLY SUBMITTED IN APPLICATION

A petition to expunge information unintentionally submitted in an application (other than information forming part of the original disclosure) may be filed under 37 CFR 1.59(b), provided that:

(A) the Office can effect such return prior to the issuance of any patent on the application in issue;

(B) it is stated that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted;

(C) the information has not otherwise been made public;

(D) there is a commitment on the part of the petitioner to retain such information for the period of any patent with regard to which such information is submitted;

(E) it is established to the satisfaction of the Director that the information to be returned is not material information under 37 CFR 1.56; and

(F) the petition fee as set forth in 37 CFR 1.17(g) is included.

A request to expunge information that has not been clearly identified as information that may be later subject to such a request by marking and placement in a separate sealed envelope or container shall be treated on a case-by-case basis. Applicants should note that unidentified information that is a trade secret, proprietary, or subject to a protective order that is submitted in an Information Disclosure Statement may inadvertently be placed in an Office prior art search file by the examiner due to the lack of such identification and may not be retrievable.

III. INFORMATION SUBMITTED IN INCORRECT APPLICATION

37 CFR 1.59(b) also covers the situation where an unintended heading has been placed on papers so that they are present in an incorrect application file. In such a situation, a petition should request that the papers be expunged rather than transferred to the correct application file. For Image File Wrapper (IFW) processing, see IFW Manual. The grant of such a petition will be governed by the factors enumerated in paragraph II of this section in regard to the unintentional submission of information. Where the Office can determine the correct application file that the papers were actually intended for, based on identifying information in the heading of the papers (e.g., application number, filing date, title of invention and inventor(s) name(s)), the Office will transfer the papers to the correct application file for which they were intended without the need of a petition.

IV. INFORMATION FORMING PART OF THE ORIGINAL DISCLOSURE

A petition to expunge a part of the original disclosure must be filed under 37 CFR 1.183, since such a request requires a waiver of the requirements of 37 CFR 1.59(a). Petitions under 37 CFR 1.183 should be directed to the Office of Petitions. The petition must explain why justice requires waiver of the rules to permit the requested material to be expunged. It should be noted that petitions to expunge information which is a part of the original disclosure, such as the specification and drawings, will ordinarily not be favorably entertained. The original disclosures of applications are scanned for record keeping purposes. Accordingly, the grant of a petition to expunge information which is part of the original disclosure would require that the USPTO record of the originally filed application be changed, which may not be possible.

724.06 Handling of Petitions To Expunge Information or Copy of Papers in Application File [R-6]

37 CFR 1.59. Expungement of information or copy of papers in application file.

(a)(1)Information in an application will not be expunged, except as provided in paragraph (b) of this section.

(2) Information forming part of the original disclosure (*i.e.*, written specification including the claims, drawings, and any preliminary amendment specifically incorporated into an executed oath or declaration under §§ 1.63 and 1.175) will not be expunged from the application file.

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

(c) Upon request by an applicant and payment of the fee specified in § 1.19(b), the Office will furnish copies of an application, unless the application has been disposed of (*see* §§ 1.53(e), (f) and (g)). The Office cannot provide or certify copies of an application that has been disposed of.

*****

37 CFR 1.59 provides that information, other than the original disclosure of the application, may be expunged from the file wrapper provided a petition to expunge under 37 CFR 1.59(b) and the required fee set forth in 37 CFR 1.17(g) are filed, and further that

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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PILLSBURY WINTHROP
ATTN: DOCKETING DEPARTMENT
11682 EL CAMINO REAL, SUITE 200
SAN DIEGO, CA 92130

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OFFICE OF PETITIONS

In re Application of
Howard M. Dintzis et al
Application No. 09/757,774
Filed: January 9, 2001
Attorney Docket No. 041828-0276361

ON PETITION

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.**

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 January 2, 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 April 3, 2004.

The above-identified application is being revived for consideration of a submission under 37 CFR 1.114 (request for continued examination).

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 $490.00 extension of time submitted with the petition on November 1, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

The Revocation of Power of Attorney with New Power of Attorney and Change of Correspondence Address filed on March 3, 2004 has been entered and made of record.

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

This matter is being referred to Technology Center AU 1646 for processing of the request for continued examination (RCE) under 37 CFR 1.114.

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

Attachment: Notice Regarding Change of Power of Attorney
Notice of Acceptance of Power of Attorney

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COMMISSIONER FOR PATENTS
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Paper No.

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4350 LA JOLLA VILLAGE DRIVE
SAN DIEGO, CA 92122

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OFFICE OF PETITIONS

In re Application of :
Jun Koyama et al :
Application No. 09/757,778 : ON PETITION
Filed: January 9, 2001 :
Attorney Docket No. 07977-108002/US :
3190D1 :

This is a decision on the petition, filed September 2, 2003, which is being treated as a 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 June 16, 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]

---

[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).

The correspondence filed September 2, 2003 is not signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of John F. Hayden 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 acts. However, if Mr. Hayden 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. Hayden, the petitioner herein. However, 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 Wan Laymon at (703) 306-5685.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2871 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

Wan Laymon

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

cc: FISH & RICHARDSON
1425 K STREET NW
11TH FLOOR
WASHINGTON, DC 20005-3500

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Commissioner for Patents
United States Patent and Trademark Office
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MAR – 3 2005

In re Application of	:	
Keith Anderson et al	:	NOTICE OF WITHDRAWAL
Serial No. 09/757,788	:	FROM ISSUE
Filed: January 10, 2001	:	UNDER 37 CFR 1.313(b)
For: TRANSEPITHELIAL DELIVERY OF	:	
GLP-1 DERIVATIVES	:	

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 be 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.

Bruce M. Kisliuk, Director
Technology Center 1600

REZA GREEN, ESQ.
NOVO NORDISK PHARMACEUTICALS, INC.
100 COLLEGE ROAD WEST
PRINCETON NJ 08540

cc: Allowed Files, PK3-910
Drafting Branch, PK3-910

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.
2200 ROSS AVENUE
SUITE 2800
DALLAS, TX 75201-2784

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OFFICE OF PETITIONS

In re Patent No. 6,920,182 :
Issue Date: July 19, 2005 :
Application No. 09/757,798 : ON PETITION
Filed: January 9, 2001 :
Patentee: Jerry Thomas Bolton, Jr. :

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.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

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OFFICE OF PETITIONS

In re Application of :
Yokio Isobe et al. :
Application No. 09/757,802 : ON PETITION
Filed: January 9, 2001 :
Attorney Docket No. 16869S-019500US :

This is a decision on the petition filed July 30, 2001, requesting that the above-identified application be accorded a filing date of January 9, 2001. The petition is being treated under 37 CFR 1.182.

After the application was filed, the Office of Initial Patent Examination mailed a "Notice of Incomplete Application Papers" on April 24, 2001, *inter alia*, stating that no filing date had been assigned because the application was deposited without drawings. The "Notice" set a two (2) month period for response and advised that the filing date would be the date of receipt of the drawings or that by petition, it could be asserted that the drawings had been previously submitted or that the drawings were not necessary.

In response, on July 30, 2001 with a one month extension of time, petitioner filed a response to the "Notice" which included a copy of the drawings and the instant petition arguing that the application claims priority to Japanese Patent Application 2000-006062, filed January 11, 2000 and that the disclosure of which was incorporated by reference. A copy of the certified priority document was included with the petition.

The application was accorded the filing date of the petition and the drawings received on July 30, 2001.

Petitioner argues that the application should be entitled to the original filing date of January 9, 2001 based on the express incorporation by reference.

It is noted that the application transmittal did in fact note and incorporate by reference Japanese Patent Application 2000-006062, filed January 11, 2000, however according to a review of the application file by the Examiner of Record, the drawings in the Foreign Priority document filed on even date with the instant

application are different from the drawings in Japanese Patent Application 2000-006062, filed January 11, 2000. Therefore, the drawings, as described in the specification, was not a part of the disclosure of the prior application and thus is considered new matter. [1]

It is however the USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first sentence). [2] A review of the record reveals that the application contains at least one method claim. Therefore, the present application is deemed to be an application which does not require a drawing for an understanding of the invention. Accordingly, the application, as filed, is entitled to a filing date.

The petition is **GRANTED**.

The "Notice of Incomplete Nonprovisional Application" mailed on April 24, 2001, 2003, was sent in error and is hereby **VACATED**.

The application is being forwarded to the Office of Patent Application Processing for a correction of the filing date to January 9, 2001 and for an indication on the bib-data sheet that no sheets of drawings were present on filing.

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] MPEP 201.06(c) states that:
. . . an applicant may incorporate by reference the prior application by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition. (emphasis supplied)

[2] MPEP 601.01(f).

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO CA 94111-3834

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DEC 27 2007

OFFICE OF PETITIONS

In re Application of
Yukio Isobe et al
Application No. 09/757,802
Filed: July 30, 2001
Attorney Docket No.
16869S-019500US

: DECISION DISMISSING PETITION
: UNDER 37 CFR 1.313(a)

This is a decision on the petition under 37 CFR 1.313(a), filed October 11, 2007, to withdraw the above-identified application from issue.

The petition is **DISMISSED AS MOOT** since this application is now abandoned for failure to timely pay the issue and publication fees on or before October 26, 2007 as required by the Notice of Allowance and Fee(s) Due, mailed July 26, 2007.

Petitioner should note that the mere filing of a petition to withdraw from issue does not stay the period for paying the fees required by the Notice of Allowance and Fee(s) Due. Unless an applicant receives a written communication from the Office that the application has been withdrawn from issue, the issue and publication fees must be timely submitted to avoid abandonment. *Note* MPEP § 1308(I)(A).

In view of the above, the petition to withdraw from issue must be dismissed as involving a moot issue.

Petitioner may wish to consider filing a petition under 37 CFR 1.137 to revive this application.

Inquiries concerning this decision may be directed to the undersigned at (571) 272-3218 or to the Office of Petitions Help Desk at (571) 272-3282 after January 3, 2008.

This application is being referred to the Office of Data Management for processing as an abandoned application.

Frances Hicks
Petitions Examiner
Office of Petitions

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OFFICE OF PETITIONS

In re Application of: Yukio ISOBE
Application No.: 09/757,802
Filed: January 9, 2001
Attorney Docket No.: 16869S-019500US

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 9, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before October 26, 2007, as required by the Notice of Allowance and Fee(s) Due, mailed July 26, 2007. Accordingly, the date of abandonment of this application is October 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 payment of the issue fee of $1,400 and the publication fee of $300, (2) the petition fee of $1540; and (3) an adequate statement of unintentional delay.

Additionally, applicant should note that in the decision on petition mailed November 29, 2007, the petition for correction of the filing date was granted to the extent that the application upon filing included at least one method claim and thus was entitled to a filing date of January 9, 2001.

Telephone inquiries concerning this decision should be directed to Anthony Knight at (571) 272-3687.

This application is being referred to Office of Data Management for processing into a patent.

Anthony Knight
Supervisor
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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JUN 27 2005

OFFICE OF PETITIONS

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

In re Application of	:	DECISION ON PETITION
Nobuhiro Komata	:	
Application No. 09/757,814	:	
Filed: January 10, 2001	:	
Atty Docket No.:	:	
SCEI 17.986	:	

This is a decision on the Petition to Revive the Application based upon unintentional abandonment, filed May 10, 2005.

The petition is **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due ("Notice"), mailed November 18, 2004. The Notice set a non-extendable statutory period for reply of three (3) months. Accordingly, the application became abandoned on February 19, 2005. A Notice of Abandonment was mailed April 18, 2005.

With the instant petition Applicant has submitted the issue fee.

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

Telephone inquiries concerning this matter should be directed to the undersigned at (571) 272-3232.

Derek L. Woods
Petitions Attorney
Office of Petitions

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 5

WIGGIN & DANA
ATTENTION: PATENT DOCKETING
P.O. BOX 1832
NEW HAVEN, CT 06508-1832

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MAY 16 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of	:	
Edward R Knapp et al.	:	DECISION GRANTING
Application No. 09/757,842	:	PETITION
Filed: January 10, 2001	:	
Attorney Docket No. 102088-300	:	

This is a decision on the petition under 37 CFR 1.10(d) filed March 14, 2001, requesting that the above-identified application be accorded a filing date of January 10, 2001, rather than the presently accorded filing date of January 11, 2001.

Petitioners requests the earlier filing date on the basis that the application was purportedly deposited with the U.S. Postal Service (USPS) as Express Mail on January 10, 2001. The petition is accompanied by the copies of the USPS Track/Confirm system information showing that the package bearing Express Mail label No. EL662116464US was accepted on January 10, 2001. The same Express Mail receipt number was referred to in the copy of the original Application Transmittal Letter submitted with the present petition.

In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on January 10, 2001.

Receipt of the declaration filed April 23, 2001 is acknowledged in response to the Notice To File Missing Parts of Nonprovisional Application mailed February 28, 2001.

The petition is granted.

The application is being returned to Initial Patent Examination Division for correction of the filing date to January 10, 2001.

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

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

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6521254	2003-02-18	09/757,852	2001-01-10	

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		Small Entity	
Fee	Code	Fee	Code
○ 3 ½ year	(1551)	◉ 3 ½ year	(2551)
○ 7 ½ year	(1552)	○ 7 ½ year	(2552)
○ 11 ½ year	(1553)	○ 11 ½ year	(2553)

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Robert R Deleault/	Date (YYYY-MM-DD)	2007-04-16
Name	Robert R. Deleault	Registration Number	39165

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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In re Patent No. 6521254
Issue Date: February 18,2003
Application No. 09757852
Filed: January 10,2001
Attorney Docket No. 0701.164C

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

This is a decision on the electronic petition, filed April 16,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 16,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJr: 01-03

Paper 13

MARCIA DEVON
5285 APPIAN WAY
P.O. BOX 3781
LONG BEACH CA 90803

COPY MAILED

JAN 3 1 2003

OFFICE OF PETITIONS

In re Application of
Rabello :
Application No. 09/757,855 : DECISION ON PETITION
Filed: 10 October, 2001 :
Attorney Docket No. (None) :

This is the decision on the petition filed 30 January, 2003, to revive the above-identified application under 37 C.F.R. §1.137(b).[1]

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

BACKGROUND

The record indicates that:

- the instant application was filed on 10 January, 2001;
- the application became abandoned for failure to reply timely and properly to the Formalities Notice (to file the Abstract on a separate page) mailed on 23 February, 2001, and due (absent extension of time) on or before 23 April, 2001;
- Petitioner indicated in a response filed via FAX on 16 April, 2001, that she thought she had

---

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

[2] For completeness of the record, it is noted at this point that, on 17 and 24 October, 2002, Petitioner filed a petition (with credit card fee authorization) seeking to revive the instant application as abandoned due to unavoidable delay under 37 C.F.R. §1.137(a) or have the holding of abandonment withdrawn under 37 C.F.R. §1.181.

filed the Abstract on a separate page, and in support filed a copy of her original--however, that document clearly indicated that the Abstract was not set out on a separate page, and no other document was filed to satisfy the response to the Formalities Notice;

- therefore, on 25 May, 2001, the Office mailed a Notice of Incomplete Reply, which Notice Petitioner indicates she did not receive, although it was properly addressed;
- Notice of Abandonment was mailed 28 August, 2002;
- on 9 September, 2002, Petitioner Noticed the Office as to a change of her address;[3]
- on 17 and 24 October, 2002, Petitioner filed (with a new page of Abstract set forth on a separate page) a petition (with credit card fee authorization) seeking to revive the instant application as abandoned due to unavoidable delay under 37 C.F.R. §1.137(a) or have the holding of abandonment withdrawn under 37 C.F.R. §1.181--it is noted that in the supplementary filing of 30 January, 2003, Petitioner asks that these petitions be withdrawn;[4]
- on 30 January, Petitioner filed the instant petition (with credit card fee authorization) under 37 C.F.R. §1.137(b), and--having previously satisfied the "reply" requirement--now also satisfied the "statement" requirement.

Accordingly, in view of Petitioner's satisfaction of the "reply" and statement requirements, the petition to revive as to unintentional delay under 37 C.F.R. §1.137(b) is **granted** and the petitions under 37 C.F.R. §§1.137(a) and 1.181 are **dismissed as withdrawn**.

The instant application is being forwarded to OIPE to complete the initial review before being forwarded for examination in due course.

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

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

---

[3] Also, about this time, Petitioner Noticed the Office that the filing date of the application was now incorrectly reflected on the Filing Receipt as 11 January, 2001, although Petitioner's allegation of filing on 10 January, 2001, is consistent with the deposit "date in" with the US Postal Service Express Mail. That matter is addressed under separate cover.

[4] Although Petitioner mis-cited the authority for these petitions as "37 C.F.R. [§§]1.181, 1.182(a), or 182(b)," nonetheless the intent of the filing is clear.

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Paper 14

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LONG BEACH CA 90803

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OFFICE OF PETITIONS

In re Application of
Rabello
Application No. 09/757,855
Filed: 10 October, 2001
Attorney Docket No. (None)

DECISION ON PETITION

This is the decision on the petition filed on 16 April, 2001, and again on 10 September, 2002, and supplemented on 24 October, 2002, and 30 January, 2003, to correct a filing receipt and therefore considered under 37 C.F.R. §1.10.[1]

The Office regrets the delay in addressing this matter.

The petition under 37 C.F.R. §1.10 is **GRANTED**.[2]

---

[1] The regulations at 37 C.F.R. §1.10 provide in pertinent part:

§ 1.10 Filing of papers and fees by "Express Mail."

* * *

(e) Any person mailing correspondence addressed as set out in § 1.1(a) to the Office with sufficient postage utilizing the "Express Mail Post Office to Addressee" service of the USPS but not received by the Office, may petition the Commissioner to consider such correspondence filed in the Office on the USPS deposit date, provided that:

(1) The petition is filed promptly after the person becomes aware that the Office has no evidence of receipt of the correspondence;

(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";

(3) The petition includes a copy of the originally deposited paper(s) or fee(s) that constitute the correspondence showing the number of the "Express Mail" mailing label thereon, a copy of any returned postcard receipt, a copy of the "Express Mail" mailing label showing the "date-in," a copy of any other official notation by the USPS relied upon to show the date of deposit, and, if the requested filing date is a date other than the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS, a showing pursuant to paragraph (d)(3) of this section that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day; and

(4) The petition includes a statement which establishes, to the satisfaction of the Commissioner, the original deposit of the correspondence and that the copies of the correspondence, the copy of the "Express Mail" mailing label, the copy of any returned postcard receipt, and any official notation entered by the USPS are true copies of the originally mailed correspondence, original "Express Mail" mailing label, returned postcard receipt, and official notation entered by the USPS.

(f) The Office may require additional evidence to determine if the correspondence was deposited as "Express Mail" with the USPS on the date in question.

[48 Fed. Reg. 2708, Jan. 20, 1983, added effective Feb. 27, 1983; 48 Fed. Reg. 4285, Jan. 31, 1983, paras. (a) & (c), 49 Fed. Reg. 552, Jan. 4, 1984, effective Apr. 1, 1984; paras. (a)-(c) revised and paras. (d) - (f) added, 61 Fed. Reg. 56439, Nov. 1, 1996, effective Dec. 2, 1996; paras. (d) & (e) revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

[2] For completeness of the record, it is noted at this point that, on 17 and 24 October, 2002, Petitioner filed a petition (with credit card fee authorization) seeking to revive the instant application as abandoned due to unavoidable delay under 37 C.F.R. §1.137(a) or have the holding of abandonment withdrawn under 37 C.F.R. §1.181 in connection with an incomplete response to a Formalities Notice. That matter is addressed under separate cover.

The application was and is entitled to a filing date of 10 January, 2001, under the provisions of 37 C.F.R. §1.10. The petition fee is waived.

BACKGROUND

The record indicates that:

- Petitioner alleges that this nonprovisional application was filed via Express Mail (US Postal Service (USPS) Express Mail No. EF272391125US) on 10 January, 2001;
- Petitioner received both a her receipt card and filing receipt setting forth the date of filing as 11 January, 2001, and Petitioner first requested on 16 April (letter dated 13 April), 2001, a corrected filing receipt;
- in companion filings of 10 September and 24 October, 2002, Petitioner further advanced here request for a corrected filing receipt;
- the instant petitions are supported by statements by Counsel Marcia A. Devon (Reg. No. 31,947), as well as USPS documents including the USPS Express Mail No. EF272391125US bearing the "date in" of 10 January, 2001 (time: 8:52 a.m.), and a copy of the application transmittal for the instant application bearing USPS Express Mail No. EF272391125US.

Therefore, as to the instant nonprovisional application, Application No. 09/757,855, the Office of Initial Patent Examination is specifically instructed to:

- assign a filing date of 10 January, 2001; and
- issue a filing receipt specifying the filing date as that of 10 January, 2001.

The instant application is being forwarded to OIPE to be handled as set forth above before being forwarded for examination in due course.

Telephone inquiries concerning this decision may 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 PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
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FEB 2 4 2003

Technology Center 2100

Paper No. 11

Fenwick & West
Silicon Valley Center
801 California Street
Mountain View, California 94041

In re Application of: John Flowers et al.	)	
Application No. 09/757,963	)	
Filed: January 1, 2001	)	**DECISION ON PETITION**
For: INTEROPERABILITY OF	)	**UNDER M.P.E.P. §708.02(II):**
VULNERABILITY INTRUSION	)	**INFRINGEMENT**
DETECTION SYSTEMS	)	

This is a decision on the petition, filed December 2, 2002, under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(II): Infringement, to make the above-identified application special.

A grantable petition under 37 C.F.R. §1.102(c), and M.P.E.P. §708.02, Section II, must be accompanied by payment of the fee under 37 C.F.R.§1.117(I) and a statement under 37 C.F.R. §1.102 by the applicant or assignee or statements by an attorney/agent registered to practice before the Patent and Trademark Office that (A) there is an infringing device or product actually on the market or method in use; (B) 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) 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 prior art. A fee under 37 C.F.R. for such a petition is required .

Applicant's submission meets 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.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 13

Robert M. Trepp
Intellectual Property Law Dept.
IBM Corporation
PO Box 218
Yorktown Heights, NY 10598

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OFFICE OF PETITIONS

In re Application of	:	
Tak Hung Ning	:	
Application No. 09/757,965	:	ON PETITION
Filed: January 10, 2001	:	
Attorney Docket No.YOR920000588US2	:	

This is a decision on the petition under 37 CFR 1.137(b), filed November 14, 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 in a timely manner to the Non-Final Office action mailed November 20, 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 February 21, 2003.

The detailed statement of facts submitted with the instant petition indicates that the delay in responding to the Office action was both unintentional and unavoidable. While the showing of record is not sufficient to establish that the delay was unavoidable, the showing or record is sufficient to establish that the delay until the filing of the instant petition was unintentional.

The application file is being forwarded to Technology Center AU 2811 for further processing.

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
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Paper No.

David E. Rogers
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Phoenix, AZ 85004-4498

MAIL

JUN 02 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
Francois-Xavier Nuttall
Application No. 09/757,966
Filed: January 10, 2001
For: METHOD FOR COMPUTER NETWORK OPERATIONPROVIDING BASIS FOR USAGE FEES

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation Under 37 CFR 1.36 and 10.40(c) filed March 21, 2005.

A Power of Attorney Under 37 CFR 1.36 was filed on April 4, 2005. The Power Of Attorney revoked all prior Powers Of Attorney and appointed James H. Salter (Macrovision Corporation) as the attorneys of record of the instant application. The Power Of Attorney of April 4, 2005, was accepted. Accordingly, all communications from the U.S. Patent and Trademark Office to applicant are to be conducted by James H. Salter.

For the above stated reasons, the request is **DISMISSED AS MOOT**.

No further communication to you regarding this application will be made.

James R. Matthews

for Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

cc: James H. Salter
MACROVISION COPPORATION
2830 De La Cruz Boulevard
Santa Clara, CA 95050

PTO/SB/44 (04-06)
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15367-4007

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 7,089,315
APPLICATION NO. : 09/757,966
ISSUE DATE : August 8, 2006
INVENTOR(S) : Francois-Xavier Nuttall

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

IN THE CLAIMS

Column 11, line 47, claim 6, delete the word "The" and insert therefor the word --A--.

Column 12, line 2, claim 6, delete the word "request" and insert therefor the word --requesting--.

Column 12, line 2, claim 6, delete the word "requesting" and insert therefor the words --request comprising--.

MAILING ADDRESS OF SENDER:

Sanjeet K. Dutta
Orrick, Herrington & Sutcliffe LLP
4 Park Plaza, Suite 1600
Irvine, CA 92614

PATENT NO. 7,089,315

No. of additional copies

⇒ 2

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 USC 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.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: —

DATE : 11/2/06

TO SPE OF : ART UNIT 2154

SUBJECT : Request for Certificate of Correction for Appl. No.: 9/757966 Patent No.: 7089315 B2

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: _____

LARRY D. DONAGHUE
PRIMARY EXAMINER

SPE

2154
Art Unit

WILLIAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov
DIW 01-02

Paper No. 6

RICHARD AFON OSMAN
SCIENCE AND TECHNOLOGY LAW GROUP
75 DENISE DRIVE
HILLSBOROUGH, CA 94010

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JAN 23 2002

OFFICE OF PETITIONS

In re Application of	:	
Baichwal et al.	:	
Application No. 09/758,003	:	DECISION
Filed: 9 January, 2001	:	UNDER 37 CFR 1.28(c)
Attorney's Docket No. T95-006-2	:	

This is in response to the deficiency fee payment filed pursuant to 37 CFR 1.28(c) on 26 December, 2001.

37 CFR 1.28(c) states, "The deficiency is based on the amount of the fee, for other than a small entity, in effect at the time the deficiency is paid in full."

The current fees due for a large entity are $920.00. On 9 January, 2001, $445.00 was paid. Therefore, a deficiency of **$475.00** is due. Petitioner has submitted a check in the amount of $475.00. However, petitioner is ultimately responsible for ensuring that the correct fee is paid and MUST notify the Office if the above calculations are incorrect.

Small entity status will no longer apply.

The file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries should 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
Washington, D.C. 20231
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Paper No. 6

Calfee Halter & Griswold
800 Superior Avenue
Suite 1400
Cleveland, OH 44114

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OCT 1 2 2001

OFFICE OF PETITIONS

In re Application of	:
John Clarke et al.	:
Application No. 09/758,026	: DECISION GRANTING STATUS
Filed: January 10, 2001	: UNDER 37 CFR 1.47(a)
For: Seamless Pressure Vessel	:

This is a decision on the petition under 37 CFR 1.47(a) filed August 23, 2001.

The petition under 37 CFR 1.47(a) 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.

The petition for a three month extension of time received on August 23, 2001 (certificate of mailing August 21, 2001) was received more than three months after the due date for response to the February 21, 2001 Notice to File Missing Parts (Notice). In this regard, the petition for a three month extension of time is insufficient to consider the reply to the Notice of February 21, 2001 as having been timely received. Accordingly, as authorized, an additional fee of $250 (code 218) for the fourth month extension of time will be charged to Deposit Account No. 03-0172.

After the mailing of this decision, the file will be forwarded to the Office of Initial Patent Examination for further processing.

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

Latrice Bond

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

Frances Hicks

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
P.O. Box 1450
Alexandria, VA 22313-1450
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KATTEN MUCHIN ZAVIS ROSENMAN
575 MADISON AVENUE
NEW YORK NY 10022-2585

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FEB 22 2008

In re Application of	:	
Nobuhiro Komata	:	
Application No. 09/758,033	:	ON PETITION
Filed: January 10, 2001	:	
Attorney Docket No. SCEI 17.966	:	

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed August 2, 2007.

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

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

The above-identified application became abandoned for failure to timely file a reply in response to the non-final Office action mailed October 15, 2002. This Office action set a shortened statutory period for reply of three (3) months. Furthermore, the Office action was properly mailed to the address of "Helfgott & Karas, 60th Floor, Empire State Building, New York NY 10118-6098", as set forth in the declaration filed March 5, 2001. Subsequent to the mailing of the Office action, Applicant filed a

Change of Correspondence Address on November 27, 2002. No response to the Office action having been received, the application became abandoned on January 16, 2003. A Notice of Abandonment was mailed on June 9, 2003.

To establish nonreceipt of an Office action, a petitioner must: 1) include a statement that the Office action was not received; 2) attest to the fact that a search of the file jacket and docket records indicates that the Office action was not received; and 3) include a copy of the docket record where the nonreceived Office action would have been entered had it been received and docketed.[1] A proper docket report consists of a "docket record where the nonreceived Office action would have been entered had it been received and docketed."[2] "For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket record showing **all** replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted..."[3]

Here, the docket record submitted on petition is only the prosecution history for the instant application. As set forth above, to establish that the October 15, 2002 Office action was not received, petitioner would need to submit his docket records showing all of his replies docketed for the due date of January 15, 2003. Furthermore, such a showing would need to come from the law firm of record to which the Office action was mailed, namely the firm of Helfgott & Karas.

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is not precluded from obtaining relief by filing a petition pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m); and (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.

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

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[1] See MPEP 711.03(c)(II).

[2] MPEP 711.03(c)(II) (emphasis added).

[3] Id.

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

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

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

Cliff Congo
Petitions Attorney
Office of Petitions

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

KATTEN MUCHIN ZAVIS ROSENMAN575 MADISON AVENUENEW YORK NY 10022-2585

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MAR 11 2009

OFFICE OF PETITIONS

In re Application of	:	
Nobuhiro Komata	:	
Application No. 09/758,033	:	ON PETITION
Filed: January 10, 2001	:	
Attorney Docket No. SCEI 17.966	:	

This is a decision on the petition to revive under 37 CFR 1.137(b), filed March 13, 2008.

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

The above-identified application became abandoned for failure to timely file a reply in response to the non-final Office action mailed October 15, 2002. This Office action set a shortened statutory period for reply of three (3) months. Furthermore, the Office action was properly mailed to the address of "Helfgott & Karas, 60th Floor, Empire State Building, New York NY 10118-6098", as set forth in the declaration filed March 5, 2001. Subsequent to the mailing of the Office action, Applicant filed a Change of Correspondence Address on November 27, 2002. No response to the Office action having been received, the application became abandoned on January 16, 2003. A Notice of Abandonment was mailed on June 9, 2003.

Applicant filed a petition to withdraw the holding of abandonment on August 2, 2007. However, the petition was dismissed in a decision mailed on February 22, 2008.

With the instant petition, petitioner made the proper statement of unintentional delay, submitted the required reply in the form

of an Amendment, and paid the petition fee (by authorizing that any required fees be charged to his deposit account).

The petition fee of $1540 has been charged to Deposit Account No. 50-1290, as authorized.

The application is being forwarded to Group Art Unit 2673 for consideration of the Amendment filed March 13, 2008.

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

/Cliff Congo/
Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Paper No.

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C. GEORGE YU, ATTORNEY
STE. 210
1250 OAKMEAD PKWY
SUNNYVALE, CA 94085

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MAY 0 7 2004

OFFICE OF PETITIONS

In re Application of :
Kwok Leung Lam, et al. :
Application No. 09/758,034 : ON PETITION
Filed: January 9, 2001 :
Attorney Docket No. WIW-001.01 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 23, 2004, to revive the above-identified application.

The application became abandoned for failure to timely respond to a Notice to File Missing Parts (Notice) mailed April 5, 2001. The notice required the statutory basic filing fee, an oath or declaration under 37 CFR 1.63 and the requisite surcharge. Since no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the application became abandoned on June 6, 2001. A Notice of Abandonment was mailed on July 7, 2003. In response, on April 23, 2004, petitioner filed the present petition, the requisite filing fee and surcharge, a partially executed declaration and a petition under 37 CFR 1.47(a).

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

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by: **(1)** the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute, but must be the payment of the issue fee or any outstanding balance thereof in an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof; **(2)** the petition fee required by 37 CFR 1.17(m); **(3)** a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and **(4)** a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)). This petition lacks item (1) above in view of the deficiencies found in the partially signed declaration and the petition under 37 CFR 1.47(a).

The petition under 37 CFR 1.47(a) is **DISMISSED**.

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 items (1) and (2) as set forth above.

As to item (1), applicant appears to demonstrate that Mr. Fung was only presented with a declaration and assignment papers. Unless Mr. Fung was presented with a copy of the application papers (specification, claims and drawings), Mr. Fung could not attest that he has "reviewed and understands the application papers" and therefore could not sign the declaration which he was given. In order to show that the inventor has refused to join in the application, petitioner must provide adequate proof that the application papers were sent or presented to the inventor, but that the inventor did not respond to the request that he sign the oath/declaration. Did the inventor receive the application papers? See Manual of Patent Examining Procedure, Section 409.03(d). The present petition fails to show that the inventor has refused to sign the declaration.

Further, Rule 47 applicant has failed to show that the inventor cannot be reached. While it appears a copy of the declaration and assignment papers were sent to the last known address of the non-signing inventor on June 20, 2003 and January 6, 2004, were the papers ever returned? What other efforts to locate the missing inventor were explored, e.g. contact through e-mail or telephone? The present petition fails to show that the inventor cannot be located.

As to item (2) the declaration of Mr. Lam does not set forth either his or Mr. Fung's residence and post office address. Accordingly, an oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by Mr. Lam on behalf of himself and Mr. Fung is required. See MPEP 409.03(a).]

The above-identified application cannot be revived until a declaration under 37 CFR 1.63 is filed in response to the Notice of Missing Parts mailed April 5, 2001 **or** a grantable petition in compliance with 37 CFR 1.47(a) is submitted.

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. No further petition fee is required. However, the reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)", as well as the missing items noted above. Petitioner is advised that this is not a final agency decision.

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

The centralized facsimile number is (703) 872-9306.

The Power of Attorney filed April 23, 2004 is not accepted since the Power of Attorney is from an assignee and the Certificate required by 37 CFR 3.73(b) has not been received. However, in accordance with 37 CFR 1.34(a), the signature of Kevin Oliver 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. The correspondence address will not be changed. A courtesy copy of this decision is being mailed to petitioner. If Mr. Oliver desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. All future correspondence regarding this application file will be directed solely to the address of record.

Any questions concerning this matter may be directed to the undersigned at (703) 305-9220.

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

cc: Kevin A. Oliver
Foley Hoag, LLP
155 Seaport Boulevard
Boston, MA 02210-2600

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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FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BLVD
BOSTON, MA 02110

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MAY 1 1 2005

OFFICE OF PETITIONS

In re Application of	:	
Kwok Leung Lam, et al.	:	
Application No. 09/758,034	:	ON PETITION
Filed: January 9, 2001	:	
Attorney Docket No. NSO-001.01	:	

This is a decision on the renewed petitions under 37 CFR 1.137(b) and 37 CFR 1.47(a) filed November 10, 2004.

The declaration and the petition have been reviewed and found to be in compliance with 37 C.F.R. § 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 inventors at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

In view of the decision granting 1.47(a) status, the requirements under 37 CFR 1.137(b) have now been satisfied.

The petitions are **GRANTED**.

Telephone inquiries relating to this matter may be directed to the undersigned at (571) 272-3204.

The application is being returned to the Office of Initial Patent Examination (OIPE) for further processing using the declaration executed by Kwok Laung Lam on behalf of himself and nonsigning joint inventor Pascale Fung filed November 10, 2004.

Sherry D. Brinkley

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
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PASCALE FUNG
DEPARTMENT OF ELECTRICAL AND ELECTRONIC ENGINEERING
UNIVERSITY OF SCIENCE AND TECHNOLOGY
CLEAR WATER BAY, KOWLOON
HONG KONG

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MAY 12 2005

OFFICE OF PETITIONS

In re Application of
Kwok Leug Lam and Pascale Fung
Application No. 09/758,034
Filed: January 9, 2001
Title: SYSTEM AND METHOD FOR UTTERANCE VERIFICATION OF CHINESE LONG AND SHORT KEYWORDS

LETTER

Dear Mr. Fung:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at (571) 272-3204. 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).

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

cc: FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BLVD
BOSTON MA 02110

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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BELL, BOYD, & LLOYD LLP
P.O. BOX 1135
CHICAGO IL 60690

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JAN 25 2007

OFFICE OF PETITIONS

In re Application of	:	
Leberer et al.	:	
Application No. 09/758,036	:	ON PETITION
Filed: January 11, 2001	:	
Attorney Docket No. 38005-0126	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed November 15, 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 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 1600 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

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. 6

FOGG SLIFER & POLGLAZE, P.A.
P.O. BOX 581009
MINNEAPOLIS, MN 55458-1009

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JUL 19 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
Oded M. Hadass, Igor Bashes and :
Meiron Atias :
Application No. 09/758,048 :
Filed: January 10, 2001 :
Attorney Docket No. 100.009US01 :
Title: EMULATING EXCHANGE FOR :
MULTIPLE SERVERS :

DECISION ACCORDING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the petition, filed April 26, 2001, under 37 C.F.R. §1.47(a).

The petition under 37 C.F.R. §1.47(a) is **GRANTED**.

The above-identified application was filed on January 25, 2001, without the statutory basic filing fee, with additional claim fees due, and with a declaration executed by joint inventors Oded M. Hadass and Meiron Atias on behalf of themselves and on behalf of non-signing inventor Igor Bashes. No petition under §1.47 accompanied this declaration. Accordingly, on February 26, 2001, a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" was mailed, requiring payment of the filing fee and additional claim fees; the signature of inventor Bashes on an oath or declaration in compliance with §1.63; and payment of the surcharge for late filing under §1.16(e). This Notice set a two-month period for reply.

In reply, applicant timely paid the filing fee, additional claim fees and the surcharge, and filed the instant petition (and fee). Applicant asserts that inventor Bashes refuses to join in the application. A grantable petition under 37 C.F.R. §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.

By declaration, attorney William Weisel, set forth the facts relied on to conclude that inventor Bashes refuses to join in the application. He detailed *inter alia* presenting the application papers to non-signing inventor Bashes at his last known address by registered letter on February 13, 2001, and failing to get a response. In support thereof, applicant submitted, *inter alia*: 1) the registered letter of February 13, 2001, showing that the a copy of the patent application and declaration were sent to non-signing inventor Bashes at his last known address; and 2) what

appears to be a postal service registered letter receipt (in Hebrew). Accordingly, it is concluded that rule 47 applicant 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.

The declaration filed January 10, 2001, and the petition have been reviewed and found in compliance with 37 C.F.R. §1.47(a).

This application is hereby accorded Rule 1.47(a) status.

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

The application file is being forwarded to the Office of Initial Patent Examination for completion of pre-examination processing.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Nancy Johnson at (703) 305-0309.

Beverly M. Flanagan
Supervisory 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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#9

MAR 16 2005

HICKS & PENMAN
SUITE 123
31ST STREET NW
CALGARY AB T2L2K-7 CA CANADA

In re Application of	:	
Michael Zuk	:	
Application No: 09/758,133	:	NOTICE OF WITHDRAWAL
Filed: January 12, 2001	:	FROM ISSUE
Title: Bruxism appliance and method for forming	:	UNDER 37 CFR 1.313(b)

The above-identified application is withdrawn from issue after payment of the issue fee due to unpatentability of one or more claims. See 37 CFR 1.313(b)(3).

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. This 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 Richard Bertsch at (571) 272-2975.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Richard A. Bertsch

Richard A. Bertsch, Director
Technology Center 3700

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

PILLSBURY WINTHROP SHAW PITTMAN
P.O. BOX 10500
McLEAN, VA 22102

COPY MAILED

JUL 22 2005

OFFICE OF PETITIONS

In re Patent No. 6,893,638	:	
Issue Date: May 17, 2005	:	
Application No. 09/758,173	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. 037003-0276603	:	

This is a decision on the petition under 37 CFR 1.183, filed June 9, 2005, and supplemented on June 10, 2005, which is being treated as a petition under 37 CFR 3.81(b)[1] to accept the correction of the assignee on the front page of the above-identified patent.

The petition is **dismissed**.

Petitioner requests issuance of a certificate of correction in the name of "Biogen Idec Inc., **Cambridge, MA.**" However, Office PALM computer database assignment records reflect that the city and state name of the assignee sought by the certificate of correction was recorded as San Diego, California. Accordingly, if reconsideration of this decision is requested, petitioner must supply either the reel and frame number where the recorded assignment appears or supply a copy of the recorded assignment. If the assignment was not recorded, or submitted for recordation, prior to issuance of this patent, a certificate of correction would not be in order. Note MPEP Section 307.

However, it would be appropriate to grant the instant petition to reflect the assignee data as Biogen Idec Inc., San Diego, CA, on the front page of the Letters Patent. Accordingly, if petitioner desires to have the assignee data corrected on the front page of the Letters Patent, petitioner should submit a request for reconsideration under 37 CFR 3.81(b), along with a request for a Certificate of Correction and PTO Form 1050.

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
Randolph Building

---

[1] *See* Official Gazette of June 22, 2004

401 Dulany Street
Alexandria, VA 22314

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

Telephone inquiries concerning this decision should 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

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. 13

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

COPY MAILED

MAY 1 4 2003

OFFICE OF PETITIONS

In re Application of	:	
Mark Landesmann	:	
Application No. 09/758,239	:	DECISION GRANTING PETITION
Filed: January 12, 2001	:	UNDER 37 CFR 1.137(f)
Attorney Docket No. 084561-0103	:	

This is a decision on the petition, filed April 29, 2003, to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f).

The petition is **GRANTED**.

The instant nonprovisional application is the subject of applications filed in a foreign country on October 30, 2001. However, the U.S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign 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 Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(f) must be accompanied by:

(1) the 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(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 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 rescinded. A corrected Filing Receipt which sets forth the projected publication date of August 21, 2003 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 3622 for examination in due course.

Frances Hicks

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

ATTACHMENT: 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. 12

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

COPY MAILED

JUL 23 2003

OFFICE OF PETITIONS

In re Application of	:	
Brogne, et al.	:	
Application No. 09/758,245	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. Q62281	:	

This is a decision on the petition under 37 CFR 1.137(b), filed July 15, 2003, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply within two months to the "Decision Refusing Status Under 37 CFR 1.47(a)" mailed September 10, 2001. Accordingly, this application became abandoned on November 11, 2001. A Notice of Abandonment was mailed on September 16, 2002.

The file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries 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

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UNITED STATES PATENT AND TRADEMARK OFFICE
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ALEXANDRIA, VA 22313-1450
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SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

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JUL 2 3 2003

OFFICE OF PETITIONS

In re Application of :
Nicolas Brogne, Jean-Pierre :
Kelles and Emmanuel Sutter : DECISION GRANTING PETITION
Application No. 09/758,245 : UNDER 37 CFR 1.47(a)
Filed: January 12, 2001 :
Title: METHOD OF SENDING VOICE MESSAGES, AND SYSTEM AND SERVER THEREFOR

This is in response to the request for reconsideration of "Petition Under 37 CFR 1.47(a)," filed October 1, 2002.

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 Declaration. Notice of the filing of this application will also be published in the Official Gazette.

The file is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 306-9200.

Edward J. Tannouse
Senior 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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JEAN-PIERRE KELLES
RUE STE WALBURGE, 456
4000 LIEGE
BELGIUM

COPY MAILED

JUL 2 3 2003

OFFICE OF PETITIONS

In re Application of
Nicolas Brogne, Jean-Pierre Kelles and Emmanuel Sutter
Application No. 09/758,245
Filed: January 12, 2001
Title: METHOD OF SENDING VOICE MESSAGES, AND SYSTEM AND SERVER THEREFOR

Dear JEAN-PIERRE KELLES:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 306-9200. 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).

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

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037
USA

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20037

COPY MAILED

APR 1 8 2003

OFFICE OF PETITIONS

In re Application of :
Brogne, et al. :
Application No. 09/758,245 : ON PETITION
Filed: January 12, 2001 :
Attorney Docket No. Q62281 :

This is a decision on the petition under 37 C.F.R. §1.181, filed October 1, 2002, to withdraw the holding of abandonment in 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 application became abandoned for failure to timely reply within two months to the "Decision Refusing Status Under 37 CFR 1.47(a)" mailed September 10, 2001. Accordingly, this application became abandoned on November 11, 2001. A Notice of Abandonment was mailed on September 16, 2002.

Petitioner contends a timely "Response to Decision," along with a request for a five (5) month extension of time, was submitted to the Office of Petitions by facsimile transmission, on April 10, 2002. In support, petitioner has submitted a copy of the "Response to Decision" purportedly filed April 10, 2002, and a copy of the facsimile receipt that indicates the successful facsimile transmission of five (5) pages to 703-308-6916 (the Office of Petitions fax number).

The Patent and Trademark Office (Office) has a well known procedure to ensure timely submission of responses by facsimile transmission. 37 CFR 1.8(a), Certificate of Mailing or Transmission states, in pertinent part:

> (a) ...[C]orrespondence 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...
>
> (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:
> ...
> (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.

Petitioner has not provided any supporting documentation that evidences the timely submission of the "Response to Decision" through the use of a Certificate of Mailing or Transmission under 37 CFR 1.8. If petitioner complied with the requirements of 37 CFR 1.8 in the submission of the "Response to Decision", then petitioner should provide, in any renewed petition petitioner may wish to file, a copy of the "Response to Decision" and any supporting documentation that indicates the necessary compliance with 37 CFR 1.8 (Certificate of Mailing or Transmission) which would allow for the "Response to Decision" to be considered timely submitted.

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

By mail: Mail Stop Petition
P.O. Box 1450
Alexandria, VA 22313-1450

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 should be directed to the undersigned at (703) 306-9200.

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. 5

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLL
2100 PENNSYLVANIA AVENUE, N.W.
WASHINGTON , DC 20037-3213

COPY MAILED

SEP 1 0 2001

OFFICE OF PETITIONS

In re Application of
BROGNE, NICOLAS, *et al.*
Application No. 09/758,245
Filed: 01/12/2001
For: METHOD OF SENDING VOICE MESSAGES, AND SYSTEM AND SERVER THEREFOR

DECISION REFUSING STATUS UNDER 37 C.F.R. §1.47(a)

This is in response to the August 6, 2001 petition Under 37 C.F.R. §1.47(a).

HISTORY

Applicant filed the above-identified application on January 12, 2001, naming Nicolas Brogne, Jean-Pierre Kelles, and Emmanuel Sutter as joint inventors. However, the application as filed did not include the declaration required by 37 C.F.R. §1.53.

Accordingly, on April 4, 2001, the Office of Initial Patent Examination mailed a notice to file missing parts (hereinafter "the notice") to the address of record. A two month extendable deadline was set for filing a reply.

Petitioner filed this reply on August 6, 2001, which with the included two month extension of time request was timely under 37 C.F.R. §§1.7 & 1.8.

LAW

§ 1.47 Filing when an inventor refuses to sign or cannot be reached.

> (a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself or herself and the nonsigning inventor. The oath or declaration in such an application must be accompanied by a petition including proof of the pertinent facts, the fee set forth in §1.17(l) and the last known address of the nonsigning inventor. The Patent and Trademark Office shall, except in a continued prosecution application under §1.53(d), forward notice of the filing of the application to the nonsigning inventor at said address and publish notice of the filing of the application in the Official Gazette. The nonsigning inventor may subsequently join in the application on filing an oath or declaration complying with §1.63.

ANALYSIS

Petitioner is urged to note the M.P.E.P. 409.03(d) (Proof of Unavailability or Refusal), which states:

> "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 that fully describes the exact facts which are relied on to establish that a diligent effort was made...[t]he 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."

Petitioner has not made a sufficient showing. Specifically, the Commissioner cannot accept that a single mailing to the last known address constitutes a diligent effort to locate co-inventor Sutter. Such an effort constitutes, at best, an unsuccessful first step. A diligent effort should include further steps, such as inquiries made to his current (if known) or former employer, internet searches, and inquiries among known friends and colleagues.

Because of the foregoing, this petition is accordingly *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. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.47(a)".

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: Special Program Law Office
By hand:	Crystal Plaza Four, Suite 3C23 2201 S. Clark Place Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at (703) 306-5593.

Scott M. Ledford
Petitions Attorney
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/758,267	01/12/2001	Stefano Faccinn	NOKIA.30US	4056

22907 7590 06/19/2009
BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
WASHINGTON, DC 20005-4051

EXAMINER
MOORE, IAN N

ART UNIT	PAPER NUMBER
2416	

MAIL DATE	DELIVERY MODE
06/19/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

JUN 19 2009

DIRECTOR OFFICE
TECHNOLOGY CENTER 2400

BANNER & WITCOFF, LTD.
1100 13th STREET, N.W.
SUITE 1200
Washington DC 20005-4051

In re Application of:
Stefano Faccinn et al.
Application No. 09/758,267
Filed: January 12, 2001

For: **COMMON CHARGING IDENTIFIER FOR COMMUNICATION NETWORKS**

DECISION ON PETITION

This is a decision on the petition, filed on May 8, 2008, requesting withdrawal of the Notification of Non-Complaint Appeal Brief mailed April 8, 2008.

A review of the application indicates that (1) the Notification of Non-complaint Appeal Brief mailed April 8, 2008 was proper and (2) the subsequent Appeal Brief filed on October 8, 2008 is found in to be in complied with all provisions of 37 CFR 41.37 and acted upon by Examiner. An Examiner's Answer was mailed on December 4, 2008 and the application has been forwarded to the Board of Appeals.

For the above stated reasons, the petition is **DISMISSED AS MOOT**.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3088.

Hassan Kizou
WQAS, Technology Center 2400

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.

LOEFFLER JONAS & TUGGEY, LLP
755 EAST MULBERRY STREET
SUITE 200
SAN ANTONIO, TX 78212

COPY MAILED

FEB 23 2005

OFFICE OF PETITIONS

In re Application of Richard Watson Application No. 09/758,381 Filed: January 10, 2001 Title: FINGERTIP DEVICE FOR RUPTURING AMNIOTIC MEMBRANES	: : : : : :	DECISION ON APPLICATION FOR PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT," filed September 2, 2004. Applicant requests correction of the patent term adjustment to date from sixty four (64) days to three hundred thirty-seven (337) days. In part, applicant requests reconsideration on the basis of the Office taking in excess of three years to issue the patent.

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).

Patentee 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. 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.

The request for reconsideration of the patent term adjustment at the time of mailing of the notice of allowance is otherwise **DISMISSED**.

On June 2, 2004, 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 to date is 64 days. On September 2, 2004,

applicant timely[1] submitted an application for patent term adjustment (with required fee). Therein, applicant stated that a period of reduction of 92 days (rather than 93 days) should have been entered in the record for applicant's late deposit of a response on February 14, 2003.

A review of the record reveals that the response was deposited on February 15, 2003, and a period of reduction of 93 days was properly entered. The response is present in the record with a date of receipt thereon of February 15, 2003. Petitioner has provided neither a copy of an Express Mail mailing label showing a date-in of February 14, 2003 nor has filed a petition under § 1.10 to correct the date of receipt of record. Moreover, a review of the USPTO's USPS Express Mail Information Database confirms that the response deposited was accepted by the USPS on February 15, 2003 at 12:50 in the morning. Thus, use of the date of February 15, 2003 for receipt of the response and calculation of the reduction was proper.

In view thereof, the patent term adjustment at the time of mailing of the notice of allowance is sixty four (64) days.

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). 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

Enclosure: USPTO's USPS Express Mail Information Database record

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[1] The Issue Fee payment was also submitted on September 2, 2004.

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. 18

Fish & Richardson
225 Franklin Street
Boston, MA 02110-2804

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JUL 2 5 2003

OFFICE OF PETITIONS

In re Application of :
Arnaout et al. :
Application No. 09/758,493 :
Filed: January 11, 2001 :
Attorney Docket No. 00786-804001/MGH :
1721.1

ON PETITION

This is a decision on the petition filed July 3, 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 in a timely manner in reply to the Notice of Non-Responsive Amendment filed October 1, 2002, which set a period for reply of (1) One month or (30) Thirty days from the mailing 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 November 2, 2002.

This application is being forwarded to Technology Center AU 1644 for further processing.

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

Latrice Bond

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

Peter McGee
OSTROLENK,FABER, GARB and SOFFEN
1725 K. Street, N.W.
Washington, D.C.

MAILED

MAR 2 1 2002

Technology Center 2100

In re Application of:Derek Lidow	)	
Application No. 09/758,509	)	DECISION ON PETITION FOR
Filed: January 11, 2001	)	ACCELERATED EXAMINATION
For: SUPPY CHAIN ARCHITECTURE	)	UNDER M.P.E.P. §708.02(VIII)

This is a decision on the petition, filed December 5, 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.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i);

(b) Presents all claims directed to a single invention, ...

(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 merely provides a short one-sentence description of many of the references, or reproduces a portion of the Abstracts provided in the references. That is, the submission does not satisfy the requirement, as it does not provide a ***detailed discussion*** of the references with the particularity required by 37 CFR 1.111(b) and (c).

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.

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

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

SEP 13 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2300

Ostrolenk, Faber, Gerb & Soffen
1180 Avenue of the Americas
New York, NY 10036-8403

Paper No. 15

In re application of
Derek Lidow
Application No. 09/758,509
Filed: January 11, 2001
For: SUPPLY CHAIN ARCHITECTURE

: **DECISION ON PETITION**
: **TO MAKE SPECIAL**
: **(ACCELERATED EXAMINATION)**

This is in response to the renewed petition filed on June 6, 2002 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) 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; and (E) a detailed discussion of how the claimed subject matter is patentable over the references.

Since the requirements lacking in the original petition of December 5, 2001 have now been supplied, all the items above required for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

SUMMARY: Petition to Make Special **GRANTED**.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868

SNM: 9/10/02

OIPE JC165
APR 0 2 2001
PATENT & 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 DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/758,514	01/11/2001	3723	652	HOG520	5	53	1

CONFIRMATION NO. 8392

FILING RECEIPT

OC000000005806252

Edward J. Timmer
Walnut Woods Center
5955 W. Main Street
Kalamazoo, MI 49009

Date Mailed: 02/27/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. 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 Customer Service Center. 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 PTO processes the reply to the Notice, the PTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

Rainer ~~Ludwing~~ Ludwig, Balgheim, GERMANY;

Continuing Data as Claimed by Applicant

Foreign Applications

GERMANY 100 00 954.9 01/17/2000
GERMANY 100 01 337.6 01/17/2000
GERMANY 100 24 976.0 05/19/2000

If Required, Foreign Filing License Granted 02/27/2001

Projected Publication Date: To Be Determined - pending completion of Missing Parts

Non-Publication Request: No

Early Publication Request: No

**** SMALL ENTITY ****

Title

Monitoring device

Preliminary Class

081

Data entry by : TSIGE, WUBALEM **Team :** OIPE **Date:** 02/27/2001

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 CRF 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 36 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 Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, 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).

PLEASE NOTE the following information about the Filing Receipt:

- The articles such as "**a**," "**an**" and "**the**" are not included as the first words in the title of an application. They are considered to be unnecessary to the understanding of the title.
- The words "**new**," "**improved**," "**improvements in**" or "**relating to**" are not included as first words in the title of an application because a patent application, by nature, is a new idea or improvement.
- The title may be truncated if it consists of more than 600 characters (letters and spaces combined).
- The docket number allows a maximum of 25 characters.
- If your application was submitted under 37 CFR 1.10, your filing date should be the "date in" found on the Express Mail label. If there is a discrepancy, you should submit a request for a corrected Filing Receipt along with a copy of the Express Mail label showing the "date in."
- The title is recorded in sentence case.

Any corrections that may need to be done to your Filing Receipt should be directed to:

Assistant Commissioner for Patents
Office of Initial Patent Examination
Customer Service Center
Washington, DC 20231

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

DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

COPY MAILED
OCT 0 2 2006
OFFICE OF PETITIONS

In re Application of	:
Geoffrey B. Rhoads	:
Application No. 09/758,532	: DECISION ON PETITION
Filed: January 10, 2001	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 60244	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed September 27, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/571,422, filed May 15, 2000, as set forth in the amendment and Application Data Sheet received on September 27, 2006.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

(1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of 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)(2)(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.

All of the above requirements having been satisfied, the late claim for benefit of priority under 35 U.S.C. § 120 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)(3) should not be construed as meaning that this application is entitled to the benefit 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. § 120 and 37

CFR 1.78(a)(1) and (a)(2) 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 nonprovisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3218. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center Art Unit 2618 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to prior-filed Application No. 09/571,422.

Frances Hicks
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

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/758,532	01/10/2001	2618	1312	60244		6	3

CONFIRMATION NO. 9755

CORRECTED FILING RECEIPT

OC000000020646350

23735
DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

Date Mailed: 09/29/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. 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 mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. 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 (if appropriate).**

Applicant(s)

Geoffrey B. Rhoads, West Linn, OR;

Power of Attorney: The patent practitioners associated with Customer Number 23735.

Domestic Priority data as claimed by applicant

This application is a CIP of 09/571,422 05/15/2000 PAT 6,947,571
which claims benefit of 60/163,332 11/03/1999

Foreign Applications

If Required, Foreign Filing License Granted: 02/22/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/758,532

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

DATA ENTRY METHOD AND SYSTEM

Preliminary Class
455

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 Assets Control, 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

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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DIGIMARC CORPORATION
9405 SW GEMINI DRIVE
BEAVERTON, OR 97008

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SEP 28 2006
OFFICE OF PETITIONS

In re Application of	:
Geoffrey B. Rhoads	:
Application No. 09/758,532	: DECISION GRANTING PETITION
Filed: January 10, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 60244	:

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 August 25, 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]

The $200 fee applied against petitioner's deposit account for the present petition under 37 CFR 1.313(c)(2)is in excess of the required fee of $130. Accordingly, the $70 overpayment will be refunded to petitioner's deposit account in due course.

It is noted in the amendment filed with the petition that petitioner is seeking to amend the priority claim to delete originally claimed Application No. 09/543,125 and adding a new priority benefit claim to Application No. 09/571,422. While no petition is required to delete a priority claim, a petition under 37 CFR 1.78(a)(3) is required in applications filed on or after November 29, 2000, where an applicant seeks to amend the specification to claim benefit of a prior-filed application after the periods specified in 37 CFR 1.78(a)(2)(ii).

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

This matter is being referred to Technology Center AU 2618 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment and Application Data Sheet.

Frances Hicks
Frances Hicks
Petitions Examiner
Office of Petitions

C:\Documents and Settings\FHicks\My Documents\470\Sept9\758532.wpd

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

MAC MILLAN SOBANSKI & TODD LLC
ONE MARITIME PLAZA, FOURTH FLOOR
720 WATER STREET
TOLEDO, OH 43604

COPY MAILED

APR 0 6 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Hans Heinle et al :
Application No. 09/758,538 :
Filed: January 11, 2001 :
Attorney Docket No. 1-22914

This is a decision on the petition, filed April 5, 2005, which is being treated as a 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 January 7, 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 will be forwarded to Technology Center AU 3683 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PATRICK J. O'SHEA
O'SHEA, GETZ & KOSAKOWSKI, P.C.
SUITE 912
1500 MAIN STREET
SPRINGFIELD, MA 01115

COPY MAILED

NOV 3 0 2006

OFFICE OF PETITIONS

In re Application of :
Bernhard Albicker :
Application No. 09/758,552 :
Filed: January 11, 2001 :
Attorney Docket No. WESTPHAL.6030 :

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed June 2, 2006, 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**.

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 (1).

The instant petition fails to comply with item (1) above in that no notice or statement has been provided as to the filing date of the international application. Accordingly, before a decision can be rendered on the instant petition, petitioner must provide the filing date of the international application and must be accompanied by a renewed petition under 37 CFR 1.137(b).

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
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 Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

Attachment: Petition for Revival of an Application for Patent Abandoned for Failure to Notify the Office of a Foreign or International Filing (37 CFR 1.137(f))

PTO/SB/64a (09-06)
Approved for use through 03/31/2007. 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.

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED FOR FAILURE TO NOTIFY THE OFFICE OFA FOREIGN OR INTERNATIONAL FILING (37 CFR 1.137(f))	Docket Number (Optional)

First named inventor:

Application No.: Art Unit:

Filed: Examiner:

Title:

Attention: Office of Petitions
Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
FAX (571) 273-8300

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to timely notify the Office of the filing of an application in a foreign country or under a multinational international treaty that requires publication of applications eighteen months after filing. The date of abandonment is the day after the expiration date of the forty-five (45) day period set in 35 U.S.C. 122(b)(2)(B)(iii).

PURSUANT TO 37 CFR 1.137(f), APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION UNDER 37 CFR 1.137(b)

1.Petition fee

☐ Small entity-fee $ _____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☐ Other than small entity – fee $ _____ (37 CFR 1.17(m))

2. Notice of Foreign or International Filing (35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c))

Subsequent to the filing of the above-identified application, an application was filed in another country, or under a multinational international treaty (e.g., filed under the Patent Cooperation Treaty), that requires publication of applications eighteen months after the filing. The filing date of the subsequently filed foreign or international application is _____.

This collection of information is required by 37 CFR 1.137. 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 1.0 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: Mail Stop Petition, 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.

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: The entire delay in filing the required notice of a foreign or international filing from the due date for the required notice until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Signature	Date
Typed or printed name	Registration Number, if applicable
Address	Telephone Number
Address	

Enclosures: ☐ Fee Payment

☐ Additional sheets containing statements establishing unintentional delay

☐ Other:_____

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

☐ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

Date	Signature
	Typed or printed name of person signing certificate

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 16 2007

OFFICE OF PETITIONS

O'SHEA GETZ & KOSAKOWSKI, P.C.
1500 MAIN ST., SUITE 912
SPRINGFIELD, MA 01115

In re Application of
Bernhard Albicker
Application No. 09/758,552
Filed: January 11, 2001
Attorney Docket No: WESTPHAL.6030

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed December 11, 2006, 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 inappropriate for the reasons stated below.

The record discloses that, on January 11, 2001, the date of filing of the instant application, a Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) was filed 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."

Petitioner now requests under 35 U.S.C. § 122(b)(2)(B)(ii) that the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) be rescinded and the application be revived because this application became abandoned for failure to notify the USPTO within 45 days of the filing of a corresponding international or foreign application. In this regard, petitioner states that an international or foreign application corresponding to the instant application was filed on October 13, 1999, which date is prior to the date of filing the instant application.

The instant nonprovisional application did not become abandoned as a result of the filing of a corresponding application filed in another country, or under a multilateral international agreement, **subsequent** to the filing of the present application. In this regard, 35 U.S.C. § 122((b)(2)(B)(iii) states:

> An applicant who has made a request under clause (i) but who **subsequently files, in a foreign country or under a multilateral international agreement** specified in clause (i), an application directed to the invention disclosed in the application filed in the Patent and Trademark Office, shall notify the Director of such filing not later than 45 days **after the date of the filing of such foreign or international application**. A failure of the applicant to provide such notice within the prescribed period shall result in the application being regarded as abandoned, unless it is shown to the satisfaction of the Director that the delay in submitting the notice was unintentional.

The facts of this case are that the subject application was filed on January 11, 2001, and the corresponding foreign application was filed on October 13, 1999. The statute does not provide for the situation where a certification under 35 U.S.C. § 122(b)(2)(B)(i) was made, despite the fact that an application was previously filed in another country or under the multilateral international agreement. The provisions of 35 U.S.C. § 122(b)(2)(B)(iii) only provide for revival in the situation where a certification was made under 35 U.S.C. § 122(b)(2)(B)(i) at the time of filing the application and an application was subsequently filed in a foreign country without notifying the Office within 45 days of the filing thereof.

In view of the above and since this application did not become abandoned pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii), a petition to revive under the provisions of 37 CFR 1.137(b) is inappropriate and, therefore, must be dismissed.

As requested, the Request and Certification Under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request indicating a projected publication date will be mailed in a separate correspondence.

The rules and statutory provisions governing the operations of the USPTO require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(c)(7). Accordingly, the petition fee of $1500 received on June 2, 2006 will not be refunded.

This application is being forwarded to Technology Center AU 2618 for examination in due course.

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

Irvin Dingle
Petition 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

KENDYL A. ROMAN
730 BARTEY COURT
SUNNYVALE, CA 94087

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SEP 29 2008

OFFICE OF PETITIONS

In re Application of	:	
Kendyl A. Roman	:	
Application No. 09/758,573	:	ON PETITION
Filed: January 10, 2001	:	
Attorney Docket No. N/A	:	

This is a decision on the petition under 37 CFR 1.137(b), filed on August 27, 2008, to revive the above-identified application.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) under 37 CFR 1.114, with the $405 filing fee; (2) the petition fee of $770; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

This application is being revived for consideration of the RCE.

The application file is being referred to Technology Center Art Unit 2628, for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the previously filed amendment.

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

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

Chiron Corporation
Intellectual Property R338
P.O. Box 8097
Emeryville, CA 94662-8097

Mail Date: 04/21/2010

Applicant	: Joerg Kaufmann	: DECISION ON REQUEST FOR
Patent Number	: 7605246	: RECALCULATION of PATENT
Issue Date	: 10/20/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/758,575	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/09/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1390** 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 Stat s Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Paper No. 13

INCYTE GENOMICS, INC.
3160 PORTER DRIVE
PALO ALTO, CA 94304

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AUG 2 7 2002

OFFICE OF PETITIONS

In re Application of	:
Michael G. Walker	:
Application No. 09/758,593	: DECISION ON PETITION
Filed: January 10, 2001	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. PC-0025 CIP	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed August 12, 2002, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2) of the prior-filed application, unless previously submitted;[1]
> **(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)(2) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

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[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS) to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant pending application was filed on January 10, 2001, and was pending at the time of filing of the instant petition. Further, the instant nonprovisional application was copending with the prior-filed nonprovisional application, for which a claim for benefit of priority is now being sought, at the time of filing. A reference to the prior-filed application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(3).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2). Also, the reference to the prior-filed application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the prior-filed application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted as of the date of filing the petition.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 1646 for processing the amendment filed August 6, 2002 and for consideration by the examiner of the claim under 35 U.S.C. § 120 and 37 CFR 1.78(a)(3) for the benefit of priority to the prior-filed application.

Frances Hicks

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

ATTACHMENT: Corrected Filing Receipt

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

John S. Beulick
Armstrong Teasdale LLP
Suite 2600
One Metropolitan Sq.
St. Louis, MO 63102

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Todd Vincent Graves, et al. :
Application No. 09/758,611 :
Filed: January 11, 2001 :
Attorney Docket No. 9D-RG-19587 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 8, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Nonprovisional Application mailed February 26, 2001. 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 April 27, 2001.

Telephone inquiries concerning this decision should be directed to Retta Williams at (703) 306-5594 or in my absence, Sherry Brinkley at (703) 305-9220.

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

Sherry Brinkley

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

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CISLO & THOMAS, LLP
233 WILSHIRE BLVD
SUITE 900
SANTA MONICA CA 90401-1211

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SEP 2 6 2005

OFFICE OF PETITIONS

In re Application of :
Cassel :
Application No. 09/758,615 : ON PETITION
Filed: January 10, 2001 :
Attorney Docket No. 05-14973 :
FOR: KING PIN NUT FOR SKATEBOARD APPLICATIONS

This is a decision on the petition under 37 CFR 1.137(a), filed August 1, 2005 (certificate of mailing date July 27, 2005), to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to timely submit the issue fee, publication fee, and corrected formal drawings within three months of mailing of a March 12, 2003 Notice of Allowance and Fee(s) Due and Notice of Allowability, respectively. Accordingly, the above-identified application became abandoned on June 13, 2003. A Notice of Abandonment was mailed on July 18, 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; (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 requirements (1) and (3).

Regarding (1), petitioner has still not submitted corrected formal drawings, as is required in the Notice of Allowability, mailed March 12, 2003.

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

In the instant case, petitioner has failed to establish that the delay was unavoidable. Petitioner asserts that the delay was unavoidable because petitioner's former attorney failed to advise the inventor that "an issue fee was due and payable." It is noted that a publication fee, issue fee, and corrected formal drawings were due. It is assumed that petitioner is constructively arguing that the former attorney of record failed to inform Mr. Cassel of any of these requirements' due date.

Petitioner was represented by a registered practitioner. The Office must rely on the actions or inactions of the duly authorized and voluntarily chosen representatives of applicants, and the applicants are bound by the consequences of those actions or inactions. Link v. Wabash, 370 U.S. 626, 633-34 (1962). If the attorney made any errors, petitioners are bound by such errors.[1]

The attorney must act reasonably and prudently.

> If [the] attorney somehow breach[es] his duty of care to plaintiff, then plaintiff may have certain other remedies available to him against his attorney. He cannot, however, ask the court to overlook [the attorney's] action or inaction with regard to the patent application. He hired the [attorney] to represent him. [The attorney's] actions must be imputed to him.[2]

The Seventh Circuit has stated,

> The other assumption is that, if the complainants failed in their application through the

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[1] See California Med. Products v. Technol Med. Products, 921 F. Supp. 1219, 1259 (D. Del. 1995) (citing Smith v. Diamond, 209 U.S.P.Q. 1091, 1093 (D.D.C. 1981) (citing Link v. Walbash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962))).

[2] Haines v. Quigg, 673 F. Supp. 314, 317, 5 U.S.P.Q. 2d (BNA) 1130 (citing Link v. Walbash Railroad Co., 370 U.S. 626, 8 L. Ed. 2d 734, 82 S. Ct. 1386 (1962) ("Petitioner voluntarily chose his attorney as his representative in the action and he cannot now avoid the consequences of the acts or omissions of this freely selected agent ... Each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'" (emphasis added); Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983) ("Courts hesitate to punish a client for its lawyers gross negligence, especially when the lawyer affirmatively misled the client" but "if the client freely chooses counsel, it should be bound to counsel's actions."); see also Wei v. State of Hawaii, 763 F. 2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983)). See also Smith v. Diamond, 209 U.S.P.Q. (BNA) 1091 (D. D.C. 1981).

> negligence of their attorney, the delay would be unavoidable, which is wholly unwarranted in the law. It is of the very nature of negligence that it should not be unavoidable, otherwise it would not be actionable. The negligence of the attorney would be the negligence of the [client]. The purpose of the statute was to put an end to such pleas, and there would be no limit to a renewal of these applications if every application, however remote, could be considered under the plea of negligence of attorneys, by whom their business is generally conducted.[3]

The United States Court of Appeals for the Federal Circuit has stated,

> If we were to hold that an attorney's negligence constitutes good cause for failing to meet a PTO requirement, the PTO's rules could become meaningless. Parties could regularly allege attorney negligence in order to avoid an unmet requirement.[4]

In the instant case, Marie Marden, Vice President of Dark Horse Distribution, Inc., states that the President of Dark Horse Distribution, Inc., who is also Donald Cassel, inventor of the above-identified invention, was not properly informed by his former attorney that the issue fee was due. It is not clear why Ms. Marden is providing a statement, rather than Mr. Cassel. Furthermore, there are no details as to what communication took place between the former attorney and Mr. Cassel or the ususal course of communication between the two about patent matters. Ms. Marden asserts that she will not divulge what communication occurred between Dark Horse Distribution, Inc. and the former attorney because of the desire to maintain attorney client privilege. Thus, no evidence has been submitted regarding details as to why the former attorney did not respond in a timely manner.

The fact remains that the Notices in question were addressed to the proper correspondence address of record, that of the former attorney of record. The former attorney was responsible for replying in a timely and complete manner and his client stands in his shoes. The purported negligence of the former attorney of record is binding on petitioner. Delay resulting from a failure in communication between a petitioner and his or her registered practitioner is a delay binding upon petitioner. See In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988); Ray v. Lehman, 55 F.3d 606, 610, 34 USPQ2d 1786, 1789 (Fed. Cir. 1989).

ALTERNATIVE VENUE

Petitioner is strongly encouraged to file a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide 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." This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the $ 750.00 petition fee.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay can not make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was

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[3] Lay v. Indianapolis Brush & Broom Mfg. Co., 120 F. 831, 836 (1903).

[4] Huston v. Ladner, 973 F.2d 1564, 1567, 23 U.S.P.Q.2D (BNA) 1910 (Fed. Cir. 1992).

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
Post Office Box 1450
Alexandria, VA 22313-1450

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

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

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

E. Shirene Willis

E. Shirene Willis
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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UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 11

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LOS ANGELES, CA 90067-3208

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OFFICE OF PETITIONS

In re Application of :
Svensson et al. :
Application No. 09/758,631 :
Filed: January 10, 2002 :
Attorney Docket No. 061450-0027 :

ON PETITION

This is a decision on the petition under 37 CFR 1.183 filed January 10, 2001, on the petition under 37 CFR 1.137(b) filed August 23, 2001, and on the petition under 37 CFR 1.181 filed January 2, 2002.

The petition under 37 CFR 1.183 is **dismissed as moot**.

The petition under 37 CFR 1.137(b) is **dismissed as moot**.

The petition under 37 CFR 1.181 is **granted in part and dismissed in part**.

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. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The application was filed on January 10, 2002, along with a petition under 37 CFR 1.183 requesting waiver of portions of the PBG-Final Rule for new reissue applications. Such waiver was necessary because the application failed to comply with the new rule in so far as the application was filed in single column format rather than double.

On February 5, 2001, a Notice to File Missing Parts was mailed to applicant stating, "Assignees statement under 37 CFR 3.73(b) establishing ownership of the patent is missing." The Notice stated that a 37 CFR 3.73(b) statement and $130 surcharge must be submitted. The Notice stated that the "reissue specification has not been provided in double-column format as is required by 37 CFR 1.173(a)(1)." The Notice set a period for reply of two (2) months from the mail date of the Notice and stated that extensions of time could be obtained.

On August 23, 2001, petitioner filed a statement under 37 CFR 3.73(b), the $130 surcharge, and a specification in double-column format. The papers contain authorization for the Office to charge necessary fees to deposit account no. 16-2230. Petitioner also filed a petition under 37 CFR 1.137(b) on August 23, 2001.

With the filing of the papers on August 23, 2001, relief under 37 CFR 1.183 appears to no longer be necessary. Therefore, the petition under 37 CFR 1.183 is dismissed as moot. A petition fee of $130 has not been charged for the petition under 37 CFR 1.183.

As to the petition under 37 CFR 1.137(b), the petition is dismissed as moot because the

application is not abandoned. Office records indicate the $1,240 fee was previously refunded. The Notice of Missing Parts allowed petitioner to buy an extension of time up to 5 months. Therefore, with the maximum extension of time, petitioner had until September 5, 2001, to file a response to the Notice of Missing Parts. Deposit account no. 16-2230 listed on the August 23, 2001 papers, will be charged for a 5 month extension of time.

For the above reasons, the petition under 37 CFR 1.181 is granted to the extent the petition requests a refund of $1,280. However, the petition is dismissed to the extent that petitioner requests a refund of $130 since the fee was due when the fee was submitted on August 23, 2001. MPEP 1410 states,

> [W]here an application is filed without . . .the consent of all assignees, if the application otherwise complies with 37 CFR 1.53(b) and the reissue rules, the Office of Initial Patent Examination (OIPE) will . . . accord send out a notice of missing parts setting a period of time for filing the missing part and for payment of any surcharge required under 37 CFR 1.53(f) and 1.16(e). If the reissue oath or declaration is filed but the assignee consent is lacking, the surcharge is required because, until the consent is filed, the reissue oath or declaration is defective, since it is not apparent that the signatures thereon are proper absent an indication that the assignees have consented to the filing.

Office records indicate the $130 fee was incorrectly refunded on April 11, 2002. Therefore, the $130 will be charged to deposit account no. 16-2230.

Petitioner may wish to note that, had the papers filed on August 23, 2001, not been timely filed, the application would have become abandoned despite the Office's later steps to withdraw the Notice. Abandonment is not based on the correctness, in whole or in part, of an Office action. If an applicant fails to respond to a restriction requirement which the examiner later determines is untenable as drafted, the application is abandoned. If an Office action is mailed rejecting claims based on anticipation over a reference that was facially not available as prior art against the application, an applicant must still respond to the Office action in order to avoid abandonment.

The Office of Petitions wishes to note that the Office of Petitions is unclear why the Office of Initial Patent Examination mailed a paper withdrawing the Notice of Missing Parts and stating that the Notice was erroneous. However, as discussed previously, the Office of Petitions need not address the correctness of the original Notice since such an issue would not affect the decisions on the petitions which have been filed.

The file is now being forwarded to Technology Center 2800 for further prosecution using the new specification, in double-column format, filed August 23, 2001.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

Charles Steven Brantley
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

MORRISON & FOERSTER LLP
555 WEST FIFTH STREET, SUITE 3500
LOS ANGELES, CA 90013-1024

COPY MAILED

OCT 13 2004

OFFICE OF PETITIONS

In re Application of	:
Yoshiki Nishitani et al	:
Application No. 09/758,632	: DECISION GRANTING PETITION
Filed: January 10, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 39303.20222.00	:

This is a decision on the petition, filed October 7, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on February 23, 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.

This matter is being referred to Technology Center AU 2837 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed 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 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
www.uspto.gov

MORRISON & FOERSTER LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

COPY MAILED
MAY 0 4 2006
OFFICE OF PETITIONS

In re Application of	:
Yoshiki Nishitani et al	:
Application No. 09/758,632	: DECISION ON PETITION
Filed: January 10, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 393032016800	:

This is a decision on the petition, filed April 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 **DISMISSED**.

Petitioner requests that this application be withdrawn from issue for consideration of an Information Disclosure Statement in a Request for Continued Examination. However, this application was held abandoned, in a Notice of Abandonment mailed April 6, 2006, for failure to timely take appropriate action (request that the previously paid issue fee be applied towards the new Notice by returning completed Part B - Fee(s) Transmittal) on or before January 19, 2006, as required by the Notice of Allowance and Fee(s) Due, mailed October 19, 2005. Accordingly, the request to withdraw cannot be granted until petitioner has submitted a grantable petition under 37 CFR 1.137 to accept the delayed submission of the reply to the Notice of October 19, 2005.

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

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
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MORRISON & FOERSTER LLP
555 WEST FIFTH STREET
SUITE 3500
LOS ANGELES, CA 90013-1024

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JUL 1 0 2006
OFFICE OF PETITIONS

In re Application of	:
Yoshiki Nishitani et al	:
Application No. 09/758,632	: DECISION ON PETITIONS UNDER
Filed: January 10, 2001	: 37 CFR 1.8(b) AND 37 CFR
Attorney Docket No. 393032016800	: 1.313(c)(2)

This is a decision on the petition under 37 CFR 1.8(b), filed June 1, 2006, requesting withdrawal of the holding of abandonment in the above-identified application and on the concurrently filed renewed petition under 37 CFR 1.313(c)(2) to withdraw the application from issue.

The petition under 37 CFR 1.8(b) is **GRANTED**.

The petition under 37 CFR 1.313(c)(2) is **GRANTED**.

DISCUSSION OF PETITION UNDER 37 CFR 1.8(b)

This application was held abandoned for failure to timely take appropriate action in reply to the Notice of Allowance and Fee(s) Due (Notice), mailed October 19, 2005; *i.e.*, request that the previously paid issue fee be applied towards the new Notice on or before January 19, 2006. A Notice of Abandonment was mailed on April 6, 2006. A petition to withdraw from issue was filed on April 13, 2006 and dismissed in a decision mailed May 4, 2006 in view of the failure of the file record to indicate timely submission of a reply to the Notice of October 19, 2005.

Petitioner states that a timely reply was mailed via certificate of facsimile transmission on October 28, 2005, which included Fee(s) Transmittal Form-Part B. In support, petitioner has submitted a copy of the previously facsimile transmitted correspondence, bearing a certificate of transmission date of October 28, 2005, which would have rendered the reply timely if made of record in the instant file. Additionally, petitioner has submitted a copy of the Auto-Reply Facsimile Transmission, which discloses receipt of 2 pages (including the cover page) in the USPTO on October 28, 2005 at 6:19:59 PM (EDT) of Part B of the Fee(s) Transmittal form, as denoted on the cover page. Further, petitioner has provided a statement by Ms. Beverly Carter (Senior Paralegal of the firm of

Morrison and Foerster) attesting to the previously timely transmission of the Fee(s) Transmittal Form-Part B on October 28, 2005.

The file record does not include the originally submitted papers. Failure to receive correspondence which includes a certificate of mailing or certificate of facsimile transmission is addressed in 37 CFR 1.8(b), 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 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 petition satisfies the above requirements of 37 CFR 1.8(b). Accordingly, the holding of abandonment for failure to timely file a reply to the Notice of October 19, 2005 is hereby withdrawn and the application restored to pending status.

The copy of the reply received with the petition will be accepted in place of the reply shown to have been transmitted by facsimile on October 28, 2005.

DISCUSSION OF PETITION UNDER 37 CFR 1.313(c)(2)

Petitioner requests that this application be withdrawn from issue for consideration of an Information Disclosure Statement. Additionally, the petition is accompanied by a Request for Continued Examination under 37 CFR 1.114.

The petition complies with the conditions of 37 CFR 1.313(c)(2). Accordingly, this application is withdrawn from issue for consideration of a submission (IDS) under 37 CFR 1.114 (request for continued examination).

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]

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

This application is being referred to Technology Center AU 2837 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 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. 21

MAIL

MAR 26 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

THE MCCALLUM LAW FIRM, LLC
132 KOLAR COURT
ERIE, CO 80516

In re Application of
Hamilton, et al

Application No. 09/758,645
Filed: January 10, 2001
For: INCIDENT RECORDING
INFORMATION TRANSFER DEVICE

DECISION ON REQUEST TO
WITHDRAW FROM RECORD

This is a decision on the Request for Withdrawal as attorney or agent and change of address filed on February 19, 2004.

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

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

All attorneys/agents of record are withdrawn.

All future communications from the Office will 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: Jennifer M. McCallum
The McCallum Law Firm, LLC
132 Kolar Court
Erie, CO 80516

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

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

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SEP 0 2 2005

OFFICE OF PETITIONS

In re Application of	:
Fred L. Starkey	:DECISION ON PETITION
Application No. 09/758,668	:UNDER 37 CFR 1.78(a)(6)
Filed: January 11, 2001	:
Attorney Docket No. 1981/637	:

This is a decision on the petition under 37 CFR 1.78(a)(6), filed May 18, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional Application No. 60/176,165, filed January 14, 2000, the amendment of which is embodied in the instant petition.[1]

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR § 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR § 1.78(a)(6), petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed application.

The instant pending nonprovisional application was filed on January 11, 2001, and was pending at the time of filing of the instant petition. Reference to the prior-filed application was made in the declaration filed with the instant application.

The current procedure where a claim for priority under 37 CFR 1.78(a)(6) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR § 1.78(a)(5)(ii). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed application(s) set forth in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR §1.78(a)(6).[2] In the instant case, the Office noted the claim for priority of the above-noted, prior-

---

[1] Petitioner is advised that the amendment must be included in a separate paper, since different matters are handled by different branches of the Office. *Note* 37 CFR 1.4(c)) and 37 CFR 1.121.

[2] *Note* MPEP 201.11 (V), page 200-75 (Rev. 1. Feb. 2004 and 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

filed application in the declaration filed with the application, as shown by its inclusion on the filing receipt.

In view of the above, the $1,370 petition fee submitted is unnecessary and will be credited to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to Wan Laymon at (571) 272-3220. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This matter is being referred to Publishing Division to be processed into a patent.

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
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JUL 25 2003

Paper No. 9

In re Application of
Albert J. Van Mullem *et al*
Application No. 09/758,680
Filed: January 11, 2001
Attorney Docket No. 024445-061

: DECISION ON PETITION

This is a decision on the petition filed on July 21, 2003 by which petitioners request withdrawal of the holding that this application stands abandoned for failure to file a timely and proper reply to the Office letter dated November 20, 2002. The petition is considered under 37 CFR 1.181, and no fee is required for the petition.

The petition is granted.

Petitioners allege that this application is not abandoned because a timely reply to the Office letter in question was in fact filed. Petitioners support this allegation by furnishing a copy of the reply as filed, and a copy of a filing receipt for the reply showing that it was in fact received in the Office on December 20, 2002. From this evidence, it is clear that the application is not in fact abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner to enter the Revocation and New Power of Attorney that is attached to the petition, with a filing date of December 20, 2002. The Head Supervisory Applications Examiner should also change the Attorney Docket No. in the PALM system to agree with the docket number appearing at the top of this Decision. Thereafter, the application will be forwarded to the examiner for action on the reply filed on December 20, 2002.

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Ronald L. Grudziecki, Esq.
Burns, Doane, Swecker & Mathis, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

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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DRINKER BIDDLE & REATH (DC)
1500 K STREET, N.W.
SUITE 1100
WASHINGTON, DC 20005-1209

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DEC 2 0 2005

OFFICE OF PETITIONS

In re Application of

Albert J. Van Mullem

Application No. 09/758,680

Filed: January 11, 2001

Attorney Docket No. 18306/169

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 14, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to file a proper response to the final Office action mailed March 11, 2005. The final Office action set a shortened statutory period for reply of three months from its mailing date. A response was filed on June 23, 2005, with a request for an extension of time within the first month. An Advisory Action mailed July 18, 2005, advised that the response of June 23, 2005, 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 24, 2005.

The Request for Continued Examination and amendment filed October 14, 2005, are noted and made of record.

The application file is being forwarded to Technology Center 3700, GAU 3725 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin

Kenya A. McLaughlin
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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OFFICE OF PETITIONS

BATTELLE MEMORIAL INSTITUTE
505 KING AVENUE
COLUMBUS, OH 43201-2693

In re Patent No. 7,193,124	:	
Issue Date: March 20, 2007	:	
Application No. 09/758,716	:	NOTICE
Filed: January 11, 2001	:	
Attorney Docket No. BER-3.5.009/3714	:	

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 the undersigned at (571) 272-6059.

A. Kelley

Alicia Kelley
Petitions Examiner
Office of Petitions

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Paper No. 15

HEWLETT PACKARD COMPANY
P.O. BOX 272400, 3404 E. HARMONY RD.
INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS CO 80527-2400

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JAN 12 2004

OFFICE OF PETITIONS

In re Application of :
Jeffrey L. Thielman et al :
Application No. 09/758,744 :
Filed: January 11, 2001 :
Attorney Docket No. 10982025-1 :

ON PETITION

This is a decision on the petition, filed January 8, 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 November 25, 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 2861 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

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MICROSOFT CORPORATION
ONE MICROSOFT WAY
REDMOND WA 98052-6399

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MAR 0 1 2007

OFFICE OF PETITIONS

In re Application of	:	
Yue Chen, et al.	:	
Application No. 09/758,831	:	ON PETITION
Filed: January 11, 2001	:	
Attorney Docket No. 150562.01	:	

This is a decision on the petition under 37 CFR 1.137(b), filed October 30, 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 April 24, 2006. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination 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). A one-month extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is August 25, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a 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 2182 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

Commissioner for Patents
United States Patent and Trademark Office
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STOEL RIVES LLP - SLC
201 SOUTH MAIN STREET
ONE UTAH CENTER
SALT LAKE CITY UT 84111

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NOV 30 2006

OFFICE OF PETITIONS

In re Application of	:	
Murakami et al.	:	
Application No. 09/758,836	:	ON PETITION
Filed: January 10, 2001	:	
Attorney Docket No. 36360/1.9	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed July 19, 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 an Oath/Declaration; (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 Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Date Mailed : 3-15-06

Patent No.: 6,754,752
Patent Issued : June 22, 2004
Inventor(s) : Bryan D. Marietta
Title: MULTIPLE MEMORY COHERENCE GROUP IN A SINGLE SYSTEM AND METHOD THEREFOR
Docket No.: SC11054TS-3

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 1.322.

The alleged error in col. 12, line 14 is printed in accordance with the record.

In view of the foregoing, your request in this matter is hereby denied. However, further consideration will be given upon receipt of a request for reconsideration directed to Decisions & Certificates of Correction Branch.

Eva James
For Cecelia B. Newman
Certificate of Correction Branch
(703) 308-9390 ext. 124 or ext. 102

Robert L. King
Freescale Semiconductor, Inc.
Law Department
7700 West Parmer Lane PL02
Austin, TX 78729

ej

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COMMISSIONER FOR PATENTS
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Paper No. 6

MAIL

JAN 3 0 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

David A. Hall
Heller, Ehrman, White & McLauliffe LLP
4350 La Jolla Village Drive
7th Floor
San Diego CA 92122-1246

In re Application of :
Chow et al. :
Application No. 09/758,884 :
Filed: January 10, 2001 :
For: METHOD AND APPARATUS FOR A FLEXIBLE AND RECONFIGURABLE PACKET CLASSIFIER USING CONTENT ADDRESSABLE MEMORY :

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney/agent of record filed on November 19, 2003.

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

Petitioner has satisfied the requirements for successfully requesting withdrawal. Accordingly, ***the request is granted.*** Future correspondence will be sent to the below listed address which has been provided by the withdrawing attorney(s).

Dwayne D. Bost
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4778

cc: Acute Communications Corporation
1962 Zanker Road
San Jose, CA 94112

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PFIZER INC
Steve T. Zelson
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NEW YORK NY 10017-5612

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AUG 25 2008

OFFICE OF PETITIONS

In re Application of
David, et al.
Application No. 09/758,902
Filed: January 11, 2001
Attorney Docket No. PC9047D
For: MULTICOMPONENT CLOSTRIDIAL VACCINES USING SAPONIN ADJUVANTS

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed on June 11, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to properly respond to the final Office action mailed December 4, 2007, which set an extendable three month period for reply. Applicants submitted an amendment after final on March 4, 2008. The amendment after final failed to place this application in *prima facie* condition for allowance, as was explained in the March 20, 2008 Advisory action. Accordingly, this application became abandoned on March 5, 2008.

Applicants have submitted a RCE and required $810.00 fee and amendment as the submission in reply to the December 4, 2007 final Office action, an acceptable statement of the unintentional nature of the delay in responding to the December 4, 2007 final Office action, and the $1,540.00 petition fee.

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, petitioners 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, petitioners 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.

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 $1,050.00 extension of time submitted with the petition on June 11, 2008 was submitted subsequent to the maximum period obtainable for reply, this fee is unnecessary and will be credited to petitioners' deposit account.

Petitioners are informed that the first named inventor is Roberts S. David. This is the typewritten name listed as the first joint inventor in the declaration filed on January 11, 2001. If petitioners wish the Office to recognize the signed version of the name – David S. Roberts- then a petition under 37 CFR 1.182 and a $400.00 petition fee is required. MPEP 605.04(b)

After the mailing of this decision the application will be forwarded to Technology Center AU 1645 for consideration of the RCE and amendment filed on June 11, 2008.

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

CC: TIMOTHY J. GUMBLETON
7000 PORTAGE ROAD
KALAMAZOO MI 49001

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. 05

MAR 4 2003

ROBERT J. SCHAAP
21241 Ventura Boulevard
Suite 188
Woodland Hills, CA 91364

In re Application of:	:	
Pharo, *et al.*	:	DECISION ON PETITION TO
Application No. 09/758,934	:	WITHDRAW HOLDING OF
Filed: January 11, 2001	:	ABANDONDMENT
For: PERSONNEL GUIDANCE AND	:	
LOCATION CONTROL SYSTEM		

This is a decision on the request filed on January 24, 2003, refiled January 30, 2003, and supplemented, via facsimile transmission, on February 06, 2003, to withdraw the holding of abandonment of the above-identified application. The request is being treated as a petition under 37 C.F.R. 1.181 to withdraw the holding of abandonment in the above-identified application. A petition fee is not required.

The petition is **granted.**

An Office action was mailed on June 05, 2002.

Petitioner asserts that the Office action dated June 05, 2002, was not received. The petition includes, *inter alia*, declarations from Liliana Cancion, the Office Administrator in the Office of Robert J. Schaap, and Pauline Barraza, the secretary for Mr. Schaap, copies of the practitioners docket records, and a response to the Office action of June 05, 2002[1]. The declarations of Ms. Cancion and Ms. Barraza indicate that a search of the docket records revealed that the petitioner did not receive the Office action. The supplemental petition includes a statement from the practitioner that a search of the file jacket revealed that the petitioner did not receive the Office action. The petition further includes a copy of the practitioner's docket records that demonstrate where the non-received Office action would have been entered had it been received by the practitioner.

1 The petitioner received a copy of the Office action of June 05, 2002, via facsimile transmission, on December 10, 2002.

A review of the written record indicates no irregularity in the mailing of the Office action, and in the absence of any irregularity there is a strong presumption that the Office action was properly mailed to 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 action must include a statement from the practitioner stating that the Office action was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office action was not received. A copy of the docket record where the non-received Office action would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Actions Are Not Received" 1156 Official Gazette 53 (November 16, 1993) and M.P.E.P. § 711.03(c).

The petition and supporting docket records satisfy the above-stated requirements

For the above stated reason, the petition is granted and the holding of abandonment withdrawn.

The application file is being forwarded to the Technology Center 2800 support staff for remailing of the Office action dated June 05, 2002 and for entering the response to the office action of June 05, 2002.

Thereafter, the application will be forwarded to the examiner for appropriate action.

Inquiries regarding this decision should be directed to Lissi Mojica Marquis at (703) 308-2260.

Lissi Mojica Marquis, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 11

Vincent A. Cichosz
Delphi Technologies, Inc.
1450 West Long Lake
Troy, MI 48007

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MAR 1 7 2003

OFFICE OF PETITIONS

In re Application of
Danan Dou et al.
Application No. 09/758,948
Filed: January 11, 2001
Attorney Docket No. DP-300744

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 11, 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 19, 2002. No extensions of time under the provisions of 37 CFR 1.136 have been obtained. Accordingly, the application became abandoned on October 20, 2002.

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 Latrice Bond at (703) 308-6911.

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

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

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DOCKET ADMINISTRATOR
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AUG 26 2005

OFFICE OF PETITIONS

ON PETITION

In re Application of	:	
Lee-Fang Wei	:	
Application No. 09/758,958	:	
Filed: January 11, 2001	:	
Attorney Docket No. 52	:	

This is a decision on the petition, filed August 25, 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 July 7, 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 2634 will consider the request for continued examination under 37 CFR 1.114.

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

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

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Paper No.

MAIL

JAN 2 6 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Denise L. McKenzie
SIDLEY AUSTIN BROWN & WOOD LLP
555 West Fifth Street
Los Angeles, CA 90013-1010

In re Application of:
Lambert et al.
Application No. 09/758,968
Filed: January 10, 2001
For: TECHNIZUE OF GENERATING A COMPOSITE MEDIA STREAM

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed December 27, 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 December 27, 2004 meets all the requirements. Accordingly the request is **GRANTED**.

Because no request was made for a change in correspondence address, 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. 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 Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
(571) 272-3613

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BUTZEL LONG
DOCKETING DEPARTMENT
100 BLOOMFIELD HILLS PARKWAY
SUITE 200
BLOOMFIELD HILLS MI 48304

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FEB 0 2 2006

OFFICE OF PETITIONS

In re Application of	:	
Torok et al.	:	DECISION ON PETITION
Application No. 09/758,978	:	TO WITHDRAW
Filed: January 12, 2001	:	FROM RECORD
Attorney Docket No. 133114-02CP	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed December 19, 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 Thomas T. Moga, the sole attorney of record.

Thomas T. Moga has been withdrawn as attorney of record. Applicant is reminded that there is no attorney of record at this time.

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

Telephone inquires concerning this decision should be directed to Petitions Examiner Liana Chase at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

David Bucci
Petitions Examiner
Office of Petitions

Cc: DR. BRIAN A. TOROK
2948 WOODCREEK WAY
BLOOMFIELD HILLS, MI 48304

0400
4-10-01

4-9-01

Sector
#7

OIPE JC154
APR 06 2001
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PATENT
514412-2025.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	:	Marc DeBeuckeleer
Serial No.	:	09/758,987
Filed	:	January 11, 2001
For	:	METHODS AND KITS FOR IDENTIFYING ELITE EVENT GAT-SM1 IN BIOLOGICAL SAMPLES
Examiner	:	Unassigned
Group Art Unit:		Unassigned

EXPRESS MAIL

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Date of Deposit: April 6, 2001

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" Service under 37 CFR 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Patents, Washington, DC 20231.

Charles Jackson
(Typed or printed name of person mailing paper or fee)

Charles Jackson
(Signature of person mailing paper or fee)

RESPONSE TO NOTICE TO FILE MISSING PARTS

Assistant Commissioner for Patents
Washington, D.C. 20231

Box: Missing Parts

Sir:

In response to the NOTICE TO FILE MISSING PARTS OF APPLICATION, mailed March 29, 2001, enclosed are the following:

DP0315

1. A copy of a Communication sent by Express Mail on March 16, 2001 wherein we enclosed a copy of the Declaration, as well as a copy of the Assignment (copies attached).

2. A copy of the stamped postcard acknowledging receipt by the Patent Office, together with the Express Mail Receipt.

3. Copy of our check for $130.00 in payment of the surcharge.

4. Copy of Notice to File Missing Parts.

It is believed that no other fees are deemed necessary in connection with the filing of this Response. However, if any fee is required, the Assistant Commissioner is authorized to charge such fee or credit any overpayment to Deposit Account 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP
Attorneys for Applicants

By Susan Lehnhardt

Susan K. Lehnhardt
Registration No. 33,943
Tel. (212) 588-0800

RK

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RUSSELL E. PARKS, FRANK DAVIDE,
ALLISON M. MCCORMACK and JAE K. PARK

Appeal No. 2004-0344
Application No. 09/759,016

ON BRIEF

MAILED
AUG 19 2004
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Before KRASS, FLEMING and DIXON, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-7.

The invention is directed to a skills matching application (SMA) which allows a user to communicate requirements to technical service suppliers so as to procure technical services from contractors. This Web-based skills matching application is

said to facilitate the procurement process for technical services contractors.

Representative independent claim 1 is reproduced as follows:

1. A Skills Matching Application (SMA) which allows a user to communicate requirements to technical service suppliers in a way that significantly reduces the process time and improves the accuracy of requests sent to suppliers comprising:

means for accessing the SMA from a Requisition/Catalog (REQ/CAT) application;

means for prompting a user through a series of screens to enter a Statement of Work (SOW) and complete a skills detail checklist for each of the technical skills requested;

means for submitting the request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against;

means for receiving from a supplier a candidate or candidates with appended resumes as appropriate; and

means for displaying for the user the supplier responses and associated resumes.

The examiner relies on the following reference:

Puram et al. (Puram)	6,289,340	Sep. 11, 2001 (filed Aug. 3, 1999)

Claims 1-7 stand rejected under 35 U.S.C. § 101 as lacking utility, and under 35 U.S.C. § 112, first paragraph, as not being enabled because of the lack of utility.

Claims 1-7 stand further rejected under 35 U.S.C. § 102(e) as anticipated by Puram.

Reference is made to the brief and answer for the respective positions of appellants and the examiner.

OPINION

With regard to the rejection under 35 U.S.C. § 101, it is the examiner's position that the instant claimed invention fails to produce a "useful, concrete and tangible result" and, thus, has no practical application. In particular, the examiner alleges that the invention is not "useful" since the asserted utility is not accomplished; it is not "tangible" because it is no more than a manipulation of an abstract idea; and it is not "concrete" because the result cannot be assured.

We disagree.

The claimed invention is certainly useful in matching the skills wanted by a user with the skills of technicians employed by a supplier. The invention clearly has a tangible result because the user is given a choice of candidates from the supplier from which to choose. The invention produces a concrete result because a list, or choice, of candidates is provided to the user. Of course, the specific result will vary with the user because each user may be looking for different skills in a

technician but this does not mean that a result "cannot be assured," or that no "concrete" result is obtained, as alleged by the examiner.

Utility is a question of fact. The claims must first be interpreted to define the invention that is alleged to be useful. Stiftung v. Renishaw PLC, 945 F.2d 1173, 20 USPQ2d 1094 (Fed. Cir. 1991). While utility does not require commercial marketability Barmag Barmer Masch. AG v. Murata Mach., Ltd, 731 F.2d 831, 221USPQ561 (Fed. Cir. 1984), commercial success may demonstrate utility, Raytheon Co. v. Roper Corp., 724 F.2d 951, 220 USPQ 592 (Fed. Cir. 1983).

Appellants assert commercial success in the declaration of Russell E. Parks, June 4, 2003 and the examiner offers no counter arguments even though such commercial success may be an indicator of utility.

While the examiner appears to backtrack on his assertion of no tangible or useful result (see page 8 of the answer), the examiner still asserts no "concrete" results are produced by the instant claimed invention. In our view, the concrete result would be the display of supplier responses and associated resumes of skilled candidates matching the request of the user.

It is our view that the claimed invention is a useful process/system for matching requested skills of candidates by the user to the skills of candidates from suppliers.

Accordingly, we will not sustain the rejection of claims 1-7 under 35 U.S.C. § 101 for lack of utility.

We also will not sustain the rejection of claims 1-7 under 35 U.S.C. § 112, first paragraph, based on lack of enablement because this rejection is premised on the lack of utility asserted in the rejection under 35 U.S.C. § 101. Clearly, based on the specification and the drawings, the skilled artisan would have been taught how to make and use the instant claimed invention without undue experimentation.

Finally, we turn to the rejection of claims 1-7 under 35 U.S.C. § 102(e) as anticipated by Puram.

A rejection for anticipation under section 102 requires that the four corners of a single prior art document describe every element of the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In re Paulsen, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

We make reference to the answer, at pages 6-8, for the examiner's rationale in applying Puram to the instant claims.

While appellants admit that Puram describes a system wherein technical service providers enter data about their skills and users of these skills enter requirements and the system attempts to make a match, appellants allege that this is "unlike the claimed invention where suppliers respond to a Request for Service (RFS) by submitting candidates to the requester" (brief-page 19) so that whereas Puram includes a database of prospective candidates, the claimed invention includes no such database. Appellants also argue that the claimed invention is a "proprietary system" so that the suppliers of the services have contracts with the user of the system "which specify pre-negotiated rates for the services" (brief-page 19).

The arguments re "pre-negotiated rates" in a "proprietary system" and no "database" are not persuasive as they are not directed to any claimed subject matter.

We are convinced, however, by appellants' argument regarding suppliers responding to a request by submitting candidates to the requester. Each of the independent claims 1, 4 and 5, requires submitting a request to contracted suppliers by e-mail notification notifying the supplier that a new request has been entered into the SMA application for them to review and submit a candidate against. The examiner alleges that this is shown in

Puram at column 2, lines 49-50 and 59-66, and column 3, lines 25-39. However, our review of these portions of Puram does not find such a teaching. While these portions of Puram describe interfaces that are accessible to users through the internet browser, there is no indication that users submit a request to contracted suppliers "by e-mail." Moreover, the cited portions of Puram fails to describe any notification to the supplier that a new request has been entered for the supplier to review. Rather, Puram appears merely to compare and match skills input by candidates with skills desired by a user and that the operations may be performed via the internet.

It may very well be that, in view of the disclosure of Puram, and of the similarity between Puram and the instant claimed invention, that it would have been obvious for the user to submit a request for a skilled candidate directly to a supplier via e-mail, rather than match candidates having certain desired skills with a database of candidates via the internet. However, the rejection before us is one of anticipation under 35 U.S.C. § 102(e), and not one of obviousness under 35 U.S.C. § 103. As such, we cannot sustain the rejection of claims 1-7 under 35 U.S.C. § 102(e) because the examiner has not shown that the four corners of the Puram document describe every element of

the claimed invention, either expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation. In applying a rejection under 35 U.S.C. § 102(e), the examiner must show how each and every claim element is taught in the reference and the examiner, in the instant case, has not done so.

Therefore, we will not sustain the rejection of claims 1-7 under 35 U.S.C. § 102(e).

The examiner's decision rejecting claims 1-7 under 35 U.S.C. §§ 101, 112 and 102(e) is reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)
MICHAEL R. FLEMING Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH L. DIXON Administrative Patent Judge	)

EK/RWK

WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
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SUITE 340
RESTON, VA 20190

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MAR 1 4 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
Carrai et al.
Application No. 09/759,022
Filed: January 11, 2001
For: **TEXT IMPROVEMENT**

DECISION ON PETITION
TO WITHDRAW HOLDING OF
ABANDONMENT

This is a decision on the petition filed December 10, 2004 to withdraw the holding of abandonment pursuant to 37 C.F.R.§ 1.181. No fee is required.

The petition is **GRANTED.**

The application was held abandoned for failure to timely file a notice of appeal. A Notice of Abandonment was mailed November 30, 2004.

Petitioner supplied copies of the notice of appeal and subsequently filed appeal brief. A review of the file records reveals that the original appeal brief, filed January 14, 2004, has been located and matched with the file.

The originally filed notice of appeal has not been located. Petitioner alleges to have timely filed the notice of appeal on December 4, 2003. To support this position, Petitioner has included with the instant petition a copy of the notice of appeal bearing a proper certificate of mailing date of December 4, 2003.

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. Therefore, it is concluded that the notice of appeal was timely filed in compliance with the requirements of 37 CFR 1.8(a)(1).

In view of the above stated reason, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. Any inconvenience caused Petitioner is regretted.

The examiner will be notified of the change in status of this application, and will take action in due course.

Kenneth A. Wieder

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

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)
6819804	2004-11-16	09759041	2001-01-11	

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	/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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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
www.uspto.gov

In re Patent No. 6819804
Issue Date: November 16,2004
Application No. 09759041
Filed: January 11,2001
Attorney Docket No. IT 000003

: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 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 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.

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JUN 17 2002

#6

Murray Schaffer
Jaspan Schlesinger Hoffman LLP
300 Garden City Plaza
Garden City, New York 11530

In re Application of
Andrjez Krueger, et al
Application No. 09/759,082
Filed: January 12, 2001
Attorney Docket No. P-6594-1

: DECISION ON PETITION

This is in respond to applicant's "PETITION TO REINSTATE" filed May 8, 2002.

On June 15, 2001, an Office action was mailed to applicant. On March 27, 2002, a Notice of Abandonment for failure to timely file a proper reply to the Office letter mailed on June 15, 2001 was mailed. On May 8, 2002, the present petition was filed. Petitioner asserts that a response was filed on December 17, 2001 together with a Request for Extension.

Applicant's statement and evidence have been reviewed and considered. The response filed on December 17, 2001 is timely. Accordingly, the petition is **Granted**.

Should there be any questions with respect to 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) 308-3890.

Cecilia Tsang for

Bruce Kisliuk
Director, Technology Center 1600

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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Murry Schaffer
Jaspan Schlesinger Hoffman
300 Garden City Plaza
Garden City, NY 11530

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JUL 1 9 2004
OFFICE OF PETITIONS

In re Application of	:	
Andrzej Krueger, et al.	:	
Application No. 09/759,082	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. P-6594-1	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 30, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

The application file is being referred to Technology Center 1600 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Marianne E. Jenkins
Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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VERIZON
PATENT MANAGEMENT GROUP
1515 N. COURTHOUSE ROAD, SUITE 500
ARLINGTON, VA 22201-2909

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OCT 18 2007

OFFICE OF PETITIONS

In re Application of :
W. David Shambroom :
Application No. 09/759,100 : ON PETITION
Filed: January 12, 2001 :
Attorney Docket No. 96-3-512CON1CIP2

This is a decision on the petition, filed October 10, 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 September 18, 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 2131 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).

UNITED STATES PATENT AND TRADEMARK OFFICE

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Roberts Abokhair & Mardula, L.L.C.
11800 Sunrise Valley Drive, Suite1000
Reston VA 20191

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APR 15 2005

OFFICE OF PETITIONS

In re Application of :
Light et al. :
Application No. 09/ 759,107 : ON PETITION
Filed: January 12, 2001 :
Attorney Docket No. 2344-001-CIP2 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed on October 21, 2004, to accept an unintentionally delayed claim under 35 USC 120 for the benefit of prior- filed nonprovisional Application 09/265,656 filed March 2, 1999.

The petition is **Dismissed**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition must accompanied by:

(1) the reference to the prior filed nonprovisional application, supplied in an application data sheet, or the specification must contain or be amended to contain such reference in the first sentence following the title. *See* 35 USC 120 and 37 CFR 1.78(a)(2);

(2) the surcharge as set forth in 37 CFR 1.17(t); and

(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) and the date the claim was filed as unintentional. The Director may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

A reference to add the above-noted, prior filed applications in the amendment to the specification has been filed with the instant petition. However the amendment is not acceptable as drafted since it improperly incorporates by reference the prior filed application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew distinction between a permissible 35 U.S.C. §120 statement and the impermissible introduction of new matter by way of incorporation by reference in a 35 U.S.C. § 120 statement. The Court specifically stated:

> Section 120 merely provides the mechanism whereby an application becomes entitled to benefit of the filing date of an earlier application disclosing the same subject matter. Common subject matter must be disclosed, in both applications, either specifically or by an express incorporation by reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. *In re deSeversky*, *supra* at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See In re deSeversky*, *supra*. Note also MPEP 201.06(c).

It is noted the specification supplied on filing did include an incorporation by reference statement to application 08/963,373. However, the incorporation by reference statement referencing 09/265,656 is not appropriate.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted , a substitute

amendment[1] deleting the incorporation by reference statement as it applies to 09/265,656, along with a renewed petition under 37 CFR 1.78(a)(3), is required.

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 delivery service: (FedEx, UPS, DHL, etc.)	U.S. Patent and Trademark Office Customer Service Window, Mail Stop Petition Randolph Building 401 Dulany Street Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to Petition Attorney Charlema R. Grant at 571.272- 3215.

Charles Pearson
Director
Office of Petitions

[1]Note 37 CFR 1.121 and 37 CFR 1.116

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Roberts Abokhair & Mardula, L.L.C.
11800 Sunrise Valley Drive, Suite1000
Reston VA 20191

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JUL 2 7 2005

OFFICE OF PETITIONS

In re Application of :
Light et al. :
Application No. 09/ 759,107 : ON PETITION
Filed: January 12, 2001 :
Attorney Docket No. 2344-001-CIP2 :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed on April 19, 2005, to accept an unintentionally delayed claim under 35 USC 120 for the benefit of prior- filed nonprovisional Application 09/265,656 filed March 2, 1999.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR §§1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR §§1.78(a)(3) must be accompanied by:

> **1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of 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)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed application is submitted after expiration of the period specified in 37 CFR§ 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR §1.78(a)(3).

37 CFR § 1.78 (a) (3) requires a statement that the entire delay between the date the claim was due under 37 CFR §1.78 (a) (2) (ii) and the date the claim was filed was unintentional. Since the statement contained in the instant petition varies from the language required by 37 CFR §1.78 (a)(3), the statement contained in the instant petition is being construed as the required statement.

The petition complies with the requirements for a grantable petition under 37 CFR §1.78(a)(3) in that (1) a reference to the above-noted, prior-filed application has been included in an amendment to the first sentence of the specification following the title, as provided by 37 CFR 1.78(a)(2)(iii); (2) the surcharge fee required by 37 CFR 1.17(t) has been submitted; and (3) the petition contains an adequate statement of unintentional delay. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed application satisfies the conditions of 37 CFR §1.78(a)(3) the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) 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 instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Charlema R. Grant at (571) 272-3215. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to the examiner of Technology Center Art Unit 2645 for consideration of applicants' entitlement to claim benefit of priority under 35 U.S.C. § 120 and 37 CFR 1.78(a)(3) to the above-noted, prior filed application.

Frances Hicks

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
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Paper No. 9

MARVELL SEMICONDUCTOR, INC.
INTELLECTUAL PROPERTY DEPARTMENT
700 FIRST AVENUE, MS#509
SUNNYVALE, CA 94089

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MAR 2 4 2003

OFFICE OF PETITIONS

In re Application of	:	
Yat-Tung Lam et al	:	
Application No. 09/759,151	:	DECISION ON PETITION
Filed: January 16, 2001	:	UNDER 37 CFR 1.181
Attorney Docket No. MP0071	:	

This is a decision on the petition under 37 CFR 1.137(b), filed September 19, 2002, which, for the reasons stated below, is being treated as a petition under 37 CFR 1.181 requesting withdrawal of the holding of abandonment in the subject application.

The petition is **granted**.

This application became abandoned by operation of law for failure to timely respond to the Notice to File Corrected Application Papers, mailed March 26, 2001, which set a two month period for the submission of substitute drawings in compliance with 37 CFR 1.84.

Petitioner states that failure to timely reply was due to nonreceipt of the Notice of March 26, 2001. Petitioner further contends that the Notice was mailed to a party not connected with this application and that, in fact, the Notice should have been mailed to the address noted in the declaration submitted with the application papers on January 16, 2001; namely, to the Customer Number for Katten Muchin Zavis, applicants' attorneys at the time.

The petition is not accompanied by the evidence required to establish nonreceipt of the Notice of March 26, 2001. However, it is apparent from a review of the file history for this application that the Notice of March 26, 2001 was not in fact mailed to the correct address. Therefore, it is appropriate here to treat the petition under 37 CFR 1.137(b) as one requesting withdrawal of the holding of abandonment due to nonreceipt of the Notice of March 26, 2001.

In view of the above, the holding of abandonment is hereby withdrawn. The reply to the Notice, substitute drawings, filed concurrently with the instant petition will be accepted as having been timely filed.

A petition to withdraw the holding of abandonment under 37 CFR 1.181 does not require a fee, and none has been assessed to petitioner's deposit account.

Any questions concerning this decision 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

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

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FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON DC 20005

PROCESSED BY
PG PUB DIVISION

JUN 18 2002

Applicant: Veronique Douin et al.
Appl. No.: 09/759,165
Filing Date: January 16, 2001
Title: COSMETIC COMPOSITIONS COMPRISING AN AMPHOTERIC STARCH AND A CATIONIC CONDITIONER, AND USES THEREOF
Attorney Docket No.: 05725.0827
Pub. No.: US 2001/0031270 A1
Pub. Date: October 18, 2001

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), filed on December 17, 2001 for the above-identified application.

The request is granted.

The corrected patent application publication will be published in due course.

Inquires concerning this communication should be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).

Mark O. Polutta
Office of Patent Legal Administration
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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NXP, B.V.
NXP INTELLECTUAL PROPERTY DEPARTMENT
M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE CA 95131

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FEB 12 2007

OFFICE OF PETITIONS

In re Application of	:	
Franz Amtmann	:	
Application No. 09/759,177	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. AT 000001 US	:	

This is a decision on the petition filed December 19, 2006, under the unintentional provisions of 37 CFR 1.137(b), 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 4, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 5, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) a reply in accordance with 37 CFR 1.111; (2) the petition fee of $1500; and (3) a proper statement of unintentional delay. Accordingly, the reply filed December 19, 2006, to the Non-final office action of April 4, 2006, is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Ramesh Krishnamurthy at (571) 272-4914, or in his absence to the undersigned at (571) 272 - 7099.

This application is being referred to Technology Center AU 2611 for processing of the response filed on December 19, 2006, and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.111.

David Bucci
Petitions Examiner
Office of Petitions

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APR 2 8 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Linda S. Chan
Katten, Muchin, Zavis, Rosenman
575 Madison Avenue
New York, NY 10022-2585

In re Application of: Igarashi, et al.
Application No. 09/759,183
Attorney Docket No. FUJR 18.213
Filed: January 12, 2001
For: NETWORK SYSTEM WITH DYNAMIC SERVICE PROFILE UPDATING FUNCTIONS

SUA SPONTE
WITHDRAWAL OF HOLDING OF ABANDONMENT

The information and request for withdrawal of the holding of abandonment, filed December 9, 2004 is acknowledged.

A review of the application reveals that a Notice of Abandonment was mailed to the applicant on November 29, 2004. The notice incorrectly indicated that the instant application was being held abandoned for failure to respond to the Non-Final Office communication (mailed on May 24, 2004). A timely filed amendment with a two-month extension of time (37 CFR § 1.136(a)) was filed on October 14, 2004 bearing a certificate of facsimile transmission of October 14, 2004. Accordingly, the amendment/response was timely filed.

In view of these facts, the abandonment of the application was clearly in error and is hereby **VACATED**.

The application is being forwarded to the Supervisory Legal Instruments Examiner with instructions to **WITHDRAW** the holding of abandonment, restore the instant application to pending status and to charge the $430 fee to deposit account **50-1290** for the two months extension of time for filing of the October 14, 2004 amendment. The application will then be forwarded to the Examiner of record for prompt action on the merits.

Inquiries to this decision may be directed to Special Programs Examiner Brian Johnson at (571) 272-3595.

Brian L. Johnson 4/19/05
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

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Alexandria, VA 22313-1450
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SHEMWELL GREGORY & COURTNEY LLP
4880 STEPHENS CREEK BLVD
SUITE 201
SAN JOSE CA 95129

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JUN 17 2005

OFFICE OF PETITIONS

In re Application of	:	
Frietas, et al.	:	
Application No. 09/759,204	:	ON PETITION
Filed: January 16, 2001	:	
Attorney Docket No. PALM-0899	:	

This is a decision on the petition under 37 CFR 1.137(b), filed April 21, 2005.

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

The above-identified application became abandoned for failure to timely file a response to the non-final Office action mailed April 8, 2004. This Office action set a shortened statutory period for reply of three months. No extensions of time under 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on July 9, 2004. A Notice of Abandonment was mailed on November 3, 2004.

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

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 $1020 extension of time fee submitted with the petition on April 21, 2005 was subsequent to the maximum period obtainable for reply (October 8, 2004), this fee has been refunded to petitioner's Deposit Account 50-1914.

The Revocation and Power of Attorney submitted with the instant petition has been entered. Future correspondence concerning this application will be mailed to the above address of record.

The application file is being forwarded to Group Art Unit 2121 for consideration of the amendment filed April 21, 2005.

Telephone inquiries concerning 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

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.
09/759,207	01/16/2001	Iris Pecker	00/21505	1817

7590 08/09/2002

G. E. EHRLICH (1995) LTD.
c/o ANTHONY CASTORINA
SUITE 207
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER
DECLOUX, AMY M

ART UNIT	PAPER NUMBER
1644	16

DATE MAILED: 08/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

09/759207

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.

EXAMINER	
ART UNIT	PAPER NUMBER
	16

DATE MAILED:

The decision on the petition filed in the above entitled application is as follows:

☐ Delay in Prosecution Held Unavoidable (35 U.S.C. 133),

Petition Granted _____

☐ Delayed Payment of Issue Fee Accepted (35 U.S.C. 151),

Petition Granted _____

☐ Petition Granted _____

☒ Petition Denied The petition to accept color drawings filed 7/9/02 ~~is hereby denied because~~ it is not signed.

☐ Petition Dismissed _____

By direction of the Deputy
Assistant Commissioner for Patents

_____

Christina Chan
CHRISTINA CHAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Please note that the amendment to the specification at Brief Description of the Drawings (Page 20, line 19) should be submitted as a formal amendment and not be included in the 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

HOWREY SIMON ARNOLD & WHITE LLP
BOX NO 34
301 RAVENSWOOD AVENUE
MENLO PARK, CA 94025

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MAY 0 6 2004

OFFICE OF PETITIONS

In re Application of	:
Rong-Chang Liang et al	:
Application No. 09/759,212	: DECISION GRANTING PETITION
Filed: January 11, 2001	: UNDER 37 CFR 313(c)(2)
Attorney Docket No. 26822-003US	:

This is a decision on the petition, filed April 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 March 17, 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) 305-8680.

This matter is being referred to Technology Center AU 2871 for processing of the request for continued examination under 37 CFR 1.114 filed April 2, 2004.

Frances Hicks

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).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:

DATE : 6/21/07

TO SPE OF : ART UNIT 2871 SN 09/759212

SUBJECT : Request for Certificate of Correction on Patent No.: 6,795,138

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

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

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

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

Note your decision on the appropriated box.

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

Comments: Certificate of Correction of 8/18/05 approved.

David Nelms
Supervisory Patent Examiner
Technology Center 2800

SPE: 2871 Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVE NW
WASHINGTON DC 20004

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APR 29 2005

OFFICE OF PETITIONS

In re Application of	:	
Jonathan H. Bari, Scott R. Elkins,	:	
Joshua Hartmann	:	DECISION GRANTING PETITION
Application No. 09/759,225	:	UNDER § 1.183
Filed: January 16, 2001	:	
Attorney Docket No. 051726-0002	:	

This is a response to the petition under 37 CFR 1.183, filed November 19, 2004, requesting waiver of 37 CFR 1.131 to the extent that it requires all of the named inventors execute the declaration filed thereunder.

The petition is **GRANTED**.

Petitioners assert that while both of the named inventors contributed to the conception of the claimed invention which is under rejection, only Jonathan Bari participated at the reduction to practice, and, as such, Scott Elkins and Joshua Hartmann seek relief from having to jointly execute the aforementioned declaration, which is asserted to demonstrate reduction to practice of the claimed invention.

As noted in MPEP 715.04, an adequate showing may lead to acceptance of a declaration under 37 CFR 1.131 executed by less than all the named inventors of the claimed subject matter in question. Under the facts presented, it is agreed that justice requires waiver of the rules to the extent they require Elkins and Hartmann to declare. However, the favorable decision herein does not relieve applicants from their burden to establish that the invention was completed before the date of the reference and that the claimed invention was the product of the joint inventors. See In re Carlson, 79 F.2d. 900, 27 USPQ 400 (CCPA 1935).

This application is being returned to Group Art Unit 2131.

Telephone inquiries related 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 PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
www.uspto.g

Paper No. 5

Paul J. Skwierawski
ANTONELLI, TERRY, STOUT &
KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, VA 22209

MAILED

JUL 0 7 2003

Technology Center 2100

In re Application of:	)	
Hall, et al.	)	
Application No. 09/759,245	)	**DECISION ON REQUEST FOR**
Filed: January 16, 2001	)	**WITHDRAWAL AS ATTORNEY**
For: LOW WEIGHT DATA ENCODING FOR MINIMAL POWER DELIVERY IMPACT	)	

This is a decision on the Request To Withdraw from Representation filed June 23, 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 23, 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: KENYON & KENYON
1500 K Street, N.W.
Suite 700
Washington, DC 20005-1257

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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JUL 14 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

MORRIS LISS
POLLOCK, VANDE SANDE & AMERNICK, R.L.L.P
P.O. BOX 19088
WASHINGTON DC 20036-3425

In re Application of:
Toshiyuki SANO
Application No. 09/759,257
Filed: January 16, 2001
For: SOLID STATE IMAGING APPARATUS

DECISION
ON PETITION

This is a response to the petition to withhold abandonment under 37 CFR 1.181, filed May 27, 2005. The petition 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 21, 2004, which set a shortened statutory period of three (3) months to reply. That period lapsed without reply, rendering this application abandoned as of July 22, 2004. A Notice of Abandonment has not yet been mailed.

Petitioner alleges to have timely filed a response to the Office action on July 21, 2004. To support this position, Petitioner has included with the instant petition a copy of the response and 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 July 21, 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.

A review of the file record indicates that the response filed with the instant petition has been entered. Therefore, the file is being forwarded to the examiner for consideration in due course.

Doris To
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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TECHNOLOGY CENTER 2600

MORRIS LISS
POLLOCK, VANDE SANDE & AMERNICK, R.L.L.P
P.O. BOX 19088
WASHINGTON DC 20036-3425

In re Application of:
Toshiyuki SANO
Application No. 09/759,257
Filed: January 16, 2001
For: SOLID STATE IMAGING APPARATUS

DECISION
ON PETITION

This is a response to the petition to withhold abandonment under 37 CFR 1.181, filed May 27, 2005. The petition 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 21, 2004, which set a shortened statutory period of three (3) months to reply. That period lapsed without reply, rendering this application abandoned as of July 22, 2004. A Notice of Abandonment has not yet been mailed.

Petitioner alleges to have timely filed a response to the Office action on July 21, 2004. To support this position, Petitioner has included with the instant petition a copy of the response and 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 July 21, 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.

A review of the file record indicates that the response filed with the instant petition has been entered. Therefore, the file is being 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
Washington, D.C. 20231
www.uspto.gov

Paper No. 9

Patrick R. Roche
Fay, Sharpe, Fagan, Minnich & McKee, LLP
1100 Superior Avenue
Seventh Floor
Cleveland, OH 44114-2518

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MAR 0 7 2003

OFFICE OF PETITIONS

In re Application of	:	
Tarun Mullick, et al.	:	
Application No. 09/759,398	:	DECISION GRANTING PETITION
Filed: January 12, 2001	:	UNDER 37 CFR 1.137(f)
Attorney Docket No. MCK 2 0001	:	

This is a decision on the petition filed February 20, 2003, to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states the instant nonprovisional application is the subject of an application filed in a foreign country on January 12, 2002. However, the U. S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign 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 Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(f) must be accompanied by:

(1) the reply which is met by 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 for 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.

The instant petition has been found in compliance with the 37 CFR 1.137(f). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days as provided by 35 USC 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 USC 122(b)(2)(B)(i) has been rescinded. A Corrected Filing Receipt which sets forth the projected publication date of June 12, 2003 accompanies this decision on petition.

Telephone inquiries concerning this decision should be directed to Marianne Morgan at (703) 306-3475.

The application file is being forwarded to Technology Center Art Unit 3737.

Frances Hicks

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

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

MAR 25 2003

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

#10

Patrick R. Roche
Fay. Sharpe Fagan, Minnich & McKee, LLP
1100 Superior Avenue
Seventh Floor
Cleveland, OH 44114-2518

In re Application of	:	
Mullick et al	:	DECISION ON PETITION
Serial No.: 09/759,398	:	
Filed: January 12, 2001	:	
For: Miniature Ingestibel Capsule	:	

This is in response to applicants' petition filed July 20, 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

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

PATRICK R. ROCHE
FAY, SHARPE, FAGAN
MINNICH & MCKEE, LLP
1100 SUPERIOR AVENUE, SEVENTH FLOOR
CLEVELAND, OH 44114-2518

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DEC 0 1 2005

OFFICE OF PETITIONS

In re Application of :
Tarun Mullick, et al. :
Application No. 09/759,398 :
Filed: January 12, 2001 :
Attorney Docket No. MCK 2 0001 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 11, 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 final Office action mailed May 7, 2004, which set a shortened statutory period for reply of three (3) months. A three-months extension of time under the provisions of 37 CFR 1.136(a) was obtained. An Advisory action was mailed September 28, 2005 indicating that the reply filed on November 8, 2004, failed to place the application in condition for allowance. Accordingly, the application became abandoned on November 8, 2004.

The unentered amendment filed November 8, 2004 will be considered the submission required under 37 CFR 1.114.

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 and a Request for Continued Examination (RCE); (2) the petition fee of $750; and (3) the required statement of unintentional delay have been received. Accordingly, the petition filed October 11, 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 forwarded to Technology Center 3700, Art Unit 3737 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

JUN 28 2005

RYAN K. SIMMONS, ESQ
IP Capital Group, Inc.
Suite 325
400 Cornerstone Drive
Williston, VT 05495

In re application of
John E. Cronin
Application No. 09/759,421 :
Filed: January 12, 2001 :
For: METHOD FOR USING A WEB-BASED MARKETING AND/OR MANAGEMENT TOOL :

DECISION ON REQUEST FOR WITHDRAWAL OF ATTORNEY

This is a decision on the request filed on May 09, 2005, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition B) above.

As to condition B), a proper reason for withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided.

Kenneth J. Dorner
Special Programs Examiner
Patent Technology Center 3600
(571) 272-6587

KJD/slb: 06/15/05

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

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AUG 2 2 2007

OFFICE OF PETITIONS

In re Application of :
Bart F. Rice :
Application No. 09/759,425 :
Filed: January 12, 2001 :
Attorney Docket No.: 18721-5695 :

ON PETITION

This is a decision on the petition, filed August 21, 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 Paul G. Nagy 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. Nagy, the petitioner herein. However, if Mr. Nagy 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 May 29, 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 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 processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: PAUL G. NAGY
BERKELEY LAW & TECHNOLOGY GROUP, LLP
17933 NW EVERGREEN PARKWAY, SUITE 250
BEAVERTON, OR 97006

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

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

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AUG 2 2 2007

OFFICE OF PETITIONS

In re Application of
Bart F. Rice
Application No. 09/759,425
Filed: January 12, 2001
Attorney Docket No. 18721-5695

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-identified application, filed May 29, 2007.

The petition is **GRANTED**.

The application became abandoned for failure to pay the issue fee on or before February 15, 2007. A Notice of Abandonment was mailed on March 28, 2007. In response, on May 29, 2007, the present petition was filed.

It is noted that the petition is not signed by an attorney of record. However, in accordance with 37 CFR 1.34(a), the signature of Calvin E. Wells 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 on whose behalf he acts. A courtesy copy of this decision is being mailed to petitioner. If Mr. Wells desires to receive future correspondence regarding this application, then the appropriate power of attorney or authorization of agent must be submitted. All future correspondence regarding this application file will be directed solely to the address of record.

The petition satisfies the requirements of 37 CFR 1.137(b) in that the petitioner has supplied (1) the reply in the form of payment of the issue fee of $1,400 and the publication fee of $300; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay[1].

Telephone inquires related to this decision should be directed to the undersigned at (571) 272-3204. Telephone inquiries related to processing at Publishing Division should be directed to (571) 272-4200.

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. While the statement is not made by an attorney of record, 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.

cc: CALVIN E. WELLS
17933 NW EVERGREEN PKWAY., STE 250
BEAVERTON, OR 97006

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

PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

Mail Date: 04/20/2010

Applicant	: Lee R. Bolduc	: DECISION ON REQUEST FOR
Patent Number	: 7651510	: RECALCULATION of PATENT
Issue Date	: 01/26/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/759,430	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 01/12/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **283** 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. 14

AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7009

COPY MAILED
AUG 1 5 2003
OFFICE OF PETITIONS

In re Application of	:	
Kirsten Valley et al	:	
Application No. 09/759,431	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. 047-D1-C1	:	

This is a decision on the petition under 37 CFR 1.137(b), filed August 4, 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 October 25, 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 January 26, 2003.

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

The application file is being forwarded to Technology Center 3700 for further processing.

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

United States Patent and Trademark Office

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

Paper No. 6

SIMPSON & SIMPSON, PLLC
5555 Main Street
Williamsville, NY 14221-5406

MAILED

APR 08 2002

OFFICE OF DIRECTOR
GROUP

In re Application of)
KNEBEL)
Application No. 09/759,509)
Filed: January 12, 2001)
For: MICROSCOPE ASSEMBLAGE)

DECISION ON PETITION TO RESET PERIOD FOR REPLY

This is a decision on the petition filed on February 21, 2002, requesting that the shortened statutory period for reply set forth in the Office action mailed on November 30, 2001, be reset.

The petition is **granted** to the extent indicated below.

Petitioner has provided a statement that the Office action in question was received at the correspondence address of record on February 1, 2002. The petition includes a copy of the cover sheet of the Office action having a date of receipt of "FEB 01 2002" stamped thereon.

Petitions to reset the period for reply to an Office action due to late receipt of the action are treated in MPEP § 710.06. As set forth in MPEP § 710.06, a petition to restart the previously set period for reply must be filed within two weeks of the date of receipt of the Office action at the correspondence address. In view of the fact that the Office action 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, this requirement will be waived. Petitioner is advised that any future petition to reset the period for reply to an Office action may not receive favorable consideration unless filed within two weeks of the date of receipt.

In accordance with MPEP § 710.06, the shortened statutory period set forth in the Office action originally mailed on November 30, 2001, is hereby reset to run FROM THE RECEIPT DATE OF February 1, 2002.

Petitioner requests that the Office action be remailed. Since petitioner has received a copy of the Office action, and there is no alleged defect in the Office action itself which would preclude a proper response, the request to remail the Office action is denied.

In view of a request by petitioner to send the Office action to the below indicated address, a

courtesy copy of this Decision is being mailed to petitioner at the below indicated address.[1] Petitioner is advised that in the future, double correspondence with two principal attorneys will not be permitted.

The application file is being forwarded to the Central Files of Technology Center 2800 to await a response to the Office action. No fee is required for the petition.

Edward Glick, Special Program Examiner
Technology Center 2800 - Semiconductors, Electrical
and Optical Systems and Components
(703) 308-4858

cc: George L. Snyder, Jr.
Hodgon Russ LLP
One M&T Plaza, Suite 2000
Buffalo, NY 14203-2391

[1]A Change of Correspondence Address requesting that correspondence be mailed to the above indicated address was filed via facsimile transmission on March 28, 2002.

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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THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

COPY MAILED
OCT 28 2005
OFFICE OF PETITIONS

In re Application of	:
David Edward Wilson et al	:
Application No. 09/759,551	: DECISION GRANTING PETITION
Filed: January 12, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 8395	:

This is a decision on the petition, filed October 27, 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 3752 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 Issue Fee Transmittal Form PTOL-85(b) (along with any balance due or the amount due at the time of payment), 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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WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

COPY MAILED
MAY 26 2006
OFFICE OF PETITIONS

In re Application of Wilson et al.	:	
Application No. 09/759,551	:	Decision on Petition
Filing Date: January 12, 2001	:	
Attorney Docket No. 8395	:	

This is a decision on the petition under 37 CFR 1.137(b), filed March 1, 2006, to revive the above-identified application.

The petition is **granted**.

This application became abandoned on March 1, 2006, for failure to file a proper reply to the Notice of Allowance mailed November 30, 2005.

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.

Petitioner submitted $800 for the issue fee. However, the Office has applied the issue and publication fees paid on June 9, 2005, to the instant application. Therefore, the $800 will be credited back to petitioner's deposit account.

The Office of Patent Publications will be informed of the instant decision and will issue the application as a patent 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
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 18

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER – BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

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OCT 15 2004

OFFICE OF PETITIONS

In re Application of	:	
David Edward Wilson	:	
Application No. 09/759,552	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. 8394	:	

This is a decision on the petition under 37 CFR 1.137(b), filed August 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 December 5, 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 March 6, 2004.

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

The application 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

Paper No.

Syngenta Biotechnology Inc.
3054 Cornwallis Road
Research Triangle Park, NC 27709

COPY MAILED
MAY 1 1 2004
OFFICE OF PETITIONS

In re Application of	:	
Willem F. Broekaert, et al.	:	
Application No. 09/759,584	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. SEE 36525/US/N3	:	

This is a decision on the petition under 37 CFR 1.137(b), filed March 18, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

The application file is being forwarded to Technology Center 1600.

Marianne E. Morgan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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KOLISCH HARTWELL, P.C.
200 PACIFIC BUILDING
520 SW YAMHILL STREET
PORTLAND, OR 97204

MAILED

APR 0 8 2009

OFFICE OF PETITIONS

In re Patent No. 7,295,751	:	
Issue Date: November 13, 2007	:	
Application No. 09/759,588	:	NOTICE
Filed: January 12, 2001	:	
Attorney Docket No. ELBX 17.815A	:	

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 Goodwyn at (571) 272-6735.

Thurman K. Page

Thurman Page
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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SHIRLEY S. MA
KX INDUSTRIES, L.P.
269 S. LAMBERT ROAD
ORANGE, CT 06477

COPY MAILED

FEB 28 2005

OFFICE OF PETITIONS

In re Application of :
Evan E. Koslow, et al. :
Application No. 09/759,593 : ON PETITION
Filed: January 12, 2001 :
Attorney Docket No. 349.6640USU :

This is a decision on the petition under 37 CFR 1.137(b), filed October 14, 2004, to revive the above-identified application.

The petition is **GRANTED.**

A Notice of Non-Compliance was mailed on June 16, 2004. The Notice indicated that the Amendment filed April 1, 2004 was considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, June 30, 2003). Petitioner was given a time period of one (1) month or thirty (30) days from the mailing date of the notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment of the application. A reply was received on July 13, 2004 but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. Accordingly, the application became abandoned on July 17, 2004.

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 currently of record until such time as appropriate instructions are received to the contrary.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 1700, Art Unit 1724 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc: Robert Curcio
DeLio & Peterson, LLC
121 Whitney Avenue
New Haven, CT 06510-1241

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)
6,731,908	2004-05-04	09/759,602	2001-01-16	3842P2609

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	/Jeffrey D. Moy/	Date (YYYY-MM-DD)	2008-10-07
Name	Jeffrey D. Moy	Registration Number	39307

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. 6731908
Issue Date: May 4,2004
Application No. 09759602
Filed: January 16,2001
Attorney Docket No. 052625-5002

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

This is a decision on the electronic petition, filed October 7,2008 ,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 October 7,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

MAIL

MAR 26 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Greg T. Sueoka
FENWICK & WEST LLP
TWO PALO ALTO SQUARE
PALO ALTO , CA 94306

In re Application of:	)	
Andreas Schilling, et al.	)	DECISION ON REQUEST TO
Application No.: 09/759,624	)	WITHDRAW AS ATTORNEY
Filed: January 12, 2001	)	
For: BAUD-RATE TIMING RECOVERY	)	

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 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: Paul Hickman
OPPENHEIMER WOLFF & DONNELLY, LLP
1400 Page Mill Road
Palo Alto, CA 94304

UNITED STATES PATENT AND TRADEMARK OFFICE

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FISH & RICHARDSON P.C.
PO BOX 1022
MINNEAPOLIS MN 55440-1022

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MAY 23 2005

OFFICE OF PETITIONS

In re Application of	:	
Tom Knapp, et al.	:	
Application No. 09/759,629	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. AURO1290-4	:	

This is a decision on the petition under 37 CFR 1.313(c)(2), filed May 20, 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 January 10, 2005, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

It is noted that the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in this case in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address noted on the petition. However, until otherwise instructed, all future correspondence regarding this application will be mailed solely to the address of record.

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 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).

The application is being referred to Technology Center AU 1641 for further processing of the request for continued examination under 37 CFR 1.114 filed May 20, 2005.

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

cc: Teresa A. Lavoie, Ph.D.
Fish & Richardson P.C., P.A.
60 South Sixth Street
Suite 3300
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Fish & Richardson
60 South Sixth Street
Suite 3300
Minneapolis, MN 55402

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NOV 29 2005

OFFICE OF PETITIONS

In re
Knapp et al
Application No. 09/759,629
Filing Date: January 12, 2001
Attorney Docket: 60215139

RECONSIDERATION OF
PATENT TERM ADJUSTMENT

This decision is in response to applicants' APPLICATION FOR PATENT TERM ADJUSTMENT timely[1] filed on January 10, 2005 requesting that the Office adjust the PTA calculation at the time of the notice of allowance from a determination of zero (0) days to a determination of ZERO (0) days.[2]

The applicants' request for PTA reconsideration is **GRANTED.** The Office will adjust the PTA determination at the time of the mailing of the notice of allowance to reflect forty days of administrative delay and two hundred and five (205)days of applicant delay as suggested by applicant.

Applicants assert that Office determination of zero (0) days is accurate but the amount of PTO delay and applicant delay is inaccurate. Applicants agree with the applicant delays of (49+96+2+52)days under either 37 CFR 1.704(b) or 1.704(c)(8). Applicants assert that the Office failed to assess an additional 6 days of applicant delay for the submission of an RCE on January 5, 2005. Applicants further assert that the Office erred in not assessing 40 days of Office delay for an over 4 month reply to the May 20, 2004 RCE submission. See 37 CFR 1.702(a)(2).

---

[1]Issue fee paid on January 10, 2005.

[2]Although applicants are not contesting overall determination of zero (0)days. Applicants believe that the amount of PTO delay is forty days while applicant delay is zero days. This is different from calculated amount of 195 applicant delay and zero days of administrative delay.

Applicants arguments are persuasive. The Office failed to enter the RCE submission filed May 10, 2004 and accordingly the PTA failed to provide applicants with 40 days of administrative delay based upon failing to reply within four months of the filing of the RCE. In addition, the Office failed to file deduct the six days of applicant delay for an response more than three months after the mail date of the notice of allowance of September 30, 2004. Accordingly, the PTA at the time of the notice of allowance is zero days (40-205=0).

After the mailing of this decision, the file will be forwarded to the Office of Patent Publications for a prompt issuance of the patent. Any delays in issuing the application more than four months from the payment of the issue fee and all other requirements being satisfied will be calculated and provided notice to applicants in the issue notification letter that is provided to applicants approximately three weeks prior to issuance of the application.

Applicants have provided the required $200.00 fee. No additional fees are required in the determination of this request.

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

Kery Fries

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

cc: Adjusted PTA calculation

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

James E. Goepel
Greenberg Traurig
1750 Tysons Boulevard, 12th Floor
McLean, VA 22102

MAILED

APR 2 6 2002

Technology Center 2100

In re Application of: G. Colby Conkwright et al)
Application No. 09/759,640)
Filed: January 16, 2001)
For: PRIVACY COMPLIANT MULTIPLE)
DATASET CORRELATION)
SYSTEM)

DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER M.P.E.P. §708.02(VIII)

This is a decision on the petition, filed March 18, 2002 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.

M.P.E.P. §708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(I);

(b) Presents all claims directed to a single invention, ...

(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 a similar statement, that the entirety of the independent claims are not taught or suggested by the reference, is presented for each of the references purported to be "most closely related". That is, the submission does not satisfy the requirement, as it does not provide a detailed discussion of the references and it does not point out how the ***claimed subject matter is patentable over the references***.

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.

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

Paper No. 5

MAILED

JUN 2 6 2002

Technology Center 2100

Richard E. Kurtz, II
Greenberg Traurig
1750 Tysons Boulevard, 12th Floor
McLean, Virginia 22102

In re Application of: G. C. Conkwright et al.	)	
Application No. 09/759,640	)	
Filed: January 16, 2001	)	**DECISION ON PETITION FOR**
For: PRIVACY COMPLIANT MULTIPLE	)	**ACCELERATED EXAMINATION**
DATASET CORRELATION	)	**UNDER M.P.E.P. §708.02(VIII)**
SYSTEM	)	

This is a decision on the Request for Reconsideration dated May 22, 2002, filed by the applicants in response to an earlier Decision mailed on April 26, 2002 by the Office. The original petition was filed on March 18, 2002 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.

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, 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.

The May 22, 2002 Request for Reconsideration filed by the applicants is accompanied by a detailed discussion of the references that are most closely related the claimed invention and explanation as to how the claimed subject matter is patentable over the references.

Applicant's submission meets all the criteria set out above, accordingly, the Petition is **GRANTED**.

The application file is being forwarded to the Examiner of Record for accelerated examination according to the procedures set forth in M.P.E.P. §708.02, Section VIII.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : July 17, 2009

TO SPE OF : ART UNIT 3639
SUBJECT : Request for Certificate of Correction for Appl. No.: 09/759649/7103581

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

Magdalene Talley
Certificates of Correction Branch
703-308-9390 ext. 120

Thank You For Your Assistance

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

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

Comments: _____

Jack Thomas
SPE

3628
Art Unit

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ALEXANDRIA, VA 22313-1450
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Paper No. 5

JOHN HAN
ASSOCIATE GENERAL COUNSEL-INTELLECTUAL PROPERTY
ERICSSON INC.
MS/EVW2-C-2
6300 LEGACY DRIVE
PLANO, TX 75024

MAIL

JUN - 4 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re application of:
HARRISON
Application No. 09/759671
Filed: January 12, 2001
For: **METHODS, SYSTEMS AND COMPUTER PROGRAM PRODUCTS FOR BANDWIDTH ALLOCATION BASED ON THROUGHTPUT GUARANTEES**

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney/agent of record filed on February 12, 2004.

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

Petitioner has satisfied the requirements for successfully requesting withdrawal. Accordingly, the request is **GRANTED.**

All of the attorneys/agents of record listed in the Request are withdrawn.

All future correspondence will continue to be directed to the above address until such a time as a request for change of address is filed. A courtesy copy of this decision is being sent to petitioner at the address provided below.

KENNETH WIEDER
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: MYERS BIGEL SIBLEY & SAJOVEC PA
P O BOX 37428
RALEIGH, NC 27627

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.

ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO TX 75024

COPY MAILED

NOV 14 2007

OFFICE OF PETITIONS

In re Application of :
James T. St. John et al. :
Application No. 09/759,671 :
Filed: January 12, 2001 :
Attorney Docket Number: P12541 :
(8194-470) :
Title: METHODS, SYSTEMS AND :
COMPUTER PROGRAM PRODUCTS FOR :
BANDWIDTH ALLOCATION BASED ON :
THROUGHPUT GUARANTEES

DECISION ON PETITION
UNDER 37 C.F.R. § 1.137(A)

This is a decision on the petition filed August 31, 2007, pursuant to 37 C.F.R. § 1.137(a)[1], to revive the above-identified application.

The petition is **DISMISSED**.

Background

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 and Issue Fee Due, mailed September 19, 2005, which set a shortened statutory period for

1 A grantable petition pursuant to 37 C.F.R. § 1.137(a) must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;
(2) The petition fee as set forth in 37 C.F.R. § 1.17(l);
(3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
(4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

reply of three months. No extensions of time are permitted for transmitting issue or publication fees[2]. Accordingly, the above-identified application became abandoned on December 20, 2005. A Notice of Abandonment was mailed on February 10, 2006.

With the present petition, Petitioner has submitted the petition, issue, and publication fees, along with a statement of facts. Petitioner has met requirements (1) and (2) of 37 C.F.R. § 1.137(a). The fourth requirement is not applicable.

Regarding the third requirement, a discussion follows.

The Applicable Standard

Nonawareness of a PTO rule will not constitute unavoidable delay[3]

The burden of showing the cause of the delay is on the person seeking to revive the application[4].

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."[5]

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"[6]

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action[7].

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2 See MPEP §710.02(e).

3 See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel. See also Donnelley v. Dickinson, 123 Fsupp2d 456, 459.

4 Id.

5 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

6 See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

7 See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

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[8].

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable[9]."

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions[10]. Specifically, petitioner's delay caused by the mistakes or negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 U.S.C. § 133[11].

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later distance himself from this attorney, so as to avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and constructively possess "notice of all facts, notice of which can be charged upon the attorney[12]."

Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions[13]."

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8 In re Mattullath, 38 App. D.C. at (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).
9 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.
10 Link v. Wabash, 370 U.S. 626, 633-634 (1962).
11 Haines, 673 F.Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; 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. 103, 131 (Comm'r Pat. 1891).
12 Link at 633-634.
13 Inryco, Inc. v. Metropolitan Engineering Co., Inc., 708 F.2d 1225, 1233 (7th Cir. 1983). See also, Wei v. State of Hawaii, 763 F.2d 370, 372 (9th Cir. 1985); LeBlanc v. I.N.S., 715 F.2d 685, 694 (1st Cir. 1983).

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account[14]."

A petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable[15]."

The Relevant Law and Regulations

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 Director in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Director that such delay was unavoidable.

(Amended Nov. 29, 1999, Public Law 106-113, sec. 1000(a)(9), 113 Stat. 1501A-582 (S. 1948 sec. 4732(a)(10)(A)).)

37 C.F.R. § 1.135: Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 FR 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 FR 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997]

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14 Smith v. Mossinghoff, 671 F.2d at 538; 213 USPQ at 982.
15 Haines, 673 F. Supp. at 314, 316-17; 5 USPQ2d at 1131-32.

Analysis

The relevant events are as follows:

- On February 12, 2004, the former attorney of record, a member of the law firm Myers, Bigel, Sibley, and Sajovec PA (hereinafter referred to as "the firm") submitted a request for withdrawal at attorney pursuant to 37 C.F.R. § 1.36.

- On April 19, 2004, the Assignee submitted a Power of Attorney and Correspondence Address Indication Form along with a Statement Under 37 C.F.R. § 3.73(b).

- On June 4, 2004, the Technology Center mailed a decision, granting the firm's request and indicating "all future correspondence will continued to be directed to the above address until such time as a request for change of address is filed," with the "above address" being the address of the Assignee.

- On April 5, 2005, a non-final Office action was mailed not to the Assignee, but rather to the firm.

- On July 5, 2005, a response to the non-final Office action was received. It is noted that this response was submitted not by the firm, but rather by the Assignee, and bears Petitioner's signature. As such, it appears that the non-final Office action was forwarded to the Assignee by the firm.

- On September 19, 2005, a Notice of Allowance and Issue Fee Due was mailed to the firm.

Petitioner (the Assignee) has asserted that the Notice of Allowance and Issue Fee Due was not received "because the USPTO mailed the Notice to the wrong address."

It is noted that on April 19, 2004, the Assignee instructed the Office to direct all correspondence to the same. Office records have been reviewed, and it does not appear that the correspondence address was updated subsequent to the receipt of the aforementioned Power of Attorney and Correspondence Address Indication Form.

The fact that the Assignee responded to the non-final Office action strongly suggests that it was received by the Assignee.

A review of the response to the non-final Office action indicates that Petitioner executed this submission, and the response bears the Assignee's name and address as the return address below his signature. **A review of the non-final Office action indicates that the cover sheet of the same bears the name and address of the firm as the mailing address. As such, it is clear that Petitioner either knew or should have known that the communication was mailed to the firm. However, the response to the non-final Office action has been reviewed, and it does not appear that Petitioner notified the Office of the failure to update the correspondence address.**

As set forth above, the entire period of delay cannot be deemed to have been "unavoidable" where the Applicant failed to exhibit the level of care or diligence that is "generally used and observed by prudent and careful men in relation to their most important business."

It does not appear that Petitioner exhibited "the level of care or diligence that is generally used and observed by prudent and careful men in relation to their most important business." It appears that Petitioner either was aware or should have been aware of the Office's failure to update the correspondence address, and yet Petitioner prepared a response to the non-final Office action, and failed to bring this fact to the Office's attention. It seems that an ordinary man, acting in relation to his most important business, would have brought this fact to the Office's attention via the inclusion of a statement in the response to the non-final Office action (if for no other reason than if one paper was mailed to the firm, there was a strong likelihood that subsequent mailings would also be addressed to the firm).

CONCLUSION

The correspondence address of record and attorney docket number have been updated.

On renewed petition, Petitioner will need to explain how the failure to notify the Office of its failure to update the correspondence address, when he either knew or should have known of the same, amounted to "the level of care or diligence that is generally used and observed by prudent and careful men in relation to their most important business."

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a)

are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.137(a)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail[16], hand-delivery[17], or facsimile[18]. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web[19].

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

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225[20]. 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

---

16 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
17 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
18 (571) 273-8300- please note this is a central facsimile number.
19 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html
20 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.

UNITED STATES PATENT AND TRADEMARK OFFICE

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FINNEGAN HENDERSON FARABOW GARRETT
& DUNNER LLP
901 NEW YORK AVENUE NW
WASHINGTON DC 20001-4413

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APR 0 9 2008

OFFICE OF PETITIONS

In re	:
Halstead, Jr. et al.	: DECISION REGARDING
Application No. 09/759,697	: PATENT TERM ADJUSTMENT
Filed: January 21, 2001	:
Attorney Docket No. 09612.1028-01000	:

This decision is in response to the "NOTICE OF ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT", filed October 31, 2007, requesting correction of the patent term adjustment (PTA) indicated on the patent.

The request 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 **two hundred sixty (260) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

The Office determined a patent term adjustment of three hundred forty-one (341) days based on an adjustment for PTO delay of six hundred twenty-three (623) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by sixty-four (64), thirty-nine (39), eighty-seven (87), and ninety-two (92) days of applicant delay, all pursuant to 35 U.S.C.

154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b). All adjustments have been reviewed and determined to be correct.

However, a review of the file reveals that applicant should have been assessed additional delay on two separate occasions pursuant to 37 C.F.R. § 1.704(b). In the first instance, the Office mailed a final Office action on June 16, 2004. In response, Applicant filed an RCE on September 20, 2004. Accordingly, pursuant to § 1.704(b), four (4) days of Applicant delay should have been assessed.

In the second instance of delay under § 1.704(b), the Office mailed a final Office action on December 8, 2006. However, applicants did not file a reply until May 18, 2007 (made timely for purposes of avoiding abandonment by obtaining the appropriate extension of time). Accordingly, pursuant to § 1.704(b), seventy-one (71) days of Applicant delay should have been assessed.

Lastly, it is also determined that applicant should have been assessed delay for filing a supplemental paper pursuant to 37 C.F.R. § 1.704(c)(8). After applicant filed his May 18, 2007 reply, applicant filed a terminal disclaimer on May 24, 2007. Accordingly, applicant delay of six (6) days should have been assessed for this filing.

In view thereof, the correct determination of PTA at the time of the mailing of the Notice of Allowance is **two hundred sixty (260)** days (623 days of PTO delay, reduced by 363 (6+71+92+87+39+4+64) days of applicant delay).

No petition fee was required and none has been charged. The Office thanks Applicants for their good faith and candor in bringing this matter to the attention of the Office.

The matter is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this letter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Nancy Johnson

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enc: updated PALM screen

PALM INTRANET

Day : Tuesday
Date: 4/8/2008
Time: 19:07:55

PTA Calculations for Application: 09/759697			
Application Filing Date:	01/12/2001	PTO Delay (PTO):	623
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	282
Post-Issue Petitions:	0	Total PTA (days):	260
PTO Delay Adjustment:	-81		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
117	04/08/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		6	
116	04/08/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		71	
115	04/08/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		4	
108	10/19/2007	MAIL NOTICE OF ALLOWANCE			
107	10/18/2007	ISSUE REVISION COMPLETED			
106	10/18/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
105	10/18/2007	DOCUMENT VERIFICATION			
104	10/18/2007	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
103	10/01/2007	NOTICE OF ALLOWABILITY			
102	09/12/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
101	09/12/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
100	09/12/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
99	09/17/2007	DATE FORWARDED TO EXAMINER			
98	09/12/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
97	09/17/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
96	09/12/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
95	09/12/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
94	09/12/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
93	08/22/2007	FINISHED INITIAL DATA CAPTURE			
92	07/17/2007	EXPORT TO INITIAL DATA CAPTURE			

91	07/12/2007	MAIL NOTICE OF ALLOWANCE			
90	07/10/2007	ISSUE REVISION COMPLETED			
89	06/27/2007	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
88	06/27/2007	DOCUMENT VERIFICATION			
87	06/27/2007	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
86	06/11/2007	NOTICE OF ALLOWABILITY			
85	05/18/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
84	06/05/2007	PARALEGAL TD ACCEPTED			
83	05/24/2007	TERMINAL DISCLAIMER FILED			
82	05/18/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
81	05/18/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
80	05/18/2007	REFERENCE CAPTURE ON IDS			
79	05/18/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
78	05/23/2007	DATE FORWARDED TO EXAMINER			
77	05/18/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
76	05/23/2007	DATE FORWARDED TO EXAMINER			
75	05/18/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
74	05/23/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
73	05/18/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
72	05/18/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
71	05/18/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
70	12/08/2006	MAIL FINAL REJECTION (PTOL - 326)			
69	12/06/2006	FINAL REJECTION			
68	09/27/2006	DATE FORWARDED TO EXAMINER			
67	09/20/2006	RESPONSE AFTER NON-FINAL ACTION		92	65
66	09/20/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
65	03/20/2006	MAIL NON-FINAL REJECTION			
64	03/16/2006	NON-FINAL REJECTION			

63	03/16/2006	DATE FORWARDED TO EXAMINER			
62	03/09/2006	SUPPLEMENTAL RESPONSE			
57	02/08/2006	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
56	02/07/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
55	01/26/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
54	01/20/2006	CASE DOCKETED TO EXAMINER IN GAU			
53	12/23/2005	NEW OR ADDITIONAL DRAWING FILED			
52	01/17/2006	DATE FORWARDED TO EXAMINER			
51	12/23/2005	RESPONSE AFTER NON-FINAL ACTION		87	49
50	12/23/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
49	06/27/2005	MAIL NON-FINAL REJECTION			
48	06/23/2005	NON-FINAL REJECTION			
47	06/23/2005	CASE DOCKETED TO EXAMINER IN GAU			
46	05/27/2005	CASE DOCKETED TO EXAMINER IN GAU			
45	01/07/2002	REFERENCE CAPTURE ON IDS			
44	09/10/2003	REFERENCE CAPTURE ON IDS			
43	03/30/2005	REFERENCE CAPTURE ON IDS			
42.7	03/30/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	39
42	03/30/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
41	03/30/2005	MISCELLANEOUS INCOMING LETTER			
40	04/19/2005	DATE FORWARDED TO EXAMINER			
39	03/30/2005	RESPONSE AFTER NON-FINAL ACTION		39	36
38	03/30/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
37	03/22/2005	CASE DOCKETED TO EXAMINER IN GAU			
36	11/19/2004	MAIL NON-FINAL REJECTION			
35	11/15/2004	NON-FINAL REJECTION			
34	11/01/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
33	11/01/2004	DATE FORWARDED TO EXAMINER			
32	09/20/2004	REQUEST FOR CONTINUED EXAMINATION (RCE)			
31	11/01/2004	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			

30.7	09/20/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
30	09/20/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
29	11/01/2004	CORRESPONDENCE ADDRESS CHANGE			
28	11/01/2004	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
27	02/02/2004	REFERENCE CAPTURE ON IDS			
26	07/07/2002	REFERENCE CAPTURE ON IDS			
25	01/27/2003	REFERENCE CAPTURE ON IDS			
24	09/20/2004	WORKFLOW INCOMING AMENDMENT IFW			
23	09/20/2004	WORKFLOW - REQUEST FOR RCE - BEGIN			
22	06/16/2004	MAIL FINAL REJECTION (PTOL - 326)			
21	06/14/2004	FINAL REJECTION			
20	05/18/2004	DATE FORWARDED TO EXAMINER			
19	04/29/2004	RESPONSE AFTER NON-FINAL ACTION		64	15
18	04/29/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
17	04/29/2004	WORKFLOW INCOMING AMENDMENT IFW			
16.7	02/02/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
16	02/02/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	11/25/2003	MAIL NON-FINAL REJECTION	623		-1
14	11/17/2003	NON-FINAL REJECTION			
13	10/27/2003	CASE DOCKETED TO EXAMINER IN GAU			
12.7	09/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	09/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	06/22/2003	CASE DOCKETED TO EXAMINER IN GAU			
10.7	01/27/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	01/27/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9.7	02/19/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	02/19/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	02/26/2002	CASE DOCKETED TO EXAMINER IN GAU			

7.7	01/07/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
7	01/07/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
6.7	12/26/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
6	12/26/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
5	03/26/2001	CASE DOCKETED TO EXAMINER IN GAU			
4	02/26/2001	APPLICATION DISPATCHED FROM OIPE			
3	02/22/2001	CORRESPONDENCE ADDRESS CHANGE			
2	01/31/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	01/12/2001	INITIAL EXAM TEAM NN			

Search Another: Application# Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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Paper No. 3

Roberts Abokhair & Mardula, LLC
11800 Sunrise Valley Drive, Suite 1000
Reston, VA 20191-5302

MAILED

SEP 0 3 2004

Technology Center 2100

In re Application of:
Scott EISENBERG
Application No. 09/759,720
Filed: January 12, 2001
For: SYSTEM AND METHOD FOR GRANTING ELECTRONICS RIGHTS USING THE SIGNATURE OF DISTRIBUTABLE PHYSICAL MEDIA

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed November 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.**

There is no indication that Applicant has been notified of the request for withdrawal. Accordingly, 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. 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 Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
703-305-9750

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TECHNOLOGY CENTER 2100

Roberts Abokhair & Mardula, LLC
Suite 1000
11800 Sunrise Drive
Reston, VA 20191-5302

In re Application of:
Scott Eisenberg
Application No. 09/759, 720
Filed: January 12, 2001
For: SYSTEM AND METHOD FOR GRANTING ELECTRONIC RIGHTS USING THE SIGNATURE OF DISTRIBUTABLE PHYSICAL MEDIA

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed October 19, 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 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.

Michelle R. Dees

Vincent N. Trans
Special Program Examiner
Technology Center 2100

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HEIMLICH LAW
5952 DIAL WAY
SAN JOSE CA 95129

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OFFICE OF PETITIONS

In re Application of :
Schwartz : DECISION ON
Application No. 09/759,728 : APPLICATION FOR
Filed: January 11, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. DIGI-P001 :

This decision is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT" filed November 13, 2008. Applicant submits that the correct patent term adjustment to be indicated on the patent is nine hundred and seventeen (917) days, not five hundred and three (503) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicant appears to request this correction on the basis that the Office will take in excess of three years to issue this patent.

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, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

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 § 1.702(b). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation 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 adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, 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. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

---

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

The Office of Data Management has been advised of this decision. This application 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 Maria Nuzzolillo at 571-272-8150 or the undersigned at (571)272-7757.

/Kery A. Fries/

Kery A. Fries

Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
For Patent Examination Policy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100715

DATE : July 15, 2010

TO SPE OF : ART UNIT 2454

SUBJECT : Request for Certificate of Correction on Patent No.: 7,269,664

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

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

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

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

Note your decision on the appropriated box.

☒ **Approved** All changes apply.

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

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

Comments:

Ashok Patel
(ASHOK B. PATEL)
SPE
AU 2449.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20070826

DATE : August 26, 2007

TO SPE OF : ART UNIT 2837

SUBJECT : Request for Certificate of Correction on Patent No.: 6653810

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:

LINCOLN DONOVAN
SUPERVISORY PATENT EXAMINER

SPE: Lincoln Donovan **Art Unit** 2837

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 4-26-05

Paper No.: 050105

TO SPE OF : ART UNIT 1638

SUBJECT : Request for Certificate of Correction on Patent No.: 6712034

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.

Please check spec / claims

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

1638
Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 11/4/04

Paper No.: _____

TO SPE OF : ART UNIT 1638

SUBJECT : Request for Certificate of Correction on Patent No.: 6,740,795 09/259,759

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.

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.

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

Comments:

The changes do not affect the scope of the claimed invention.

Amy Nelson
SPE

1638
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

09/759762

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 021605

DATE : **10/25/2004**

TO SPE OF : ART UNIT **1600**

SUBJECT : Request for Certificate of Correction on Patent No.: **6,717,040**

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.

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.

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

Comments:

SPE

1638
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 5

Dennis F. Armijo, Esq.
DENNIS F. ARMIJO, P.C.
5300 Sequoia Rd., NW, Suite 200
Albuquerque, NM 87120

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OCT 0 9 2002

OFFICE OF PETITIONS

In re Application of
Mohsen Shahinpoor, et al.
Application No. 09/759,766
Filed: January 12, 2001
Attorney Docket No. 2359-00

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 20, 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 Corrected Application Papers mailed March 8, 2001. 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 May 9, 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 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

Frances Hicks for
Sherry Brinkley
Petitions Examiner

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Alexandria, VA 22313-1450
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SHEPPARD, MULLIN, RICHTER & HAMPTON, LLP
333 SOUTH HOPE STREET
48TH FLOOR
LOS ANGELES, CA 90071-1448

MAILED

JUN 10 2009

OFFICE OF PETITIONS

In re Application of	:	
Gajendra D. Savant, et. al.	:	
Application No. 09/759,773	:	DECISION ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. 100.238	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed May 7, 2009, to revive the above-identified application.

The petition is **DISMISSED**.

The application became abandoned for failure to file a reply to the final Office action mailed March 24, 2004, which set a statutory period for reply of three months. No extension of time under 37 CFR 1.136 was obtained. Accordingly, the application became abandoned on September 25, 2004.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks item (3).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (over 4 years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on September 25, 2004. That party, in turn must explain what effort(s) was made to further reply to the outstanding Office action and, further, why no reply was filed. If no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). As Leonard Tachner, a Professional Law Corporation was responsible for this application at the time of abandonment, they should explain why this application became abandoned while it was under their control and what efforts was made to reply and with whom this matter was discussed outside of the Office. Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from the responsible person and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons and any responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well

as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over 4 years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons, Leonard Tachner, a Professional Law Corporation, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

> (A) the date that the applicant first became aware of the abandonment of the application; and
>
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -

*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

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.

Any renewed petition may be addressed as follows:

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

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

The centralized facsimile number is (571) 273-8300.

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
Washington, D.C. 20231
www.uspto.gov

Paper No. 16

WARNER-LAMBERT COMPANY
2800 PLYMOUTH ROAD
ANN ARBOR, MI 48105

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MAY 28 2003

OFFICE OF PETITIONS

In re Application of	:	
Maria Isabel Gonzalez et al	:	
Application No. 09/759,777	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. 5771-P1-01-BD	:	

This is a decision on the petition under 37 CFR 1.78(a)(3), filed April 21, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of the prior-filed applications, and on the petition 37 CFR 1.78(a)(6) to accept an unintentionally delayed claim under under 35 U.S.C.§ 119(e), for the benefit of the prior-filed provisional application set forth in the amendment filed concurrently with the instant petition.

The petition is **DISMISSED AS MOOT**.

A petition under 37 CFR 1.78(a)(3) and under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000.

Along with the instant petition under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) petitioner has submitted an amendment to the first sentence of the specification following the title to include a reference to the prior-filed applications.

The instant pending nonprovisional application was filed on January 12, 2001. While a reference to the prior-filed applications was not included in an ADS or in the first sentence of the specification following the title, reference nevertheless was made in the oath or declaration.

The current procedure where a claim for priority under 37 CFR 1.78(a)(2) and 37 CFR 1.78(a)(5) is not included in the first sentence of the specification or in an ADS but does appear either in the oath or declaration or a transmittal letter filed with the application and the Office notes the claim for priority, no petition will be required to accept a late claim for priority. This is because the application would have been scheduled for publication on the basis of the information concerning the claim submitted elsewhere in the application within the time period set forth in 37 CFR 1.78(a)(2) and 37 CFR 1.78(a)(5). However, on the other hand, if the USPTO does not note the claim for priority to the prior-filed applications in the oath or declaration or transmittal letter submitted with the application, a petition will be required to accept a late claim for priority under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6).[1] In the instant case, the Office noted the claim for priority of the prior-filed applications in the oath or declaration, as shown by its inclusion on the filing receipt.

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[1] Note 66 Federal Register 67087 at 67089 (Dec. 28, 2001), effective December 28, 2001.

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 currently of record until such time as appropriate instructions are received to the contrary.

In view of the above, the $1,300 petition fee submitted is unnecessary and will be refunded to petitioner's deposit account in due course.

Any questions concerning this decision on petition may be directed to Karen Creasy at (703)305-8859. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

This application is being forwarded to Technology Center AU 1617 for consideration by the examiner of the claim under 35 U.S.C. §§ 120 and 365(c) and 37 CFR 1.78(a)(3) and the claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior-filed applications.

Frances Hicks

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

cc:
PFIZER INC.
PATENT DEPARTMENT, MS 8260-1611
EASTERN POINT ROAD
GROTON, CT 06340

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Paper No. 5

MING-CHIEH HSU
4972 HERITAGE DRIVE
CHINO HILLS CA 91709

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MAY 2 2 2003

OFFICE OF PETITIONS

In re Application of
Ming-Chieh Hsu
Application No. 09/759,783
Filed: January 16, 2001
Title: STRUCTURE OF A SCREWDRIVER TIP

ON PETITION

This is a decision on the paper titled "A Statement that the Entire Delay was Unintentional", filed September 10, 2002, which is being treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181 (no fee) in light of petitioner's statement that the Office action mailed February 27, 2001 was never received. The Office apologizes for the delay in responding.

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

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)" or "Renewed Petition under 37 CFR 1.137(b)," as appropriate. Extensions of time under 37 CFR 1.136(a) are permitted.

The above-identified application became abandoned for failure to timely reply to the Notice to File Corrected Application Papers Office mailed February 27, 2001. This Office action set a shortened statutory period for reply of two months. Extensions of time under 37 CFR 1.136(a) were available. No reply to the Notice having been received, the above-identified application became abandoned on April 28, 2001. A Notice of Abandonment was mailed on August 23, 2002.

With the instant "petition", petitioner states that he never received the Notice to File Corrected Application Papers mailed February 27, 2001. To withdraw the holding of abandonment due to non receipt of an Office action, a petitioner must state that the Office action was not received and must attest to the fact that a search of the file jacket and docket records indicates nonreceipt. Furthermore, a petitioner must include a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed.[1]

Alternatively, if petitioner can not meet the requirements necessary to establish non-receipt of the Notice to File Corrected Application Papers, petitioner may seek to revive the above-identified application by way of a petition under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay).

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1)

---

[1] See MPEP 711.03(c)(II).

the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l) - currently $55 for a small entity; (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 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d).

A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m) - currently $650 for a small entity; (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

As there was no fee necessary for the instant petition under 37 CFR 1.181, the $50 submitted with the petition will be refunded to petitioner under separate cover.

Enclosed for petitioner's convenience are blank copies of Form PTO/SB/61 (unavoidable delay) and PTO/SB/64 (unintentional delay).

Also enclosed for petitioner's convenience, and in the event petitioner chooses to reply with a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), is a copy of the Notice to File Corrected Application Papers.

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

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

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

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, Virginia

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

Cliff Congo

Cliff Congo
Petitions Attorney
Office of Petitions

Enc: PTO/SB/61 (3 pages)
PTO/SB/64 (2 pages)
Notice to File Corrected Application Papers (1 page)

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 9

MING-CHIEH HSU
4972 HERITAGE DRIVE
CHINO HILLS CA 91709

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FEB 0 2 2004

OFFICE OF PETITIONS

In re Application of Ming Chieh Hsu Application No. 09/759,783 Filed: January 16, 2001 Title: STRUCTURE OF A SCREWDRIVER TIP	: : : : : :	DECISION ON PETITION

This is a decision on the paper transmitted via facsimile on June 2, 2003, and the papers filed June 27, 2003, consisting of a substitute specification, abstract, and request for extension of two months (credit card payment in the amount of $205). Both sets of papers are being treated as a petition under 37 CFR 1.181 (no fee required).

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 above-identified application became abandoned for failure to timely reply to the Notice to File Corrected Application Papers, mailed on February 27, 2001. This notice set a shortened statutory period for reply of two months. Extensions of time under 37 CFR 1.136(a) were available. No reply to the Notice having been received, the above-identified application became abandoned on April 28, 2001. A Notice of Abandonment was mailed on August 23, 2002.

On September 10, 2002, applicant filed a paper titled "A Statement that the Entire Delay was Unintentional", together with a petition fee of $50. Applicant stated that the Notice to File Corrected Application Papers was never received. In light of applicant's statement of non receipt, applicant's September 10, 2002 paper was treated as a petition to withdraw the holding of abandonment under 37 CFR 1.181 (for which no fee is required), rather that a petition to

revive an unintentionally abandoned application under 37 CFR 1.137(b) (for which a fee of $640 was required on September 22, 2002).

On May 22, 2003, a decision was mailed dismissing applicant's petition. The dismissal set a shortened period for reply of two months. Applicant did not submit the required proof to establish non-receipt of the Notice to File Corrected Application Papers. To establish non-receipt of an Office action, applicant is required to: (1) state that the Office action was not received; (2) attest to the fact that a search of the file jacket and docket records indicates that it was not received; and (3) include a copy of his docket records where the non-received Office action would have been entered had it been received and docketed. Applicant did not meet requirements (2) and (3). Accordingly, the holding of abandonment could not be withdrawn and applicant's "petition" had to be dismissed. As there was no fee necessary for a petition to withdraw the holding of abandonment, applicant's petition fee of $50 was refunded.

In the May 22, 2003 decision, applicant was advised that if he could not establish the non-receipt requirements necessary to withdraw the holding of abandonment, he could still file a petition to revive the application under either 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay). In addition, applicant was advised of the requirements for a grantable petition under 37 CFR 1.137(a) and 37 CFR 1.137(b). Once again, those requirements are as follows.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l) – currently $55 for a small entity; and (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 was unavoidable.

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 set forth in 37 CFR 1.17(l) – currently $665 for a small entity; and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

In his June 2, 2003 facsimile, applicant has stated that he filed a petition to revive an abandoned application due to unintentional delay on September 10, 2002, paid $50 for the fee, and yet doesn't understand why the petition was dismissed. The petition was dismissed because a petition to revive an abandoned application due to unintentional delay requires a petition fee of $665 ($640 at the time applicant filed his petition on September 10, 2002).

Receipt of the substitute specification and abstract, filed June 27, 2003, is acknowledged. However, as there was no need for a two month extension of time (the May 22, 2003 decision set a period for reply of two months), the $205 fee submitted will be refunded to applicant under separate cover.

As applicant has not filed a grantable petition to withdraw the holding of abandonment under 37 CFR 1.181, or a grantable petition under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay), the application remains abandoned. Copies of the forms for the unavoidable and unintentional delay petitions are enclosed for applicant's convenience.

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 copy of the form required to change an address is enclosed for applicant's convenience. 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 may be directed to the undersigned at 703-305-0272.

Cliff Congo
Petitions Attorney
Office of Petitions

Enc: PTO/SB/61 (3 pages)
PTO/SB/64 (2 pages)
PTO/SB/122 (1 page)

Cc : Ming-Chieh Hsu
No 207 Chulio Rd
Chulio Village
Tashu Hsiang, Kaohsiung
Taiwan R.O.C.

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Paper No. 11

MING-CHIEH HSU
4972 HERITAGE DRIVE
CHINO HILLS CA 91709

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OFFICE OF PETITIONS

In re Application of :
Ming-Chieh Hsu :
Application No. 09/759,783 : ON PETITION
Filed: January 16, 2001 :
Title: STRUCTURE OF A SCREWDRIVER TIP :

This is a decision on the Petition for Revival of an Application Abandoned Unintentionally Under 37 CFR 1.137(b), filed February 24, 2004 (Certificate of Mailing dated February 19, 2004).

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

The above-identified application became abandoned for failure to timely reply to the Notice to File Corrected Application Papers, mailed on February 27, 2001. This Notice set a shortened statutory period for reply of two months. Extensions of time under 37 CFR 1.136(a) were available. No reply to the Notice having been received, the above-identified application became abandoned on April 28, 2001. A Notice of Abandonment was mailed on August 23, 2002. Applicant filed a petition to revive on September 10, 2002. However, this petition was dismissed in a decision mailed on May 22, 2003. Applicant filed another petitoin on June 2, 2003. However, this petition was dismissed in a decision mailed on February 2, 2004.

With the instant petition, petitioner paid the proper petition fee and made the proper statement of unintentional delay. The required reply in the form of a substitute specification and abstract was previously filed on June 27, 2003.

The application file is being forwarded to the Office of Initial Patent Examination for pre-examination processing.

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

Cliff Congo
Petitions Attorney
Office of Petitions

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IBM Corporation
Intellectual Property Law
Dept. 917/Bldg. 006-1
3605 Highway 52 North
Rochester, MN 55901-7829

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DEC 20 2005
OFFICE OF PETITIONS

In re Application :
Bates, et al. :
Application No. 09/759,784 : PATENT TERM ADJUSTMENT
Filed: January 12, 2001 :
Dkt. No.: ROC920000007US2 :

This letter is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. § 1.705)," filed September 28, 2005. This matter is being treated under 37 CFR 1.705(b).

Applicants argue that the Office will have failed to issue the patent within three years from the date the application was filed in accordance with 35 U.S.C. 154(b) and request an adjustment of 767 days. Applicants do not appear to contest any of the adjustments and/or reductions accorded to date.

Accordingly, applicants are advised that decision on the instant request for reconsideration of patent term adjustment ("PTA") under 37 CFR 1.705(d) is hereby **held in abeyance** subject to an issuance date being set by the Office of Patent Publications at which time the PTA will be routinely recalculated.

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 § 1.705(d) must be met. Request for reconsideration on other bases must be timely filed and must include payment of the required fee.

Applicants are reminded that if an application is entitled to an adjustment under 35 USC 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded

under 35 USC 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 USC 154 (b)(1)(B) in determining whether periods of delay overlap under 35 USC 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than three years after the filing date of the application which overlap the

Applicants are further advised to submit a letter to the Office within two months of the issuance of the patent if, at the time of issuance of the patent, the appropriate adjustment under 37 CFR 1.702(b) has not been accorded.

In view thereof, at the time of Notice of Allowance the application is entitled to a patent term adjustment of 493 days.

The Office acknowledges receipt of the required fee of $200.00 for an application for patent term adjustment.

This application is being forwarded to the Office of Patent Publication for processing into a patent.
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

SPE UIKA CHAUHAN

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 09/759,789

Paper No.: _____

DATE : 6/16/05

TO SPE OF : ART UNIT 2671

SUBJECT : Request for Certificate of Correction on Patent No.: 6850244

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.

Lamonte M. Newsome

Thank You For Your Assistance

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:

_____

_____

_____

_____

_____

SPE — 2672 Art Unit

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/759798	01/12/01	SCIBORA, MARCO	13686-106

BRIGGS AND MORGAN P.A.
2200 IDS CENTER
80 SOUTH 8TH ST
MINNEAPOLIS MN 55402

EXAMINER	
BAROT, BHARAT	
ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 2/8/07

NOTICE OF RESCINDED ABANDONMENT

☒ **In response to your communication filed** 2/7/07

☒ **Through inadvertence, a Notice of Abandonment was mailed in the above-identified application. The Notice of Abandonment is hereby rescinded.**

For Manager, Publications Division
Office of Patent Publication
571-272-4200

PTO/SB/97 (09-04)
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 contains a valid OMB control number.

FAX COVER SHEET

January 24, 2007

Please deliver the following 14 page(s) (This includes this cover sheet)

RECIPIENTS

Name	Firm	Phone Number	Fax Number
Darlene Lyon	U.S. Patent and Trademark Office		571-270-9805

CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office on 24 JAN 07.
Date

Signature

Gerald E. Helget
Typed or printed name of person signing Certificate

30,948
Registration Number if applicable

612-977-8480
Telephone Number

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

1. Petition to Withdraw Holding of Abandonment Under 37 C.F.R. § 1.181
2. Copy of Notice of Abandonment
3. Copy of Transmittal Cover Letter
4. Copy of Fee Transmittal Sheet (Form PTOL-85)
5. Copy of Notice of Allowance
6. Copy of Check in the amount of $1,030.00 for payment of issue fee, publication fee and patent copies
7. Copy of cashed check from bank
8. Copy of return receipt post card

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CUSTOMER SERVICE
PUBLISHING DIVISION

This collection of information is required by 37 CFR 1.8. 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 1.8 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.

1987314v1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appln. No.:	09/759,798	**Examiner:**	Bharat Barot
Confirm. No.:	3374	**Group Art Unit:**	2155
Filed:	January 12, 2001	**Docket No.:**	13686-106 (33046.23)
Title:	COMPRESSION AND REMOTE STORAGE APPARATUS FOR DATA, MUSIC AND VIDEO		

PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 C.F.R. § 1.181

Sir:

This petition is filed in response to the Notice of Abandonment mailed December 13, 2006 (copy enclosed) with regard to the above-referenced matter. The Notice of Abandonment states that the application was abandoned for failure to timely pay the required issue fee and publication fee within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85), and that the issue fee and publication fee have not been received.

On November 14, 2006, Applicant timely paid the issue fee and the publication fee. Copies of the Transmittal Cover Letter, Fee Transmittal Sheet (Form PTOL-85), the check submitted in payment and the Notice of Allowance are attached, as well as a copy of the return receipt postcard. Please note, the certificate of mailing indicates the issue fee and publication fee were mailed on November 14, 2006 and the postcard has the Patent Office date stamp affixed thereon acknowledging receipt of the issue fee and publication fee on November 16, 2006.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this document is being transmitted via facsimile, number 571-270-9805, to Darlene Lyon, U.S. Patent and Trademark Office, Arlington, VA 22313-1450, on the date indicated below.

By: _____

Date 24 JAN 07

1987215v1

In view of the foregoing, Applicant respectfully requests that this application be reinstated. Applicant does not believe any fee is due with regard to this Petition for Reinstatement. However, should the Office disagree, authorization is hereby made to deduct any charges and/or credit any overpayments to Deposit Account No. 023732.

Should you have any questions, please do not hesitate to contact the undersigned at the address and telephone number set forth below.

Respectfully submitted,

Dated: 24 Jan 07

By _____

Gerald E. Helget (Reg. No. 30,948)
BRIGGS AND MORGAN, P.A.
2200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
Telephone: (612) 977-8480

1987215v1

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,798	01/12/2001	Marco Scibora	13686-106 33046.23	3374

32300 7590 12/13/2006
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80 SOUTH 8TH ST
MINNEAPOLIS, MN 55402

Advanced Comm. Designs

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IP DOCKETING DEPT

EXAMINER
BAROT, BHARAT

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 12/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Notice of Abandonment	Application No.	Applicant(s)	
	09/759,798	SCIBORA	
	Examiner	Art Unit	
	BAROT	2155	

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

This application is abandoned in view of:

1. ☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.
   (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
   (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
   (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
   (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
   (d) ☐ No reply has been received.

2. ☒ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
   (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
   (b) ☐ The submitted fee of $_____ is insufficient. A balance of $_____ is due.
   The issue fee required by 37 CFR 1.18 is $_____. The publication fee, if required by 37 CFR 1.18(d), is $_____.
   (c) ☒ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
   (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
   (b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

lgd

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

PAGE 5/14 * RCVD AT 2/7/2007 10:22:45 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-3/19 * DNIS:2709805 * CSID:+ * DURATION (mm-ss):04-52

Attachment to Notice of Abandonment

For questions concerning the notice contact Office of Patent Publication Image Assistance Center: 888-786-0101.

Information is also available on the USPTO Internet web site:
http://www.uspto.gov/web/patents/pubs/abandonnotice.html

Respond to the Notice of Abandonment by one of the following:

1. **Petition To Withdraw Holding of Abandonment (See MPEP 711.03(c) I and 37 CFR § 1.181) No fee required**

Where an applicant contends that the application is not in fact abandoned (e.g., a reply was in fact filed), a petition under 37 CFR § 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action. Any petition under 37 CFR § 1.181 to withdraw the holding of abandonment not filed within 2 months of the mail date of a Notice of Abandonment may be dismissed as untimely under 37 CFR § 1.181(f). In order for a petition to be granted, the evidence must be sufficient according to 37 CFR § 1.8(b) Certificate of Mailing 37 CFR § 1.10 "Express Mail" mailing or MPEP 503 Postcard Receipt as Prima Facie Evidence. The petition should be addressed as follows:
By mail: Mail Stop: Issue Fee, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450
By facsimile: 571-273-8300

2. **Petition To Withdraw Holding Of Abandonment Based On Failure To Receive Office Action (MPEP 711.03(c) II and 37 CFR § 1.181). No fee required**

Where an applicant contends that the original Notice of Allowance and Fee(s) Due was never received, if adequately supported, the Office may grant the petition and remail the Office action. The showing required establishing non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received 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 would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement.
Petition should be addressed to the Technology Center handling the application as follows:
By mail: Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450
By facsimile: 571-273-8300

3. **Petition To Revive An Abandoned Application (See MPEP 711.03(c) III)**

Where there is no dispute as to whether an application is abandoned (e.g., the applicant's contentions merely involve the cause of abandonment) a petition under 37 CFR § 1.137 (a) or (b) (accompanied by the appropriate petition fee) is necessary to revive the abandoned application. The text of these rules is available on the USPTO Internet Web site. Forms for these petitions, "Petition For Revival Of An Application For Patent Abandoned Unavoidably Under 37 CFR § 1.137(a)," PTO/SB/61, and "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)," PTO/SB/64, are available in the forms section of the USPTO website: http://www.uspto.gov.

Petitions under 37 CFR § 1.137 should be addressed to the Office of Petitions as follows:
By mail: Mail Stop Petition, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450
By facsimile: 571-273-8300

Note: 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

PAGE 6/14 * RCVD AT 2/7/2007 10:22:45 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-3/19 * DNIS:2709805 * CSID:+ * DURATION (mm-ss):04-52

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Marco Scibora
Appln. No.:	09/759,798
Filed:	January 12, 2001
For:	COMPRESSION AND REMOTE STORAGE APPARATUS FOR DATA, MUSIC AND VIDEO
Examiner:	Bharat Barot
Group Art Unit:	2155
Confirmation No.:	3374
Attorney:	Gerald E. Helget
Attorney Docket No.:	33046.23
Additional Fees:	Charge to Deposit Account No. 02-3732

MAIL STOP ISSUE FEE
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

TRANSMITTAL COVER LETTER

Sir:

Enclosed for filing, please find the following:

1. Fee Transmittal Sheet
2. Check in the amount of $1,030.00
3. Copy of Notice of Allowance
4. Postcard Receipt.

Respectfully submitted,

Dated: 11/14/06

By Nelson R Capes

Gerald E. Helget (Reg. No. 30,948)
Nelson R. Capes (Reg. No. 37,106)
Briggs and Morgan, P.A.
2200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
Telephone: (612) 977-8480

CERTIFICATE OF MAILING

I hereby certify that this document, along with the documents referenced above, are being deposited as first class mail with the United States Postal Service, in an envelope addressed to, MAIL STOP ISSUE FEE, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date indicated below.

By: Nelson R Capes

Date: 11/14/06

1965396v1

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

NOTICE OF ALLOWANCE AND FEE(S) DUE

32300 7590 08/15/2006
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80 SOUTH 8TH ST
MINNEAPOLIS, MN 55402

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EXAMINER	
BAROT, BHARAT	
ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 08/15/2006

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,798	01/12/2001	Marco Scibora	13686-106	3374

TITLE OF INVENTION: COMPRESSION AND REMOTE STORAGE APPARATUS FOR DATA, MUSIC AND VIDEO

Advanced Communication Design 33046.23

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	$700	$300	$0	$1000	11/15/2006

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PAGE 9/14 * RCVD AT 2/7/2007 10:22:45 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-3/19 * DNIS:2709805 * CSID:+ * DURATION (mm-ss):04-52

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,798	01/12/2001	Marco Scibora	13686-106	3374

32300 7590 08/15/2006

BRIGGS AND MORGAN P.A.
2200 IDS CENTER
80 SOUTH 8TH ST
MINNEAPOLIS, MN 55402

EXAMINER
BAROT, BHARAT

ART UNIT	PAPER NUMBER
2155	

DATE MAILED: 08/15/2006

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 502 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 502 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

PAGE 10/14 * RCVD AT 2/7/2007 10:22:45 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-3/19 * DNIS:2709805 * CSID:+ * DURATION (mm-ss):04-52

Notice of Allowability	Application No.	Applicant(s)	
	09/759,798	SCIBORA, MARCO	
	Examiner	Art Unit	
	Bharat N. Barot	2155	

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

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to *amendment filed on 04/17/2006*.

2. ☒ The allowed claim(s) is/are *1-31*.

3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
   a) ☐ All b) ☐ Some* c) ☐ None of the:
      1. ☐ Certified copies of the priority documents have been received.
      2. ☐ Certified copies of the priority documents have been received in Application No. _____ .
      3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

   * Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
   (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
   (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

   Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 3/14/06 & 4/26/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____ .
7. ☐ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

Bharat Barot

BHARAT BAROT
PRIMARY EXAMINER
(571) 272-3979

PAGE 11/14 * RCVD AT 2/7/2007 10:22:45 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-3/19 * DNIS:2709805 * CSID:+ * DURATION (mm-ss):04-52

CHECK HAS A COLORED BACKGROUND AND A PINK INK SQUARE IN BOTTOM RIGHT CORNER. RUB SQUARE AND INK WILL FADE AND REAPPEAR.

BRIGGS AND MORGAN

Briggs and Morgan, Professional Association
W2200 First National Bank Building
332 Minnesota Street
St. Paul MN 55101-1396

U.S. Bank
Nicollet Mall
Minneapolis, Minnesota 55402-2157

194761

Pay: One thousand thirty and 00/100**********

Date: 11/14/2006

Amount $ ***1,030.00***

TWO SIGNATURES REQUIRED IF OVER $2000.00
VOID 180 DAYS AFTER DATE OF ISSUE

TO THE ORDER OF: Commissioner of Patents

Lynn M Mattson

[redacted]

Vendor ID: 11714

Check #: 194761

Inv Date	Client	Matter	G/L Acct	Narrative	Amount	Inv Total
Nov 14/06	33046	00023		Issue Fee, publication fee, patent copies. VENDO	1,030.00	1,030.00
				Invoice : 111406		
				Check Totals:		$1,030.00

Briggs and Morgan Professional Association THE ATTACHED CHECK IS IN PAYMENT OF ITEMS DESCRIBED ABOVE. Detach and Retain this Statement

BEST AVAILABLE COPY

U.S. Bank Confidential Communication

Requested by: LINDA PERLICH

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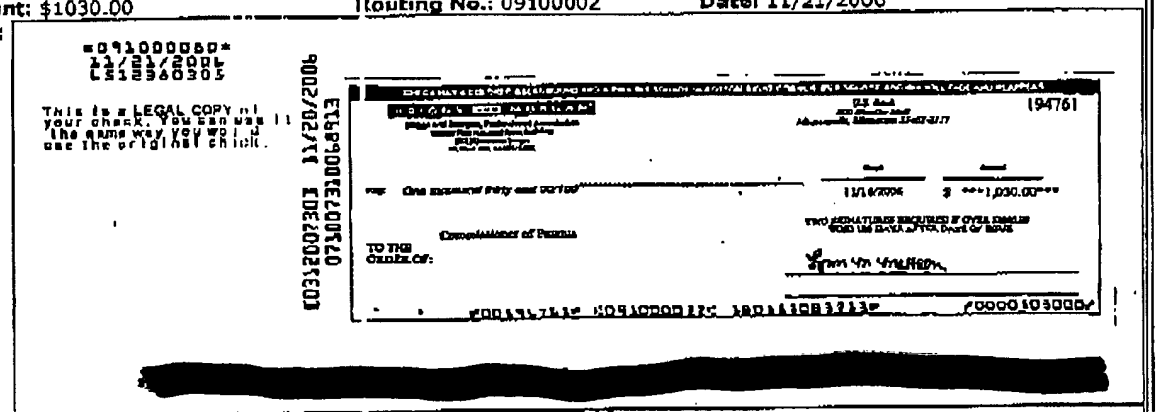
Item #1

Account No.: 180111083713 **Check No.:** 194761 **Sequence No.:** 005946051165

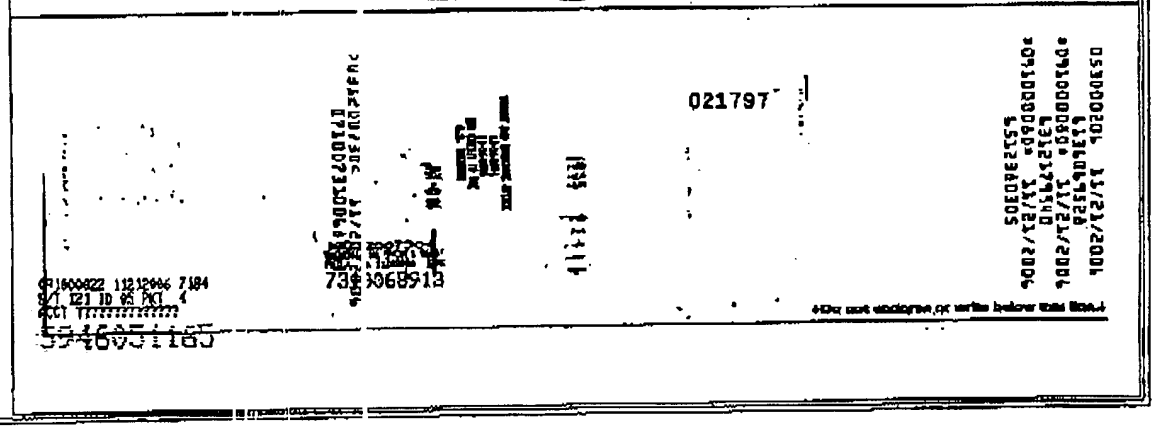
Amount: $1030.00 **Routing No.:** 09100002 **Date:** 11/21/2006

Front:



[redacted]

Back:



PAGE 13/14 * RCVD AT 2/7/2007 10:22:45 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-3/19 * DNIS:2709805 * CSID:+ * DURATION (mm-ss):04-52

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OIPE IAP65 NOV 16 2006 PATENT & TRADEMARK

Applicant: Marco Solbora
Appln. No.: 09/795,798
Filed: January 12, 2001
For: COMPRESSION AND REMOTE STORAGE APPARATUS FOR DATA, MUSIC AND VIDEO

Receipt is hereby acknowledged by the U.S. Patent and Trademark Office for the following:

1. Transmittal Cover Letter
2. Fee Transmittal Sheet (Form PTOL-85)
3. Copy of Notice of Allowance
4. Check in the amount of $1,030.00

for the above-referenced patent application.

Docket No. 33046.23 November 14, 2006 GEH:lms

Adv. Comm. Designs

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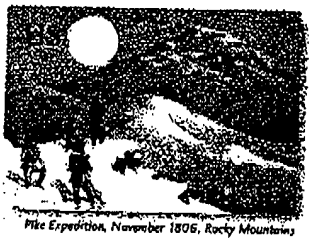
IP DOCKETING DEPT



Pike Expedition, November 1806, Rocky Mountains

Briggs and Morgan, P.A.
2200 IDS Center
80 South 8th Street
Minneapolis, MN 55402

PAGE 14/14 * RCVD AT 2/7/2007 10:22:45 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-3/19 * DNIS:2709805 * CSID:+ * DURATION (mm-ss):04-52
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United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 7

DAVID C READ ESQ
MARSHALL O'TOOLE GERSTEIN MURRAY & BORUN
6300 SEARS TOWER
233 SOUTH WACKER DRIVE
CHICAGO IL 60606-6402

COPY MAILED

DEC 3 1 2002

OFFICE OF PETITIONS

In re Reissue Application of :
Lowell R. Tully, Stephen A. :
Johnson, Dave Konieczny, Stephen :
R. Estes :
Patent No. 5,858,142 :
Application No. 09/759,823 : DECISION ACCORDING STATUS
Isued: January 12, 1999 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 29627/36393
Title: ANGULAR ORIENTATION CONTROL
SYSTEM FOR FRICTION WELDING

This is in response to the petition, filed January 12, 2001, under 37 CFR 1.47(a). The Office apologizes for the delay.

The petition under 37 CFR 1.47(a) is **GRANTED**.

The above-identified reissue application was filed on January 12, 2001, without a fully executed declaration. Concurrent with the filing of the reissue application, applicant filed a petition under 37 CFR 1.47(a). With the instant petition, applicant filed a reissue declaration executed by inventors Lowell Tully, Dave Konieczny, and Stephen Estes, on behalf of themselves and on behalf of non-signing inventor Stephen Johnson.

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, drawings, oath or declaration); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

With the instant petition, attorney David C. Read included a copy of a cover letter dated December 27, 2000, transmitting the reissue declaration and issued patent to Johnson through his attorney, Matthew Yeakey. According to Read, no executed reissue declaration from Johnson has been received.

The declaration filed January 12, 2001, and the petition have been reviewed and found to be 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 inventors at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

The application file is being forwarded to the Technology Center 1700 for examination of the reissue application.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.

For

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

STEPHEN A JOHNSON
16495 W MADISON
SOUTH BEND IN 46614

COPY MAILED

DEC 3 1 2002

OFFICE OF PETITIONS

In re Reissue Application of
Lowell R. Tully, Stephen A. Johnson, Dave Konieczny, Stephen R. Estes
Patent No. 5,858,142
Issued: January 12, 1999
Title: ANGULAR ORIENTATION CONTROL SYSTEM FOR FRICTION WELDING

LETTER

Dear Mr. Johnson:

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 C.F.R. 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 C.F.R. 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 (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 C.F.R. 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Cliff Congo at (703) 305-0272. 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).

For

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

David C. Read
Marshall, O'Toole, Gerstein, Murray & Borun
6300 Sears Tower
233 South Wacker Drive
Chicago, Illinois 60606-6402
(312)474-6300

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HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 272400
FORT COLLINS, CO 80527-2400

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JAN 26 2005

OFFICE OF PETITIONS

In re Application of :
Daniel R. Marshall :
Application No. 09/759,867 :
Filed: January 12, 2001 :
Attorney Docket No. 10002307-1 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 14, 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 April 19, 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 reply submitted on June 14, 2004 did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed November 17, 2004. 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) was obtained. Accordingly, the above-identified application became abandoned on July 20, 2004.

The above-identified application is being revived solely for purposes of continuity with a submission under 37 CFR 1.114 (request for continued examination (RCE)).

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.

Pursuant to petitioner's authorization, Deposit Account No. 08-2025 was charged a total of $2,290.00 -- $1,500.00 for the petition to revive an unintentionally abandoned application and $790.00 for the RCE fee.

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

This matter is being referred to Technology Center 2182 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Amendment.

Wan Layman

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

cc: MICHAEL BINZAK
DICKE BILLIG AND CZAGA PA
100 S 5TH ST STE 2250
MINNEAPOLIS, MN 55402

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Paper No. 3

MAIL

JAN 0 6 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

FERNANDEZ & ASSOCIATES LLP
1047 El Camino Real
Suite 201
Menlo Park, CA 94025

In re Application of
Jonathan C. SALAS, et al
Application No. 09/759,868
Filed: January 12, 2001
For: SYSTEM AND METHOD FOR DYNAMIC ALLOCATION OF COMPUTING TASKS

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed December 1, 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 communication 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 U.S. Patent and Trademark Office (the Office) of any change in correspondence address to ensure receipt of all communications from the Office.

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

cc: John J. Bruckner
Gray Cary Ware & Freidenrich LLP
1221 South MoPac Expressway
Suite 400
Austin, TX 78746-6875

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Fernandez & Associates, LLP
P.O. Box D
Menlo Park, CA 94026-6204

MAILED

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Technology Center 2100

In re Application of:
Jonathan C. SALAS, et al.
Application No. 09/759,868
Filed: January 12, 2001
For: SYSTEM AND METHOD FOR DYNAMIC ALLOCATION OF COMPUTING TASKS

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed July 30, 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 signer of the petition, Dennis S. Fernandez, is no longer an attorney or agent of record; therefore he is not authorized to act on behalf of the attorney(s) of record. Accordingly, the request is **DENIED.**

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

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Paper No. 15

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

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JUN 1 2 2003

OFFICE OF PETITIONS

In re Application of
Kirjavainen et al.
Application No. 09/759,938
Filed: January 11, 2001
Title of Invention: DIELECTRIC CELLULAR ELECTRET FILM AND PROCEDURE FOR ITS MANUFACTURE

DECISION GRANTING DECISION UNDER 37 CFR 1.78(a)(3)

This is a decision on the Petition to Accept Unintentionally Delayed Claim Under 35 U.S.C. §365(C) for the Benefit of a Prior Filed Application, which is treated as a petition under 37 CFR 1.78(a)(3) to accept an unintentionally delayed claim under 35 U.S.C. §120 for benefit of the filing date of national stage application No. PCT/FI95/00426, filed August 11, 1995.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

> **(1)** the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(I) of the prior-filed application, unless previously submitted;[1]

---

[1] Any nonprovisional application or international application designating the United States of America claiming the benefit of one or more prior-filed copending applications or international applications designating the United States of America must contain or be amended to contain a reference (amendment to the first line of the specification following the title or in an application data sheet (ADS)), to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date filing date and indicating the relationship of the applications.

(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)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on January 11, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed national stage application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

Also, the instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Further to this, the reference to the prior-filed application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) 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 instant application is entitled to the benefit of the earlier filing date.

Cross references to other related applications may be made when appropriate (*see* § 1.14).

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

This application is being forwarded to Technology Center Art Unit 1771 for consideration by the examiner of applicant's entitlement to the claim of the benefit of priority under 35 U.S.C. § 120 to prior-filed national stage application No. PCT/FI95/00426, filed August 11, 1995, and for consideration of the Amendment, filed February 25, 2003 with a request for a three (3) month extension-of-time, in response to the non-final Office action, mailed on September 11, 2002.

ATTACHMENT: Corrected Filing Receipt

Telephone inquiries concerning this matter should be directed to petitions attorney Derek L. Woods at (703) 305-0014.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions

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DILLON & YUDELL LLP
8911 NORTH CAPITAL OF TEXAS HWY
SUITE 2110
AUSTIN, TX 78759

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OFFICE OF PETITIONS

In re Application of Cromer et al. :
Application No. 09/759,953 :
Filing Date: January 12, 2001 :
Attorney Docket No. RPS920000080US1 :

Decision on Petition

This is a decision on the petition under 37 CFR 1.137(b), filed December 14, 2005, to revive the above-identified application.

The petition is **granted**.

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed July 27, 2005, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on October 28, 2005. A Notice of Abandonment was mailed on December 8, 2005.

The instant petition requests revival of the application.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Therefore, the petition is granted and the application is revived.

The Office of Publications will be informed of the instant decision and a patent will be issued 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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CENTRAL COAST PATENT AGENCY, INC
3 HANGAR WAY SUITE D
WATSONVILLE, CA 95076

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JUL 25 2007

OFFICE OF PETITIONS

In re Application of :
Stuart Berkowitz, et al. :
Application No. 09/760,028 : ON PETITION
Filed: January 12, 2001 :
Attorney Docket No. 668437600004 :

This is a decision in response to the petition, filed April 9, 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 August 29 2006. A Notice of Abandonment was mailed on March 21, 2007. In response, on April 9, 2007, the present petition was filed.

The petition satisfies the conditions for revival pursuant to the provisions 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.

The application is being referred to Technology Center AU 1621 for consideration of the amendment filed March 7, 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

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.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

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OCT 3 1 2008

OFFICE OF PETITIONS

Patent No. 7,401,327	:	LETTER REGARDING
Issue Date: July 15, 2008	:	PATENT TERM ADJUSTMENT
Application No. 09/760,031	:	AND
Filed: January 12, 2001	:	NOTICE OF INTENT TO ISSUE
Atty Docket No. 09612.1014-02000	:	CERTIFICATE OF CORRECTION

This letter is in response to the "NOTICE OF ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT" filed April 8, 2008. Pursuant to patentees' duty of good faith and candor to the Office, patentees disclose that the correct patent term adjustment period is three hundred ninety (390) days, not five hundred sixty-four (564) days.

The request for reconsideration of patent term adjustment indicated in the patent is **GRANTED to the extent indicated herein**.

For the reasons stated herein, 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 **one hundred ninety-eight (198)** days.

On July 15, 2008, this application matured into U.S. Patent No. 7,401,327, with a revised patent term adjustment of 564 days. Patentees give no basis for their assertion that the correct patent term adjustment is 390 days.

A review of the application history confirms that patentees are correct that the patent term adjustment of 564 indicated on the patent is incorrect. Additional periods of reduction pursuant to 37 CFR 1.704(b) and 1.704(c)(8) are warranted.

37 CFR 1.704(b) provides that:

> [A]n 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.

A review of the record reveals that applicants failed to engage in reasonable efforts to conclude processing or examination within the meaning of 37 CFR 1.704(b) on two occasions not recognized by the Office. First, applicants did not file a request for continued examination (RCE) in response to the final Office action mailed December 21, 2006, until June 14, 2007, three months and 85 days later. Second, applicants did not file a RCE in response to the final Office action mailed June 15, 2005, until December 15, 2005, three months and 91 days later. Thus, pursuant to 37 CFR 1.704(b), periods of reduction of 85 and 91 days are being entered for applicant delay in taking in excess of three months to reply to an Office action.

Further, 37 CFR 1.704(c)(8) provides that:

> Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, 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 initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

A review of the record reveals that applicants failed to engage in reasonable efforts to conclude processing or examination within the meaning of 37 CFR 1.704(c)(8) on two occasions not recognized by the Office. First, a period of reduction of 11 days should have been entered for applicant delay in filing an Information Disclosure Statement (IDS) on November 18, 2003 after having filed a Request for Continued Examination (RCE) and submission on April 13, 2005. Neither IDS was expressly requested by the examiner. Neither IDS included a § 1.704(d) statement. Accordingly, pursuant to 1.704(c)(8), periods of reduction of 128 and 62 days should have been entered.

In view thereof, the patent should have issued with a revised patent term adjustment of one hundred ninety-eight (198) days 751 (681 + 70) days of Office delay - 553 (63 + **128** + **91** + 94 + **85** + **62** + 30) days of applicant delay.

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 **ONE HUNDRED NINETY-EIGHT (198)** days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson

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 : 7,401,327 B2

DATED : **July 15, 2008** **DRAFT**

INVENTOR(S) : Halstead, Jr. 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 564 days

Delete the phrase "by 564 days" and insert – by 198 days--

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Paper No.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

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DEC 15 2008

Patent No. 7,401,327	:	**CORRECTED**[1] LETTER REGARDING
Issue Date: July 15, 2008	:	PATENT TERM ADJUSTMENT
Application No. 09/760,031	:	AND
Filed: January 12, 2001	:	NOTICE OF INTENT TO ISSUE
Atty Docket No. 09612.1014-02000	:	CERTIFICATE OF CORRECTION

This letter is in response to the "NOTICE OF ERROR IN THE DETERMINATION OF PATENT TERM ADJUSTMENT" filed April 8, 2008. Pursuant to patentees' duty of good faith and candor to the Office, patentees disclose that the correct patent term adjustment period is three hundred ninety (390) days, not five hundred sixty-four (564) days.

The request for reconsideration of patent term adjustment indicated in the patent is **GRANTED to the extent indicated herein**.

For the reasons stated herein, 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 **one hundred ninety-eight (198)** days.

On July 15, 2008, this application matured into U.S. Patent No. 7,401,327, with a revised patent term adjustment of 564 days.

---

[1] This decision is issued to correct a word processing error. No change is made to the calculation of patent term adjustment of 198 days set in the decision as originally mailed on October 31, 2008. Rather this decision corrects the bases for entry of periods of reduction of 128 and 62 days pursuant to 37 CFR 1.704(c)(8). The prior decision did not set forth the proper bases.

Patentees give no basis for their assertion that the correct patent term adjustment is 390 days.

A review of the application history confirms that patentees are correct that the patent term adjustment of 564 indicated on the patent is incorrect. Additional periods of reduction pursuant to 37 CFR 1.704(b) and 1.704(c)(8) are warranted.
37 CFR 1.704(b) provides that:

> [A]n 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.

A review of the record reveals that applicants failed to engage in reasonable efforts to conclude processing or examination within the meaning of 37 CFR 1.704(b) on two occasions not recognized by the Office. First, applicants did not file a request for continued examination (RCE) in response to the final Office action mailed December 21, 2006, until June 14, 2007, three months and 85 days later. Second, applicants did not file a RCE in response to the final Office action mailed June 15, 2005, until December 15, 2005, three months and 91 days later. Thus, pursuant to 37 CFR 1.704(b), periods of reduction of 85 and 91 days are being entered for applicant delay in taking in excess of three months to reply to an Office action.

Further, 37 CFR 1.704(c)(8) provides that:

> Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, 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 initial reply was filed and ending on the date that the supplemental reply or other such paper was filed;

A review of the record reveals that applicants failed to engage in reasonable efforts to conclude processing or examination within the meaning of 37 CFR 1.704(c)(8) on two occasions not recognized by the Office. First, a period of reduction of 128 days should have been entered for applicant delay in filing an Information Disclosure Statement (IDS) on April 13, 2005 after having filed a response on December 6, 2004. Second, a period of reduction of 62 days should have been entered for applicant delay in filing Information Disclosure Statements (IDS) on August 10 and 15, 2007[2] after having filed a Request for Continued Examination (RCE) and IDS on June 14, 2007. None of the IDSs were expressly requested by the examiner. None included a § 1.704(d) statement. Accordingly, pursuant to 1.704(c)(8), periods of reduction of 128 and 62 days should have been entered.

In view thereof, the patent should have issued with a revised patent term adjustment of one hundred ninety-eight (198) days 751 (681 + 70) days of Office delay - 553 (63 + **128** + **91** + 94 + **85** + **62** + 30) days of applicant delay.

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 **ONE HUNDRED NINETY-EIGHT (198)** days.

---

[2] The period of delay for filing the IDS on August 10, 2007 overlaps with the period of delay for filing the IDS on August 15, 2007. Pursuant to 37 CFR 1.704(c)(8), a single reduction of 62 days is being entered for both failures to engage in reasonable efforts to conclude prosecution.

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

Day : Friday
Date: 12/12/2008

PALM INTRANET

Time: 12:22:03

PTA Calculations for Application: 09/760031			
Application Filing Date:	01/12/2001	PTO Delay (PTO):	751
Issue Date of Patent:	07/15/2008	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	187
Post-Issue Petitions:	0	Total PTA (days):	198
PTO Delay Adjustment:	-366		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
115	10/31/2008	RECORD A PETITION DECISION OF GRANTED FOR PATENT TERM ADJUSTMENT AFTER ALLOWANCE			
114	10/28/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		62	
113	10/28/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		85	
112	10/28/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		91	
111	10/28/2008	ADJUSTMENT OF PTA CALCULATION BY PTO		128	
107.5	06/25/2008	PTA 36 MONTHS			
107	07/15/2008	PATENT ISSUE DATE USED IN PTA CALCULATION			
106	06/17/2008	EXPORT TO FINAL DATA CAPTURE			
105	06/12/2008	FINISHED INITIAL DATA CAPTURE			
104	06/13/2008	DISPATCH TO FDC			
103	06/12/2008	APPLICATION IS CONSIDERED READY FOR ISSUE			
102	06/11/2008	RESPONSE TO REASONS FOR ALLOWANCE			
101	06/11/2008	ISSUE FEE PAYMENT VERIFIED			
100	06/11/2008	ISSUE FEE PAYMENT RECEIVED			
99	04/25/2008	EXPORT TO INITIAL DATA CAPTURE			
97	04/22/2008	MAIL NOTICE OF ALLOWANCE			
96	02/26/2008	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
91	03/25/2008	ISSUE REVISION COMPLETED			
90	03/25/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
89	03/25/2008	EXAMINER'S AMENDMENT COMMUNICATION			
88	03/17/2008	DOCUMENT VERIFICATION			
87	03/11/2008	NOTICE OF ALLOWABILITY			

83	01/24/2008	PARALEGAL TD ACCEPTED			
82	01/23/2008	DATE FORWARDED TO EXAMINER			
81	12/27/2007	RESPONSE AFTER NON-FINAL ACTION		30	79
80	12/27/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
79	08/27/2007	MAIL NON-FINAL REJECTION			
78	08/20/2007	NON-FINAL REJECTION			
77	08/10/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
76	08/10/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
75	08/15/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
74	08/15/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
73	08/15/2007	MISCELLANEOUS INCOMING LETTER			
72	08/15/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
71	08/14/2007	MISCELLANEOUS INCOMING LETTER			
70	08/10/2007	REFERENCE CAPTURE ON IDS			
69	08/10/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
68	06/14/2007	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
66	06/14/2007	REFERENCE CAPTURE ON IDS			
65	06/14/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
64	06/18/2007	DATE FORWARDED TO EXAMINER			
63	06/14/2007	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
62	06/18/2007	DATE FORWARDED TO EXAMINER			
61	06/14/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
60	06/18/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
59	06/14/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
58	06/14/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
57	06/14/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
56	12/21/2006	MAIL FINAL REJECTION (PTOL - 326)			

55	12/11/2006	FINAL REJECTION			
54	09/27/2006	DATE FORWARDED TO EXAMINER			
53	09/25/2006	RESPONSE AFTER NON-FINAL ACTION		94	51
52	09/25/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
51	03/23/2006	MAIL NON-FINAL REJECTION			
50	03/20/2006	NON-FINAL REJECTION			
49	02/01/2006	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
48	01/27/2006	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
47	01/10/2006	DATE FORWARDED TO EXAMINER			
46	12/15/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
45	01/10/2006	DATE FORWARDED TO EXAMINER			
44	12/15/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			
43	01/10/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
42	12/15/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
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40	06/15/2005	MAIL FINAL REJECTION (PTOL - 326)	70		32
39	06/13/2005	FINAL REJECTION			
38	04/13/2005	REFERENCE CAPTURE ON IDS			
37.7	04/13/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
37	04/13/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
36	12/06/2004	MISCELLANEOUS INCOMING LETTER			
35.7	12/06/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
35	12/06/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
34	12/06/2004	NEW OR ADDITIONAL DRAWING FILED			
33	04/08/2005	DATE FORWARDED TO EXAMINER			
32	12/06/2004	RESPONSE TO RULE 105 REQUIRED FOR INFORMATION FILED			
31	03/22/2005	CASE DOCKETED TO EXAMINER IN GAU			
30	12/06/2004	WORKFLOW INCOMING AMENDMENT IFW			

29	11/30/2004	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
28	11/16/2004	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
27	11/23/2004	CORRESPONDENCE ADDRESS CHANGE			
26	11/24/2004	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
25	10/07/2004	MAIL INDEPENDENT RULE 105 COMMUNICATION			
24	10/01/2004	REQUIREMENT UNDER RULE 105 - INDEPENDENT COMMUNICATION			
22	07/20/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
21	07/20/2004	DATE FORWARDED TO EXAMINER			
20	06/24/2004	RESPONSE AFTER NON-FINAL ACTION		63	15
19	06/24/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
18	02/02/2004	REFERENCE CAPTURE ON IDS			
17	06/24/2004	WORKFLOW INCOMING AMENDMENT IFW			
16.7	02/02/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
16	02/02/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	01/22/2004	MAIL NON-FINAL REJECTION	681		-1
14	01/12/2004	NON-FINAL REJECTION			
13	12/11/2003	CASE DOCKETED TO EXAMINER IN GAU			
12.7	09/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	09/10/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	06/22/2003	CASE DOCKETED TO EXAMINER IN GAU			
10.7	01/27/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	01/27/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	12/23/2002	CASE DOCKETED TO EXAMINER IN GAU			
8	11/08/2002	CASE DOCKETED TO EXAMINER IN GAU			
7.7	02/12/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
7	02/12/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			

6	02/27/2002	CASE DOCKETED TO EXAMINER IN GAU			
5.7	01/04/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
5	01/04/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
4	03/02/2001	APPLICATION DISPATCHED FROM OIPE			
3	02/27/2001	CORRESPONDENCE ADDRESS CHANGE			
2	01/31/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	01/12/2001	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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UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,401,327 B2

DATED : July 15, 2008 DRAFT

INVENTOR(S) : Halstead, Jr. 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 564 days

Delete the phrase "by 564 days" and insert – by 198 days--

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON DC 20001-4413

MAILED

OCT 01 2009

OFFICE OF PETITIONS

In re Patent No. 7,401,327	:	ON PETITIONS
Halstead et al.	:	under 37 CFR 1.183
Issue Date: July 15, 2008	:	and
Application No. 09/760,031	:	ON REQUEST FOR RECONSIDERATION
Filed: January 12, 2001	:	OF PATENT TERM ADJUSTMENT
Attorney Docket No.	:	
09612.1014-02000	:	
	:	

This is a decision on the 1) Petition under 37 C.F.R. 1.183, requesting that the Office waive the requirements of 37 C.F.R. §1.705(d) and consider on the merits a Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) filed more than two months from the date the above-referenced patent issued; and on the 2) Request for Determination of Patent Term Adjustment - Post Grant, both filed on January 9, 2009.

The petition under 37 CFR 1.183 is **dismissed**.

The request for reconsideration of patent term adjustment under 37 CFR 1.705(d) is **dismissed as untimely filed**.

Any request for reconsideration, whether directed to the decision on petition under 37 CFR 1.183 or to the decision on application for patent term adjustment under 37 CFR 1.705(d), must be filed within two months of the mailing date of this decision. Extensions of time under 37 CFR 1.136 are not permitted. See § 1.181(f).

BACKGROUND

On July 15, 2008, the above-identified application matured into U.S. Patent No. 7,401,327, with a revised patent term adjustment of 564 days. By decision mailed October 31, 2008[1] and issuance of a Certificate of Correction dated November 25, 2008, the revised patent term adjustment was corrected to 198 days. This correction was pursuant to the letter regarding patent term adjustment filed April 8, 2008, disclosing pursuant to their duty of candor and good faith that the initial determination of patent term adjustment was longer than appropriate.

No request for reconsideration of the patent term adjustment indicated in the patent was filed within two months of the date the patent issued. Patentee now petitions under 37 C.F.R. § 1.183 to (i) waive the requirement of 37 C.F.R. § 1.705(d) that a Request for Reconsideration of Patent Term Adjustment be filed within two months of the date the patent issued; and (ii) consider the enclosed Request for Reconsideration of Patent Term Adjustment. Patentee references the recent decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. Sept. 30, 2008) as the basis for the petition.

ON PETITION UNDER 37 CFR 1.183
TO WAIVE THE TWO-MONTH REQUIREMENT OF 37 CFR 1.705(d)

The above-referenced patent issued on July 15, 2008. A request for reconsideration of the patent term adjustment indicated in the patent was not filed until January 9, 2009. Petitioner requests that the Office waive the rules and consider on the merits the Request for Reconsideration of Patent Term Adjustment under 37 C.F.R. 1.705(d) even though it was untimely filed more than two months from the date the patent issued.

The relevant regulation, 37 CFR 1.705(d), provides that:

> If there is a revision to the patent term adjustment indicated in the notice of allowance, the patent will indicate the revised patent term adjustment. If the

[1] A corrected decision was mailed on December 15, 2008. This decision did not make a substantive change in the decision, but rather corrected language that was inadvertently omitted from the original decision.

> patent indicates or should have indicated a revised patent term adjustment, *any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued* and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section. Any request for reconsideration under this section that raises issues that were raised, or could have been raised, in an application for patent term adjustment under paragraph (b) of this section shall be dismissed as untimely as to those issues. (*emphasis* added).

By the express provisions of 37 CFR 1.705(d), a request for reconsideration of patent term adjustment must be filed within two months of the date the patent issued. It is undisputed that no such request for reconsideration was filed by September 15, 2008, the date two months from the date this patent issued, July 15, 2008. Rather, on January 9, 2009, more than three months after the issuance of a decision in Wyeth v. Dudas on September 30, 2008, petitioner filed the instant request for waiver of the two-month requirement.

37 CFR 1.183 provides that:

> 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, requires the Office to provide the applicant one opportunity to request reconsideration of any patent term adjustment determination made by the Director, authorizes the Director to establish the procedures for requesting such reconsideration. Those procedures[2] include pursuant to 37 CFR

---

[2] 35 U.S.C. § 154(b)(3) provides that the USPTO shall: (1) prescribe regulations establishing procedures for the application for and determination of patent term adjustments under 35 U.S.C. § 154(b); (2) make a determination of any patent term adjustment under 35 U.S.C. § 154(b) and transmit a notice of that determination with the notice of allowance under 35 U.S.C. § 151; and (3) provide the applicant one opportunity to request reconsideration of any patent term adjustment determination. Pursuant to the mandate and authority in 35 U.S.C. § 154(b)(3), the USPTO promulgated 37

1.705(d) setting a two-month period for filing a request for reconsideration of the revised patent term adjustment indicated in the patent.

Having considered petitioner's arguments, it is concluded that waiver of the two-month requirement is not warranted. The primary basis for requesting waiver set forth by petitioner is the recent decision in Wyeth v. Dudas, No. 07-1492 (D.D.C. Sept. 30, 2008). Specifically, petitioner states that in Wyeth, the U.S. District Court for the District of Columbia ruled that the PTA should be determined as the sum of the term adjustments of separate time periods, rather than the greater one of the term adjustments.

Petitioner has not explained why it could not have filed a Request for Reconsideration of Patent Term Adjustment within two months of the date the above-referenced patent issued. Apparently, petitioner's argument is that the basis for the Request for Reconsideration of Patent Term Adjustment is the Wyeth decision, which was entered more than two months after the issuance of their patent.

The fact that any relief ultimately granted in Wyeth would benefit patentee had they timely filed a request for reconsideration does not make the situation extraordinary. Wyeth followed the procedure set forth in 37 CFR 1.705 for requesting reconsideration of the patent term adjustment determination. Then, pursuant to 35 U.S.C. 154(b)(4)(A), Wyeth timely filed a complaint in District Court seeking judicial review of the Office's decision. A Memorandum Opinion and Order, the Wyeth decision of September 30, 2008, directed to the parties involved was issued.

C.F.R. § 1.705, which provides that: (1) the notice of allowance will include notification of any patent term adjustment under 35 U.S.C. § 154(b)(37 C.F.R. § 1.705(a)); (2) any request for reconsideration of the patent term adjustment indicated in the notice of allowance (except as provided in 37 C.F.R. § 1.705(d)) must be by way of an application for patent term adjustment filed no later than the payment of the issue fee and accompanied by (inter alia) the fee set forth in 37 C.F.R. § 1.18(e)(37 C.F.R. § 1.705(b)); and (3) if the patent indicates or should have indicated a revised patent term adjustment, any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued.

Petitioner chose not to challenge their revised patent term adjustment within the two-month period. Petitioner's argument that they could not have filed a Request for Reconsideration of Patent Term Adjustment within two months of the date the above-referenced patent issued because the basis for the Request for Reconsideration of Patent Term Adjustment is the Wyeth decision, which was entered more than two months after the issuance of their patent, is not persuasive.

Petitioner could have filed a Request for Reconsideration of Patent Term Adjustment as Wyeth did. It is acknowledged that petitioner may have chosen not to file a request for reconsideration based on a conclusion that the Office's interpretation of 35 U.S.C. § 154(b)(2)(A) was correct. Nonetheless, the fact that the District Court has now issued an Opinion contrary to the Office's interpretation does not make the situation extraordinary. This is not unlike any other situation where a patentee (or applicant) challenges a final agency decision and the decision upon judicial review could have had applicability to another patentee (or applicant) had they taken such action. In fact, many patentees may be in the same situation as petitioner with respect to the Wyeth decision. In addition, given that the law only allows 180 days for both the filing of a petition and for the Office's consideration of that petition, petitioner's unexplained nearly four-month delay in filing the petition weighs against them.

Petitioner simply fails to articulate how their failure to file a request for reconsideration of patent term adjustment within two months of the issue date of the patent was due to an extraordinary situation. Petitioner cannot rely on Wyeth's actions or the Wyeth decision to establish that their situation was extraordinary.

The contention that a decision is in error is a basis for a timely request for review of the decision but does not justify a delay in seeking review of such decision.

The Office provided notice that petitions under 37 CFR 1.182 and 1.183 or requests for certificate of corrections under 35 USC 354 and §1.323 or 35 U.S.C. 255 and §1.324 are not substitute *fora* to obtain to obtain reconsideration of a patent term adjustment determination indicated in a notice of allowance if applicant fails to submit a request for reconsideration within the time period specified in §1.705(b) or to obtain

reconsideration of a patent term adjustment determination indicated in a patent if a patentee fails to submit a request for reconsideration within the time period specified in §1.705(d). See 69 Fed. Reg. 21704, 21707 (April, 22, 2004).

In view thereof, the petition under 37 CFR 1.183 for waiver of the two-month requirement of 37 CFR 1.705(d) is **dismissed**.

Accordingly, consideration now turns to the Request for Reconsideration of Patent Term Adjustment under 37 CFR 1.705(d).

ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(d)

This is a decision on the "DETERMINATION OF PATENT TERM ADJUSTMENT - POST GRANT," filed January 9, 2009. Therein, patentee requests correction of the patent term adjustment (PTA) indicated in the patent to eight hundred ninety-one (891) days.

On July 15, 2008, the above-identified application matured into U.S. Patent No. 7,401,327 with a revised patent term adjustment of 564 days. The instant request for reconsideration was filed almost five months after the issuance of the patent, on January 9, 2009.

No error in the printing of the patent has been shown. The patent term adjustment indicated on the patent reflects the Office's determination of patent term adjustment shown in the PAIR system for this application. 37 CFR 1.705(d) provides the sole avenue before the Office for requesting reconsideration of the Office's determination of patent term adjustment indicated in the patent. Moreover, § 1.705(d) states that "any request for reconsideration of the patent term adjustment indicated in the patent must be filed within two months of the date the patent issued and must comply with the requirements of paragraphs (b)(1) and (b)(2) of this section." Since the request was not filed within two months of the issue date of the patent, the request is properly **dismissed as untimely filed**.

CONCLUSION

It is determined that waiver of the requirement pursuant to 37 CFR 1.183 is not warranted. Accordingly, the request for reconsideration of the patent term adjustment under 37 CFR

1.705(d) filed more than two months after the issue date of the patent is dismissed as untimely filed.

Receipt of the fees required for the petition under 37 CFR 1.183 and the application for patent term adjustment is acknowledged.

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

Nancy Johnson for

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 7

MOTOROLA, INC.
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IL01/3RD
SCHAUMBURG IL 60196

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OFFICE OF PETITIONS

In re Application of
Joseph Rinchiuso et al.
Application No. 09/760,039
Filed: January 12, 2001
Attorney Docket No.: CE08395R
Title: PACKET DATA TRANSMISSION WITHIN A BROAD-BAND COMMUNICATION SYSTEM

DECISION ON PETITION
UNDER 37 C.F.R. §1.137(b)

This is a decision on the petition filed on September 24, 2001, pursuant to 37 C.F.R. §1.137(b)[1], to revive the above-identified application.

The Office regrets the delay in issuing this decision. The petition was only recently forwarded to the Office of Petitions.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice of Missing Parts (notice[2]), mailed February 23, 2001, which set a shortened statutory period for reply of two (2) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on April 24, 2001.

---

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.

2 The Notice indicated that an oath or declaration along with the associated fee, and substitute drawings would be required.

With this petition, petitioner submitted the petition fee, the filing fee, the fee associated with the late filing of an oath or declaration, and a declaration.

The instant petition is not grantable because requirement (1) again has not been satisfied.

Regarding the first requirement above, the petitioner has failed to submit the complete required reply, in that he has not submitted substitute drawings, as required by the notice. It is noted that on November 2, 2001, a Notice of Incomplete Reply (Nonprovisional) was sent to the petitioner, reminding him that substitute drawings were required.

Therefore, this petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

On renewed petition, petitioner must submit the required reply.

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 reply to this letter may be submitted by mail[3], hand-delivery[4], or facsimile[5]. **Please note that the later two have changed, as of December 1, 2003.**

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (703) 305-0011.

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

3 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
4 Customer Window, Mail Stop Petition, Crystal Plaza Two, Lobby, Room 1B03, Arlington, Virginia 22202
5 (703) 872-9306.

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OFFICE OF PETITIONS

In re Application of
Joseph Rinchiuso et al.
Application No. 09/760,039
Filed: January 12, 2001
Attorney Docket No.: CE08395R
Title: PACKET DATA TRANSMISSION WITHIN A BROAD-BAND COMMUNICATION SYSTEM

DECISION ON RENEWED PETITION UNDER 37 C.F.R. §1.137(b)

This is a decision on the renewed petition filed January 15, 2004 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 in a timely manner to the Notice of Missing Parts (notice[2]), mailed February 23, 2001, which set a shortened statutory period for reply of two (2) months. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the above-identified application became abandoned on April 24, 2001.

With the original petition, filed September 24, 2001, petitioner submitted the petition fee, the filing fee, the fee associated with the late filing of an oath or declaration, and a declaration.

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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.

2 The Notice indicated that an oath or declaration along with the associated fee, and substitute drawings would be required.

This petition was dismissed via the mailing of a decision on December 16, 2003, for failure to submit substitute drawings.

With this renewed petition, petitioner submitted the requisite drawings.

As such, the renewed petition is **GRANTED**.

After this decision is mailed, the application will be forwarded to the Office of Initial Patent Examination (OIPE) for further processing.

Telephone inquiries concerning *this decision* should be directed to the undersigned at (703) 305-0011. Questions pertaining to this application should be directed towards the Office of Initial Patent Examination at (703) 308-1202.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6-29-07

TO SPE OF : Technology Center 1615

09/760046

SUBJECT : Request for Certificate of Correction on Patent No.: 7029700 B2

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:

MICHAEL P. WOODWARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

SPE — **Art Unit** 1615

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Number: 7,029,700 Date Issued: April 18, 2006

Application Number: 09/760,046 Filed: January 12, 2001

Name of Patentee: Edith Mathiowitz, Yong S. Jong, and Jules S. Jacob

Title of Invention: *MICRONIZED FREEZE-DRIED PARTICLES*

ATTN: Certificate of Correction Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REQUEST FOR CERTIFICATE OF CORRECTION OF PATENT DUE TO PTO'S AND APPLICANT'S ERRORS

Sir:

OK to ENTER
CS 8/20/07

Attached is form PTO/SB/44, which is suitable for printing.

In accordance with MPEP 1485, the exact page and/or claim and line number where errors occurred in the application file are discussed below:

LIST OF ERRORS IN THE PATENT

1. Claim 1, column 46, line 58.
2. Claim 11, column 47, line 30.
3. Claim 24, column 48, line 33.

PTO'S ERRORS

In error 1, claim 1, column 46, line 58, "eta" should be "of a". Support for this correction is found in the amendment filed February 18, 2005, page 2.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9/6/2005

TO SPE OF : ART UNIT 1700 (1725)

SUBJECT : Request for Certificate of Correction on Patent No.: 6,841,134

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.

okay to enter drawings as requested?

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:

OK to enter

SPE

1725
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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APR 09 2007

Technology Center 2100

Edmund J. Sease
McKee, Voorhess & Sease, P.L.C.
801 Grand Avenue, Suite 3200
Des Moines, Iowa 50309-2721

In re Application of:
Bonnstetter et al
Application No. 09/760,145
Filed: January 12, 2001
For: Network Based Document Distribution Method

DECISION ON PETITION UNDER 37 C.F.R. § 1.181 TO Force Entry of an 131 Declaration

This is a decision on the petition filed May 12, 2006 under 37 CFR § 1.181 requesting the forced entry of the 131 declaration to overcome a 103 rejection using the Dirksen reference for the first time in the Final rejection of January 12, 2006.

A review of the file reveals that the October 19, 2006 office action no longer rellied on Dirksen thus rendering the declaration moot.

For the above stated reasons, the petition is **Dismissed as Moot**.

Tod Swann
Quality Assurance Specialist
Technology Center 2100
Computer Architecture, Software, and Information Security

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. 16

Ingrassia Fisher & Lorenz
7150 E. Camelback, Suite 325
Scottsdale, AZ 85251

COPY MAILED
OCT 15 2003
OFFICE OF PETITIONS

In re Application of	:	
Joseph L. Sullivan et al.	:	
Application No. 09/760,212	:	ON PETITION
Filed: January 12, 2001	:	
Attorney Docket No. 1023-253US01	:	

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 within the meaning of 37 CFR 1.113 in a timely manner in reply to the final Office action mailed December 6, 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 March 7, 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 3762 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

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AUG 30 2005

OFFICE OF PETITIONS

Bernard Malina
Bernard Malina, Esq.
Malina & Wolson
60 East 42nd Street
New York NY 10165-0501

In re Application of
COHEN
Application No.: 09/760,277
Attorney Docket No.: MS-678

: DECISION on PETITION
:
: UNDER 37 CFR 1.137(b)
:

This is a decision on the petition under 37 CFR 1.137(b), filed 21 January 2005 to revive the above-identified application.

The petition is **DISMISSED**.

The above-identified application became abandoned for failure to reply in a timely manner to Notice to File Corrected Application Papers mailed February 22, 2001, which set a 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 at midnight on April 22, 2001. A Notification of Abandonment was mailed on June 5, 2003.

The provisions of 37 CFR 1.137(b) provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application pursuant to 37 CFR 1.137(b) . A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by: (1) the 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 set forth in 37 CFR 1.20(d) required pursuant to 37 CFR 1.137(c).

The instant petition does not satisfy requirement (2) above. A petition fee of $685 was submitted and is insufficient. The requisite petition fee, effective 08 December 2004, for a petition to revive unintentionally abandoned application is $1500 ($750 for a small entity). Applicant did not provide an authorization to charge fees to his deposit account. Without payment of the full petition fee, the petition is dismissed.

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

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

By fax: 571-273-
Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22313

Telephone inquiries concerning this decision should be directed to Cynthia Kratz at (571) 272-3286 or in her 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

SEP 30 2005

OFFICE OF PETITIONS

Bernard Malina
Bernard Malina, Esq.
Malina & Wolson
60 East 42nd Street
New York NY 10165-0501

In re Application of
YEHUDA COHEN
Application No.: 09/760,277
Attorney Docket No.:MS-678

: DECISION on PETITION
:
: UNDER 37 CFR 1.137(b)
:

This is a decision on the petition under 37 CFR 1.137(b), filed 21 January 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 Notice to File Missing Parts mailed February 21, 2001, which set a period for reply of two (2) months. Extensions of time under the provisions of 37 CFR 1.136(a) were available. Accordingly, the above-identified application became abandoned at midnight on September 21, 2001.

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 substitute drawings, (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Office action of February 21, 2001 is accepted as having been unintentionally delayed.

The application is being referred to Office of Initial Patent Examination for further processing.

Telephone inquiries concerning this decision should be directed to Cynthia Kratz at (571) 272-3286 or in her 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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 8

FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP
FOUR EMBARCADERO CENTER, SUITE 3400
SAN FRANCISCO CA 94111-4187

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JUL 1 7 2002

OFFICE OF PETITIONS

In re Application of :
Hau H. Duong et al :
Application No. 09/760,384 :
Filed: January 11, 2001 :
Atty Docket No. A-68718-2/RFT/RMS/RMK :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 24, 2002, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned by operation of law for failure to timely submit substitute drawings in compliance with 37 CFR 1.84 within two months of the May 24, 2001 Notice to File Missing Parts of Nonprovisional Application. A five month extension of time pursuant to the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the date of abandonment of this application is December 25, 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. 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.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 305-8680.

The application file is being forwarded to the Office of Initial Patent Examination Division for pre-examination processing.

Frances Hicks

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
P.O. Box 1450
Alexandria, VA 22313-1450
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JUN 2 8 2005

OFFICE OF PETITIONS

Brinks,Hofer, Gilson & Lione
PO Box 10395
Chicago, Illinois 60610

In re Application of
Shiga
Application No. 09/760,393
Filed: January 12, 2001
Attorney Docket No. 9281/3876

: DECISION HOLDING PETITION IN ABEYANCE

This is a decision on the "REQUEST FOR RECONSIDERATION UNDER § 1.705(b) OF PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(b) INDICATED IN THE NOTICE OF ALLOWANCE," filed October 12, 2004. Applicant requests that the patent issuing from the above-identified patent application be afforded a patent term adjustment of fort hundred and forty-three(443) additional days, to one thousand and ninety-eight (1098)days. The sole basis for this request is the Office taking in excess of three years to issue the patent.

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.

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). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. Any delays in issuance of the patent will be provided for in the issuance notification letter mailed prior to the issuance of the patent.

Telephone inquiries specific to this matter should be directed to Kery Fries, Senior Legal Advisor, Office of Patent Legal Administration, at (571) 272-7757.

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

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Brinks Hofer Gilson & Lione
P.O.Box 10395
Chicago, Illinois 60610

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SEP 15 2005

OFFICE OF PETITIONS

In re Application of
Shiga
Application No. 09/760,399
Filed: January 12, 2001
Attorney Docket No. 9281-3876

: DECISION HELD IN ABEYANCE

This is a decision on the "REQUEST FOR RECONSIDERATION Of PATENT TERM ADJUSTMENT UNDER 35 U.S.C. § 154(d)," filed October 12, 2004. Applicants request that the patent issuing from the above-identified patent application be afforded a patent term adjustment of one hundred and ninety-seven (197) additional days, to eight hundred and fifty-two (852) days. The sole basis for this request is the Office taking in excess of three years to issue the patent.

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.

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 authorization to charge a fee of the $200.00 fee set forth in 37 CFR 1.18(e) to Deposit Account 23-1925 . No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. Any delays in issuing the application more than four months after payment of the issue fee and other requirements being satisfied will be reflect in the issue notification letter mailed approximately 3 weeks prior to issuance.

Telephone inquiries specific to this matter should be directed to Kery Fries at 571-272-7757.

Kery Fries
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
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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

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SEP 22 2005
OFFICE OF PETITIONS

In re Application	:	
Joseph, et al.	:	
Application No. 09/760,434	:	PATENT TERM ADJUSTMENT
Filed: January 12, 2001	:	
Dkt. No.: 00-551	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(b)," filed August 2, 2005.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is **GRANTED TO THE EXTENT INDICATED HEREIN**.

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 939 days. A copy of the updated PAIR screen showing the correct determination is enclosed.

Applicants request that the Determination of Patent Term Adjustment be corrected from 780 days, as indicated on the Determination of Patent Term Adjustment mailed May 12, 2005, to 870 days.

A review of the application history reveals that in accordance with 37 CFR 1.702(a)(1), an adjustment of 870 days can be attributed to the Office. The adjustment began March 13, 2002, the day after the date that is 14 months from the date the application was filed, and ended July 29, 2004, the date the non-final Office action was mailed. *See*, 37 CFR 1.703(a)(1).

In accordance with 37 CFR 1.702(a)(2), a further adjustment of 72 days can be attributed to the Office. The adjustment began March 2, 2004, the day after the date that is four months after the date that the response to the non-final Office action was filed, and ended May 12, 2005, the date the Notice of Allowance was mailed. *See*, 37 CFR 1.703(a)(2).

The Office errantly entered January 27, 2005 as the date of reply to the non-final Office action was filed, rather than November 1, 2004, the date the response was in fact received as evidenced by the copy of the date stamped postcard receipt submitted with the instant application. Applicants' are reminded that the date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation.

Accordingly, the adjustment of 942 days is reduced three days in accordance with 37 CFR 1.704(b) for applicants' failure to engage in reasonable efforts to conclude prosecution (or processing). The reduction began October 30, 2004, the day after the date that is three months after the date that the non-final Office action was mailed, and ended November 1, 2004, the date a reply was filed.

In view thereof, at the time of Notice of Allowance the application is entitled to a patent term adjustment of 939 days.

Receipt of the required patent term adjustment application fee of $200.00 is hereby acknowledged.

This application is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery Fries

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

Enclosure: Copy of Adjustment PAIR Calculation

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 02-14-09

TO SPE OF : ART UNIT 2112

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/760514 Patent No.: 7243294

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

Certificates of Correction Branch
703-308-9390 ext. 123

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: This correction is for typographical errors and does not introduce new matter. /JDT/

/Scott T. Baderman/ — **SPE**

2114 — **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA
22ND FLOOR
CHICAGO IL 60606

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OCT 19 2005

OFFICE OF PETITIONS

In re Patent No. 6,801,148 :
Issue Date: October 5, 2004 :
Application No. 09/760,531 : ON PETITION
Filed: January 16, 2001 :
Attorney Docket No. 1693-81437 :

This is a decision on the petition, filed August 30, 2005, which is being treated as a petition 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 petition is GRANTED.

The 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 the undersigned at (571) 272-3204. Questions regarding the certificate of correction should be directed to Certificate of Corrections Branch at (703) 305-8309.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1] *See* Official Gazette of June 22, 2004

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AUG 3 0 2005

81437

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Pat. No.: 6,801,148 B2

Inventor: Freeman et al.

Serial No.: 09/760,531

Issued: October 5, 2004

For: BEAMFORMED ULTRASONIC IMAGER WITH DELTA-SIGMA FEEDBACK CONTROL

Attorney Docket No.: 1693-81437

Petition to Correct the Assignee

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

Sir:

In response to the Communication mailed August 3, 2005 (copy attached), attached are copies of *two* Notices of Recordation from the parent application (Patent No. 5,964,708) showing the Assignee in one Assignment to be The Regents of the University of Michigan (Reel/Frame 9092/0476), and the Assignee in the other Assignment to be Q-Dot, Inc. (Reel/Frame 9092/0471).

Patentee requests that 37 CFR 3.81(a) be waived to permit the correct name of the assignee to be provided. Patentee states that the failure to include the correct assignee name on form PTOL-85B was inadvertent.

Should this Petition be granted, Patentee requests that this Petition be forwarded to the Certificates of Correction Branch for issuance of a Certificate of Correction.

The Commissioner is hereby authorized to charge Deposit Account No. 23-0920 in the amount of $130 to cover the fee for the Petition. Should any further fee be

08/31/2005 NNGUYEN1 00000059 230920 09760531
01 FC:1464 130.00 DA

1808

PAGE 3/16 * RCVD AT 8/30/2005 3:12:09 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/29 * DNIS:2738300 * CSID: * DURATION (mm-ss):04-18

Adjustment date: 10/19/2005 AKELLEY
08/31/2005 NNGUYEN1 00000059 230920 09760531
01 FC:1464 130.00 CR
10/19/2005 AKELLEY 00000004 230920 09760531
01 FC:1808 130.00 DA

needed, please charge our Deposit Account No. 23-0920, and deem this paper to be the required petition.

The Examiner is requested to phone the undersigned should any questions arise that can be dealt with over the phone to expedite this prosecution.

Respectfully submitted,
WELSH & KATZ, LTD.

By
Jon P. Christensen
Registration No. 34,137

Enclosures:
Copy of Communication dated August 3, 2005
2 Notice of Recordations from parent application (Patent No. 5,964,708)

August 30, 2005
WELSH & KATZ, LTD.
120 South Riverside Plaza
22nd Floor
Chicago, Illinois 60606
(312) 655-1500

PAGE 4/16 * RCVD AT 8/30/2005 3:12:09 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-6/29 * DNIS:2738300 * CSID: * DURATION (mm-ss):04-18

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: X

DATE : October 05,2007

TO SPE OF : ART UNIT 2121

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/760,569 Patent No.: 6880009 B2

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: _____

SPE

2121
Art Unit

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

JENKENS & GILCHRIST
Suite 3200
1445 Ross Avenue
Dallas TX 75202--2799

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NOV 2 1 2001

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Charas :
Application No. 09/760,572 :
Filed: January 15, 2001 :
Attorney Docket No. 51656-3USPX :

This is a decision on the petition filed October 10, 2001, to accord the above-identified application a filing date of January 15, 2001, instead of January 16, 2001.

The petition is **granted**.

37 CFR 1.10(c) states,

> 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.

All of the above requirements have been met. Therefore, the application will be accorded a filing date of January 15, 2001.

The file is now being forwarded to the Office of Initial Patent Examination to accord the application a filing date of January 15, 2001.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

Charles Steven Brantley
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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DICKINSON WRIGHT PLLC
1901 L. STREET NW
SUITE 800
WASHINGTON DC 20036

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JUL 19 2006
OFFICE OF PETITIONS

In re Application of	:	
Lin et al.	:	
Application No. 09/760,596	:	DECISION ON PETITION
Filed: 16 January, 2001	:	
Atty Docket No. 46599-00245	:	

This is a decision on the petition filed on 25 May, 2006, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 24 December, 2004, for failure to file a reply to the Notice of Noncompliant Amendment (37 CFR 1.121), mailed on 23 November, 2004, which set a one (1) month shortened period for reply. No extensions of time in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 3 October, 2005.

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[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional 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 present petition is accompanied by an amendment as the required reply.

This application is being referred to Technology Center Art Unit 2616 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

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MARLBOROUGH, MA 01752-3064

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JUN 22 2007

OFFICE OF PETITIONS

In re Application of	:	
BURGESS et al	:	
Application No.: 09/760,721	:	DECISION ON PETITION
Filing Date: January 17, 2001	:	UNDER 37 CFR 1.137(B)
Attorney Docket No.: 922-120	:	

This is a decision on the petition under 37 CFR 1.137(b), filed April 6, 2007, to revive the above-identified application.

The petition is **DISMISSED.**

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed May 3, 2005, which set a statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on August 4, 2005.

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before June 8, 1995.

The instant petition does not satisfy requirement (3) above. Specifically, the petition fails to state that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)."

Further correspondence with respect to this matter should be addressed 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 Bryan Lin at (571) 272-3303.

Bryan Lin

Bryan Lin
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

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AUG 24 2007

OFFICE OF PETITIONS

In re Application of	:	
BURGESS et al	:	
Application No.: 09/760,721	:	DECISION ON PETITION
Filing Date: January 17, 2001	:	UNDER 37 CFR 1.137(B)
Attorney Docket No.: 922-120	:	

This is a decision on the renewed petition under 37 CFR 1.137(b), filed July 23, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to submit the issue fee and publication fee in a timely manner in reply to the Notice of Allowance mailed May 3, 2005, which set a statutory period for reply of three (3) months. Accordingly, by operation of law, the above-identified application became abandoned on August 4, 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 issue fee and publication fee; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the payment of the issue fee and publication fee is accepted as having been unintentionally delayed.

This application is being referred to the Office of Publications.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3303.

BryanLin

Bryan Lin
Legal Examiner
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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BIRCH, STEWART, KOLASCH & BIRCH, LLP
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

In re Application of: Satoshi SETO	)	
Application No.: 09/760,795	)	
Filed: January 17, 2001	)	**DECISION ON PETITION *UNDER 37 CFR §1.181* to RESET PERIOD FOR REPLY**
Attorney Docket No.: 2091-0229P-SP	)	
For: IMAGE EDITING METHOD AND SYSTEM	)	
	)	

This is a decision on the petition filed July 31, 2008 under 37 CFR § 1.181 to reset the Office action response date under MPEP 710.06 for an Office action not received. The delay in responding to the instant petition is regretted.

A review of the file record indicates that an Examiner's Answer was mailed on April 4, 2008. Most recently, a letter of Express Abandonment was filed in the instant application on January 6, 2009. The above-identified papers have been entered into the file. The response filed January 6, 2009 thus renders the request to reset the period for reply to the April 4, 2008 Examiner's Answer moot.

Accordingly, in view of the above stated reason, the instant petition, filed on July 31, 2008 to reset the period for reply to the April 4, 2008 action, is rendered moot. The application is being forwarded to the technology support staff in order to process the letter of Express Abandonment filed January 6, 2009.

Accordingly, the petition is **DISMISSED as MOOT**.

The instant application is being forwarded to the Examiner for appropriate action on the merits. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,795	01/17/2001	Satoshi Seto	2091-0229P-SP	4941

7590 01/15/2009
BIRCH, STEWART, KOLASCH & BIRCH, LLP
P.O. BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER
EL CHANTI, HUSSEIN A

ART UNIT	PAPER NUMBER
2457	

MAIL DATE	DELIVERY MODE
01/15/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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AUG 16 2006

In re PATENT APPLICATION of:
MARIA PALASIS
Application No. 09/760,807
Filed: January 17, 2001
For: Attorney Docket No. 120113/58101

DECISION ON PETITION

This is a decision on the petition filed on August 31, 2004 by which Petitioner requests reconsideration and withdrawal of the election of species requirement rendered February 24, 2004 and made final in the Office action dated June 15,2004, and that withdrawn claims 4, 6, 7, 11, 13, 15, 17-19, 22 and 25-27 be reinstated and continued to be examined on the merits. The petition is considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required.

The petition is granted.

A review of the record shows that an election of species requirement was made on February 24, 2004 subsequent to four examinations of claims to all species disclosed in this application.

This application was originally filed with 25 claims drawn to the various species. During the course of the prosecution of this application, claims 5, 16 and 24 have been cancelled and new claims 26 and 27 were added. The subject matter of claims 26 is commensurate with the subject matter of amended claim 13 presented in the petitioner's amendment dated May 16, 2002. The subject matter of claim 27 is commensurate with the subject matter of amended claim 1 presented in petitioner's amendment dated February 28, 2003.

As per MPEP 802.02 in order to require petitioner to elect a single species for examination, two criteria must be satisfied:

1. that each species must be distinct as claimed, and
2. that there would be a serious burden on the examiner if the requirement was not made.

Aside from the fact that neither criteria above has been shown by the examiner, the undersigned concurs with petitioner that, in this case, restriction of the claims can not be proper because the subject matter of each of the pending claims has already been searched. The examiner's willingness to examine the subject matter of all the pending claims (in this case, four different times) is a representation by the Patent Office that all pertinent areas have been searched and, in so doing, indicates that the Examiner did not believe that the examination of all the respective inventions imposed a burden as required for insisting upon restriction as per the guidelines in the MPEP, section 808.02.

For the reasons outlined above, the election of species requirement promulgated and construed as being made final is not in accordance with proper Office procedure. Accordingly, the Office action dated February 24, 2004 is hereby vacated.

As a further procedural note, as this petition grants Petitioner relief from the election of species requirement, the previously withdrawn claims will be reinstated and all amendments thereto are deemed responsive to which a new Office action will be rendered. The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3763 who will have the examiner promulgate an action on the merits of the presently pending claims not inconsistent with this decision.

PETITION GRANTED.

Frederick Schmidt, Director
Technology Center 3700

KURT L. VAN VOORHIES, PH.D., P.E., P.C.
P.O. BOX 68
DETOUR VILLAGE, MI 49725

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OFFICE OF PETITIONS

In re Patent No. 6,889,386	:	
Issued: March 3, 2005	:	
Application No. 09/760,839	:	ON PETITION
Filed: January 17, 2001	:	
Attorney Docket No. 0465-0807P-SP	:	

This is a decision on the petition under 37 CFR 1.182, filed March 19, 2007, requesting issuance of a duplicate Letters Patent for the above-identified application.

The petition is **GRANTED**.

The Publishing Division is directed to issue a duplicate Letters Patent.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3206. Any questions concerning issuance of the duplicate Letters Patent should be directed to Krystal Paige at (703) 308-9250.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: Krystal Paige, P/OPPD, South Tower 8C41 (FAX 571-273-9756)

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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

MAILED

FEB - 9 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Hiroyuki Shibata, et al.
Application Serial No.: 09/760,883
Filed: January 17, 2001
For: **DISPLAY APPARATUS WITH REDUCED NOISE EMISSION AND DRIVING METHOD FOR THE DISPLAY APPARATUS**

DECISION
ON PETITION

This is a decision on the letters filed November 12, 2004, December 28, 2004 and petition filed January 28, 2005. Each of the aforementioned communications from applicant are treated as petition to the Director from an action of the examiner, pursuant to 37 CFR § 1.181.

Petitioner states in their November 12, 2004 communication that "Accordingly, withdrawal of the Finality of the Action mailed July 28, 2004 is mandated since premature, pursuant to MPEP 706.07(c) through 706.07(e), and the same accordingly should be withdrawn and a new, non-final Office Action issued, setting a new Response period based on the mailing date of same.

Petitioner in their December 28, 2004 communication, refers to the subject matter of the November 12, 2004 letter. A copy of the November 12, 2004 letter was supplied with the December 28, 2004 communication from applicant. In addition, the December 28, 2004 communication presented arguments as to the relevancy of the applied Kawakami reference.

Petitioner states in their January 28, 2005 communication that "The current Action of January 12, 2005 repeats identically the prior art rejections of the pending claims, as they were presented in the Action of July 28, 2004 – and, it follows, that the final rejection is premature for the identical reason that the July 28, 2004 final rejection was premature." Petitioner requests that the finality of the Office action be withdrawn. Petitioner refers to MPEP §706.07(a) and emphasizes the point that second or subsequent actions on the merits shall be final, **except** where an examiner introduces a new ground of rejection that is not necessitated by the Applicant's amendment of the claims.

A review of the file records reveals that:

> A non-final Office action was mailed on December 12, 2003 wherein claims 1-2, 10, 14-15, 19, 23, 27-28 and 34-39 were rejected under 35 U.S.C. §103 as being obvious in view of Morrison. Claims 4, 8, 12, 17, 21, 25 and 30 were rejected under 35 U.S.C. §103 as being obvious over Morrison in view of applicant's admission of prior art. Claims 5, 9, 13, 18, 22, 26 and 31 were rejected under 35 U.S.C. §103 as being obvious over Morrison in view of Tanaka. Claim 6 and 40 were rejected under 35 U.S.C. §103 as being obvious over Jagdt. Claim 32 was rejected under 35 U.S.C. §103 as being obvious over Morrison in view of Nakata. Claim 33 was rejected under 35 U.S.C. §103 as being obvious over Morrison in view of Cooper. Claims 41-47 were rejected under 35 U.S.C. §103 as being obvious over Morrison in view of Jagdt. Claims 7, 11, 20 and 24 were indicated allowable and finally, claims 3, 16 and 29 were objected to.
>
> On May 12, 2004 applicants submitted an amendment whereby certain dependent claims were cancelled and the word "plasma" was incorporated into the claim chain of the remaining claims.

On July 28, 2004, a final Office action was mailed whereby claims 3, 7, 11, 16, 20, 24, 29 and 48 through 52 were rejected under 35 U.S.C. § 112 1st paragraph. Claims 1-2, 10, 14-15, 19, 23, 27-28 and 34-39 were rejected under 35 U.S.C. §103 as being obvious in view of Kawakami. Claims 5, 13, 18, 22, 26 and 31 were rejected under 35 U.S.C. §103 as being obvious in view of Kawakami in view of Tanaka et al. Claim 32 was rejected under 35 U.S.C. §103 as being obvious over Kawakami in view of Nakata et al. Claim 33 was rejected under 35 U.S.C. §103 as being obvious over Kawakami in view of Cooper. Claims 41-47 were rejected under 35 U.S.C. §103 as being obvious over Kawakami in view of Jagdt. Claims 6, 9 and 40 were indicated as being allowable.

On November 12, 2004 and again on December 28, 2004, Applicant filed requests to have the July 28, 2004 finality of the Office action withdrawn, withdrawal of the Office action in its entirety and issuance of a new, non-final Office action setting a new response period.

In addition, the December 28, 2004 communication from applicant, presented arguments as to the applied 35 U.S.C. §112 1st paragraph rejection and also presented arguments with respect to the Kawakami reference, newly cited in the July 28, 2004 Office action.

On January 12, 2005, the Office mailed a new final Office action which maintained the same grounds of rejection, with the exception of the 112 1st paragraph rejection, as applied in the July 28, 2004 Office action.

With respect to applicant's November 12, 2004 request (re-submitted on December 28, 2004), to withdraw the Office action and issue a new non-final Office action, the request was filed not only outside two months from the action complained of as established by 37 C.F.R. §1.181(f), but also outside the shortened statutory time period for response to the outstanding Office action. Moreover, other than the appropriateness of the finality of the Office action, Petitioner did not provide appropriate justification why the Office action excluding the finality thereof, was improper under 37 C.F.R. §1.104. The issue of whether or not Petitioner agrees with the art applied to the claims, is not a petitionable matter but rather part of the examination process.

With respect to petitioner's November 12, 2004 request (re-submitted on December 28, 2004) to withdraw the finality of the July 28, 2004 Office action, the examiner, in accordance with MPEP §706.07(a) and (d), agreed with petitioner and withdrew the finality of the July 28, 2004 action as stated in the first section of the Office action mailed January 12, 2005.

Accordingly, the petition filed November 12, 2004 and re-submitted on December 28, 2004, is hereby **Granted in Part** to the extent that the finality of the July 28, 2004 Office action was withdrawn by the examiner in their next Office action, i.e., January 12, 2005.

The communication submitted December 28, 2004 not only re-submitted the request from November 12, 2004, but applicant also argued distinction between their claims and the applied Kawakami reference. Applicant requests: "Accordingly, we ask that you reconsider not only the premature Final rejection but also the irrelevance of Kawakami with respect to the invention defined by the pending claims of the present application."

37 CFR § 1.111. Reply by applicant or patent owner to a non-final Office action, states in part:
(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. [emphasis added]

The December 28, 2004 communication requested reconsideration of the action in which the Kawakami reference was applied. Given that Kawakami was the base reference for all claim rejections, applicants' December 28, 2004 communication was properly taken as a full and proper response to the outstanding Office action.

It is noted at this point that in order for the December 28, 2004 communication to be considered a timely submission, in order to avoid abandonment of the application, a two month extension of time was required. Attached to the December 28, 2004 reply was a copy of the November 12, 2004 letter, wherein applicant states: "If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935." Accordingly, applicants' deposit account has been charged for a two month extension of time. [emphasis added]

Finally, with respect to Petitioner's January 28, 2005 communication which requests that the final Office action mailed January 12, 2005, be withdrawn, first stated that the grounds of rejection was not a result of applicants' amendment. It is agreed that the examiner used the wrong form paragraph in communicating the holding of finality of the Office action. However, this does not mean that the finality of the January 12, 2005 Office action was improper. Merely, that the examiner used the wrong form paragraph in noting the finality.

In addition, the January 28, 2005 petition states that "The current Action of January 12, 2005 repeats identically the prior art rejections of the pending claims, as they were presented in the Action of July 28, 2004 - and. it follows, that the final rejection is premature for the identical reason that the July 28, 2004 final rejection was premature."

MPEP §706.07(a) [R-1] Final Rejection, When Proper on Second Action, states in part:..

> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

It is argued that the January 28, 2005 final rejection is premature for the same reasons that the July 28, 2004 final rejection was premature. However, as acknowledged by applicants in their petition, the examiner maintained the same grounds of rejection as that set forth in the July 28, 2004 Office action, with the exception that the 112 1st paragraph rejection was not maintained.

Therefore, in accordance MPEP §706.07(a) the Office action was appropriately made final, i.e., the examiner did not introduce a new ground of rejection given that the same grounds set forth in the July 28, 2004 Office action, were maintained in the January 28, 2005 final Office action.

Accordingly, petitioner's request to withdraw the final Office action of January 28, 2005 is **Denied.**

The file is being forwarded to the Technology Center's Central Files to await Applicant's response to the outstanding Office action.

Leo Boudreau

Leo Boudreau, Acting Director
Technology Center 2600
Communications

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

In re Application of:
Hiroyuki Shibata, et al.
Application Serial No.: 09/760,883
Filed: January 17, 2001
For: **DISPLAY APPARATUS WITH REDUCED NOISE EMISSION AND DRIVING METHOD FOR THE DISPLAY APPARATUS**

DECISION
ON PETITION

This is a decision on the request for reconsideration of the Director's decision filed March 3, 2005, pursuant to 37 CFR § 1.181.

Petitioner states in their request for reconsideration that the original petition decision, mailed February 9, 2005, erred in the statement of facts, specifically regarding the request for withdrawal of final rejection mailed July 28, 2004. Petitioner also states that the February 9 decision erred in considering the December 28, 2004 submission as a response to the July 28, 2004 final rejection. Petitioner requests that the outstanding Office action be withdrawn and a new non-final Office action issued.

For the record, the Office erred in prematurely making the July 28, 2004 Office action a final rejection.

As stated by petitioner, the December 28, 2004 submission by applicant was merely applicants' record of an interview held between the examiner and applicants' counsel. Although the file record does not contain an interview summary, the December 28, 2004 submission will be considered a record of said interview.

The Office again erred by "withdrawing" the July 28, 2004 Office action, instead of vacating the previous action. Then, the Office mailed a new final Office action on January 28, 2005. Thus compounding the errors.

Therefore, in accordance with petitioner's request, both the July 28, 2004 and January 28, 2005 Office actions are hereby vacated.

The petition for reconsideration is **Granted.**

The file is being forwarded to the Examiner for preparation of a new non-final Office action.

Leo Boudreau

Leo Boudreau, Acting Director
Technology Center 2600
Communications

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Commissioner for Patents
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P.O. Box 1450
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10/27/09

Patent No. :7193596
Ser. No. :09/760883
Inventor(s) :HIROYUKI SHIBATA ET AL.
Issued : 1/17/01
Title : DISPLAY APPARATUS WITH REDUCED NOISE EMISSION AND DRIVING METHOD FOR THE DISPLAY APPARATUS
Docket No. :

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

Assignees' names and addresses (assignment data) printed in a patent, are based *solely* on information supplied in the appropriate space for identifying the assignment data, i.e., item 3 of the Issue Fee Transmittal Form PTOL-85B. Granting of a request under 37 CFR 3.81(b) is required to correct applicant's error providing ***incorrect or erroneous*** assignment data, *before* issuance of a Certificate of Correction, under 37 CFR 1.323 *(see Manual of Patent Examining Procedures (M.P.E.P) Chp.1400, sect. 1481).* This procedure is required *at any time after the issue fee is paid*, including after issuance of the patent.

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

A request to correct the Assignee under 37 CFR 3.81(b) should include:

A. **the processing fee set forth in 37 CFR 1.117(h) (currently $130);**
B. a statement that the failure to include the correct assignee name on the PTOL-85B was inadvertent; and
C. a copy of the Notice of Recordation of Assignment Document, reflecting the reel and frame number where the assignment(s) is recorded and/or reflecting proof of *the date* the assignment was submitted for recordation.

In the Request, Applicant(s) may request that the file be forwarded to Certificates of Correction Branch, for issuance of a Certificate of Correction, if the Request is granted.

Any request under 37 CFR 3.81(b) should be directed to the following address or facsimile number:

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

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

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

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, , no additional fee is required.

A certificate of correction will be issued to correct the remaining errors noted in your request.

Henry Randall
Decisions & Certificates
of Correction Branch
(703) 756-1571

STAAS & HALSEY
1201 NEW YORK AVENUE N.W.
7TH FLOOR
WASHINGTON DC 20005

HR

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STAAS & HALSEY LLP
SUITE 700
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WASHINGTON DC 20005

In re Patent No. 7,193,596 :
Issue Date: March 20, 2007 :
Application No. 09/760,883 : ON PETITION
Filed: January 17, 2001 :
Attorney Docket No. 1872.1005 :

This is a decision on the petition filed September 29, 2009, 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 "**FUJITSU HITACHI PLASMA DISPLAY LIMITED**" be added as an additional assignee to the issued patent, because Assignee "**FUJITSU HITACHI PLASMA DISPLAY LIMITED**" was inadvertently omitted from 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 all 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

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

set forth in § 1.20(a) and the processing fee set forth in § 1.17(i) of this chapter.

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 may be directed to Diane C. Goodwyn at (571) 272-6735. 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.

for Thurman K. Page
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. 14

KRISTIN K VIDOVICH
SHANKS & HERBERT
TRANSPOTOMAC PLAZA
1033 N FAIRFAX STREET
SUITE 306
ALEXANDRIA VA 22314

COPY MAILED

MAY 20 2002

OFFICE OF PETITIONS

In re Application of
Harrington et al.
Application No. 09/760,897
Filed: January 17, 2001
Attorney Docket No. 0221-0003OC

DECISION
DISMISSING PETITION

This is a decision on the petition under 37 CFR 1.53(e), filed March 8, 2002, to accord the above-identified application a filing date of January 17, 2001, with an indication that 166 pages of the application were present on filing.

The petition is **DISMISSED**

Applicant must submit any reply to this decision within TWO MONTHS of this mailing. See 37 CFR 1.181(f). Extensions of time are not available under 37 CFR 1.136(a) or (b). No further petition fee is due.

The instant application papers were deposited on January 17, 2001, as a purported continuation of application No. 09/515,124 filed February 27, 2000.[1]

However, on January 9, 2002, a "Notice of Omitted Item(s)" was mailed indicating that pages 53 and 54 of the specification were missing. The Notice offered 3 alternate options for action: (1) applicant could submit a petition and its fee along with evidence of deposit and contend the missing items were in fact deposited with the other application papers, (2) the missing items could be supplied along with a petition under 37 CFR 1.182 and its fee, and the date of submission would become the filing date, or (3) a failure to proceed under either foregoing option would be treated as a constructive acceptance of the application papers as deposited with the USPTO.

---

[1] Any issues as to the prior application's filing date, as discussed in a communication from applicant received March 5, 2002, as well as in the instant petition in this application, must be resolved by way of an appropriate petition captioned for, and filed in, the parent application. See 37 CFR 1.5.

In reply, applicant filed the instant petition and fee, and includes a copy of itemized postcard receipts for both the above-identified application papers, as well as those of the prior application. Petitioner points to the postcard receipt for the prior application papers, which specifically acknowledges receipt of 166 pages of specification in the USPTO on February 25, 2000, and the receipt for this application, indicating that applicant was filing a "complete copy of the prior application [papers]." Petitioner urges that since the parent application was complete and included 166 pages, and the papers filed for this application were asserted to be a copy of that complete application, all 166 pages for this application are entitled to a filing date of January 17, 2001,

Petitioner's arguments are not convincing. An appropriately itemized postcard receipt will serve as *prima facie* evidence of receipt at the USPTO of the documents enumerated thereon on the date in question. See MPEP 503. However, the postcard receipt for this application merely sets forth applicant's intent to file a copy of the prior application. Inspection of the profered receipt for this application shows that the USPTO merely acknowledged receipt of applicant's intended filing; but that the USPTO did not acknowledge receipt of 166 pages of specification drawings and claims for this application on January 17, 2001.

The postcard receipt for this application did not separately list the number of pages of the application papers that were being submitted. As set forth in MPEP 503, a postcard receipt will **not** serve as *prima facie* evidence of receipt of any item that is not adequately itemized on the postcard, and specifically sets forth that a receipt bearing a general indication of the filing of an application will not, as here, serve as evidence of receipt of any missing pages. Thus, since the receipt in question did not separately list the exact number of pages of the application being filed, but merely that an application was being filed, the instant postcard cannot be relied upon as evidence that the missing pages 54, 55 in question were received at the USPTO on January 17, 2001.

At best, the evidence supplied with the petition demonstrates applicant's attempt to file a copy of the prior application, not that all 166 pages of that prior application were in fact received at the USPTO on the date in question. Likewise, applicant's attempt to "piggyback" the receipt of papers for the parent case which contained 166 pages must therefore fall of its own weight, as that postcard receipt of 166 pages of application papers for the parent case on February 25, 2000, does not refute the contents of this file which are the official record of what was received at the USPTO on January 17, 2001. Pages 54 and 55 of the specification are simply not in this file and cannot be located. Were the postcard receipt for the papers for this application annotated with the same detailed itemization as that for the prior application, and receipt of 166 pages for this application specifically acknowledged by the USPTO, then applicant's arguments would be better founded. It is unfortunate that the two postcards did not contain the same degree and specificity of itemization, assuming *arguendo* that petitioner did in fact mail all 166 pages to the USPTO.

Accordingly, the instant application is not entitled to a filing date of January 17, 2001, containing pages 54, 55 of the specification.

Petitioner is advised that, for future reference, when filing a continuing application, he may wish to include a statement in the transmittal letter or elsewhere in the application-as-filed which specifically incorporates by reference the entire disclosure of the prior application, for which an oath or declaration is supplied, to avoid the very situation which has arisen herein. This incorporation, however, can only be relied upon when a portion has been inadvertently omitted from the later submitted application parts. See MPEP 201.06(c).

Petitioner may wish to renew this petition (no additional fee) by way of requesting the earliest date of receipt at the USPTO of the missing pages as the filing date to be accorded this application. If this alternative is adopted, in order to be able to claim benefit of the prior application(s) under 35 USC 120, it will be necessary for petitioner to revive the prior application by way of a petition under 37 CFR 1.137(b) specifically directed to that application, for purposes of obtaining copendency. Otherwise, applicant must then appropriately amend the statement under 35 USC 120 appearing in this specification, fist line, in view of the lack of continuity. Petitioner may also wish to concurrently file a separate petition in the prior application to resolve the filing date question.

This application is being returned to Technology Center AU 1655 for consideration of the amendment filed December 20, 2001.

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

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

OR

U.S. Patent and Trademark Office
P.O. Box 2327
Mailstop DAC
Arlington, VA 22202

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

By hand: Crystal Plaza 4, Suite 3C23
2201 South Clark Place
Arlington, VA

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-1820.

Brian Hearn

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 16

KRISTIN K VIDOVICH
SHANKS & HERBERT
TRANSPOTOMAC PLAZA
1033 N FAIRFAX STREET
SUITE 306
ALEXANDRIA VA 22314

COPY MAILED

NOV 1 9 2002

OFFICE OF PETITIONS

In re Application of Harrington et al. Application No. 09/760,897 Filed: January 17, 2001 Attorney Docket No. 0221-0003OC	: : : : :	DECISION DISMISSING PETITION

This is a decision on the renewed petition under 37 CFR 1.53(e), filed June 19, 2002, to accord the above-identified application a filing date of January 17, 2001, with an indication that 166 pages of the application were present on filing.

The petition is **DISMISSED** as moot.

Petiitoner requests reconsideration of the previous decision and points to an incorporation by reference statement that is aserted to incorporate the missing pages of specification.

As explained in MPEP 201.06(c):

> In a continuation or divisional application, the safeguard (petition and fee under former 37 CFR 1.60(b)) concerning the filing of an application lacking all of the pages of the specification or sheets of drawings of the prior application has not been retained in 37 CFR 1.53(b) since the specification and drawings of a continuation or divisional application are not limited to a reproduction or a "true copy" of the prior application. As a safeguard, however,an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), **without the need for a petition provided the continuation**

or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

A priority claim under 35 U.S.C. 120 in a continuation or divisional application does not amount to an incorporation by reference of the application(s) to which priority is claimed. For the incorporation by reference to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or transmittal letter-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application.

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP § 608.01(p). (emphasis added).

Accordingly, since this application has been accorded a filing date, the issue will not be decided on petition under 37 CFR 1.53(e), but instead the proposed inclusion of the missing pages by way of amendment is properly reviewed by the examiner in charge of this application.

This application is being returned to Technology Center AU 1655.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-1820.

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policyrt

DEC 1 [illegible] 02
JC54
PATENT & TRADEMARK OFFICE

JGC

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 16

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DEC 23 2002
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NOV 21 2002
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KRISTIN K VIDOVICH
SHANKS & HERBERT
TRANSPOTOMAC PLAZA
1033 N FAIRFAX STREET
SUITE 306
ALEXANDRIA VA 22314

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OFFICE OF PETITIONS

In re Application of
Harrington et al.
Application No. 09/760,897
Filed: January 17, 2001
Attorney Docket No. 0221-0003OC

DECISION
DISMISSING PETITION

This is a decision on the renewed petition under 37 CFR 1.53(e), filed June 19, 2002, to accord the above-identified application a filing date of January 17, 2001, with an indication that 166 pages of the application were present on filing.

The petition is **DISMISSED** as moot.

Petiitoner requests reconsideration of the previous decision and points to an incorporation by reference statement that is aserted to incorporate the missing pages of specification.

As explained in MPEP 201.06(c):

> In a continuation or divisional application, the safeguard (petition and fee under former 37 CFR 1.60(b)) concerning the filing of an application lacking all of the pages of the specification or sheets of drawings of the prior application has not been retained in 37 CFR 1.53(b) since the specification and drawings of a continuation or divisional application are not limited to a reproduction or a "true copy" of the prior application. As a safeguard, however,an applicant may incorporate by reference the prior application by including, in the continuation or divisional application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The incorporation by reference statement can only be relied upon to permit the entering of a portion of the prior application into the continuation or divisional application when the portion of the prior application has been inadvertently omitted from the submitted application papers in the continuation or divisional application. The inclusion of this incorporation by reference of the prior application(s) will permit an applicant to amend the continuation or divisional application to include any subject matter in such prior application(s), **without the need for a petition provided the continuation**

or divisional application is entitled to a filing date notwithstanding the incorporation by reference.

A priority claim under 35 U.S.C. 120 in a continuation or divisional application does not amount to an incorporation by reference of the application(s) to which priority is claimed. For the incorporation by reference to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or transmittal letter-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application.

Mere reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP § 608.01(p). (emphasis added).

Accordingly, since this application has been accorded a filing date, the issue will not be decided on petition under 37 CFR 1.53(e), but instead the proposed inclusion of the missing pages by way of amendment is properly reviewed by the examiner in charge of this application.

This application is being returned to Technology Center AU 1655.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-1820.

Brian Hearn
Senior Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policyrt

1655

SHANKS & HERBERT

Intellectual Property Advocates

TransPotomac Plaza, 1033 N. Fairfax St., Suite 306, Alexandria, VA 22314
Telephone: 703-683-3600 Facsimile: 703-683-9875 Email: Joseph@mail.ipadvocates.com

OIPE JC54
DEC 19 2002
PATENT & TRADEMARK OFFICE

RECEIVED
DEC 23 2002
TECH CENTER 1600/2900

Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Re: U.S. Patent Application
Serial No.: 09/760,897
Filed: January 17, 2001
For: Compositions and Methods for Non-Targeted Activation of Endogenous Genes
Inventor(s): Harrington et al.
Attorney Docket No.: 0221-0003OC

Sir:

The following documents are forwarded herewith for appropriate action by the U.S. Patent and Trademark Office:

1. Amendment Under MPEP § 201.06(c) to Add Missing Pages to Specification;
2. Copy of the Decision Dismissing Petition mailed from the Office of Petitions on November 19, 2002;
3. Copy of the Preliminary Amendment filed March 27, 2001; and
4. 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.

Respectfully submitted,

SHANKS & HERBERT

Date: 12/19/02

Joseph G. Contrera
Reg. No. 44,628

JGC/TY:ewm
Encl.

West Coast Office
4350 La Jolla Village Drive, Suite 330, San Diego, CA 92122
Telephone: (858) 597-6688 Facsimile: (858) 597-6682

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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LAHIVE & COCKFIELD, LLP
FLOOR 30, SUITE 3000
ONE POST OFFICE SQUARE
BOSTON MA 02109

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JUL 07 2008

In re Patent No. 7,033,782 :
Issue Date: April 25, 2006 :
Application No. 09/760,897 : NOTICE
Filed: January 17, 2001 :
Attorney Docket No. ATX-007CP4DV15CN :

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 the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

GEOFFREY LEE MCCABE
6124 GLEN TOWER WALK
HOLLYWOOD, CA 90065

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MAR 1 7 2003

OFFICE OF PETITIONS

In re Application of	:	
McCabe	:	
Application No. 09/760,908	:	ON PETITION
Filed: January 16, 2001	:	
For: TUNING MEANS FOR STRINGED MUSICAL INSTRUMENT	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 10, 2003, 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 August 17, 2001. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on November 18, 2001. A Notice of Abandonment was mailed on March 6, 2002.

Petition requests revival of the application. Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Therefore, the petition is granted and the application is revived.

The file is now being forwarded to Technology Center 2800 for consideration of the amendment filed on March 10, 2003.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (703) 306-5683.

Charles Steven Brantley
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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HOWARD L. SPEIGHT
BAKER BOTTS
910 LOUISIANA
HOUSTON, TX 77002

COPY MAILED
JUN 15 2006
OFFICE OF PETITIONS

In re Application of	:	
Mohamed M. Haq	:	
Application No. 09/760,917	:	DECISION ON PETITION
Filed: January 16, 2001	:	TO WITHDRAW
Attorney Docket No. 069089.0102	:	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 6, 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 Office cannot approve the request at this time since the reason provided does not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one of the permissive reasons listed in 37 CFR 10.40(c). The reason set forth in the request is "... responsibility for the matter has been transferred to Marc A. Sockol," does not meet any of the conditions set forth in 37 CFR 10.40.

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

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

This application is being referred to Technology Center AU 3626.

David Bucci
Petitions Examiner
Office of Petitions

cc: MARC A. SOCKOL
BROWN RAYSMAN MILLSTEIN FELDER & STEINER
303 TWIN DOLPHIN DRIVE, SUITE 600
REDWOOD SHORE, CA 94065

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 9

MAILED

MAR 0 1 2004

Technology Center 2100

Scott A. Hatfield
MYERS BIGEL SIBLEY & SAJOVEC
111 Corning Road
Suite 250
Raleigh, NC 27511

In re Application of
Gerald M. COOPER
Application No. 09/760,935
Filed: January 15, 2001
For: FILTERING UNSOLICITED EMAIL

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed February 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 is **GRANTED**.

All future communication 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 U.S. Patent and Trademark Office (the 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
Information Security
(703) 305-9750

cc: John Han
Associate General Counsel - Intellectual Property
Ericsson Inc.
MS/EVW2-C-2
6300 Legacy Drive
Plano, Texas 75024

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

Knobbe Martens Olson & Bear LLP
2040 Main Street
Fourteenth Floor
Irvine, CA 92614

MAILED

OCT 11 2002

Technology Center 2100

In re Application of: Christopher L. Knauft	)	
Application No. 09/760,956	)	
Filed: January 15, 2001	)	
For: SYSTEM AND METHOD FOR CONTROLLING AND ENFORCING ACCESS RIGHTS TO ENCRYPTED MEDIA	)	**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed October 1, 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.

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

cc: Frank Nguyen, General Counsel
MACROVISION CORPORATION
2830 De La Cruz Boulevard
Santa Clara, CA 95050

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Motorola, Inc.
1303 East Algonquin Road
IL01/3rd
Schaumburg, IL 60196

COPY MAILED
FEB 26 2004
OFFICE OF PETITIONS

In re Application of	:	
LoGalbo et al.	:	
Application No. 09/760,981	:	ON PETITION
Filed: January 16, 2001	:	
Attorney Docket No. CM04762H	:	

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

The petition is Granted.

The above-identified application became abandoned for failure to reply in a timely manner to the restriction requirement mailed June 17, 2003, which set a period for reply of (1) One month 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 July 18, 2003.

The application file is being forwarded to Technology Center AU 2666 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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5/14/09

TO SPE OF : ART UNIT 2416 Pham Brenda (Spe)

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/760985 Patent No.: 7002985

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

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

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

Comments: Claim 36 also be allowed.

SPE

2464
Art Unit

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)
6603770	2003-08-05	09761110	2001-01-16	100.001

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)	2007-08-08
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.

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In re Patent No. 6603770
Issue Date: August 5,2003
Application No. 09761110
Filed: January 16,2001
Attorney Docket No. 2008.001

:
: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.

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LEONARD TACHNER
A PROFESSIONAL LAW CORPORATION
17961 SKY PARK CIRCLE, SUITE 38-E
IRVINE, CA 92614

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JAN 0 2 2008

OFFICE OF PETITIONS

In re Application of :
Freddie Lin et al. :
Application No. 09/761,114 :
Filed: January 16, 2001 :
Attorney Docket No. 2008.003 :

ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed September 28, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the final Office action mailed, June 28, 2005, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on September 29, 2005. A Notice of Abandonment was mailed on May 3, 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 $395.00, and the submission required by 37 CFR 1.114; (2) the petition fee of $750.00; 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 or authorization of agent to prosecute the application. If the person signing the 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 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 Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 2621 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.

Frances Hicks
Petitions Examiner
Office of Petitions

cc: Young A. Tang
Sheppard Mullin Richter
& Hampton, LLP
333 South Hope Street, 48th Fl.
Los Angeles, CA 90071-1448

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VIRTUAL LEGAL, P.C.
MICHAEL A. KERR
3476 EXECUTIVE POINTE WAY, UNIT 16
CARSON CITY, NV 89706

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APR 25 2006
OFFICE OF PETITIONS

In re Application of Hodge, et. al. Application No. 09/761,205 Filed: January 16, 2001 Attorney Docket No. COAX 01.001	:	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 January 25, 2006.

The request is **APPROVED**.

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

The request was signed by the sole attorney of record, Michael A. Kerr.

Michael A. Kerr has been withdrawn as attorney of record.

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

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

This application file is being referred to Technology Center Art Unit 2623, for review of the amendment filed March 27, 2006.

Telephone inquiries concerning this decision should be directed to Andrea Smith at 571-272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

Conferee: Amelia Au

cc: Winston Hodge
Coax Corporation
24290 Avenida De Marcia
Yorba Linda, CA 92887

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MICHAEL A. KERR
3476 EXECUTIVE POINTE WAY, UNIT 16
CARSON CITY, NV 89706

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~~APR 25 2006~~
~~OFFICE OF PETITIONS~~

In re Application of
Hodge, et. al.
Application No. 09/761,205
Filed: January 16, 2001
Attorney Docket No. COAX 01.001

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 January 25, 2006.

The request is **APPROVED**.

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

The request was signed by the sole attorney of record, Michael A. Kerr.

Michael A. Kerr has been withdrawn as attorney of record.

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

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

This application file is being referred to Technology Center Art Unit 2623, for review of the amendment filed March 27, 2006.

Telephone inquiries concerning this decision should be directed to Andrea Smith at 571-272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

Conferee: Amelia Au

cc: Winston Hodge
Coax Corporation
24290 Avenida De Marcia
Yorba Linda, CA 92887

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CARSON CITY, NV 89706

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APR 20 2006

OFFICE OF PETITIONS

In re Application of
Hodge, et. al.
Application No. 09/751,208
Filed: January 16, 2001
Attorney Docket No. COAX 01.002

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 January 25, 2006.

The request is **APPROVED**.

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

The request was signed by the sole attorney of record, Michael A. Kerr.

Michael A. Kerr has been withdrawn as attorney of record.

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

There is an outstanding final Office action mailed December 14, 2005, that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Andrea Smith at 571-272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

Conferee: Amelia Au

cc: Winston Hodge
Coax Corporation
24290 Avenida De Marcia
Yorba Linda, CA 92887

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OFFICE OF PETITIONS

In re Application of
Hodge, et. al.
Application No. 09/761,208
Filed: January 16, 2001
Attorney Docket No. COAX 01.002

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 January 25, 2006.

The request is **APPROVED**.

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

The request was signed by the sole attorney of record, Michael A. Kerr.

Michael A. Kerr has been withdrawn as attorney of record.

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

There is an outstanding final Office action mailed December 14, 2005, that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Andrea Smith at 571-272-3226.

Andrea Smith
Petitions Examiner
Office of Petitions

Conferee: Amelia Au

cc: Winston Hodge
Coax Corporation
24290 Avenida De Marcia
Yorba Linda, CA 92887

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Paper No. 9

J. Scott Denko
Andrews & Kurth, L.L.P.
111 Congress Avenue
Suite 1700
Austin, TX 78701

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JUL 28 2003

OFFICE OF PETITIONS

In re Application of :
Carmen Burns :
Application No. 09/761,210 : ON PETITION
Filed: January 16, 2001 :
Attorney Docket No. D-5531/C1/CP1/D1 :

This is a decision on the petition under 37 CFR 1.137(b), submitted by facsimile transmission on July 21, 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 Restriction Requirement mailed August 27, 2002, which set a shortened statutory period for reply of thirty (30) days. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on September 28, 2002.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Therefore, the extension of time submitted with the petition on July 21, 2003 was subsequent to the maximum extendable period for reply and unnecessary.

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 3729.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry D. Brinkley
Petitions Examiner

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 06/23/06

TO SPE OF : ART UNIT 2157

SUBJECT : Request for Certificate of Correction for Appl. No.: **09/761264** Patent No.: **6976052**

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.

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: _____

ARIO ETIENNE **SPE**

2157
Art Unit

SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

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SECOND SIGHT MEDICAL PRODUCTS, INC.
12744 SAN FERNANDO ROAD BUILDING 3
SYLMAR CA 91342

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MAY 30 2006

OFFICE OF PETITIONS

In re Application of :
Ok et al. :
Application No. 09/761,270 :
Filed: January 16, 2001 :
Attorney Docket No. S125-USA :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed March 9, 2006, to revive the above-identified application.

On October 8, 2003, the Office mailed a Notice of Allowance and Fee(s) Due, which set a three-month statutory period for reply. In the absence of a timely filed response, the application became abandoned on January 9, 2004. On February 10, 2004, the Office mailed a Notice of Abandonment.

Petitioner has met the requirements of 37 CFR 1.137(b) to revive this application. Petitioner submitted a reply in the form of payment of the issue fee and the publication fee, made the appropriate statement of unintentional delay, and paid the petition fee. Accordingly, the petition is granted.

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 an inquiry has not been made, petitioner must make such an inquiry. If the 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 or authorization of agent to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted.

This matter is being referred to the Office of Patent Publication.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211. All other questions regarding the status of the application or the issuance of a patent should be directed to the Office of Patent Publication Customer Service at (571) 272-4200.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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CHRISTENSEN, O'CONNOR,
JOHNSON, KINDNESS, PLLC
1420 FIFTH AVENUE
SUITE 2800
SEATTLE, WA 98101-2347

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OFFICE OF PETITIONS

In re Application of :
Morrow et al. :
Application No. 09/761,340 :
Filed: January 16, 2001 :
Title of Invention: FORWARD LEAN :
SYSTEM FOR A SNOWBOARD BOOT :

This is a decision on the petition filed October 3, 2005, pursuant to 37 C.F.R. §3.81(b), to request a change in the name of the assignee after payment of the issue fee. The petition is properly treated as a request under 37 CFR 3.81(b)[1].

The Petition is **granted**.

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 (703) 305-8309.

The application is being referred to the Certificate of Corrections Branch for issuance of the requested Certificate of Correction.

Derek L. Woods
Attorney
Office of Petitions

[1] See, 1283 OG 148 22 June 2004, 69 Fed. Reg. 29865 26 May 2004

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SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS MN 55402

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DEC 03 2004

OFFICE OF PETITIONS

In re Application of :
Randhir Thakur et al :
Application No. 09/761,355 :
Filed: January 16, 2001 :
Attorney Docket No. 303.275US2 :

ON PETITION

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 November 1, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2812 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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Paper No. 19

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS MN 55402

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JUL 3 1 2006

OFFICE OF PETITIONS

In re Application of	:	
Lemke et al.	:	DECISION ON PETITION
Application No. 09/761,382	:	TO WITHDRAW HOLDING OF
Filed: 16 January, 2001	:	ABANDONMENT
Atty Dcket No. 736.001US2	:	

This is a decision on the petition, filed on 4 August, 2003, (certificate of mailing date 29 July, 2003), to withdraw the holding of abandonment in the above-identified application. A duplicate copy of the petition was filed on 23 April, 2006.

The Office apologizes for the delay in responding to the present petition and regrets any inconvenience to petitioners.

The application was held abandoned for failure to timely submit corrected drawings in response to the Notice of Allowability mailed on 23 September, 2002. Notice of Abandonment was mailed on 14 April, 2003.

Petitioners assert that corrected drawings were in fact timely filed in response to the Notice of Allowability. In support of the petition, petitioners submitted a copy of a date-stamped post card receipt acknowledging receipt of 11 sheets of formal drawings on 26 December, 2002. Additionally, petitioners have submitted a copy of the drawings and the transmittal letter sent therewith.

The corrected drawings petitioners assert were timely filed are not of record in the file and cannot be located. However, M.P.E.P. § 503 states, "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the corrected drawings were

INTELLEVATE
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RECEIVED
Coded ____ Verified ____

Schwegman, Lundberg, Woessner & Kluth, P.A.
AUG 0 3 2006

were received in the Office but was not matched with the application file.

The date-stamped on the post card of 26 December, 2002, is after the due date for the response. However, under 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 cover letter entitled "Communication RE: Submission of Formal Drawings" filed with the present petition bears a proper certificate of mailing, dated 18 December, 2002, in compliance with the requirements of 37 C.F.R. § 1.8(a)(1) as set forth above. Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The petition is **GRANTED**.

The application file will be referred to the Publishing Division for processing into a patent.

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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 12

Lacasse & Associates, LLC
1725 Duke Street
Suite 650
Alexandria, VA 22314

COPY MAILED

AUG 2 3 2002

OFFICE OF PETITIONS

In re Application of	:	
Thomas H. Williams	:	
Application No. 09/761,398	:	ON PETITION
Filed: January 16, 2001	:	
Attorney Docket No. N/A	:	

This is a decision on the petition under 37 CFR 1.137(b), filed July 23, 2002, 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 January 14, 2002, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on April 15, 2002.

Telephone inquiries concerning this decision should be directed to Retta Williams at (703) 306-5594 or in my absence, Sherry Brinkley at (703) 305-9220.

The application file is being forwarded to the Publishing Division for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry Brinkley

Sherry 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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 3

DOEPKEN KEEVICAN & WEISS
USX TOWER - 58TH FLOOR
600 GRANT STREET
PITTSBURGH, PA 15219

COPY MAILED

JUN 22 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of	:	
Mark Ontiveros et al.	:	DECISION GRANTING
Application No. 09/761,499	:	PETITION
Filed: January 16, 2001	:	
Attorney Docket No. CAPTNE/P002A1	:	

This is a decision on the paper styled "Petition To Secure Filing Date..." filed May 31, 2001, which is properly treated as a petition under 37 CFR 1.10(c), requesting that the above-identified application be accorded a filing date of January 16, 2001, rather than the presently accorded filing date of January 18, 2001.

Applicants allege that the application was deposited in "Express Mail" service with the U.S. Postal Service, on January 16, 2001. In support, applicants provided a copy of the Express Mail label, receipt no. EL234123066US, showing a Date-In of January 16, 2001. The same Express Mail receipt number was referred to in the copy of the original Application Transmittal Letter submitted with the instant petition. Applicants request that the application be accorded a filing date of January 16, 2001.

The Office considers the date the paper or fee is shown to have been deposited as "Express Mail" to be the "Date In" on the Express Mail label, MPEP 513. That is the date that verifies that the package was actually mailed. In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on January 16, 2001.

The petition is granted. Since the petition was a result of PTO error, the $130.00 petition fee is being credited to counsel's deposit account.

The application is being returned to Initial Patent Examination Division for correction of the filing date to January 16, 2001.

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

Sherry Brinkley

Sherry 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

DEC 15 2004

Darby & Darby P.C.
805 Third Avenue
New York, NY 10022

Paper No.

#19

In re Application of
Takayuki Hisanaka
Serial No. : 09/761,511
Filed : January 16, 2001
For : Absorbent Article Containing Skin-Protective Ingredient

: DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on petitioner's request filed October 13, 2004, to review the holding of abandonment mailed October 4, 2004 for failure to respond to the Office action mailed January 30, 2004. There is no fee required for this petition.

In support of the request, petitioner has submitted a copy of a response that included a Certificate of Express Mailing under 37 CFR 1.10 identifying the papers submitted (a transmittal letter and nine page amendment), the certificate including the Express Mail No. EL 983945875US. Also submitted with the request is a copy of a Track and Confirm receipt from the United States Postal Service indicating that the Office received Express Mail No. EL 983945875US correspondence on March 24, 2004.

In view of the above, the Notice of Abandonment mailed October 4, 2004 is in error and is hereby vacated. The holding of abandonment is withdrawn. Upon, the mailing of this decision, the application will be forwarded to the Examiner via the Legal Instruments Examiner for entry and consideration of the response received March 22, 2004.

Summary: Holding of Abandonment Withdrawn.

John E. Kittle, Director
Groups 3730 and 3760
Phone: (571) 272-2975

ak/12/8/04

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

JUL - 8 2002

#7

Luke A. Kilyk
KILYK & BOWERSOX, PLLC
53A LEE STREET
WARRENTON, VA 20186

In re Application of	:	
Batarseh et al	:	
Serial No.: 09/761,561	:	PETITION DECISION
Filed: January 17, 2001	:	
Attorney Docket: 3731-002	:	

This is in response to applicants' "Petition to Withdraw Holding of Abandonment Based on failure to Receive Office Action", filed on May 1, 2002, requesting that the above-identified application be revived based on a non-receipt of an Office Action.

A review of the file history indicates the examiner mailed the Office Action on January 3, 2002, setting a three month shortened statutory period for reply. On May 1, 2002, the present petition was filed. Applicants indicated that they became aware of a substantive Office action was mailed only through a result of a telephon conversation with the examiner. Applicants assert that the Office Action is question was never received. A search of the file and docket records shows non-receipt at Kilyk & Bowersox, PLLC at the above address, and a copy of the docket records for Appl. No. 09/761,561 (which corresponds to Attorney Docket 3731-002) is provided. The review shows that the application is technically abandoned but no Notice of Abandonment has been amiled. Accordingly, the petition is Dismissed. The Office action dated January 3, 2002 is being remailed herewith. A shortened Statutory Period for reply is set to expired Three Months from the mailing 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) 308-3890.

Cecilia Tsang for
John Doll
Director, Technology Center 1600

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5/5/06

TO SPE OF : ART UNIT 1616

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/761561 Patent No.: 6939566

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**.

Certificates of Correction Branch

703-308-9390 ext. _____

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

JOHANN RICHTER
SUPERVISORY PATENT EXAMINER
GROUP 1600

SPE

1616
Art Unit

OIPE JC165
JUL 0 2 2001
PATENT & TRADEMARK OFFICE

FISH & RICHARDSON P.C.

Frederick P. Fish
1855-1930

W.K. Richardson
1859-1951

225 Franklin Street
Boston, Massachusetts
02110-2804

Telephone
617 542-5070

Facsimile
617 542-8906

Web Site
www.fr.com

BOSTON
DALLAS
DELAWARE
NEW YORK
SAN DIEGO
SILICON VALLEY
TWIN CITIES
WASHINGTON, DC

January 16, 2001

Attorney Docket No.: 10363-003004

Box Patent Application
Commissioner for Patents
Washington, DC 20231

Presented for filing is a new continuation patent application of:

Applicant: ROGER J. DAVIS, JOEL RAINGEAUD and BENOIT DERIJARD

Title: CYTOKINE-, STRESS, AND ONCOPROTEIN-ACTIVATED HUMAN PROTEIN KINASE KINASES

The prior application is assigned of record to University of Massachusetts, a Massachusetts corporation, by virtue of an assignment submitted to the Patent and Trademark Office and recorded on May 14, 1998 at 9178/0789.

Enclosed are the following papers, including those required to receive a filing date under 37 CFR §1.53(b):

	Pages
Specification	68
Claims	8
Abstract	1
Declaration	4
Drawing(s)	27

Enclosures:
- Preliminary Amendment canceling claims 2-31, 45-49, and 53-55.
- Postcard.

This application is entitled to small entity status.

CERTIFICATE OF MAILING BY EXPRESS MAIL

Express Mail Label No. EL298429959US

I hereby certify under 37 CFR §1.10 that this correspondence is being deposited with the United States Postal Service as Express Mail Post Office to Addressee with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

January 16, 2001
Date of Deposit

Signature

Lisa G. Gray
Typed or Printed Name of Person Signing Certificate

This application is a continuation (and claims the benefit of priority under 35 U.S.C. 120) of U.S. application serial no. 09/149,879, filed on September 8, 1998, which is a continuation of U.S. Serial No. 09/057,009, filed on April 7, 1998; which is a CIP of U.S. Serial No. 08/530,950, filed on September 19, 1995, now U.S. Patent No. 5,736,381, which issued on April 7, 1998, which is a CIP of U.S. Serial No. 08/446,083, filed on May 19, 1995, now U.S. Patent No. 5,804,427, which issued on September 8, 1998. The disclosure of the prior applications is considered part of (and is incorporated in its entirety by reference in) the disclosure of this application.

Basic filing fee	$355
Total claims in excess of 20 times $9	$0
Independent claims in excess of 3 times $40	$0
Fee for multiple dependent claims	$0
Total filing fee:	$355

Under 37 CFR §1.53(f), no filing fee is being paid at this time.

If this application is found to be incomplete, or if a telephone conference would otherwise be helpful, please call the undersigned at (617) 542-5070.

Kindly acknowledge receipt of this application by returning the enclosed postcard.

Please send all correspondence to:

J. PETER FASSE
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804

Respectfully submitted,

J. Peter Fasse

J. Peter Fasse
Reg. No. 32,983
Enclosures
JPF/dxm
20198287.doc

Sector $

Attorney's Docket No.: 10[redacted]03004 / UMMC Ref.: 95-10

OIPE JC165
JUL 0 2 2001
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Davis et al.
Serial No. : 09/761,569
Filed : January 16, 2001
Title : CYTOKINE-, STRESS, AND ONCOPROTEIN-ACTIVATED HUMAN PROTEIN KINASE KINASES

Art Unit : Unknown
Examiner : Unknown

BOX MISSING PARTS
Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION

In response to the Notice to File Missing Parts of Application under 37 CFR §1.53(b) mailed March 28, 2001 (copy enclosed), applicants as a small entity submits herewith the following:

- ☒ Payment of the basic filing fee for small entity of $355;
- ☒ Payment of $65 surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application;
- ☒ Request to Transfer Computer Readable Form and a paper copy of the Sequence Listing;
- ☒ Substitute specification;
- ☒ Copy of Transmittal Letter;
- ☒ Payment of $55 and Petition for One Month Extension of Time;
- ☒ Copy of Transmittal Letter;

The Notice to File Missing Parts states that a small entity statement must be filed. Applicants do not believe this is necessary as they claimed small entity status when filing the

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

June 28, 2001
Date of Deposit

Lisa G. Gray
Signature

Lisa G. Gray
Typed or Printed Name of Person Signing Certificate

09761569.070201

application. As proof of this, copy of the Transmittal Letter filed with the instant application is enclosed.

It is understood that this perfects the application and no additional papers or filing fees are required. Please apply any other charges or credits to Deposit Account No. 06-1050 referencing attorney docket no. 10363-003004.

Respectfully submitted,

Date: June 28, 2001

J. Peter Fasse
Reg. No. 32,983

Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20267947.doc

#4

OIPE JC165
JUL 0 2 2001
PATENT & 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
09/761,569	01/16/2001	Roger J. Davis	10363-003004

CONFIRMATION NO. 9227

FORMALITIES LETTER

IOC000000005909867*

J. PETER FASSE
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804

Docketed By Practice Systems
Action Code: Missing Parts/Informal Appl. /Seq Listing
Base Date: 3-28-01
Due Date: 5-28-01
Deadline: 9-28-01
Initial: JMG

Date Mailed: 03/28/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

07/09/2001 EEKUBAY1 00000098 09761569
FC:201 355.00 OP
FC:205 65.00 OP

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

Docketed By Billing Secretary
Due Date:
Deadline:
Initials:

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 $ **355** *to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).*
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of $65 for a small entity in compliance with 37 CFR 1.27, must be submitted with the missing items identified in this letter.
- **The balance due by applicant is $ 420.**

The application is informal since it does not comply with the regulations for the reason(s) indicated below. Applicant is given TWO MONTHS from the date of this Notice within which to correct the informalities indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- A substitute specification in compliance with 37 CFR 1.52 because:
  - Papers contain improper margins. *Each sheet must have a left margin of at least 2.5 cm (1") and top, bottom and right margins of at least 2.0 cm (3/4")*
- This application does not contain a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821 (g), 1.825(b), or 1.825(d). Applicant must provide such statement. If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR

54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000).

- A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing" and a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825 (b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

For questions regarding compliance to these requirements, please contact:

- **For Rules Interpretation, call (703) 308-4216**
- **To Purchase PatentIn Software, call (703) 306-2600**
- **For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov**

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

#11 DW

UNITED STATES PATENT AND TRADEMARK OFFICE

JAN 13 2004

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

MAILED

JAN 13 2004

OFFICE OF THE DIRECTOR
TC 3600

PATRICK R. SCANLON
PIERCE ATWOOD
ONE MONUMENT SQUARE
PORTLAND, ME 04101

In re Application of :
David Michael Bains, et al. :
Application No. 09/761,573 :
Filed: January 18, 2001 :
For: METHOD AND SYSTEM FOR PERFORMING GEARBOX FINAL ASSEMBLY CLEAN CHECK

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in reply to 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 22, 2003.

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 April 30, 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.

cps/1/12/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

#3

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
09/761,579	01/18/2001	John Smith	P 276521 PHM70638/US

RECEIVED
PILLSBURY WINTHROP LLP/DC
MAY 04 2001
CL# 9901 MT# 276521
ATTY(S) DJB MXK
DUE: June 30, 2001
DKT BY (1) CMS (2) mott

CONFIRMATION NO. 4747
FORMALITIES LETTER
OC000000006021600

Pillsbury Madison & Sutro LLP
Intellectual Property Group
East Tower, Ninth Floor
1100 New York Avenue, N.W.
Washington, DC 20005-3918

OIPE JC152
JUL 26 2001
PATENT & TRADEMARK OFFICE

Date Mailed: 04/30/2001

NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant is given **TWO MONTHS FROM THE DATE OF THIS NOTICE** within which to file the items indicated below to avoid abandonment. Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

- This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998). If the effective filing date is on or after September 8, 2000, see the final rulemaking notice published in the Federal Register at 65 FR 54604 (September 8, 2000) and 1238 OG 145 (September 19, 2000). Applicant must provide an initial computer readable form (CRF) copy of the "Sequence Listing", an initial paper or compact disc copy of the "Sequence Listing", as well as an amendment directing its entry into the application. Applicant must also provide a statement that the content of the sequence listing information recorded in computer readable form is identical to the written (on paper or compact disc) sequence listing and, where applicable, includes no new matter, as required by 37 CFR 1.821(e), 1.821 (f), 1.821(g), 1.825(b), or 1.825(d). If applicant desires the sequence listing in the instant application to be identical with that of another application on file in the U.S. Patent and Trademark Office, such request in accordance with 37 CFR 1.821(e) may be submitted in lieu of a new CRF.

For questions regarding compliance to these requirements, please contact:

- **For Rules Interpretation, call (703) 308-4216**
- **To Purchase PatentIn Software, call (703) 306-2600**
- **For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov**

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 1 - ATTORNEY/APPLICANT COPY

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
DIW 02-05

CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON DC 20044-4300

COPY MAILED

FEB 17 2005

OFFICE OF PETITIONS

In re Application of	:	
Bachinger et al.	:	DECISION ON PETITION
Application No. 09/761,661	:	
Filed: 18 January, 2001	:	
Attorney Docket No. 1748X/49451	:	

This is a decision on the petition filed on 13 October, 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 a final agency decision.

The above-identified application became abandoned on 21 February, 2004, for failure to timely file a reply to the non-final Office action mailed on 20 November, 2003, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 27 May, 2004.

The petition is accompanied by a declaration by Kerry B. Hillier, Manager of Intellectual Property for assignee Ballard Power Systems, Inc. (hereinafter "Ballard"). In his declaration, Mr. Hillier states, in pertinent part.

...

5. During January, 2004, in my capacity as Intellectual Property Counsel, I instructed (or

> authorized others to instruct) Ballard's outside patent counsel to allow U.S. patent application Serial No. 09/761,661, of which Ballard is currently the record owner, to become abandoned, due to budgetary considerations for our intellectual property operations.

...

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)).

The present petition does not satisfy requirement (3) above. The statement of Mr. Hillier raises a question as to whether the entire delay in filing a petition under 37 CFR 1.137(b) was unintentional.[1] Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning

---

[1] See MPEP 711.03(c)(III)(D); 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).

of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).[2]

In the present petition, petitioner apparently asserts that the delay was unintentional due to petitioner Ballard's financial condition.

With regard to the "unintentional" delay standard:

> Where the applicant deliberately permits an application to become abandoned (*e.g.*, due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). . . . An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.[3]

Here, the petition indicates that at least some of the discretionary funds that were available to petitioner Ballard in 2003 and 2004 were consciously and deliberately allocated to the prosecution and/or maintenance in force of other members of petitioner's domestic and foreign patent and trademark portfolios. While the petition does not indicate where and when such moneys were allocated, or the amounts, inspection of USPTO patent financial records for other patents assigned to Ballard indicate that in 2003 alone, petitioner was able to obtain or allocate $1,345.00 toward the prosecution of Application No.

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[2] See In re Application of G., 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989).

[3] See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 86 (October 21, 1997)(discussing the meaning of "unintentional" delay in the context of the revival of an abandoned application).

09/890,176 (now U.S. Patent No. 6,696,188), and $1,639.00 toward the prosecution of Application No. 09/875,274 (now U.S. Patent No. 6,699,608). Thus, as petitioner was able to allocate to the prosecution of other patent applications in the USPTO more than enough fees to have continued prosecution of this application, petitioner clearly subordinated the prosecution of this patent application to the furtherance of the prosecution of other applications.

Notwithstanding what other currently undisclosed fees petitioner allocated to his domestic and foreign intellectual property pursuits, consideration of the delay arising from those fees known to have been deliberately diverted away from the prosecution of this patent application is inconsistent with a finding that the delay in prosecution of the above-identified application was unintentional. That is, as petitioner came to the conclusion that those fees were better spent elsewhere, in that the instant application did not warrant continued prosecution, the abandonment of this application is considered to be a deliberately chosen course of action, and the resulting delay in prosecution thereof cannot be considered as "unintentional" within the meaning of 35 U.S.C. § 41(c) and 37 CFR 1.137(b).[4] Any renewed petition should include a chronological itemization of the fees paid to in pursuit of petitioner's intellectual property portfolio in 2003-2004, and an explanation if possible, as to why the deliberate allocation of this fees away from the instant application can reasonably considered to be unintentional.

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: (703) 872-9306
Attn: Office of Petitions

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[4] See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989); MPEP 711.03(c), Section III, subsection (C)(1).

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.

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON DC 20044-4300

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SEP 22 2005

OFFICE OF PETITIONS

In re Application of	:	
Bachinger et al.	:	DECISION ON PETITION
Application No. 09/761,661	:	
Filed: 18 January, 2001	:	
Atty Docket No. 1748X-49451	:	

This is a decision on the renewed petition filed on 20 April, 2005, under 37 CFR 1.137(b), to revive the above-noted application.

The petition is denied.

BACKGROUND

This application became abandoned on 21 February, 2004, for failure to timely reply to the non-final Office action mailed on 20 November, 2003, which set a three (3)-month shortened statutory period for reply. No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 27 May, 2004.

A first petition under 37 CFR 1.137(b) was filed on 13 October, 2004, and was dismissed in the decision of 17 February, 2005.

STATUTE AND REGULATION

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, 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." Specifically, 35 U.S.C. § 41(a)(7) provides that the Commissioner shall charge:

> On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, $1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $110.

Effective December 1, 1997, 37 CFR 1.137(b) provides:

> Unintentional. Where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph 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 § 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.

OPINION

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR

1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). The language of both 35 USC 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition.

The original petition is accompanied by a declaration by Kerry B. Hillier (hereinafter "Hillier"), Manager of Intellectual Property for assignee Ballard Power Systems, Inc. (hereinafter "Ballard"). In his declaration, Hillier states, in pertinent part.

> ...
>
> 5. During January, 2004, in my capacity as Intellectual Property Counsel, I instructed (or authorized others to instruct) Ballard's outside patent counsel to allow U.S. patent application Serial No. 09/761,661, of which Ballard is currently the record owner, to become abandoned, due to budgetary considerations for our intellectual property operations.
>
> ...

In the present renewed petition, petitioners assert that the delay in prosecution was not intentional because Hillier's instructions "were sent (1) contrary to the company's policy and intention regarding [the present patent application], (2) without knowledge of Ballard's determination to preserve any patent applications relating to the divestiture of assets [pursuant to an agreement executed 8 July, 2004], and (3) prior to the time that [Hillier} assumed his current position of Manager, Intellectual Property, after which time [Hillier] learned of the existence of the negotiations relating to the divestiture [of assets including the present application for patent]."

Petitioner has failed to meet his burden of establishing that the delay in this case was unintentional subsequent to petitioner's receipt of the Notice of Abandonment.

37 CFR 1.137(b) as amended, effective December 1, 1997, requires, *inter alia*, that the entire delay was unintentional, but does not include a filing period requirement. As the record shows an intentional delay in filing a petition to revive the above-identified application, the instant petition must be **denied**, under the provisions of 37 CFR 1.137(b), because the delay between 21 February, 2004, (the mail date of the non-final Office action) and 13 October, 2004, (the filing of the first petition to revive) was not "unintentional" within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b), but the result of a deliberate decision on the part of petitioners to delay the revival of the above-identified application.

Petitioners have failed to meet their burden of establishing to the satisfaction of the Commissioner that the delay in prosecution of the application was unintentional.

Petitioners concede that Hillier, then intellectual property counsel for Ballard, deliberately and intentionally instructed outside patent counsel to allow the application to become abandoned, but overlooks the salient fact that the language of both 35 USC 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and furthermore, without qualification. That is, the delay in prosecution of the application must have been, without qualification, "unintentional" for the application to now be revived on petition.[1]

That petitioner relied upon Hillier and/or outside counsel for matters regarding prosecution of the above-identified application shifts the focus of the inquiry regarding the abandonment of the application from petitioners to Hillier and outside patent counsel. See California Medical Products v. Technol Med. Prod., 921 F.Supp. 1219, 1259 (D. Del. 1995).

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[1] Cf. Centigram Communication Corp. v.. Lehman, 862 F.Supp. 113, 118, 32 USPQ2d 1346, 1350 (E.D. Va. 1994), *appeal dismissed,* 47 F.3d 1180 (Fed. Cir. 1995).
The Commissioner **may** accept late payment of the maintenance fee if the delay is shown to the satisfaction of the Commissioner to have been "unintentional"; see 35 USC 41(c)(1) and its promulgating regulation 37 CFR 1.378(a). That is, the plain language of the statute permits reinstatement of an expired patent, provided the delay in payment of the maintenance fee was "unintentional." Id. Nevertheless, the underlying congressional intent is that PTO acceptance of a delayed maintenance fee is discretionary and contingent upon a showing satisfactory to the Commissioner, that the delay was "unintentional." Id. at 1348.

While petitioners contend that pursuant to petitioners' interpretation(s) of Ballard's company policy and intent, Hillier was not authorized to act in any manner inconsistent with the aforementioned policy, the showing of record is that petitioners acquiesced to the business arrangement(s) in effect, including the fact that Hillier was at all times petitioners' contact point for instructing, or not instructing, outside patent counsel (and Ballard) to prosecute (or not continue prosecution of) the above-identified application. Further, the showing of record does not extend to any document establishing that Hillier was under contract to continue prosecution of the application, or that if Hillier instructed outside counsel not to allow the application to become abandoned, then Hillier acted contrary to any agreement in force. Further in this regard, there is no documented showing that petitioners had engaged any party, much less Hillier, to prosecute this particular application. There is no documented showing of record that Hillier had to receive prior approval from anyone at Ballard for any business decisions made by Hillier. Specifically, there is no documented showing that Hillier required Ballard's prior approval for the business decision to continue prosecution of this application (or to allow it to become abandoned), or that Hillier, much less outside patent counsel, was to specifically inform Ballard that prosecution of the application was continuing (or that the application had been allowed to become abandoned). It is noted that in the 13 October, 2004, petition, Hillier stated that he instructed outside patent counsel to allow the application to become abandoned due to "budgetary considerations". In the 17 February, 2005, decision, petitioners were required, assuming that Ballard lacked the funds to continue prosecution of this application, to provide a chronological itemization of the fees paid in pursuit of petitioners' intellectual property portfolio and to explain why the deliberate allocation of fees away from the instant application can reasonably be considered to be unintentional. However, the renewed petition lacks any meaningful response to this requirement, much less the required documentation. The showing of record, therefore, is that petitioners are estopped from contending that Hillier acted beyond his apparent authority.

Rather, the showing of record is that petitioners have acquiesced to the apparent authority of Hillier and inactions of Hillier and outside patent counsel in failing to continue prosecution of the above-identified application while prosecuting other applications in petitioners' intellectual property portfolio. Petitioners seek to revive this application and, in so doing, would have the Patent and Trademark Office believe that Hillier acted beyond his authority to cause the abandonment of this application, but do

not at the same time repudiate, or contest, that same alleged lack of authority of Hillier with respect to other patent applications. Rather, petitioners have ratified the authority of Hillier to independently withhold timely prosecution, and cause the abandonment of an application that is the property of petitioners. As such, petitioners' continued assertions that Hillier acted beyond the scope of his authority are untenable. Rather, it appears from the record that Hillier had more than a purely administrative role with regard to this patent application, and that petitioners entrusted all activities concerning this patent application to Hillier, including business decisions as to the management of the prosecution of this patent application. That is, the showing of record is that the agency of Hillier was, and remained, unchecked, throughout the entire time in question. Furthermore, it appears from the record that petitioners chose to remain, or acquiesced in remaining, uninformed of the status of the prosecution of patent applications. Moreover, since 31 May, 2001, at all times, according to Patent and Trademark Office (Office) records, Ballard has permitted the correspondence address of record for receiving Office communications pertaining to maintenance fee payment, or notice of patent expiration, to be that of current counsel of record. Thus, petitioners chose, or permitted themselves, to remain unaware of any Office communication pertaining to prosecution, such as an Office action, or Notice of Abandonment. That is, petitioners chose, or permitted themselves, to be "out of the loop." While the "no-notice" aspect of the arrangement(s) in effect may have worked to petitioners' benefit (and convenience) during prosecution of the above-identified application, petitioners acquiesced to the arrangement(s), and cannot now be heard to complain when the aforementioned arrangement(s), coupled with petitioner's lack of diligence, have worked to petitioners' apparent detriment.

Furthermore, the showing of record is that outside counsel accepted instructions from petitioners' agent Hillier (and not petitioners) as to whether prosecution of the application was to be continued, or not continued. Such showing clearly undercuts petitioners' unsupported assertion that Hillier was without discretion in this matter and simply had a purely administrative responsibility to pay the maintenance fees. Were Hillier without discretion as petitioners contend, then the record remains unclear why there is no showing that petitioners' standing instructions to Hillier, or outside patent counsel, were to respond to the Office action mailed on 20 November, 2003; in that no further input from Hillier was necessary, or desirable. Rather, the well established principles of agency law indicate

that petitioner, as principal, must be held responsible for the actions of an agent acting within the scope of his "apparent authority," even in the absence of the agent's actual authority over the matter in question.

Apparent authority is imputed where the actions of the principal give the appearance to reasonable persons that the agent is authorized to act as he is acting, and where others act in reliance on that impression. Here, petitioners, as principal, gave the appearance that Hillier had the discretionary authority to continue prosecution, or not continue prosecution of the application by permitting Hillier to be the contact point with outside patent counsel, and further, permitting Hillier to act independently with respect to providing instructions to outside patent counsel as to whether to allow to become abandoned, or not become abandoned, the present application for patent. That is, neither Hillier, nor outside patent counsel, were required to obtain any input, or authorization, from principal with respect to prosecution of the present patent application. Furthermore, petitioners' payments, apparently issued directly to outside patent counsel, ratified and reinforced the independent actions and apparent authority of Hillier. Assuming *arguendo*, that Hillier's authority was intended by petitioners to have been purely administrative in this area, that petitioners permitted Hillier's authority *vis-a-vis* outside patent counsel to remain unfettered since a period prior to January, 2004, and for Hillier to subsequently become Manager, Intellectual Property militates away from accepting petitioners' belated assertions to the contrary. Furthermore, insofar as petitioners permitted Hillier to be the contact point for outside patent counsel with respect to the affairs of petitioners for petitioners' intellectual property portfolio at the time the application became abandoned, and subsequently entrusted the position of Manager, Intellectual Property to Hillier, petitioners acquiesced to the arrangements Hillier made with respect to outside patent counsel. As petitioners have made no showing as to any contract regarding the metes and bounds of Hillier's authority and responsibility regarding the prosecution of patent applications, much less any such information known to outside patent counsel, petitioners have failed to advance any showing as to why petitioners, as principal, are not bound by the delay resulting from the actions (or inactions) of their agent, Hillier. Rather, outside patent counsel clearly accepted the apparent authority of Hillier in following Hillier's instructions to not continue prosecution of this application. Therefore, petitioners must be held accountable for the actions or inactions of Hillier. Since petitioners' agent Hillier instructed outside patent counsel to

withhold a timely reply to the Office action mailed on 20 November, 2003, the delay cannot reasonably be considered to have been "unintentional."

Accordingly, the delay in prosecution resulting from Hillier's and/or outside patent counsel's actions or inactions is chargeable to petitioner. The Patent and Trademark Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the patent holder, and petitioner is bound by the consequences of those actions or inactions. See California Medical Products v. Technol. Med. Prod., 921 F.Supp. 1219, 1259 (D.Del. 1995); Link v. Wabash, 370 U.S. 626, 633-34 (1962); Huston v. Ladner, 973 F.2d 1564, 1567, 23 USPQ2d 1910, 1913 (Fed. Cir. 1992); see also Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (D.N. Ind. 1987). That is, assuming that Hillier was petitioners' agent-representative, then the delay resulting from Hillier's instructions to outside counsel is (1) chargeable to petitioners and (2) as explained *infra*, must be considered intentional delay, even assuming, *arguendo*, that outside counsel erred in accepting Hillier's instructions. Similarly, even assuming that outside counsel erred in believing that he had been instructed to discontinue prosecution, and thus permit the application to become abandoned, nevertheless, the delay resulting from such deliberate action or inaction of outside patent counsel is binding on petitioners, regardless as to who gave the instructions to outside patent counsel.[2] Assuming that Hillier did not instruct outside patent counsel to forgo prosecution of the application, petitioners have not demonstrated that the delay in filing a timely reply to the Office action mailed on 20 November, 2003, was unintentional. In this regard, regardless of whether the record establishes that petitioners had engaged Hillier and/or outside patent counsel, in that Hillier assumed the obligation for the balance of petitioner's intellectual property portfolio, petitioner is bound by the acts or omissions of Hillier and outside patent counsel with respect to the failure to prosecute this application for patent. See California, supra.

With regard to petitioners' supposition that Hillier was unaware of Ballard's determination to continue prosecution of the any

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[2] Petitioners do not allege, nor does the showing of record establish, that Hillier and/or outside patent counsel misrepresented to petitioners either the status of the this application for patent, or sought, or received, reimbursement for continuing prosecution of the application on or after January, 2004. As such, there is no showing that the circumstances of this case should constitute an exception to the general rule that a client is bound by the mistakes or omissions of his representative. See *e.g.*, Huston supra.

patent applications relating to the divestiture of assets, the evidence of record consists of Hillier's bare assertion that he did not learn of Ballard's intent until a time after 3 May, 2004, which was after January, 2004, the time period during which Hillier, as Intellectual Property Counsel for Ballard, instructed outside patent counsel to allow this application to become abandoned. As such, it is more likely than not, as petitioners contend, that outside counsel received instructions from Hillier to discontinue prosecution of this application.

Likewise, petitioners' assertion that Hillier was not Manager, Intellectual Property, at the time the decision was made to allow the application to become abandoned does not alter the agency relationship between Hillier and Ballard. The showing of record, a mere change in title for Hillier, does not convey any change in authority of Hillier regarding Ballard's intellectual property portfolio. Further, Hillier concedes (in the declaration accompanying the petition filed on 13 October, 2004) he was acting in his capacity as Intellectual Property Counsel in instructing outside patent counsel to allow this application to become abandoned. Whether or not Hillier's title was that of "Manager" the showing of record is that Hillier had authority in January, 2004, to make decisions concerning the prosecution (or nonprosecution) of patent applications in Ballard's intellectual property portfolio.

Petitioners contend that petitioner should not suffer the consequences of Hillier's acts because petitioners did not knowingly and freely acquiesce in their representative's conduct. This argument is not persuasive, as such runs counter to established Supreme Court precedent holding that:

> There is certainly no merit to the contention that dismissal of petitioner's claim because of his counsel's unexcused conduct imposes an unjust penalty on the client. Petitioner voluntarily chose this attorney as his representative in the action, and he cannot now avoid the consequences of the acts or omissions of this freely selected agent. Any other notion would be wholly inconsistent with our system of representative litigation, in which each party is deemed bound by the acts of his lawyer-agent and is considered to have 'notice of all facts, notice of which can be charged upon the attorney.'

Link , at 633-34 (1962) (citation omitted).

Further in this regard, with respect to the lack of a satisfactory showing under 37 CFR 1.137(b) herein:

> [i]f we were to hold that an attorney's negligence constitutes good cause for failing to meet a PTO requirement, the PTO's rules could become meaningless. Parties could regularly allege attorney negligence in order to avoid an unmet requirement.[3]

While petitioners argues that there was no deliberate decision, on the part of the assignee, to permit the expiration of this patent, this argument fails to address why the delay resulting from petitioners' representative's intentional nonprosecution can, or should be, considered "unintentional" delay. Rather, delay resulting from petitioners' representative's prior intentional failure to prosecute the application for patent does not become transformed into petitioner's unintentional delay merely due to petitioner's lack of awareness:

> Where the applicant deliberately permits an application to become abandoned (*e.g.*, due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). . . . Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (**or applicant's representative's**) decision to abandon the

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[3] Huston v. Ladner, supra.

> application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival. Obviously, delaying the revival of an abandoned application, by a deliberately chosen course of action, until the industry or a competitor shows an interest in the invention (a submarine application) is the antithesis of an "unavoidable" or "unintentional" delay. An intentional abandonment of an application, or an intentional delay in seeking either the withdrawal of a holding of abandonment in or the revival of an abandoned application, precludes a finding of unavoidable or unintentional delay pursuant to [37 CFR] 1.137 (emphasis added).

See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53158-59, (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 86 (October 21, 1997)(citations omitted).

The showing of record, therefore, is that petitioners, through their representative(s), chose not to timely file a reply to the Office action mailed on 20 November, 2003, which is viewed as an act of deliberation, intentionally performed. A delay caused by a deliberate decision not to take those actions indicated as necessary within a given time period cannot be viewed as constituting an "unavoidable delay" or an "unintentional delay" within the meaning of 35 U.S.C. § 41(a)(7), 37 CFR 1.137(a) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). Such intentional action or inaction precludes a finding of unintentional delay, even if such is due, in whole or in part, to a good faith error on counsel's part. See In re Maldague, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988). As such, the showing of record must militate away from any reasonable interpretation of the deliberate withholding of prosecution by Hillier/outside patent counsel as "unintentional" within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b). It follows that, in the absence of a showing that petitioner was misled or deliberately misinformed by Hillier and/or outside patent counsel with respect to either the status of the reply to the Office action mailed on 20 November, 2003, or the abandonment of this application for patent, it is immaterial to the delay herein that petitioner was unaware of, or would not have acquiesced to, his representative's actions or inactions. See Link, supra; Huston, supra; California, supra.

Therefore, petitioners' contentions concerning either the correctness or propriety of Hillier's and/or outside patent counsel's actions does not cause petitioners' intentional failure to prosecute the application for patent to be considered unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b).

As the reply to the Office action was intentionally withheld, failure to prosecute the application cannot reasonably be considered to have been unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). Accordingly, petitioner has not established to the satisfaction of the Commissioner that the delay in payment of the maintenance fee was "unintentional" within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See Application of G, 11 USPQ2d at 1380.

DECISION

The circumstances of this application do not demonstrate that the delay in filing the first petition under 37 CFR 1.137(b) was unintentional within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b). The petition is granted to the extent the decision of 17 February, 2005, has been reconsidered, but is otherwise denied. Accordingly, the application will not be revived and the application remains abandoned.

This decision is a final agency action. See MPEP 1002.02.

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

Charles A. Pearson, Director
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. 7

THOMAS J. SCOTT, JR.
HUNTON & WILLIAMS
1900 K STREET, NW
SUITE 1200
WASHINGTON DC 20006-1109

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JAN 23 2003
OFFICE OF PETITIONS

In re Application of	:	
Kevin M. Sullivan	:	
Application No. 09/761,763	:	DECISION GRANTING PETITION
Filed: January 18, 2001	:	UNDER 37 CFR 1.137(f)
Attorney Docket No. 47004.000086	:	

This is a decision on the petition, filed January 13, 2003, to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country.[1] However, the U.S. Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in a foreign 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 Office of the filing of an application in a foreign country, or under a multilateral international agreement, that requires publication of applications 18 months after filing.

A petition under 37 CFR 1.137(f) must be accompanied by:

> (1) the reply which is met by the notification of such filing in a foreign country or under a multinational treaty;

---

[1] The petition states that this application is the subject of PCT Application No. PCT/US02/09561, filed on March 29, 2002. However, it appears that the PCT application number is actually PCT/US02/01217, filed on January 18, 2002.

(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(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 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 rescinded. A Corrected Filing Receipt which sets forth the projected publication date of May 1, 2003 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 3622 for examination in due course.

Frances Hicks

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

ATTACHMENT: Corrected Filing Receipt

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. 8

Attention: William L. Huebsch
Office of Intellectual Property Counsel
3M Innovative Properties Company
PO Box 33427
St. Paul, MN 55133-3427

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JUL 2 2 2003

OFFICE OF PETITIONS

In re Application of :
Jon E. Stickrod :
Application No. 09/761,797 :
Filed: January 17, 2001 :
Attorney Docket No. 55716US2A.002 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 14, 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 Notice to File Corrected Application Papers (Notice) mailed February 28, 2001, which set a shortened statutory period for reply of (2) Two Months from the 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 April 29, 2002.

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

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NOV - 5 2003

FISH & RICHARDSON P.C.
225 FRANKLIN STREET
BOSTON, MA 02110-2804

#14

In re Application of	:
Shih-Chieh Hung et al	:
Serial No.: 09/761,893	: PETITION DECISION
Filed: January 17, 2001	:
Attorney Docket No.: 12862-002001	:

This is a decision on the petition filed May 27, 2003, under 37 CFR 1.181, requesting revival of the above identified application based on non-receipt of an Office action. The delay in acting on this petition is regretted.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on July 28, 2002, at the above address, and specifically addressed to "Eric L. Prahl". Applicants' copy of the Office action bearing a "Received" date stamp of Fish & Richardson, P.C., Boston Office" and dated August 1, 2002, was returned to the Office on August 13, 2002, accompanied by a letter signed by Y. Rocky Tsao. The reason for return given in the letter is that the Office action is for a different Serial Number and provides 09/781,693, as the Serial Number for their Docket Number 11709-003001. However, 11709-003001 is applicants' file reference number provided on the transmittal letter filed with this application. It is clear that applicants did receive the Office action in a timely manner, but that through administrative error believed that the action was for a different file. Prior to Office receipt of the returned Office action, applicants contacted the examiner requesting remailing of the correct Office action. The examiner remailed the Office action to the same address and restarted the period for reply on August 6, 2002. Appended to the Office copy of the remailed Office action is an examiner's note indicating that applicants reported receiving an Office action for the wrong case. Applicants claim and provide evidence that the remailed Office action was never received.

DISCUSSION

While it is regretted that applicants did not receive the remailed Office action (a copy has since been provided by facsimile transmission and a reply thereto has been provided) applicants did receive the originally mailed copy of the Office action and through mistake returned it to the Office on the belief that it was for a different case based on applicants assigning a new file reference number to their file. A review of the Office action, as originally received, should have

made it evident that the Office action was for the correct Serial Number, as identified on the Office action. Thus no error on the part of the Office occurred in the original mailing of the Office action. It is further noted that the returned Office action is identical to the one remailed to applicants. Thus the originally mailed Office action was proper and timely received by applicants. It is recognized that in rare instances an Office action has been improperly mailed to an incorrect address, however, this is not the fact situation here. In view of the facts of record, applicants' failure to properly reply to a properly received Office action must lie with applicants and withdrawal of abandonment is not appropriate under 37 CFR 1.181.

DECISION

Applicant's petition under 37 CFR 1.181 is **DENIED**. As a courtesy, applicants' amendment in reply to the Final Office action has been considered by the examiner as indicated on the attached Advisory Action. No Notice of Appeal has been filed.

The application remains abandoned for failure to timely reply to an outstanding Office action.

Applicants' request that this petition alternatively be considered under 37 CFR 1.137(b) is dismissed as informal as such petition must be presented in a separate paper. In order to be considered timely, such petition must be presented within TWO MONTHS of the mail date of this decision.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, P.O. 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

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Paper No. 17

Fish & Richardson
225 Franklin Street
Boston, MA 02110-2804

COPY MAILED

MAR 2 6 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Shih-Chieh Hung et al. :
Application No. 09/761,893 :
Filed: January 17, 2001 :
Attorney Docket No. 12862-002001 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 20, 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, to the final Office action mailed August 6, 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 November 7, 2002.

The application file is being forwarded to Technology Center 1636, 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

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

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Paper No. 8

NANCY R. GAMBURD
MUCH SHELIST FREED DENENBERG AMENT&RUBENSTEIN,PC
191 N. WACKER DRIVE
SUITE 1800
CHICAGO IL 60606-2877

MAIL

NOV 2 0 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of :
Chu et al. :
Application No. 09/761,910 :
Filed: January 17, 2001 :
For: APPARATUS, METHOD AND SYSTEM FOR :
CORRELATED NOISE REDUCTION IN A TRELLIS :
CODED ENVIRONMENT

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on September 26, 2003 (paper No. 7).

A grantable request to withdraw as attorney/agent of record must:
(1) indicate the present mailing address of the attorney(s)/agent(s) who seek(s) to withdraw,
(2) be signed by each attorney/agent seeking to withdraw or clearly be signed on their behalf,
(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**.

It is also noted that the other attorneys associated with customer service number 34756, which is associated with this application, remain of record.

Given that the request to withdraw as attorney/agent did not specifically request a change of address, all future communications from the Office will continue to be directed to the above-listed address, until a specific change of correspondence is specifically requested. A courtesy copy of this decision will also be forwarded to the address listed in the letter attached to the request.

The file is being returned to the Technology Center's Central Files to await action by the examiner in appropriate time.

Dwayne D. Bost
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4778

Cc: Curtis W. Dodd
Member of Technical Staff
Adtran, Inc.
901 Explorer Blvd
Huntsville, AL 35806

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UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,940	01/17/2001	Brian Thornton	BT5302	6173

7590 12/12/2006

Mark Rogers
Speed & Rogers, P.A.
Suite 125
1701 Centerview
Little Rock, AR 72211

EXAMINER
GANEY, STEVEN J

ART UNIT	PAPER NUMBER
3752	

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

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Mark Rogers
Speed & Rogers, P.A.
Suite 125
1701 Centerview
Little Rock AR 72211

In re Application of: THORNTON, BRIAN Serial No.: 09/761,940 Filed: Jan. 17, 2001 Docket: BT5302 Title: LAWN CHEMICAL APPLICATION SYSTEM	DECISION ON PETITION TO ENTER AMENDMENT AFTER FINAL

This is a decision on the petition filed on August 11, 2004 to enter the amendment after final under 37 CFR 1.116.

The petition is **GRANTED**.

In the petition the applicant requested a review of the Advisory Action issued by the examiner on July 22, 2004. In the Advisory Action, the examiner refused to enter the amendment after final because the newly presented claim 21 would require additional consideration. The petitioner stated that the newly presented claim 21 was same as the allowed dependent claim 7. All limitations in the preceding claims 1, 5 and 6 were included in the new independent claim 21. There was no new issue involved. The petitioner requested that the amendment after final be entered and a Notice of Allowability be issued.

The record shows that:

1) On Feb. 11, 2004, the examiner issued a final rejection. The examiner finally rejected claims 1-6, 8 and 9 and allowed claims 7, 10 and 16-18.
2) On Jun. 7, 2004, the applicant filed an amendment after final under 37 CFR 1.116 which rewrote allowable dependent claim 7 in independent form as new claim 21 and canceled all other rejected claims 1-15 and 19-20 with remaining allowable claims 16-18.
3) Subsequently, the examiner issued an Advisory Action on July 22, 2004 stating that the newly presented independent claim 21 would require additional consideration.
4) On Aug. 11, 2004, the applicant filed the present petition to request entry of amendment after final and issuance of Notice of Allowability. The applicant argued that under the

amendment after final merely canceling all rejected claims and placing the application in condition for allowance.

In order to determine whether or not that new independent claim 21 raises new issue, a comparison of the new claim 21 and the previous indicated allowable dependent claim 7 must be made. The new claim 21 does appear to include all limitations in the previous indicated allowable dependent claim 7 and all limitations in the preceding claims 1, 5 and 6. Therefore, new independent 21 could not have raised new issue that the examiner did not consider before. The amendment after final merely cancels all rejected claims and places the application in condition for allowance and should have been entered. The petitioner request that the amendment after final be entered and a Notice of Allowability be issued should be granted.

Accordingly, the holding of abandonment is vacated and the amendment after final filed on June 7, 2004 will be entered.

Any inquiry regarding this decision should be directed to Henry Yuen, Special Program Examiner, at (571) 272-4856.

Karen M. Young

Karen M. Young, Director
Technology Center 3700

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OBLON, SPIVAK, MCCLELLAND
MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

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DEC 09 2008

OFFICE OF PETITIONS

In re Application of	:	DECISION ON
Moriichi et al.	:	PETITION
Application No. 09/761,961	:	and
Filed: January 17, 2001	:	NOTICE OF
Atty Docket No. 204684US6	:	ABANDONMENT

This is a decision on the REQUEST FOR WITHDRAWAL OF HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE NOTICE OF ALLOWANCE/ALLOWABILITY originally filed December 27, 2002, and resubmitted on November 16, 2004. This also responds to the PETITION FOR WITHDRAWAL OF HOLDING OF ABANDONED APPLICATION UNDER 37 C.F.R. 1.137(A) filed March 4, 2005[1].

The petition under 1.181 is **GRANTED to the extent** that the Notice of Abandonment mailed October 30, 2002 is withdrawn; however, the petition is **DISMISSED** to the extent that the holding of abandonment will not be withdrawn. For the reasons stated herein, the application is held abandoned effective April 29, 2001 for failure to timely file a response to the Notice to File Missing Parts of Nonprovisional Application mailed February 28, 2001.

Any request for reconsideration pursuant to 37 CFR 1.181 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 not permitted. See 1.181(f).

Alternatively, applicants may seek revival under the provisions of 37 CFR 1.137. Such a request should include a cover letter entitled "Petition under 37 C.F.R. § 1.137(a)" or "Petition under 37 C.F.R. § 1.137(b)," as appropriate.

---

[1] A review of the record makes clear that applicants also filed status inquiries on December 16, 2002 and July 30, 2003; and resubmitted the petition on January 9, 2004.

By Notice of Abandonment mailed October 30, 2002, applicants were advised that the above-identified application had become abandoned 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.

In response, applicants timely filed the instant petition, requesting that the holding of abandonment be withdrawn on the basis that applicants never received a Notice of Allowance (or any accompanying Notice of Allowability). In support thereof, applicants provided copies of mail logs and docket records for this application.

There is a strong presumption that correspondence is properly mailed to the applicant at the correspondence address of record. In the absence of demonstrated irregularities in mailing of the Notice of Allowance, applicants must submit evidence to overcome this presumption.

Consideration of applicants' showing[2] of nonreceipt is unnecessary. In this instance, the evidence of record overcomes the presumption that the Notice of Allowance was properly mailed to the applicant at the correspondence address of record. An irregularity in the mailing of the Notice of Allowance (and Notice of Allowability) exists. Specifically, consistent with applicants' assertion of nonreceipt, no Notice of Allowance (or Notice of Allowability) is present in the image file wrapper for this application.

The image file wrapper, and other Office records, reveal that:

- on February 28, 2001, the Office mailed a Notice to File Missing Parts of Application, requiring the statutory basic filing fee and an executed oath or declaration;
- on May 25, 2001, applicants responded with an extension of time, an executed declaration, late surcharge, statutory basic filing fee, authorization to charge any required fees to a Deposit Account and payment of fees by check;

---

[2] It is noted that applicants did not provide a copy of a master docket. See MPEP 711.03(c).

- on October 30, 2002, the Office mailed a Notice of Abandonment based on failure to timely pay the issue fee; and
- on August 10, 2005, after filing of the petition on March 4, 2005 (including submission of the issue fee), the Office marked the file as lost[3].

Action on the instant petition could not occur until the file was reconstructed. On April 4, 2007, the Office mailed applicants a NOTICE UNDER 37 CFR 1.251 - Abandoned Application, requesting submission of papers needed for reconstruction of the file. This Notice set a three-month period for reply. On August 8, 2008, applicants filed a REQUEST FOR RECONSTRUCTION OF APPLICATION, with a copy of their itemized and date-stamped postcard evidencing that applicants timely responded to the Notice on July 3, 2007. The papers received in response to the Notice were recently made of record with a date of receipt of August 8, 2008.

Nothing in the reconstructed papers supports a conclusion that a Notice of Allowance (and Notice of Allowability) were ever mailed in this application. Having looked at all available papers, the totality of the evidence supports applicants' assertion of nonreceipt of the Notice of Allowance.

Nonetheless, a close review of the application reveals that the application did become abandoned, just not for the reason stated on the Notice mailed October 30, 2002 (and consequently not at the time indicated by the Notice). Rather, the application became abandoned for failure to file a timely and proper reply to the Notice to File Missing Parts of Application mailed February 28, 2001. This Notice set a two-month time limit for response, with extensions of time obtainable under 37 CFR 1.136(a). On May 25, 2001, applicants filed an extension of time for response within the first month, an executed declaration, late surcharge, statutory basic filing fee and authorization to charge any required fees to a Deposit Account. However, none of the papers filed were signed by attorney of record Gregory J. Maier. On every document his signature line was left blank. The declaration for patent submitted was executed by the inventors. However, absent the signature of the attorney on the accompanying documents the necessary payment of

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[3] It appears that some action on reconstruction began in 2005, but was not completed.

fees, including the required extension of time and filing fees, were not submitted. Moreover, a review of the file history reveals that no general authorization to charge the required fees was present in the application on May 25, 2001. Accordingly, there was no signed document to rely on for timely submission of a complete and proper reply. Thus, the application is abandoned.

It is specifically noted that the papers filed March 25, 2001 and lacking the signature appear to be the papers originally submitted to the Office and not copies of the papers resubmitted to the Office without signature pursuant to the subsequent reconstruction of the file.

No fee is required on petition under § 1.181.

Consideration of the petition under 37 CFR 1.137(a) on the basis that the application became abandoned for failure to pay the issue fee is unnecessary.

The $500 charged on March 8, 2005 for consideration of the petition under 37 CFR 1.137(a) and accordingly, the issue fee of $1400 and the publication fee of $300 submitted pursuant to 37 CFR 1.137(a)(1) petition are being refunded to Deposit Account No. 15-0030, as authorized.

Further correspondence with respect to this decision 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 concerning this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

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Alexandria, VA 22313-1450
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MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

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DEC 23 2009

OFFICE OF PETITIONS

In re Application of	:	DECISION ON
Moriichi et al.	:	PETITION
Application No. 09/761,961	:	
Filed: January 17, 2001	:	
Atty Docket No. 204684US6	:	

This is a decision on the PETITION FOR RECONSIDERATION UNDER 37 C.F.R. §1.181/PETITION UNDER §1.137(b) FOR ACCEPTANCE OF UNINTENTIONALLY DELAYED PAPERS filed February 9, 2009. The status letter filed September 11, 2009 is acknowledged.

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

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

By decision mailed December 8, 2008, the petition under 1.181 filed December 27, 2002 (and resubmitted November 16, 2004 and March 4, 2005[1]) was **GRANTED to the extent** that the Notice of Abandonment mailed October 30, 2002 was withdrawn; however, the petition was **DISMISSED** to the extent that the holding of abandonment was not withdrawn. The decision stated that the application is held abandoned effective April 29, 2001 for failure to timely file a response to the Notice to File Missing Parts of Nonprovisional Application mailed February 28, 2001[2].

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[1] Sometime after filing of the March 4, 2005 petition, these petitions were forwarded to the undersigned for consideration. Unfortunately, the undersigned could not act on the merits of the petitions until the application file was reconstructed. The reconstruction was not properly completed until about November 2008.

[2] Once the file was reconstructed, it was determined that the application was not abandoned as stated in the Notice of Abandonment mailed October 30, 2002.

The reconstructed papers revealed that a response to the Notice was received on May 25, 2001; however, the response was not proper or timely. None of the papers filed, which required his signature, were signed by the attorney of record (or any other party). Where used, his signature line was left blank. Absent the signature of the attorney on the accompanying documents the necessary payment of fees, including the extension of time required to make the response timely and the filing fees required by the Notice, were not submitted. Moreover, a review of the file history revealed that no general authorization to charge the required fees was present in the application on May 25, 2001. Accordingly, the prior decision concluded that as there was no signed document to rely on for timely submission of a complete and proper reply, the application was properly held abandoned. This conclusion was based on a determination that the papers submitted for reconstruction were the same as the papers originally filed on May 25, 2001[3].

On instant request for reconsideration, petitioner contends that the papers provided to the Office were provided directly from the Applicant file, which included unexecuted versions of previously filed papers. Petitioner asserts that as can be appreciated from review of these papers, (e.g., by the photocopy hole punched marks in the top of these papers), these papers were not originally executed documents, instead, the originally executed documents were provided to the Patent Office on May 25, 2001.

Petitioner's arguments have been considered, but not found persuasive that withdrawal of the holding of abandonment is warranted. To avoid abandonment of the application, applicants had to have timely filed properly executed responses. The application is considered abandoned because the evidence of record only supports a conclusion that the papers filed May 25,

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Therein, applicants had been advised that the above-identified application had become abandoned 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. The reconstruction revealed both that no notice of allowance had ever been mailed in this application and that no proper reply had been filed to the Notice to File Missing Parts. Accordingly, the application was abandoned for failure to properly reply to the Notice to File Missing Parts.

[3] Petitioner references a date of March 25, 2001 for submission of the response. As petitioner indicates that this date is supported by Exhibit A, the itemized postcard date-stamped May 25, 2001, it is assumed that "March" 25, 2001 is referenced in error.

2001 were not executed. (It is noted that the fees are of record as they were submitted by separate check).

On instant renewed petition, petitioner has not provided persuasive evidence that the papers originally filed on May 25, 2001 were properly executed. It is undisputed that the papers filed May 25, 2001 (along with the entire application file) were misplaced by the Office. However, just because the file was misplaced, it cannot be presumed that the papers filed were proper. The Office then requires applicants to provide a copy of the papers as originally filed. Petitioner, in this instance, states that the papers as originally filed were executed; however, they did not retain a copy of the executed files. As applicants have not retained a copy of the papers as originally filed, they do not have the evidence necessary to show that a proper response was timely filed on May 25, 2001. Thus, the conclusion that withdrawal of the holding of abandonment is not warranted is affirmed.

Nonetheless, petitioner has met all requirements for revival pursuant to 37 CFR 1.137(b). The petition includes the required reply in the form of the responses now signed, payment of the petition fee and the required statement of unintentional delay.

It is noted that no further action is required by the Office of Patent Application Processing as the undersigned has been advised that pre-examination processing has been completed. Further, the application is not ready for consideration by the Office of Data Management as the indications in the record that a notice of allowance was mailed in this application are incorrect. This application was never allowed.

The application is being forwarded to Technology Center AU 2653 for examination in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

JUN 25 2001

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Michael J. Striker
Stricker, Stricker & Stenby
103 East Neck Road
Huntington, NY 11743

In re Application of
STAEBLER, et al.
Application No.: 09/762,007
PCT No.: PCT/DE00/01720
Int. Filing Date: 26 May 2000
Priority Date: 05 June 1999
Attorney Docket No.: 1441
For: HAND-GUIDED MACHINE JIG SAW

DECISION ON REQUEST

FOR STATUS UNDER

37 CFR 1.42

This decision is in response to applicant's submission of executed inventor's declaration filed in the United States Patent and Trademark Office (USPTO) on 15 March 2001. The submission is being treated as a request for status under 37 CFR 1.42

BACKGROUND

On 26 May 2000, applicant filed international application PCT/DE00/01720, which claimed priority of an earlier application filed 05 June 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 14 December 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 05 February 2001.

On 01 February 2001, 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); an English translation of the international application as required by 35 U.S.C. 371 (c)(2); an Information Disclosure Statement under 37 CFR1.97 and 1.98, a first preliminary amendment and an unexecuted oath or declaration of the inventors.

On 05 March 2001, applicant was mailed a "Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)" (Form PCT/DO/EO/905) informing applicant of the need to submit an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) and a surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date. Applicant was given one month to submit a reply.

On 15 March 2001, applicant responded with the present submission accompanied by a declaration executed by inventors FRECH, WIKER, ENGELFELD and KEUSCH. In addition,

the declaration was signed by Monika STAEBLER as heiress and on behalf of deceased inventor Manfred-Otto STAEBLER. Applicant also authorized the deduction of the $130.00 surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date from Deposit Account No.: 19-4675.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

In the present case, neither the declaration nor the cover letter filed 15 March 2001 indicates that Monika STAEBLER (the person signing the declaration on behalf of the first named inventor) is the **sole** heir of the deceased. Thus, there may be other heirs who are required to sign the declaration. In this regard, applicant has not satisfied the provisions of 37 CFR 1.42 and the declaration can not be accepted at this time.

CONCLUSION

For the above reasons, the petition under 37 CFR 1.42 is **DISMISSED**.

As detailed above, $130.00 will be deducted from Deposit Account No.: 19-4675 for payment of the relevant surcharge.

Applicant is hereby afforded TWO (2) MONTHS from the mail date of this decision to provide an oath or declaration in compliance with 37 CFR 1.497(a)-(b) or to provide certification from counsel that the heiress who executed the 15 March 2001 declaration constitutes all of the heirs of the deceased inventor. Extensions of time are available under 37 CFR 1.36(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Leonard Smith
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

30 SEP 20[illegible]

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Stricker Stricker & Stenby
103 East Neck Road
Huntington, NY 11743

In re Application of FRECH et al. Serial No.: 09/762,007 PCT No.: PCT/DE00/01720 Int. Filing Date: 26 May 2000 Priority Date: 05 June 1999 Attorney's Docket No.: 1441 For: HAND-GUIDED JIG SAW MACHINE	DECISION ON PETITION UNDER 37 CFR 1.137(b)

This is a decision on applicant's 'Petition To Revive" an Application for Patent Abandoned Unintentionally under 37 CFR 1.137 (b) filed in the United States Patent and Trademark Office on 30 July 2003.

BACKGROUND

On 26 May 2000, applicant filed international application No. PCT/DE00/01720 which claimed a priority date of 05 June 1999.

On 01 February 2001, prior to the twenty month deadline, applicant filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. §371 which was accompanied by authorization to charge his deposit account for the basic national fee.

On 05 March 2001, a Notification of Missing Requirements was mailed to applicant indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b) and the surcharge for filing the oath or declaration after the twenty month period was required. On 15 March 2001, applicants filed a declaration executed by the joint inventors and by the heiress of deceased inventor, Manfred-Otto Staebler.

On 25 June 2001, a decision was mailed to applicants indicating that neither the declaration or cover letter filed on 15 March 2001 indicated that Monika Staebler (the person signing the declaration on behalf of the deceased inventor) was the sole heir of the deceased. Applicant was given a two month period within which to respond, with extensions of time available.

On 29 January 2003, a Notification of Abandonment was mailed to applicant indicating that the application was abandoned for failure to timely reply to the Decision on Petition mailed on 05 March 2001.

On 30 July 2003, applicant filed a petition to revive with the petition fee of $1300, requesting the withdrawal of the abandonment of the application accompanied by a declaration executed by Monika Staebler, the sole heir of Manfred-Otto Staebler and the statement that Monika Staebler is sole heiress of the estate of the deceased Manfred-Otto Staebler.

DISCUSSION

A petition under 37 CFR 1.137(b) must be accompanied by (1) a proper response unless it has been previously submitted, (2) the fee required by law for revival of an unintentionally abandoned application (1.17(m)), and (3) a statement that the "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional".

With respect to Items (2) and (3), applicant's statement that "the entire delay in filing the required reply from the due date until the filing of the 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. The required petition fee of $1300 will be charged to applicant's deposit account per his authorization.

With regard to Item (1), a review of the application file reveals that the proper reply has now been provided with a declaration executed by the heir of the deceased inventor and the statement that Monika Staebler is the sole heir of deceased inventor, Manfred-Otto Staebler. Thus, 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 under 37 CFR 1.137(b) is **GRANTED.**

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for further processing. The 35 U.S.C. 371 date is **30 July 2003.**

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

APR 04 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Carter J. White
HOWREY SIMON ARNOLD & WHITE LLP
750 Bering Drive
Houston, TX 77057-2198

In re Application of
BALLARD, David *et al*
U.S. Application No.: 09/762,035
PCT No.: PCT/EP99/05329
Int. Filing Date: 16 July 1999
Priority Date: 30 July 1998
Attorney Docket No.: MIDR695
For: WELLBORE FLUID

DECISION ON
PETITION FOR REVIVAL
UNDER 37 CFR 1.137(b)

The "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 31 January 2001 in the above-captioned application is hereby **GRANTED** as follows:

Applicants paid a basic national fee of $1000.00 and a multiple dependent claim fee of $270.00. However, the proper basic national fee in this case is only 860.00. The $140.00 difference has been credited to Counsel's Deposit Account No. 01-2508.

Applicants' statement that "the entire delay in filing the required reply from the due date until the filing of this petition was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3). The petition fee of $1,240.00 and surcharge fee of $130.00 have also been paid. Therefore, the requirements of 37 CFR 1.137(b) have been satisfied.

However, an oath or declaration of the inventors pursuant to 35 U.S.C. 371(c)(4) was not provided. 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).

James Thomson

James Thomson
PCT Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

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

LAURENCE B BOND
TRASK BRITT
PO BOX 2550
SALT LAKE CITY, UT 84110

COPY MAILED

NOV 18 2004

OFFICE OF PETITIONS

In re Application of :
Douglas L. Jewell et al :
Application No. 09/762,074 : NOTICE
Filed: January 29, 2001 :
Attorney Docket No. 2206-3750.1U :

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 2643.

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

NOV 0 7 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Jeffrey J. Miller
McDermott, Will & Emery
28 State Street
Boston, MA. 02109-1775

In re Application of	:	
JOHNSON, et al.	:	DECISION ON PETITION
U.S. Application No.: 09/762,077	:	
PCT No.: PCT/US99/17338	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 30 July 1999	:	
Priority Date: 30 July 1998	:	
Attorney Docket No.: 56326-032 (IOPL-007)	:	
For: INFARED RADIATION SOURCES, SENSORS	:	
AND SOURCE COMBINATIONS, AND	:	
METHODS OF MANUFACTURE	:	

This decision is in response to applicants' "PETITION UNDER 37 CFR § 1.47(a)" filed 08 August 2001.

BACKGROUND

On 30 July 1999, applicants filed international application PCT/US99/17338, which claimed priority of an earlier application filed 30 July 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 29 February 2000, 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 30 January 2001.

On 30 January 2001, applicants 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); a copy of the International Search Report and a copy of the International Preliminary Examination Report. An oath or declaration of the inventors was not included.

On 08 March 2001, applicants were 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 executed 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. Applicants were advised of the need to respond within one month or by 31 months of the priority date whichever was later and that this time period could be extended with a proper petition and payment of fees.

On 08 August 2001, applicants responded with the present petition to accept the present

oath or declaration without the signature of joint inventor W. Andrew Bodkin accompanied by a combined declaration and power of attorney executed by all the remaining joint inventors other than Mr. Bodkin and a petition for a four-month extension of time. With the filing of the petition for a four-month extension of time and payment of the extension of time fee, applicants' petition is considered to be timely filed.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(I), (2) factual proof that the missing joint investor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As to Items (1), applicants have provided the $130.00 petition fee under 37 CFR 1.17(I) along with the present petition.

Regarding Item (3), applicants have provided the last known address of Mr. Bodkin. Accordingly, Items (1) and (3) have been satisfied.

As to Item (2), the Manual of Patent Examination Procedure (MPEP), Section 409.03(d) Proof of Unavailability or Refusal states that, "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." In the present petition, applicants claim that Mr. Bodkin refuses to execute the oath or declaration. However, it is unclear whether Mr. Bodkin has been presented with a complete copy of the application papers as required. The declaration of Edward A. Johnson seems to imply that Mr. Bodkin was merely sent a copy of the declaration and not a complete set of application papers. This is insufficient. In addition, the nature of the purported refusal is unclear. Mr. Johnson states that, "I was informed that Mr. Bodkin had received the inventors' declaration for his signature but that Mr. Bodkin refused to sign..." It is unclear whether the refusal came directly from Mr. Bodkin and that Mr. Johnson heard the refusal.

Regarding Item (4), the accompanying declaration signed by the remaining inventors on their behalf, and on behalf of the non-signing inventor contains two "Page 4 of 4." This suggests that the enclosed declaration was constructed from numerous complete declarations or that the inventors forwarded to counsel only the signatures pages of the declaration. Either alternative renders the submitted declaration defective under 37 CFR 1.497. While each inventor need not execute the same oath or declaration, where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. (See MPEP 201.03 B. Oath or Declaration.)

In light of the above, applicants' petition can not be granted at this time. It is necessary to

provide copies of the receipts of mailing be it certified mail receipts or Express Mail receipts which show Mr. Bodkin's address and dates of attempted delivery. It must be shown that inventor Bodkin was provided a complete set of the application papers and either expressly refused to sign the declaration or did not respond. Any statements of facts concerning the attempts to obtain Mr. Bodkin's signature and his subsequent refusal must be made by persons having first hand knowledge of those facts.

CONCLUSION

Applicant's petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice**.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file either 1) an oath or declaration in compliance with 37 CFR 1.497 (a)-(b) signed by all inventors or 2) a renewed petition satisfying all requirements under 37 CFR 1.47(a). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Richard Cole
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

17 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mark G. Lappin
McDermott, Will & Emery
28 State Street
Boston, MA. 02109-1775

In re Application of	:	
JOHNSON, et al.	:	DECISION ON PETITION
U.S. Application No.: 09/762,077	:	
PCT No.: PCT/US99/17338	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 30 July 1999	:	
Priority Date: 30 July 1998	:	
Attorney Docket No.: 56326-032 (IOPL-007)	:	
For: INFRARED RADIATION SOURCES, SENSORS	:	
AND SOURCE COMBINATIONS, AND	:	
METHODS OF MANUFACTURE	:	

This decision is in response to applicant's "SECOND RENEWED PETITION UNDER 37 CFR § 1.47(a)" filed 03 June 2002.

BACKGROUND

On 02 April 2002, applicant was mailed a decision dismissing applicant's renewed petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor W. Andrew Bodkin. Applicant was afforded two months to file any request for reconsideration.

On 03 June 2002, applicant responded with the present renewed petition. 02 June 2002 being a Sunday, the renewed petition is considered timely filed.

DISCUSSION

As discussed in the decision mailed 02 April 2002, a petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite $130 petition fee required by 37 CFR 1.17(I); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Applicant previously satisfied items (1), (2) and (3) above.

Regarding item (4), applicants have now filed a compliant combined declaration and power of attorney executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor, W. Andrew Bodkin. Therefore, all of the above items have now been satisfied and it is proper to grant applicant's renewed petition at this time.

CONCLUSION

Applicant's petition under 37 CFR 1.47(a) is **GRANTED**.

The application has an international filing date of 30 July 1999 under 35 U.S.C. 363, and will be given a date of **03 June 2002** 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.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being returned to the DO/EO/US for processing 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

17 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mr. W. Andrew Bodkin
3 Forest Street
Needham, MA. 02192

In re Application of :
JOHNSON, et al. :
U.S. Application No.: 09/762,077 :
PCT No.: PCT/US99/17338 :
Int. Filing Date: 30 July 1999 :
Priority Date: 30 July 1998 :
Attorney Docket No.: 56326-032 (IOPL-007) :
For: INFRARED RADIATION SOURCES, SENSORS :
AND SOURCE COMBINATIONS, AND :
METHODS OF MANUFACTURE :

Dear Mr. Bodkin:

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. Alternately, 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 the appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Leonard Smith
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office

Mark G. Lappin
McDermott, Will & Emery
28 State Street
Boston, MA. 02109-1775

APR 0 2 2002

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WASHINGTON, D.C. 20231
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Mark G. Lappin
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In re Application of	:	
JOHNSON, et al.	:	DECISION ON PETITION
U.S. Application No.: 09/762,077	:	
PCT No.: PCT/US99/17338	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 30 July 1999	:	
Priority Date: 30 July 1998	:	
Attorney Docket No.: 56326-032 (IOPL-007)	:	
For: INFRARED RADIATION SOURCES, SENSORS	:	
AND SOURCE COMBINATIONS, AND	:	
METHODS OF MANUFACTURE	:	

This decision is in response to applicants' "RENEWED PETITION UNDER 37 CFR § 1.47(a)" filed 07 January 2002.

BACKGROUND

On 07 November 2001, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.47(a) to accept the application without the signature of joint inventor W. Andrew Bodkin. Applicant was afforded two months to file any request for reconsideration.

On 07 January 2002, applicant responded with the present renewed petition.

DISCUSSION

As discussed in the decision mailed 07 November 2001, a petition under 37 CFR 1.47(a) must be accompanied by: (1) the requisite $130 petition fee required by 37 CFR 1.17(I); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing joint inventor; and (4) an oath or declaration executed by each of the signing joint inventors on their behalf and on behalf of the non-signing joint inventor(s). Applicant previously satisfied items (1) and (3) above.

Regarding item (2), applicants have presently provided first-hand knowledge that the non-signing inventor, Mr. Bodkin, has been presented with a complete copy of the application papers as required and expressly refused to execute the provided declaration. Thus, applicants have satisfied item (2).

As to item (4), the declaration filed 07 January 2002 is not compliant. The executed declaration executes the wrong U.S. application number. The declaration lists the serial number as "09/762,207" whereas the U.S. serial number for the present application is 09/762,077. In addition, the fourth named inventor is identified as "James T. DALEY" in the published international application while the individual is listed as, and executed by, "James T. DALY" on the filed declaration.

For the reasons stated above it is not possible to grant applicants' renewed petition under 37 CFR 1.47(a) at this time.

CONCLUSION

Applicant's renewed petition under 37 CFR 1.47(a) is **DISMISSED, without prejudice**.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b). Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Boris Milef
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 Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MAY 24 2010

OFFICE OF PETITIONS

FOLEY & LARDNER LLP
111 HUNTINGTON AVENUE
26TH FLOOR
BOSTON MA 02199-7610

In re Application of	:	
Edward A. JOHNSON et al.	:	
Application No. 09/762,077	:	NOTICE
Patent 7,119,337	:	
Filed: January 31, 2001	:	
Attorney Docket No. **082128-0115 IOPL-0007**		

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.

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.

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.

Inquiries related to this communication should be directed to the undersigned at (571) 272-2783.

/Tredelle D. Jackson/
Paralegal Specialist
Office of Petitions

cc: **MICHAEL LABRIC**
MCAFEE & TAFT
TENTH FLOOR, TWO LEADERSHIP SQUARE
211 NORTH ROBINSON
OKLAHOMA CITY OK 73102

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

SEP 10 2003

#18

B.J. Sadoff
Nixon & Vanderhye P.C.
1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714

In re Application of
HERSHFIELD et al
Serial No.: 09/762,097
Filed: August 23, 2001
Attorney Docket No. 1579-527

: Decision on Petition

This letter is in response to the Request for Withdrawal of the Restriction Requirement mailed 15 April 2003. The delay in acting upon this petition is regretted.

BACKGROUND

This application was filed under 35 U.S.C. § 371 as the national stage filing of PCT/US99/17678.

In Paper No 5, mailed 27 November 2001, the Examiner restricted the claims into 13 Groups citing 35 USC 121 as the statutory basis for his restriction, as if the case was filed under 35 U.S.C. § 111 and not 35 USC § 371. Groups I-VI were drawn to polypeptide sequences encoding uricase enzymes comprising SEQ ID Nos. 2, 4, 8, 9, 10 and 11, respectively, Groups VII-XII were drawn to nucleic acids and vectors and host cells encoding the uricase enzymes, Group XIII was drawn to a method of making the enzymes of Groups I-VI less immunogenic by attaching PEG.

In Paper No. 7, filed 28 May 2002, Applicants elected Group V with traverse. The traversal was on the grounds that the case was filed under 35 U.S.C. § 371 and not 35 U.S.C. § 111 and so therefore a proper examination would be for unity of invention to apply under PCT Rule 13.1. In Paper No. 11, mailed 15 October 2002, the Examiner considered the traversal but found it not persuasive. The Examiner argued that although the form paragraphs used for Unity of Invention are different than for restriction the reasons would for restriction would be the same. The Examiner made the restriction Final.

In Paper No. 16 filed 14 April 2003, Applicants petitioned under 37 CFR 1.181 to withdraw the Restriction Requirement. The Petition argued that unity of invention was not applied to his invention as required under PCT Rule 13.1 and that the invention as now claimed had unity of invention.

DISCUSSION

The current application was filed under 35 U.S.C. § 371, so a proper examination of the application would have led the Examiner to restrict the application according to 35 U.S.C. § 121 and § 372, identify why the groups did not share a special technical feature and therefore lacked unity of invention.

In view of facilitating a clear prosecution history the restriction set forth in Paper No. 5 is vacated and the following Lack of Unity requirement on the instantly pending claims is being set forth below:

Restriction is required under 35 U.S.C. § 121 and § 372.

This application contains the following groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

Group I, claim(s) 2-5 and 16-17, drawn to recombinant chimeric uricase proteins and methods of increasing the non-deleterious PEG attachment sites on uricase proteins.

Group II, claim(s) 6-15, drawn to polynucleotides, vectors and host cells encoding the recombinant chimeric uricase proteins.

The special technical feature of Group I is the recombinant chimeric uricase proteins.

The special technical feature of Group II is the polynucleotides, vectors and host cells encoding the recombinant chimeric uricase proteins.

4. The inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Miura et al., (of record) teaches a recombinant chimeric uricase protein which has been modified to insert one or more lysine residues wherein said protein has two or more mammalian amino acid sequences (see abstract in particular), thereby teaching Applicant's invention as presently recited in claim 2. Since Applicant's inventions do not contribute a special technical feature when viewed over the prior art they do not have single general inventive concept and lack unity of invention.

DECISION

This request for removal of the restriction requirement is **GRANTED-IN-PART**. The polypeptides will be examined together along with the method of use. However, claims directed to polynucleotides are not rejoined to the polypeptides because these inventions are not linked by a special technical feature which makes a contribution over the prior art.

Since Applicant has already received an Office action on the merits on one of the polypeptides, the examined claims in the next Office Action will be claims 2-5 and 16-17 directed to polypeptides and method of use. All of the polypeptides SEQ ID Nos. 2, 4 and 8-11 will be examined together. Since the next Office action will include an examination of polypeptides not previously examined, it will be made Non-Final.

The application is being forwarded to the examiner for action on claims 2-5 and 16-17, in response to Applicants' amendment filed 4-15-03 and the Decision of the Petition to include SEQ ID Nos. 2, 4 and 8-11 in the examination.

Since the Petition has been **GRANTED-IN-PART**, the fee of $130.00 paid on 4/16/03 upon filing of this Petition will be refunded to applicants' deposit account number 14-1140.

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

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria VA 22313-1450 or by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7230.

Bruce Kisliuk
TC1600 Group Director

#18

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
P.O.BOX 1450 ALEXANDRIA VA 22313-1450
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JUL 18 2003

BJ SADOFF
NIXON & VANDERHYE
1100 NORTH GLEBE ROAD
8TH FLOOR
ARLINGTON VA 22201-4714

In re Application of	:
COFFIN et al	:
Serial No. 09/762,098	: DECISION ON PETITION
371 Filing Date: 2 February 2001	:
Attorney Docket No. 117-340	:

This letter is in response to the Contingent Petition under 37 CFR 1.181 filed 16 August 2002.

BACKGROUND

This application was filed on 2 February 2001, under 35 U.S.C. 371 as the national stage filing of PCT/GB99/02547, filed 3 August 1999, which claims priority to Great Britain serial number 9816856.0, filed 3 August 1998.

A review of the file history shows that original claims 1-16 were directed a process for propagating a mutant herpes virus, cell lines as defined by various stages of the process, the virus so produced, and a pharmaceutical composition so produced.

A preliminary amendment filed 20 June 2001 amended some claims' dependency to correspond with US practice, cancelled claim 13 and added claims 17-27.

On 16 May 2002, the Office mailed Paper No. 8, which contained a six-way Restriction Requirement, dividing the claims into groups as follows:

Group I: Claims 1-12, 27, drawn to a process for propagating a mutant herpes virus and a composition produced by the process.
Group II, claims 14, 19-20 and 22 drawn to a cell line
Group III, claims 15, 19, 21, 22 drawn to another cell line
Group IV, claim 16, drawn to another cell line
Group V, claims 17-25 drawn to another cell line
Group VI, claim 26 drawn to a virus.

An election of species was also set forth.

In Paper No. 11, Applicants elected Group I, and species Equine herpes virus gene 12 and HSV ICP4 with traverse. Applicants also filed a Petition under 37 CFR 1.181, as paper No. 12, to be considered in the event that the restriction requirement was not withdrawn.

On 6 November 2002, the Office mailed a non-final action as Paper No. 13. Applicants' election and traversal was acknowledged. The Examiner found the arguments not persuasive, in view of the fact that the argued limitations argued were not present in the claims as pending. The Restriction Requirement was made FINAL.

On 6 May 2003, Applicants filed an amendment which cancelled all claims 11-27 directed to the non-elected invention. Applicants also added new claims 28-58 directed to the elected invention.

DISCUSSION

The petition, as filed, was premature in that it was filed prior to the examiner making the restriction requirement final and is dismissed for this reason alone. However, the additional comments which follow are also pertinent.

The application, file history and petition have been considered carefully. The petition presents two concerns:

(1) a request to have the restriction requirement withdrawn.
(2) a request that the requirement be restated wherein applicants, at their discretion, may change their election.

Each concern will be addressed in turn.

First, the petition provides no reasons as to why the restriction requirement should be withdrawn. It merely asserts that the inventions share unity (page 2, top paragraph of Paper No. 12). The reasoning the petition relies upon appears to be the same as that set before the examiner in the election, Paper No. 11, and already reconsidered by the examiner in Paper No. 13. The arguments state that the inventions share a technical feature which makes a contribution over the prior art and the reference cited by the examiner in the restriction requirement, does not address this contribution. The limitations argued in page 4, second full paragraph to top of page 5, do not appear in the claims as they stood at the time the restriction was made, or when the restriction was made final or as the claims are currently amended. For this reason, the arguments are not persuasive.

With regard to applicant's second request, it is noted that allowing applicants to change invention once a first action on the merits has been completed is generally not permitted. See MPEP 819.

Even if the first and/or second argument were persuasive, the petition appears to be asking for rejoinder of or switch to claims which are no longer pending in the application.

DECISION

The petition is **DISMISSED** for the reasons set forth above.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, Washington DC 20231 or by telephone at (703) 308-7553 or by facsimile transmission at (703) 305-7230.

for

Jasemine Chambers
TC1600 Group Director

JUL 1 8 2001

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In re Application of Leopold HACKL Application No.: 09/762,143 PCT No.: PCT/IB99/01516 Int. Filing Date: 02 August 1999 Priority Date: 31 July 1998 Attorney's Docket No.: WLH-7945 For: METHOD AND INSTALLATION OF PYROLYSIS OF WASTE PRODUCTS CONTAINING HYDROCARBONS	DECISION ON 37 CFR 1.42 PAPERS

This is a decision on the papers filed on 31 January 2001, which is being treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 02 August 1999, applicants filed international application PCT/IB99/01516, which claimed priority of an earlier German application filed 31July 1998. A Demand for international preliminary examination was filed on 29 February 2000 and accordingly, the thirty month period for paying the basic national fee for processing in the United States expired at midnight on 29 February 2001.

On 06 March 2000, the International Bureau mailed a Notification of the Recording of a Change (Form PCT/IB/306) to applicants indicating that sole applicant/inventor Leopold Hackl is recorded as a deceased inventor and that Eva Maria Hackl should be recorded as heiress of the deceased inventor.

On 31 January 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter were, *inter alia*: the basic national fee and a declaration executed by "Eva Maria Hackl, heir to Leopold Hackl".

On 14 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) indicating that an English translation of the international application and a processing fee for filing the translation after the thirty month period was required.

DISCUSSION

The declaration filed on 31 January 2001 indicates that sole inventor Leopold Hackl is deceased. The declaration is signed by Eva Maria Hackl as heir to Leopold Hackl.

Pursuant to 37 CFR 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration is unacceptable because it fails to indicate that Eva Maria Hackl is the only heir or the legal representative for the deceased inventor (See MPEP §409.01(a)). That is, there may be other heirs who are required to also sign the declaration. The declaration must indicate that Eva Maria Hackl is the sole heir or the legal representative for the deceased to accept the application under 37 CFR 1.42.

Alternatively, applicants' attorney may file a statement certifying that Eva Maria Hackl is the only heir or the legal representative.

It is noted that where a declaration is not clear that it includes the signatures of all the heirs, a statement is required clearly indicating whether or not the estate of the deceased inventor was administered by a legal representative or not. Further, if the estate of the deceased inventor was not represented by a legal representative, all of the heirs should be clearly identified in the declaration. The legal representative of a deceased inventor (or all of the heirs where there was no legal representative) must make the application for patent "on the same terms and conditions applicable to the inventor." 35 U.S.C. 117. The declaration as submitted is defective (see 37 CFR 1.64) since the names of the legal representative(s) of the deceased inventor must be set forth in the declaration or all of the heirs, where there was no legal representative. The legal representatives/heirs must identify themselves as the legal representative or heirs of the deceased inventor.

Accordingly, it is inappropriate, at this time, to accord the application status under 37 CFR 1.42.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is presently **DISMISSED WITHOUT PREJUDICE**.

If reconsideration of the merits of the request for status under 37 CFR 1.42 is desired, applicant is required to correct the above-noted defects including the furnishing of an oath/declaration in compliance with 37 CFR 1.42 and 1.497 within TWO (2) MONTHS 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."

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Request 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.

Cynthia M. Kratz
Petitions Attorney
PCT Legal Office

Leonard E. Smith
Legal Examiner
PCT Legal Office

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10 JUN 2004

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In re Application of HACKL Application No.: 09/762,143 PCT No.: PCT/IB99/01516 Int. Filing Date: 02 August 1999 Priority Date: 31 July 1998 Attorney Docket No.: WLH-7945US For: METHOD AND PLANT FOR PYROLIZING HYDROCARBON-CONTAINING WASTE PRODUCTS	DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on applicant's "Petition under 37 CFR 1.8(b)" filed in the United States Patent and Trademark Office (USPTO) on 05 March 2004. The petition is being treated as a petition under 37 CFR 1.181, requesting acceptance of documents filed on 06 April 2001 for completion of the application. No petition fee is required. This is also responsive to applicant's request for a refund of $130 petition fee, filed in the USPTO on 16 March 2004, which is granted.

BACKGROUND

On 31 January 2001, applicant filed a Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371 (Form PTO 1390) along with, *inter alia*, the basic national fee and executed declaration.

On 14 March 2001, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants indicating that the English translation of the international application and the processing fee for filing the translation after the thirty month period was required.

On 06 April 2001, in response to the Notification of Missing Requirements, applicant filed the English translation of the international application. The $130 processing fee for filing the English translation after the 30 month period was charged to applicant's credit card on 06 April 2001.

On 16 July 2001, a decision on the submission of the executed declaration was mailed to applicant, refusing to accord the application status under 37 CFR 1.42 at that time. The decision stated that the declaration was signed by Eva Maria Hackl as heir. However it is unclear whether Ms. Hackl is the sole heir or the legal representative for the deceased inventor (See MPEP §409.01(a)) or whether there may be other heirs who are also required to also sign the declaration. In the alternative, applicant's attorney could file a statement certifying that Eva Maria Hackl is the only heir or the legal representative of the deceased inventor, Leopold Hackl. Applicant was given two months to respond to the Office action and advised that

failure to respond would result in abandonment of the application.

On 24 February 2004, a Notification of Abandonment was mailed to applicant, incorrectly indicating the reason for the abandonment was that no reply was received in response to the 14 March 2001 Notification of Missing Requirements.

On 22 March 2004, applicant, in response to the Notification of Abandonment, filed a the instant petition including a copy of postcard bearing a USPTO mail room date-stamped of 06 April 2001 indicating that a certified English translation of the international application was deposited on that date with the USPTO.

DISCUSSION

At the outset it is noted that no reply to the decision mailed on 16 July 2001 is located in the application file. The declaration submitted on 31 January 2001 remains unacceptable as it is not in compliance with 37 CFR 1.497(a) and (b).

A review of the application file reveals the English translation of the international application is located in the file and is date-stamped 06 April 2001. A review of the finance records for 09/762,143 indicates that the $130 processing fee for filing the English translation after the thirty month period was paid on 06 April 2001.

A review of the finance records for this application also indicates that a petition fee of $130 was erroneously charged to applicant's credit card on 05 March 2004. No petition fee is required and the $130 petition fee will be credited to applicant's credit card account.

CONCLUSION

The petition under 37 CFR 1.181 is **MOOT**. The English translation of the international application filed on 06 April 2001 is located in the application file. The $130 petition fee charged on 05 March 2004 will be credited to applicant's credit card account.

However the application remains abandoned as no reply to the decision mailed on 16 July 2001 has been filed. For the reasons previously stated, the declaration submitted on 31 January 2001 is unacceptable as it does not meet the requirements of 37 CFR 1.497(a) and (b).

The application will be held in the PCT Legal Office to await applicant's reply.

Any further correspondence with respect to this matter 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.

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12 MAY 2005

#16

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In re Application of HACKL Application No.: 09/762,143 PCT No.: PCT/IB99/01516 Int. Filing Date: 02 August 1999 Priority Date: 31 July 1998 Attorney Docket No.: WLH-7945US For: METHOD AND PLANT FOR PYROLIZING HYDROCARBON-CONTAINING WASTE PRODUCTS	DECISION ON PETITION UNDER 37 CFR 1.181

This is a decision on applicant's "Petition under 37 CFR 1.181(alternative Petition under 37 CFR 1.137(a)) Request for Withdrawal of Holding of Abandonment" filed in the United States Patent and Trademark Office (USPTO) on 17 June 2004.

BACKGROUND

On 16 July 2001, a decision on the submission of the executed declaration was mailed to applicant, refusing to accord the application status under 37 CFR 1.42 at that time. The decision stated that the declaration was signed by Eva Maria Hackl as heir of deceased inventor Leopold Hackl. It was unclear whether Ms. Hackl is the sole heir or the legal representative for the deceased inventor (See MPEP §409.01(a)) or whether there may be other heirs who are also required to also sign the declaration. Applicant was advised that applicant's attorney could file a statement certifying that Eva Maria Hackl is the only heir or the legal representative of the deceased inventor, Leopold Hackl. Applicant was given two months to respond to the Office action and advised that failure to respond would result in abandonment of the application.

On 24 February 2004, a Notification of Abandonment was mailed to applicant, incorrectly indicating the reason for the abandonment was that no reply was received in response to the 14 March 2001 Notice of Missing Parts.

On 22 March 2004, applicant, in response to the Notification of Abandonment, filed a petition including a copy of postcard bearing a USPTO mail room date-stamped of 06 April 2001 indicating that a certified English translation of the international application was deposited on that date with the USPTO.

On 10 June 2004, a decision on petition was mailed to applicant indicating that the English translation of the international application submitted on 06 April 2001 was located in the application file. However, the application was abandoned because the declaration submitted on 31 January 2001 was unacceptable as it did not meet the requirements of 37 CFR 1.497(a) and (b).

DISCUSSION

Applicant declares that USPTO decision mailed to applicant on 16 July 2001 was never received. Applicant petitions to withdraw the holding of abandonment for failure to timely respond to the 16 July 2001 decision, which he alleges was never received.

In order to establish that papers were not received, as set forth in the Official Gazette at 1156 OG 53, applicant must provide the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket records must also be referenced in practitioner's statement). No petition fee is required.

Applicant has satisfied Items (1), (2) and (3) above with the statement that the 16 July 2001 decision was not received, that a review of the file jacket and docket record book indicating that the decision mailed on or after 16 July 2001, was not received and submission of a copy of the docket record where the non-received Office action would have been entered had it been received (that is, the docket record for 16 September 2001). Counsel has provided his docket record and explanation, showing all responses docketed for the USPTO mail date of 16 September 2001 showing that there was no record of a USPTO mailing for the present application. Thus, applicant has provided the proper showing necessary to withdraw the holding of abandonment and the petition may be properly granted at this time.

With regard to the declaration submitted on 31 January 2001, counsel states that Eva Maria Hackl is the sole heir of deceased inventor Leopold Hackl. The request for status under 37 CFR 1.42 is granted and the declaration is acceptable as it meets the requirements of 37 CFR 1.497(a) and (b).

CONCLUSION

For the reasons presented above, the Petition under 37 CFR 1.181 is **GRANTED**. The request for status under 37 CFR 1.42 is **GRANTED**.

The application will be forwarded to the United States Designated/Elected Office for further processing. The declaration is accepted under 37 CFR 1.42 and fulfills the requirements of 37 CFR 1.497(a) and (b). The 35 U.S.C. 371(c)(1), (c)(2) and (c)(4) is **31 January 2001.**

Cynthia M. Kratz

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Tetsuo Yoshida et al :
Application No. 09/762,145 :
Filed: January 31, 2001 :
Attorney Docket No. Q62887 :

This is a decision on the petition, filed October 22, 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 5, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 1774 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).

26 AUG 2003

#7

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William M Lee
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In re Application of	:	
BONHOMME et al.	:	
Application No.: 09/762,149	:	DECISION ON
PCT No.: PCT/FR99/01928	:	
Int. Filing Date: 04 August 1999	:	PETITION UNDER
Priority Date: 04 August 1998	:	
Attorney Docket No.: 518-1016	:	37 CFR 1.137(b)
For: RADIO ESTIMATION METHOD OF A	:	
MOBILE STATION VELOCITY	:	

This decision is in response to applicant's "PETITION FOR WITHDRAWAL OF ABANDONMENT OF APPLICATION" filed 19 May 2003, which has been treated as a petition under 37 CFR 1.137(b).

BACKGROUND

On 04 August 1999, applicant filed international application PCT/FR99/01928, which designated the United States and claimed a priority date of 04 August 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 February 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 February 2000, which was within 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 February 2001 (04 February 2001 being a Sunday).

On 31 January 2001, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 05 March 2001, 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, *inter alia*, that a translation of the application into English, the processing fee under 37 CFR 1.492(f) for providing the translation later than thirty months from the priority date, an oath or declaration in compliance with 37 CFR 1.497(a)-(b), and the surcharge under 37 CFR 1.492(e) were required. The Notification set a one-month extendable time period for response.

On 25 July 2001, applicants filed two declarations of inventors, a petition/fee for a four month extension of time, and the surcharge under 37 CFR 1.492(e).

On 13 August 2001, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/US/916) indicating, *inter alia*, that applicant's response filed 25 July 2001 was not complete since it failed to include a translation of the international application into English and the processing fee under 37 CFR 1.492(f).

On 11 February 2003, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/US/909) indicating that the application was abandoned as to the United States of America.

On 19 May 2003, applicants submitted a translation of the application into English, the processing fee under 37 CFR 1.492(f), and the instant "PETITION FOR WITHDRAWAL OF ABANDONMENT OF APPLICATION", which has been treated as a petition under 37 CFR 1.137(b).

DISCUSSION

A petition to revive the present application under 37 CFR 1.137(b) must include:
(1) The required reply;
(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 was unintentional.

As to item (1), applicant submitted a translation of the international application into English on 19 May 2003.

As to item (2), applicant submitted the petition fee on 19 May 2003.

As to item (3), petitioner's statement that "[t]he abandonment was unintentional" has been construed 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." If this interpretation is incorrect, applicant must notify the Office of PCT Legal Administration of such fact.

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.

Declaration of Inventors filed 25 July 2001

The two declarations of inventors filed 25 July 2001 fail to comply with 37 CFR 1.497(a)-(b). First, both declarations fail to identify the inventors. In the published international

application, the second inventor is identified as Jean-Louis Dornstetter but in the declarations of inventors filed 25 July 2001, the second inventor is identified as Jean-Louis Dorusletter. A satisfactory explanation of the difference between the last name of the inventor as indicated on the declaration and in the international application has not been provided. Nor has a grantable petition under 37 CFR 1.182 regarding a change of name of the inventor or a grantable petition under 37 CFR 1.497(d) if a change of inventorship is being made from the inventorship of the application as indicated in the international application been provided. Thus, the inventorship indicated in the declaration does not appear to correspond to the inventorship of the international application. Second, each executed declaration must identify each inventor and the citizenship of each inventor. In one of the declarations filed 25 July 2001, the citizenship of only one of the three inventors is indicated. In the other declaration filed 25 July 2001, the citizenship of only two of the three inventors is indicated. Consequently, a new oath(s) or declaration(s) in compliance with 37 CFR 1.497(a)-(b) is required.

CONCLUSION

The petition under 37 CFR 1.137(b) is **GRANTED** for the reasons set forth above.

Applicant is hereby given the time limit of **TWO (2) MONTHS** from the mail date of this communication in order to file a proper response. A proper response would be a new oath(s) or declaration(s) properly identifying all of the inventors and signed by all of the inventors and an acceptable explanation of any typographical or transliteration error in the last name of the inventor as indicated in the international application if this is the case, or a petition under 37 CFR 1.182 (see MPEP § 605.04(c)) if the inventor has changed his name, or a petition under 37 CFR 1.497(d) if a change of inventorship is being made from the inventorship of the application as indicated in the international application.

Failure to timely file a proper response to this decision in a timely manner will result in abandonment of the application with regards to national stage prosecution in the United States.

Please direct further correspondence with respect to this matter to 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.

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17 FEB 2004

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In re Application of
BONHOMME et al.
U.S. Application No. 09/762,149
PCT No.: PCT/FR99/01928
Int. Filing Date: 04 August 1999
Priority Date: 04 August 1998
Attorney Docket No.: 518-1016
For: RADIO ESTIMATION METHOD OF A MOBILE STATION VELOCITY

DECISION ON REQUEST

This decision is in response to applicants' "Request for Refund" filed 14 May 2003. The procedural background for this application is set forth in the "Decision on Petition under 37 CFR 1.137(b)" mailed 26 August 2003.

DISCUSSION

Petitioner requests a refund under 37 CFR 1.26. The present request states, "[o]n July 23, 2001, the applicant sent to the Patent and Trademark Office a Petition for Extension of Time, with the required fee of $1390. Because the application has become abandoned, that extension fee is ineffective, and it is requested that the extension fee of $1390 be refunded." Here, the declaration and petition for extension of time, filed 25 July 2001, were considered a bona fide response to the Notification of Missing Requirements mailed 05 March 2001. In order for the response to be considered, it was necessary for applicant to file the extension of time fee. Upon review of the papers it was determined that the declaration was not in compliance with 37 CFR 1.497(a)-(b) and the English translation was not included with the papers filed 25 July 2001. Subsequently, a Notice of Defective Reponse was mailed on 13 August 2001 and a Notification of Abandonment was mailed 11 February 2003 indicating that applicant failed to file a complete response to the Notification of Missing Requirements. Therefore, the refund under 37 CFR 1.26 is not appropriate.

CONCLUSION

The request for refund under 37 CFR 1.26 is dismissed without prejudice.

If reconsideration of the merits of this petition is desired, a "Renewed Request for Refund" must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted.

It is noted that applicants have not submitted a declaration in compliance with 37 CFR 1.497(a)-(b). The time limit set forth in the "Decision on Petition under 37 CFR 1.137(b)" mailed by Office of PCT Legal Administration on 26 August 2003 remains in effect.

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, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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11 MAY 2004

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In re Application of	:	
BONHOMME et al.	:	
Application No.: 09/762,149	:	
PCT No.: PCT/FR99/01928	:	
Int. Filing Date: 04 August 1999	:	DECISION
Priority Date: 04 August 1998	:	
Attorney Docket No.: 518-1016	:	
For: RADIO ESTIMATION METHOD OF A	:	
MOBILE STATION VELOCITY	:	

This decision is in response to applicant's "PETITION FOR WITHDRAWAL OF ABANDONMENT OF APPLICATION" filed 19 May 2003, which has been treated as a petition under 37 CFR 1.137(b).

BACKGROUND

On 04 August 1999, applicant filed international application PCT/FR99/01928, which designated the United States and claimed a priority date of 04 August 1998. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 February 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 February 2000, which was within 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 February 2001 (04 February 2001 being a Sunday).

On 31 January 2001, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 05 March 2001, 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, *inter alia*, that a translation of the application into English, the processing fee under 37 CFR 1.492(f) for providing the translation later than thirty months from the priority date, an oath or declaration in compliance with 37 CFR 1.497(a)-(b), and the surcharge under 37 CFR 1.492(e) were required. The Notification set a one-month extendable time period for response.

On 25 July 2001, applicants filed two declarations of inventors, a petition/fee for a four month extension of time, and the surcharge under 37 CFR 1.492(e).

On 13 August 2001, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/US/916) indicating, *inter alia*, that applicant's response filed 25 July 2001 was not complete since it failed to include a translation of the international application into English and the processing fee under 37 CFR 1.492(f).

On 11 February 2003, the DO/EO/US mailed a NOTIFICATION OF ABANDONMENT (Form PCT/DO/EO/US/909) indicating that the application was abandoned as to the United States of America.

On 19 May 2003, applicants submitted a translation of the application into English, the processing fee under 37 CFR 1.492(f), and the instant "PETITION FOR WITHDRAWAL OF ABANDONMENT OF APPLICATION", which has been treated as a petition under 37 CFR 1.137(b). In a decision dated 26 August 2003, applicants petition was granted under 37 CFR 1.1137(b), however, the declarations, filed 25 July 2001, were not in compliance with 37 CFR 1.497(a)-(b).

On 22 September 2003, applicant filed "Response to Decision on Petition under 37 CFR 1.137(b) dated 26 August 2003."

DISCUSSION

As stated above, the "Decision on Petition" dated 26 August 2003 indicated that the declarations filed 25 July 2001 were not in compliance with 37 CFR 1.497(a)-(b). Applicants state in the present response that "the citizenship for each inventor, when signing the declaration, is properly set forth and the two declaration have proper citizenship for all three inventors." A review of the two declarations reveals that each separate declaration only identified the particular inventor's citizenship that was signing that declaration. However, 37 CFR 1.497(a)(3) requires that the declaration must "identify each inventor and the country of citizenship of each inventor." Consequently, a new oath(s) or declaration(s) in compliance with 37 CFR 1.497(a)-(b) which identify each inventor and the country of citizenship of each inventor is required. Thus, a declaration in compliance with 37 CFR 1.497(a)-(b) for this application has not been received in the Patent and Trademark Office (PTO).

Because the failure to file the proper response does not appear to have been the result of an inadvertent omission (37 CFR 1.135(a)), applicant will not be accorded a new time period to correct the deficiencies in the response.

CONCLUSION

A proper response must be filed within **ONE MONTH** from the mail date of this decision and must include a proper declaration in compliance with 37 CFR 1.497(a)-(b) executed by all of the named inventors. No extensions of this time limit may be obtained under 37 CFR 1.136(a).

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, Virginia 22313-1450.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (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
www.uspto.gov

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Director's Office
Group 3700

Dewitt Ross & Stevens
8000 Excelsior Drive Suite 101
Madison WI 53717-1914

In re Application of: ANSON et al
Appl. No.: 09/762,223
Filed: May 7, 2001
For: DEVICES AND METHODS FOR THE REPAIR OF ARTERIES

: DECISION ON PETITION

This is a decision on the petition filed on December 8, 2003 by which petitioner requests reconsideration of the propriety of the final Office action issued February 11, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Review of the application and of the claims shows that on September 23, 2002, the examiner promulgated a first Office action. The claims were rejected under 35 USC 112, first and second paragraphs, and under 35 USC 103 based upon prior art to Green. Claim 70 was objected to. In response, on December 30, 2002 petitioner submitted amendments claims 55, 62, 68 and 69 to clarify the claims under 35 USC 112 second paragraph and argument to the first paragraph rejection and to the rejections based upon prior art. In response, on February 11, 2003 the examiner issued a office action, which was styled a final rejection upon the cover sheet and in the Office PALM system. This office action contained rejections based upon new specification objections, new 35 USC 112 first paragraph issues, and 35 USC 102 rejections based upon newly cited prior art. The examiner did not address any of the presented arguments, nor did the body of the office action conclude that prosecution is closed. On August 19, 2003 petitioner filed a request for reconsideration of the finality of the office action, and an amendment. This request was denied and entry of the amendment refused in an advisory action mailed September 3, 2003. Petitioner now petitions under 37 CFR 1.181 for supervisory review seeking reconsideration of and withdrawal of the finality of the office action, withdrawal of any abandonment of the application, entry of the August 19, 2003 amendment and the application returned to examination.

The advisory action of November 10, 2005 states in part "the addition limitation would require reconsideration of the cited references and another search". It does not address petitioner's request for reconsideration of the finality of the office action nor provide any reasoning or support for the office action having been styled "Final" on its cover sheet.

The holding of the February 11, 2003 office action as a Final action is without support in the Manual of Patenting Examining Procedures. As set forth in MPEP 706.07(a) under present practice, second or any subsequent actions on the merits shall be final except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's s amendment to the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with appropriate fee. In the instant application, as there was no amendment to the claims other than minimal clarification of antecedent basis issues to address 35 USC 112 second paragraph rejections, there is no basis for the change in rejections. Further, the record appears incomplete as the examiner's position with respect to petitioner's arguments regarding the prior art and enablement rejections have never been addressed on the record. The Advisory action also fails to address the issues at hand and appears dismissive. The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing and that a clear issue between applicant and examiner should be developed. Such has not happened in the instant application.

The finality of the February 11, 2003 office action is premature. Accordingly, the finality of the rejection mailed February 11, 2003 is hereby withdrawn. The August 18, 2003 amendment is to by styled a timely response to the February 11, 2003 office action and entered into the record. The application is not abandoned. The application is being forwarded to the Head Supervisory Applications examiner for correction of the PALM system to reflect the decision herein. Further, the Head Supervisory Applications examiner will ensure that the paper file is converted to the Image File Wrapper system (IFW) and will then forward the application to the Examiner of record to resume prosecution of the application.

Questions regarding this decision may be directed to J. Harrison, TC 3700 Special Programs Examiner and 571-272-4449.

PETITION GRANTED

Frederick R. Schmidt, Director
Technology Center 3700

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6-15-06

TO SPE OF : ART UNIT 1648

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/762224 Patent No.: 7033545

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

Please check claims / Ref

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**.

Certificates of Correction Branch

703-308-9390 ext. _____

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: Do not cancel claims 11 and 16. These were not cancelled in prosecution, so no USPTO error.

BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Bruce Campell
SPE

1648
Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE 7-24-09

Paper No.: _____

TO SPE OF : ART UNIT 1648

SUBJECT : Request for Certificate of Correction for Appl. No.: 04/762221 Patent No.: 7033545

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

FOR IFW FILES: – Check Reconsideration

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: _____

ROBERT MONDESI
SUPERVISORY PATENT EXAMINER

SPE

1648
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

JUL 20 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MARK M. FRIEDMAN
c/o ANTHONY CASTORINA
2001 JEFFERSON DAVIS HIGHWAY, SUITE 207
ARLINGTON, VA 22202

In re Application of	:
KAPULNIK et al.	: DECISION ON
PCT No.: PCT/IL99/00420	:
Int. Filing Date: 30 July 1999	: PETITION
Priority Date: 03 August 1998	:
Attorney's Docket No.: 01/21632	: UNDER 37 CFR 1.10(e)
For: METHOD FOR SELECTIVE AND OPTIONALLY	:
REVERSIBLE DEGENERATION OF	:
SOMATIC PLANT TISSUE	:

This is a decision on applicants' "Petition under Rule 10(e)" filed in the United States Patent and Trademark Office (USPTO) on 05 February 2001, which is being treated as a petition under 37 CFR 1.10(e) requesting that a "copy" of the Demand filed with the petition be accepted as a replacement for the original Demand filed 23 February 2000.

BACKGROUND

On 30 July 1999, applicant filed international application No. PCT/IL99/00420 which claimed priority of an earlier Israeli application filed 03 August 1998. A copy of the international application was communicated to the United States by the International Bureau on 17 February 2000. On 23 February 2000, 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 05 February 2001 (03 February 2001 was a Saturday and 04 February 2001 was a Sunday).

On 05 February 2001, 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 were, *inter alia*, the requisite basic national fee and an oath or declaration executed by the inventors.

DISCUSSION

With the petition filed on 05 February 2000, applicants provided a copy of the Demand as originally filed along with a notification of change of address and subagent power of attorney

A review of the application file reveals that a Notification of Election (Form PCT/IB/331) mailed on 18 January 2001 is located in the file contents. The Notification indicates that the Demand was timely received on 23 February 2000 and that the United States was elected. Thus, applicants' petition to accept the Demand as filed on that date is **MOOT**.

CONCLUSION

For the reasons discussed above, applicant's petition under 37 CFR 1.10(e) is **MOOT**.

This application is being forwarded to the US Designated/Elected Office for further processing. The change of address and subagent power of attorney will be corrected in PALM. The 35 U.S.C. 371(c) date is 05 February 2001.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Richard R. Cole
Legal Examiner
PCT Legal Office

CMK/RRC:cmk

Telephone: (703) 306-5467
Facsimile: (703) 308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 2/8/07

Paper No.: _____

TO SPE OF : ART UNIT 1648

SUBJECT : Request for Certificate of Correction for Appl. No.: 9/762261 Patent No.: 7096848 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: _____

BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Bruce Campell — SPE

1648 — Art Unit

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Commissioner for Patents
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P.O. Box 1450
Alexandria, VA 22313-1450
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In re Patent No. 6729258
Issue Date: May 4,2004
Application No. 09762275
Filed: February 21,2000
Attorney Docket No.

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

This is a decision on the electronic petition, filed March 12,2009 ,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 12,2009 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6729258	2004-05-04	09762275	2000-02-21	

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

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

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

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

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

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	/Edwin D. Schindler/	Date (YYYY-MM-DD)	2009-03-12
Name	Edwin D. Schindler	Registration Number	31459

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.

MAY 2 4 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MARGARET S. MILLIKIN
BASEL NORTH AMERICA, INC.
912 APPLETON ROAD
ELKTON, MD 21921

In re Application of
MORINI et al.
Application No.: 09/762,363
PCT No.: PCT/EP00/03333
Int. Filing Date: 12 April 2000
Priority Date: 15 April 1999
Attorney Docket No.: US 18003
For: COMPONENTS AND CATALYSTS FOR THE POLYMERIZATION OF OLEFINS

: DECISION ON PETITION

The petition to revive under 37 CFR 1.137(b) filed 05 February 2001 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "entire delay in failing to timely pay the basic national fee for entry into the national stage pursuant to 35 U.S.C.§371(c)(1) on or before twenty months from the priority date of April 15, 1999 from the twenty month deadline on December 15, 2000 and for submitting the Declaration of the inventors until the filing of a grantable petition under 37 CFR 1.137(b) 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.

A review of the application file reveals that the required petition fee of $1240 has been paid and 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.

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) date is 05 February 2001.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office
Telephone: (703) 306-5467

AUG 14 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

#4

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

Allan Ratner
Ratner & Prestia
P.O. Box 980
Valley Forge, PA 19482

In re Application of YAGUCHI et al	:	
U.S. Application No.: 09/762,380	:	
Int. Application No.: PCT/JP00/03620	:	
Int. Filing Date: 05 June 2000	:	DECISION
Priority Date: 07 June 1999	:	
Attorney Docket No.: MTS-3243US	:	
For: RECORDING/REPRODUCING DEVICE, MPEG VIDEO STREAM RECORDING/ REPRODUCING DEVICE, AND MEDIUM	:	

This application is before the PCT Legal Office for consideration of issues arising under 35 U.S.C. 371.

BACKGROUND

On 05 June 2000, applicants filed international application PCT/JP00/03620, which claimed priority of an earlier Japan application filed 07 June 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 14 December 2000. The twenty-month period for paying the basic national fee in the United States expired at midnight on 07 February 2001.

On 07 February 2001, 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 13 June 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Abandonment (Form PCT/DO/EO/909) which indicated that the application is abandoned as to the United States for failure to timely enter the national phase.

DISCUSSION

Because the requisite basic national fee was filed prior to the expiration of twenty months from the priority date, the national phase was entered in a timely manner.

CONCLUSION

The Notification of Abandonment (Form PCT/DO/EO/909) mailed 13 June 2001 is hereby VACATED.

The application has an International Filing Date of 05 June 2000 and a date under 35 U.S.C. 371 of 07 February 2001.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20090412

DATE : April 15, 2009

TO SPE OF : ART UNIT 2416

SUBJECT : Request for Certificate of Correction on Patent No.: 7352735 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:
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:

The changes requested by applicant do not introduce new matter and do not alter the scope and meaning of the claims.

SPE: Chi Pham **Art Unit** 2416

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

Paper No. 13

FISH & RICHARDSON PC
225 FRANKLIN ST
BOSTON MA 02110

COPY MAILED

OFFICE OF PETITIONS

In re Application of	:	
Shinzo Yasuda et al	:	
Application No. 09/762,536	:	ON PETITION
Filed: February 8, 2001	:	
Attorney Docket No. 08917-067001	:	

This is a decision on the petition, filed January 14, 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 December 23, 2002 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[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 1711 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

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. 14

NEEDLE & ROSENBERG PC
127 PEACHTREE STREET NE
ATLANTA CA 30303-1811

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MAY 28 2003

OFFICE OF PETITIONS

In re Application of	:
Josephine Egan et al	: DECISION DISMISSING PETITIION
Application No. 09/762,538	: UNDER 37 CFR 1.78(a)(6)
Filed: July 19, 2001	:
Attorney Docket No. 14014.0346U1	:

This is a decision on the petition filed by facsimile transmission on May 6, 2003, 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 priority to prior-filed provisional Application No. 60/095,917, filed August 10, 1998.

The petition is **dismissed** as moot for the reasons stated below.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000.

37 CFR 1.78(a)(2)(ii)[1] indicates that the time periods set forth therein do not apply if the later-filed application is: (1) an application for a design patent; (2) an application filed under 35 U.S.C. § 111(a) before November 29, 2000; and (3) **a nonprovisional application which entered the national stage after compliance with 35 U.S.C. § 371 from an international application filed under 35 U.S.C. § 363 before November 29, 2000.**

Since the instant nonprovisional application is the national stage entry of an international application filed prior to November 29, 2000, the provisions of

[1] 37 CFR 1.78(a)(2) was amended to place its provisions in separate paragraphs (a)(2)(i) through (a)(2)(iv) for clarity. *See* **Requirements for Claiming the Benefit of Prior-Filed Applications Under Eighteen-Month Publication of Patent Applications**, 66 FR 67087 (December 28, 2001); 1254 Off. Gaz. Pat. Office, 121 (January 22, 2002) (final rule).

37 CFR 1.78(a)(3) for acceptance of a late claim for priority do not apply to the subject nonprovisional application. Accordingly, the petition is dismissed as involving a moot issue.

In view of the dismissal of the instant petition as moot, the $1,300 fee submitted therefor is unnecessary. Accordingly, as authorized, this fee will be refunded to Deposit Account No. 14-0629 in due course.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

This application is being returned to Technology Center Art Unit 1646.

Karen Creasy for

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

DEC 1 7 2001

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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PATENT & TRADEMARK OFFICE

RECEIVED
BY DOCKET DEPT.
DEC 2 6 2001
FULWIDER PATTON LEE & UTECHT, LLP
LOS ANGELES

James W. Paul
6060 Center Drive 10th Floor
Los Angeles, CA 90045

In re Application of FERRERA et al. Application No.: 09/762,539 PCT No.: PCT/US98/25822 Int. Filing Date: 04 December 1998 Priority Date: 05 December 1997 Attorney Docket No.: MICRU: 55261 For: VASOOCLUSIVE DEVICE FOR TREATMENT OF ANEURYSMS	DECISION ON PETITION

This decision is in response to applicants' "RENEWED PETITION UNDER 37 CFR 1.47(a)" filed 09 October 2001.

BACKGROUND

On 04 December 1998, applicant filed international application No. PCT/US98/25822 which claimed a priority date of 05 December 1997, and which designated the United States. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 June 1999. A Demand for international preliminary examination in which the United States was elected, was filed on 01 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 05 June 1999.

On 08 February 2001, applicant filed a Transmittal Letter (Form PTO-1390) for entry into the national stage in the United States under 35 U.S.C. 371 along with, *inter alia*, the U.S. basic national fee, the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date, and an assertion of small entity status. Applicants also submitted a PETITION FOR REVIVAL OF AN INTERNATIONAL APPLICATION FOR PATENT DESIGNATING THE U.S. ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b) along with a declaration signed by three of the four joint inventors and a PETITION FOR APPLICATION ON BEHALF OF NON-SIGNING INVENTOR UNDER 37 CFR 1.47(a) and MPEP 409.03(a). The petition under 37 CFR 1.47(a) was also accompanied by, *inter alia*, a declaration of facts by James W. Paul.

On 21 August 2001, the USPTO mailed a decision granting applicants' petition under 37 CFR 1.137(b) and dismissing applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort had not been provided.

On 09 October 2001, applicants submitted the instant "RENEWED PETITION UNDER 37 CFR 1.47(a)" which was accompanied by a copy of a letter sent to Mr. Kurz dated 31 August 2001 and a copy of a certified mail receipt from the USPS.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 21 August 2001, items (1), (3), and (4) have been met.

As to item (2), the steps enumerated by Mr. Paul are sufficient to establish that the Mr. Kurz has been presented with the application papers and has refused to execute the application. The application and papers have been reviewed and have been found to be in compliance with 37 CFR 1.47(a).

CONCLUSION

For the reasons set forth above, applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

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.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office

of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. 371(c) date of **08 February 2001**.

Daniel Stemmer
Legal Examiner
PCT Legal Affairs
Office of Patent Cooperation Treaty
Legal Administration
Telephone: (703) 308-2066
Facsimile: (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. 8

Robert A. Muha
Kirpatrick & Lockhart
Henry W Oliver Building
535 Smithfield Street
Pittsburgh, Pennsylvania 15222-2312

MAILED

SEP 0 2 2003

Technology Center 2100

In re Application of: Lothrop Mittenthal Application No. 09/762,555 Filed: April 1, 2001 For: DETERMINISTICALLY GENERATING BLOCK SUBSTITUTION TABLES WHICH MET A GIVEN STANDARD OF NONLINEARITY	))))))))	DECISION ON PETITION TO MAKE SPECIAL UNDER 37 C.F.R. §1.102(c) AND MPEP § 708.02 (IV): APPLICANT'S AGE

This is a decision on the petition, filed August 18, 2003, under 37 C.F.R. §1.102(c) and M.P.E.P. §708.02(IV): Applicant's Age, to make the above-identified application special.

A grantable petition to make special under 37 C.F.R. § 1.102 and in accordance with M.P.E.P. § 708.02, Section IV must include a showing, as by a birth certificate or the applicant's statement, that the applicant is sixty five (65) years of age or more. No fee is required for this petition.

The petition includes a copy of Lothrop Mittenthal's birth certificate establishing that applicant is sixty five (65) years of age or more. Accordingly, the petition is **GRANTED.**

The application is being forwarded to the examiner for expedited prosecution.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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ROBERT A. MUHA
KIRTPATRICK & LOCKHART
HENRY W. OLIVER BUILDING
535 SMITHFIELD STREET
PITTSBURGH, PA 15222-2312

COPY MAILED
SEP 27 2006
OFFICE OF PETITIONS

In re Application of	:	
Lothrop Mittenthal	:	
Application No. 09/762,555	:	ON PETITION
Filed: April 10, 2001	:	
Attorney Docket No. TET-1668/980	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 2, 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 an appeal brief (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 2131 for further processing.

Irvin Dingle
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

JUN 0 5 2001

KNOBBE, MARTENS, OLSON & BEAR, LLP
620 Newport Center Drive
Sixteenth Floor
Newport Beach, CA 92660

In re Application of KATSUMATA et al	:	
U.S. Application No.: 09/762,568	:	DECISION ON PETITION
Int. Application No.: PCT/JP00/02785	:	
Int. Filing Date: 27 April 2000	:	UNDER 37 CFR 1.137(b)
Priority Date: 04 June 1999	:	
Attorney Docket No.: HIKARI.001APC	:	
For: NOVEL PLASMID VECTOR	:	

This is in response to applicants' "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 06 February 2001.

BACKGROUND

On 27 April 2000, applicants filed international application PCT/JP00/02785, which claimed priority of an earlier Japan application filed 04 June 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 14 December 2000. The twenty-month period for paying the basic national fee in the United States expired at midnight on 05 February 2001 (04 February 2001 was a Sunday).

International application PCT/JP00/02785 became abandoned as to the United States at midnight on 05 February 2001 for failure to pay the basic national fee.

On 06 February 2001, applicants filed the present petition. The petition states that it is accompanied by a proper response under 35 U.S.C. 371, the petition fee set forth in 37 CFR 1.17(m), and a statement that "the delay in submission of the proposed response or fee was unintentional."

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire

delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicants have provided the basic national fee required under 35 U.S.C. 371.

With regard to item (2), applicants have provided the required petition fee.

With regard to item (3), the petition states, "The delay in submission of the proposed response or fee was unintentional." This statement is interpreted 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 under 37 CFR 1.137(b) was unintentional. If this is an incorrect interpretation in view of the rules, petitioner is required to provide a statement to that effect.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is GRANTED.

A fee of $130.00 set forth in 37 CFR 1.492(f) for filing a translation of the international application into English later than twenty months from the priority date will be charged to Deposit Account No. 11-1410 per applicants' authorization.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision, including preparation and mailing of 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 along with the associated late filing surcharge must be filed.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

SPE : R. Crispino

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 8/17/04

TO SPE OF : ART UNIT 1733

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/762,617 Patent No.: 6986825

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.

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

Comments: _____

[signature] 1733

SPE **Art Unit**

09/762619

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : July 17, 2006

TO SPE OF : ART UNIT 1724

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/762619 Patent No.: 6,827,220

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

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

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

Magdalene Talley

Certificates of Correction Branch

703-308-9390 ext. 116

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: All changes are OK except the addition to claim 2, line 3. DO NOT ENTER this single change only.

TML — AU (1724)

DUANE SMITH
SUPERVISORY PATENT EXAMINER
SPE

1724
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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Paper No. 16

JOHN S. PRATT, ESQ
KILPATRICK STOCKTON LLP
1100 PEACHTREE STREET, SUITE 2800
ATLANTA, GA 30309

COPY MAILED

JAN 2 8 2003

OFFICE OF PETITIONS

In re Application of
Koral Embil et al
Application No. 09/762,630
Filed: April 10, 2001
Attorney Docket No. 888-50

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed November 18, 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 November 18, 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 February 19, 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. If the statement contained in the instant petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 CFR 1.137(b)(3) and petitioner must notify the Office if this is **not** a correct interpretation of the statement contained in the instant petition.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (703) 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

08-01-01

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AUG 03 2001
TECH CENTER 1600/2900

OIPE JC176
JUL 31 2001
PATENT & TRADEMARK OFFICE

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: ELKE HELFTENBEIN-1 (PCT)

SERIAL NO.: 09/762,643 FILED: FEBRUARY 9, 2001

PCT NO.: PCT/EP99/05857 PCT FILED: AUGUST 12, 1999

TITLE: VESSEL FOR BLOOD SAMPLING

RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT (37 C.F.R. §1.121)

ATTN: BOX NON-FEE AMENDMENT
Assistant Commissioner of Patents
Washington, D.C. 20231

Dear Sir:

In response to the Notice of Non-Compliant Amendment (37 C.F.R. §1.121), mailed July 5, 2001, Applicant re-submits the Preliminary Amendment previously filed on April 5, 2001, but in the format required under 37 C.F.R. §1.121. Applicant has inserted a new paragraph on page 1 providing the cross-reference to related applications, and accordingly, it is believed that there is no need to provide a marked-up version of the specification page.

Respectfully submitted,
ELKE HELFTENBEIN

Allison C. Collard, Reg. No.22,532
Edward R. Freedman, Reg. No.26,048
Attorneys for Applicant

COLLARD & ROE, P.C.
1077 Northern Boulevard
Roslyn, New York 11576
(516) 365-9802

Enclosure: Preliminary Amendment and copy of Notice

Express Mail No. EL 871 446 518 US
Date of Deposit July 31, 2001

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10, on the date indicated above, and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Lisa L. Vulpis

R:\Lisa\2001\July\Non-Compliance Notice\HELFTENBEIN-1 (PCT) notice.wpd

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 202
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.

OIPE JC176
JUL 3 1 2001
PATENT & TRADEMARK OFFICE

EXAMINER

ART UNIT	PAPER NUMBER
	9

RECEIVED
AUG 0 3 2001
TECH CENTER 1600/2900

DATE MAILED: 7-5-01

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment filed on 5-18-01 is considered non-compliant because it has not been submitted in the format required under 37 CFR 1.121, as amended on September 8, 2000 (see *65 Fed. Reg. 54603*, Sept. 8, 2000, and *1238 O.G. 77*, Sept. 19, 2000).

☐ 1. The amendment does not include a clean version of the replacement paragraph(s)/section(s). 37 CFR 1.121(b)(1)(ii).

☐ 2. The amendment does not include a marked-up version of the replacement paragraph(s)/section(s). 37 CFR 1.121(b)(1)(iii)

☐ 3. The amendment does not include a clean version of the amended claim(s). 37 CFR 1.121(c)(1)(i)

☐ 4. The amendment does not include a marked-up version of the amended claim(s). 37 CFR 1.121(c)(1)(ii)

☐ 5. Other_____

☒ **PRELIMINARY AMENDMENT:** Unless applicant re-submits the preliminary amendment in compliance with revised 37 CFR 1.121 within ONE MONTH of the mail date of this letter, examination on the merits may commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.

☐ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above mentioned reply appears to be *bona fide*, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

For your convenience, attached to this correspondence is a copy of an informational flyer (MPEP Bookmark Bulletin on "Simplified Amendment Practice").

Legal Instruments Examiner

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#4

APPLICANTS: ELKE HELFTENBEIN-1 (PCT)

SERIAL NO.: 09/762,643 FILED: FEBRUARY 9, 2001

INT'L.APPLN.NO.: PCT/EP99/05857 FILED: AUGUST 12, 1999

FOR: VESSEL FOR BLOOD SAMPLING

RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. §371

ATTN: BOX PCT
Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

In response to the enclosed Notification of Missing Requirements dated March 21, 2001, with the time for reply having been extended for one month from April 21, 2001 to May 21, 2001, applicant is submitting the Combined Declaration/Power of Attorney and a check for $130.00 for the late fee.

Also attached hereto is an executed ASSIGNMENT, along with the required cover sheet, with authorization to charge the $40.00 to the undersigned attorneys' deposit account.

Any fee deficiencies may be charged to deposit account 03-2468.

Applicant Claims Priority under 35 U.S.C. §119 of German Application No. 19836559.4 filed August 12, 1998.
Applicant Claims Priority under 35 U.S.C. §120 of: PCT No. PCT/EP99/05857 filed August 12, 1999.

05/23/2001 LLANDGRA 00000046 032468 09762643

02 FC:154 130.00 OP

Respectfully submitted,
ELKE HELFTENBEIN

Edward R. Freedman

Allison C. Collard, Reg.No.22,532
Edward R. Freedman, Reg.No.26,048
Attorneys for Applicant

COLLARD & ROE, P.C
1077 Northern Boulevard
Roslyn, New York 11576
(516) 365-9802
ERF/llv

Enclosures: Form PCT/DO/EO/905, Executed Declaration/Power of Attorney, check for $130.00, Assignment with cover sheet, Petition for One-Month Extension and a check for $110.00

EXPRESS MAIL NO. **EL 769 391 203 US** Date of Deposit: May 18, 2001

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10, on the date indicated above, and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

Lisa L. Vulpis

Lisa L. Vulpis

MAY 2 4 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Jens E. Hoekendijk
P.O. Box 4787
Burlingame, CA 94011

In re Application of SABANATHAN, Thirumani Application No.: 09/762,692 PCT No.: PCT/GB98/00652 Int. Filing Date: 03 March 1998 Priority Date: 30 April 1997 Attorney Docket No.: 007-001 For: OCCLUSION DEVICE	: : : : : : :	DECISION ON PETITION UNDER 37 CFR 1.137(b)

This is a decision on applicant's "PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED UNINTENTIONALLY UNDER CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 09 February 2001.

BACKGROUND

On 03 March 1998, applicant filed international application PCT/GB98/00652 which claimed a priority date of 30 April 1997 and which 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 November 1998.

A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999.

On 09 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee, a copy of the international application, and the present petition seeking revival under 37 CFR 1.137(b) with the appropriate fee.

DISCUSSION

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to authorize the Commissioner to revive an "unintentionally" abandoned application without a showing that the delay in prosecution was "unavoidable." 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). The circumstances of the above-identified application raise a question whether the delay was "unintentional":

> Where the applicant deliberately permits an application to become abandoned (*e.g.*, due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of [37 CFR] 1.137(b). . . . An intentional delay resulting from a deliberate course of action chosen by the applicant is not affected by: (1) the correctness of the applicant's (or applicant's representative's) decision to abandon the application or not to seek or persist in seeking revival of the application; (2) the correctness or propriety of a rejection, or other objection, requirement, or decision by the Office; or (3) the discovery of new information or evidence, or other change in circumstances subsequent to the abandonment or decision not to seek or persist in seeking revival.

See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 86 (October 21, 1997)(citations omitted).

A review of the application file and specifically the "Declaration by Mark Lunt" reveals that the entire delay cannot be held to be unintentional. In the declaration, it is stated that "[d]ue to my mistaken belief that the (Bradford Hospitals NHS Trust) Trust owned all patent rights, I followed the instructions by the Trust not to file a U.S. National Phase Application." Therefore, in view of the deliberately chosen course of action to not persist in seeking the revival of the abandoned application, the delay cannot be considered to be unintentional, and the petition may not be properly granted.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED** with regards to national stage processing in the United States.

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 1.137(b)." No additional petition fee is required.

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.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Anthony Smith
PCT Petitions Attorney
PCT Legal Office
Tel.: (703) 308-6314
Fax: (703) 308-6459

FEB 1 5 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Nina L. Medlock
Banner & Witcoff, Ltd.
1001 G Street, N.W., Eleventh Floor
Washington, D.C. 20001-4597

In re Application of	:	
SABANATHAN, Thirumani	:	
Application No.: 09/762,692	:	DECISION ON PETITION
PCT No.: PCT/GB98/00652	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 03 March 1998	:	
Priority Date: 30 April 1997	:	
Attorney Docket No.: 007-001	:	
For: OCCLUSION DEVICE		

This is a decision on applicant's "RENEWED PETITION UNDER CFR 1.137(b) AND PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136" filed in the Patent and Trademark Office (PTO) on 24 September 2001.

BACKGROUND

The procedural background for this application was set forth in detail in the decision mailed by this Office on 24 May 2001. That decision dismissed applicants' petition under 37 CFR 1.137(b) because the delay was not considered to be unintentional.

On 24 September 2001, applicants responded to the 24 May 2001 decision by filing the "Renewed Petition under CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136."

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after applicant becomes aware of the abandonment and must be accompanied by: (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 of the reply until the filing of a grantable petition was unintentional and (4) a terminal disclaimer (for applications filed before 8 June 1995).

Applicant has satisfied items (1) and (2), as to item (4), since the application was filed after 08 June 1996, a terminal disclaimer is not required.

With regards to item (3) above, a review of the present renewed petition reveals that applicant has not provided the necessary evidence that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was

unintentional. In the Petition to Revive dated 09 February 2001, Mark Lunt declared that, "[d]ue to my mistaken belief that the (Bradford Hospitals NHS Trust) Trust owned all patent rights, I followed the instructions by the Trust not to file a U.S. National Phase Application." Mr. Lunt's statement was construed as being a deliberately course of action to not persist in seeking the revival of the abandoned application.

Petitioner asserts in the renewed Petition to Revive filed 24 September 2001 that, "[i]n the present case ... no decision to abandon was made by Applicant or any authorized agent of the Applicant. Mr. Lunt abandoned the application, acting on behalf of Bradford, contrary to the known desire of Applicant to prosecute the application, without any consultation with Applicant."

As stated in Manual of Patent Examining Procedure, 711.03(c)(E):

> . . . . where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See Winkler, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See Futures Technology Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party.

However, the papers show that Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute the above identified application. Additionally, Thirmunani Sabanathan states in her declaration that "if I cooperated with any patent application, then Bradford would pay for prosecuting the PCT Application, including Mr. Lunts' fee, and in the event the invention was commercialized and that I would share royalties equally with Bradford." Therefore, Mr. Lunt had authority to prosecute (or not prosecute) the application and Ms. Sabanathan is bound by the actions of Mr. Lunt.

Since applicant has not met the requirements for revival of an application under 37 CFR 1.137(b), revival at this time would not be proper.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED** with regards to national stage processing in the United States.

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 1.137(b)." No additional petition fee is required.

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
Attorney-Advisor
PCT Legal Office
Tel.: (703) 308-6314
Fax: (703) 308-6459

15 NOV 2002

#7

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Nina L. Medlock
Banner & Witcoff, Ltd.
1001 G Street, N.W., Eleventh Floor
Washington, D.C. 20001-4597

In re Application of	:	
SABANATHAN, Thirumani	:	
Application No.: 09/762,692	:	DECISION ON PETITION
PCT No.: PCT/GB98/00652	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 03 March 1998	:	
Priority Date: 30 April 1997	:	
Attorney Docket No.: 007-001	:	
For: OCCLUSION DEVICE		

This is a decision on applicant's "Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136" filed in the Patent and Trademark Office (PTO) on 10 June 2002.

BACKGROUND

On 03 March 1998, applicant filed international application no. PCT/GB98/00652 which claimed a priority date of 30 April 1997 and which 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 November 1998.

A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999.

On 09 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee, a copy of the international application, and a petition seeking revival under 37 CFR 1.137(b) with the appropriate fee. The petition was dismissed in a decision dated 24 May 2001 because the delay was not considered to be unintentional.

On 24 September 2001, applicant responded to the 24 May 2001 decision by filing the "Renewed Petition under CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 February 2002 because the delay was not considered to be unintentional.

On 10 June 2002, applicant responded to the 15 February 2002 decision by filing the present "Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136."

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after applicant becomes aware of the abandonment and must be accompanied by: (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 of the reply until the filing of a grantable petition was unintentional and (4) a terminal disclaimer (for applications filed before 08 June 1995).

Applicant has satisfied items (1) and (2), as to item (4), since the application was filed after 08 June 1996, a terminal disclaimer is not required.

With regards to item (3) above, a review of the present renewed petition reveals that applicant has not provided the necessary evidence that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. In the Petition to Revive dated 09 February 2001, Mark Lunt declared that, "[d]ue to my mistaken belief that the (Bradford Hospitals NHS Trust) Trust owned all patent rights, I followed the instructions by the Trust not to file a U.S. National Phase Application." Mr. Lunt's statement was construed as being a deliberately course of action to not persist in seeking the revival of the abandoned application. In the Renewed Petition to Revive filed 24 September 2001, petitioner asserted that Mr. Lunt did not have the authority to abandon the application without the consent of Ms. Sabanathan. In a decision dated 15 February 2002, the PCT Legal Office held that "Mr. Lunt had authority to prosecute (or not prosecute) the application and Ms. Sabanathan is bound by the actions of Mr. Lunt."

Petitioner asserts in the (second) renewed Petition to Revive filed 10 June 2002 that, "Bradford Hospital had a fiduciary duty to Mrs. Sabanathan and assumed an affirmative obligation to prosecute both British and foreign patent on Mrs. Sabanathan's behalf applications on behalf." The PCT Legal Office respectfully disagrees with petitioner's assertion. As stated in the decision dated 15 February 2002, the papers show that Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute the above identified application. Additionally, Thirmunani Sabanathan states in her declaration that "if I cooperated with any patent application, then Bradford would pay for prosecuting the PCT Application, including Mr. Lunts' fee, and in the event the invention was commercialized and that I would share royalties equally with Bradford." Further, in Susan E. Clark's letter dated 31 March 1998 to David Jackson, Chief Executive of Bradford Hospital, states that "[a]s I understand it, any financial benefit obtained through the commercial development of the device, the exploitation of a patent or any other commercial interest in the product would . . . be split 50:50 between the Trust and the Sabanathan estate." Therefore, Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute (or not prosecute) the above identified application.

Additionally, petitioner avers that Mrs. Sabanathan is the true owner of this invention and the patent application. Petitioner relies upon an United Kingdom Patent Office entitlement decision which determined, on 21 January 2001, that "Bradford Hospital did not at any time have any ownership rights or interest in the invention or patent application." However, a review of the petition papers reveal that the United Kingdom Patent Office may not have been provided with all the information and pertinent documents. For example, was the U.K. Patent Office provided with the "Agreement" executed 06 June 2000 by NHS Bradford and Thurumani Sabanathan which assigns all rights, title and interest of the invention to the assignee, The Foundry? Moreover, it appears that NHS Bradford agreed not to contest the entitlement of the invention so that Mrs. Sabanathan would not be bound by NHS Bradford decision not to prosecute the above identified application.

Lastly, even if the PCT Legal Office had agreed with the petitioner that Mrs. Sabanathan is the true owner of the application and that NHS Bradford breached its fiduciary duty, a review of the application file reveals that the entire delay cannot be held to be unintentional. As stated above, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999. On 06 June 2000, Thurumani Sabanathan executed "Agreement" which states that "the Foundry acknowledges that it is aware that the period within which national/regional phase entry of the international application no. PCT/GB98/00653 must normally be effected may have passed with such phases having entered and therefore such application may not exist . . . " Upon execution of the agreement, Mrs. Sabanathan became aware of the abandonment of application no. PCT/GB98/00653 and should have filed a petition to revive under 37 CFR 1.137 to protect her rights in the invention. Therefore, in view of the deliberately chosen course of action to not persist in seeking the revival of the abandoned application, the delay cannot be considered to be unintentional, and the petition may not be properly granted.

Since applicant has not met the requirements for revival of an application under 37 CFR 1.137(b), revival at this time would not be proper.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED** with regards to national stage processing in the United States.

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 1.137(b)." No additional petition fee is required.

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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04 JUN 2003

#9

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Washington, D.C. 20001-4597

In re Application of	:	
SABANATHAN, Thirumani	:	
Application No.: 09/762,692	:	DECISION ON PETITION
PCT No.: PCT/GB98/00652	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 03 March 1998	:	
Priority Date: 30 April 1997	:	
Attorney Docket No.: 007-001	:	
For: OCCLUSION DEVICE		

This is a decision on applicant's "Second Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 15 January 2003.

BACKGROUND

On 03 March 1998, applicant filed international application no. PCT/GB98/00652 which claimed a priority date of 30 April 1997 and which 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 November 1998.

A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999.

On 09 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee, a copy of the international application, and a petition seeking revival under 37 CFR 1.137(b) with the appropriate fee. The petition was dismissed in a decision dated 24 May 2001 because the delay was not considered to be unintentional.

On 24 September 2001, applicant responded to the 24 May 2001 decision by filing the "Renewed Petition under CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 February 2002 because the delay was not considered to be unintentional.

On 10 June 2002, applicant responded to the 15 February 2002 decision by filing the "Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 November 2002 because the delay was not considered to be unintentional.

On 15 January 2003, applicant filed "Second Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b)."

DISCUSSION

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be filed promptly after applicant becomes aware of the abandonment and must be accompanied by: (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 of the reply until the filing of a grantable petition was unintentional and (4) a terminal disclaimer (for applications filed before 08 June 1995).

Applicant has satisfied items (1) and (2), as to item (4), since the application was filed after 08 June 1996, a terminal disclaimer is not required.

With regards to item (3) above, a review of the present renewed petition reveals that applicant has not provided the necessary evidence that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. In the Petition to Revive dated 09 February 2001, Mark Lunt declared that, "[d]ue to my mistaken belief that the (Bradford Hospitals NHS Trust) Trust owned all patent rights, I followed the instructions by the Trust not to file a U.S. National Phase Application." Mr. Lunt's statement was construed as being a deliberately course of action to not persist in seeking the revival of the abandoned application. In the Renewed Petition to Revive filed 24 September 2001, petitioner asserted that Mr. Lunt did not have the authority to abandon the application without the consent of Ms. Sabanathan. In a decision dated 15 February 2002, the Office of PCT Legal Administration held that "Mr. Lunt had authority to prosecute (or not prosecute) the application and Ms. Sabanathan is bound by the actions of Mr. Lunt." In a decision dated 15 November 2002, the Office of PCT Legal Administration held that the papers showed that Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute the above identified application and that the entire delay could not held to be unintentional.

As stated in Manual of Patent Examining Procedure, 711.03(c)(E):

> The question under 37 CFR 1.137 is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unavoidable or unintentional. When the applicant assigns the entire right, title, and interest in an invention to a third party (and thus does not retain any legal or equitable interest in the invention), the applicant's delay is irrelevant in evaluating whether the delay was unavoidable or even unintentional. See Kim v. Quigg, 718 F. Supp. 1280, 1284, 12 USPQ2d 1604, 1607-08 (E.D. Va. 1989). When an applicant assigns the application to a third party (e.g., the inventor/applicant's employer), and the third party decides not to file a reply to avoid abandonment, the applicant's actions, inactions or intentions are irrelevant under 37 CFR 1.137, unless the third party

> has reassigned the application to the applicant prior to the due date for the reply. Id.
>
> Likewise, where the applicant permits a third party (whether a partial assignee, licensee, or other party) to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See Winkler, 221 F. Supp. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See Futures Technology Ltd. v. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party.

Petitioner states in the present petition that "Bradford Hospital's authority to prosecute the patent applications was not absolute and unfettered" and that "it (USPTO) completely ignores the relevant facts that Mrs. Sabanathan granted only conditional authority to Bradford Hospital to prosecute patent application . . ." The evidence presented has been carefully reviewed and as stated in the previous Decision(s), the papers show that Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute the above identified application. Additionally, Thirmunani Sabanathan states in her declaration that "if I cooperated with any patent application, then Bradford would pay for prosecuting the PCT Application, including Mr. Lunt's fee, and in the event the invention was commercialized and that I would share royalties equally with Bradford." Further, in Susan E. Clark's letter dated 31 March 1998 to David Jackson, Chief Executive of Bradford Hospital, states that "[a]s I understand it, any financial benefit obtained through the commercial development of the device, the exploitation of a patent or any other commercial interest in the product would .... be split 50:50 between the Trust and the Sabanathan estate." Therefore, Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and that Mr. Lunt had the authority to prosecute (or not prosecute) the above identified application.

Additionally, petitioner states, "[t]he June 6, 2000 agreement was irrelevant to the Entitlement Proceedings" and that the agreement between Bradford Hospital and Mrs. Sabanathan not to contest the entitlement proceeding does not negate the U.K. Patent Office's finding. The Office of PCT Legal Administration is not negating the findings of the U.K. Patent Office or asserting that Mrs. Sabanathan is not the true owner of the above-identified application. As stated above, Ms. Sabanathan and Bradford Hospitals NHS Trust had more than a fiduciary relationship and the that Bradford Hospital NHS Trust had the authority to prosecute (or not to prosecute) the above identified application, therefore, ownership of the invention is not relevant to this matter.

Lastly, petitioner states, "applicant did not delay in filing the petition to revive." However, as stated in the previous decision, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999. On 06 June 2000, Thurumani Sabanathan executed "Agreement" which states that "the Foundry acknowledges that it is aware that the period within which national/regional phase entry of the international application no. PCT/GB98/00653 must normally be effected may have passed with such phases having entered and therefore such application may not exist . . ." Upon execution of the agreement, Mrs. Sabanathan became aware of the abandonment of application no. PCT/GB98/00653 and should have filed a petition to revive under 37 CFR 1.137 to protect her rights in the invention. Therefore, in view of the deliberately chosen course of action to not persist in seeking the revival of the abandoned application, the delay cannot be considered to be unintentional, and the petition may not be properly granted.

Since applicant has not met the requirements for revival of an application under 37 CFR 1.137(b), revival at this time would not be proper.

CONCLUSION

For the reasons above, the renewed petition under 37 CFR 1.137(b) is **DENIED**.

This decision may be viewed as a final agency decision. See MPEP 1002.02.

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, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Charles Pearson
Director
Office of PCT Legal Administration
Tel: (703) 306-4145
Fax: (703) 308-6459

25 MAR 2005

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Washington, D.C. 20001-4597

In re Application of	:	
SABANATHAN, Thirumani	:	
Application No.: 09/762,692	:	DECISION ON PETITION
PCT No.: PCT/GB98/00652	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 03 March 1998	:	
Priority Date: 30 April 1997	:	
Attorney Docket No.: 007-001	:	
For: OCCLUSION DEVICE		

This is a decision on applicant's "Renewed Petition to Revive under 37 CFR 1.137(b)" filed in the Patent and Trademark Office (PTO) on 24 November 2003.

BACKGROUND

On 03 March 1998, applicant filed international application no. PCT/GB98/00652 which claimed a priority date of 30 April 1997 and which 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 November 1998.

A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 30 October 1999.

On 09 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied, inter alia, by: the basic national fee, a copy of the international application, and a petition seeking revival under 37 CFR 1.137(b) with the appropriate fee. The petition was dismissed in a decision dated 24 May 2001 because the delay was not considered to be unintentional.

On 24 September 2001, applicant responded to the 24 May 2001 decision by filing the "Renewed Petition under CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 February 2002 because the delay was not considered to be unintentional.

On 10 June 2002, applicant responded to the 15 February 2002 decision by filing the "Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b) and Petition for Extension of Time under 37 CFR 1.136." The petition was dismissed without prejudice in a decision dated 15 November 2002 because the delay was not considered to be unintentional.

On 15 January 2003, applicant filed "Second Request for Reconsideration of Denial of Petition under 37 CFR 1.137(b)." The petition was DENIED in a decision dated 04 June 2003 because the delay was not considered to be unintentional.

On 24 November 2003, applicant filed "Renewed Petition to Revive under 37 CFR 1.137(b)."

STATUTE AND REGULATION

35 U.S.C. § 41(a)(7) 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." Specifically, 35 U.S.C. § 41(a)(7) provides:

> *On filing each petition for the revival of an unintentionally abandoned application for a patent, for the unintentionally delayed payment of the fee for issuing each patent, or for an unintentionally delayed response by the patent owner in any reexamination proceeding, $1,210, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be $110.*

37 CFR 1.137(b) provides:

> *Unintentional. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph 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 Director 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.*

OPINION

Petitioner requests reconsideration of the decision dated 04 June 2003 and seeks to distinguish the facts of this case from the opinion and precedents cited therein in that, while Bradford Hospitals NHS Trust (the "Trust") deliberately permitted the instant international application to become abandoned as the United States, the widow of the deceased inventor, Mrs. Sabanathan, the purported true original owner of the subject patent application during the relevant period, did not intentionally abandon the application and, accordingly, revival should not be foreclosed.

The issue present here is whether the Trust's decision to intentionally abandon the subject application is binding upon Mrs. Sabanathan, the widow of the deceased inventor. It is noted that the facts of this case are quite unique. Although the Trust and Mrs. Sabananthan believed that they were partial owners of the patent application, Mrs. Sabanathan was the sole owner. The Trust, a non-owner, decided not to pursue the application and never informed the owner, Mrs. Sabanathan, of this decision. Mrs. Sabanathan had a right to expect that the Trust inform her of its decision not to file the application. As a result, neither Mrs. Sabanathan nor her legal representative participated in the decision not to pursue the application. Thus, Mrs. Sabanathan, the sole owner, never intended the application to go abandoned.

CONCLUSION

Therefore, the renewed request to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration is required.

Charles Pearson
Director
Office of PCT Legal Administration
Tel: (571) 272-3224
Fax: (571) 273-0459

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Paper No. 8

PAUL J. WHITE, SENIOR COUNSEL
NATIONAL RENEWABLE ENERGY
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1617 COLE BOULEVARD
GOLDEN, CO 80401-3393

COPY MAILED
JAN 23 2003
OFFICE OF PETITIONS

In re Application of :
Gary Jorgensen et al :
Application No. 09/762,719 :
Filed: February 9, 2001 :
Attorney Docket No. NREL 97-33 :

ON PETITION

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed February 7, 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 8, 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 2800 for further processing.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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MAY 11 2009

OFFICE OF PETITIONS

In re Patent No. 6,989,924 :
Issue Date: January 24, 2006 :
Application No. 09/762,719 :
Filed: February 9, 2001 :
Attorney Docket No. NREL 97-33 :

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**.

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 the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

SEP 2 0 2001

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In re Application of MACNALLY et al. U.S. Application No. 09/762,720 PCT No.: PCT/US99/20792 Int. Filing Date: 10 September 1999 Priority Date: 10 September 1998 Attorney Docket No.: 30019.70USWO For: A SINGLE-CHIP CMOS DIRECT CONVERSION TRANSCEIVER	: : : : : : : :	DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "PETITION UNDER 37 CFR 1.47(a)" filed 19 June 2001 to accept the application without the signature of joint inventors, Donald Evan MacNally and Laurence Marguerite Plouvier. The required petition fee of $130.00 (37 CFR 1.17(i)) has been submitted.

BACKGROUND

On 10 September 1999, applicants filed international application PCT/US99/20792 which claimed a priority date of 10 September 1998 and which designated the United States. A proper Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 10 June2001.

On 08 February 2001, applicants filed a transmittal for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); preliminary amendment; and an unexecuted declaration.

On 19 March 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b).

On 19 June 2001, applicants filed: "Communication Regarding Missing Requirements"; a declarations and power of attorneys signed by seven of the nine joint inventors; a petition under 37 CFR 1.47(a) and the requisite fee; and a two-month extension and the requisite fee.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4).

As to item (2), petitioner states that Donald Evan MacNally and Laurence Marguerite Plouvier cannot be found or reached after diligent effort. Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in 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 that 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.
>
> 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 nonsigning inventor for signature.
>
> 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.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied item (2) above, in that the applicants have not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Donald Evan MacNally and Laurence Marguerite Plouvier. Ms. Xu states in her letters (Exhibit A1 and A2) to Donald Evan MacNally and Laurence Marguerite Plouvier, "we must now provide the formal papers (a Combined Declaration and Power of Attorney and Assignment). . ." The mailing of the Declaration and Power of Attorney and Assignment is not considered a complete copy of the application paper (specification, including claims,

drawings, and oath and declaration).

Additionally, petitioner states that Donald Evan MacNally and Laurence Marguerite Plouvier cannot be found or reached after diligent effort. A review of the present petition reveal that applicants have not provided an acceptable showing that a diligent effort was made to reach the non-signing inventors, Donald Evan MacNally and Laurence Marguerite Plouvier. Moreover, a review of FedEx website tracking database reveals that Donald McNally signed for both set of papers on 13 April 2001 and therefore, petitioner cannot assert that Donald Evan MacNally and Laurence Marguerite Plouvier cannot be found or located.

For the reasons stated above, it would not be appropriate to accept the application without the signatures of Donald Evan MacNally and Laurence Marguerite Plouvier under 37 CFR 1.47(a) at this time.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** 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.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.

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MAR 2 6 2002

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In re Application of :
MACNALLY et al. :
U.S. Application No. 09/762,720 : DECISION
PCT No.: PCT/US99/20792 :
Int. Filing Date: 10 September 1999 :
Priority Date: 10 September 1998 :
Attorney Docket No.: 30019.70USWO :
For: A SINGLE-CHIP CMOS DIRECT :
CONVERSION TRANSCEIVER

This is a decision on applicants' "REQUEST FOR RECONSIDERATION OF DECISION ON PETITION UNDER 37 CFR 1.47(a)" filed 20 November 2001.

The petition for status under 37 CFR 1.47(a) is moot since the declarations filed 20 November 2001 with the present communication was executed by the previously non-signing inventors, Donald Evan MacNally and Laurence Marguerite Plouvier. As such, the submission is a proper reply to the Decision mailed 20 September 2001. The declarations filed 19 June 2001 and 20 November 2001 are acceptable under 37 CFR 1.497.

The application has an international filing date of **10 September 1999** under 35 U.S.C. 363 and a date of **20 November 2001** under 35 U.S.C. 371(c).

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.

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18 OCT 2002
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In re Application of
TZOGANAKIS, Costas *et al*
Application No.: 09/762,765
PCT No.: PCT/CA99/00731
Int. Filing Date: 11 August 1999
Priority Date: 14 August 1998
Attorney's Docket No.: 1811-228 MIS:jb
For: MELT PHASE HYDROSILYLATION OF PROPYLENE

DECISION ON REQUEST TO WITHDRAW HOLDING OF ABANDONMENT AND 37 CFR 1.182

This decision is in response to applicants' "Petition to Withdraw Notification of Abandonment" filed on 17 July 2001.

BACKGROUND

On 01 March 2001, 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 a declaration in compliance with 37 CFR 1.497(a) and (b) must be provided. A one-month time period for response was set with extensions of time available.

On 01 May 2001, applicants purportedly filed a transmittal letter, an executed declaration, and a one-month extension of time and authorization to charge any required fees to Deposit Account No. 03-3870.

On 28 May 2002, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909) stating that the above-captioned application was abandoned because applicants failed to respond to Form PCT/DO/EO/905 within the time period set.

On 17 July 2002, applicants filed the instant petition which was accompanied by, *inter alia*, copies of the documents purportedly filed 01 May 2001.

On 05 September 2002, applicants submitted a check of $1,240 in response to an email sent by Patricia A. Booker of the USPTO.

DISCUSSION

In the instant petition, applicants request that the PTO withdraw the holding of

abandonment because a signed declaration was submitted on 01 May 2001 in response to the Notification of Missing Requirements mailed 01 March 2001.

A review of the documents submitted with the instant petition (which are copies of the documents purportedly filed 01 May 2001), show that two forms, the "Transmittal Form" and "Fee Transmittal for FY 2001" were captioned with the wrong U.S. application number, *i.e.*, 09/792,765, not 09/762,765. (The letter accompanying the documents did list the correct U.S. application number.) A search of U.S. application number 09/792,765 has located the missing papers that were received on 01 May 2001. These papers have been removed and placed in the above-identified application.

Therefore, this petition is treated as a petition under 37 CFR 1.182 to correct applicants' error in captioning two of the documents with the wrong U.S. application number. The $130.00 petition fee pursuant to 37 CFR 1.182 has been charged to Deposit Account No. 19-2253 as authorized. The petition fee of $1,240.00 submitted on 05 September 2002 is not warranted in this situation and has been credited to Deposit Account No. 19-2253 as authorized.

DECISION

The petition under 37 CFR 1.182 to correct the U.S. application number on the papers filed 01 May 2001 and to withdraw the holding of abandonment in the above-captioned application is hereby **GRANTED**.

Please use only U.S. application No. **09/762,765** for all future correspondence in the above-captioned application.

Applicants have completed the requirements for acceptance under 35 U.S.C. 371(c). The application has an international filing date of 11 August 1999, under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **01 May 2001**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing.

Leonard Smith
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OFFICE OF PETITIONS

In re Application of :
Tzoganakis, et al. :
Application No. 09/762,765 : ON PETITION
Filed: May 1, 2001 :
Attorney Docket No. 1811-228 MIS/ah :
For: MELT PHASE HYDROSILYLATION OF POLYPROPYLENE

This is a decision on the petition under 37 CFR 1.181, filed December 13, 2005, to withdraw the holding of abandonment of the above-identified application.

The petition under 37 CFR 1.181 is GRANTED.

This application was held abandoned on July 29, 2005 for failure to respond in a timely manner to the non-final Office action, mailed April 28, 2005, which set a three (3) month period for reply. A Notice of Abandonment was mailed November 25, 2005.

Petitioners assert that a proper response was in fact timely filed on July 15, 2005. In support, petitioners submit a copy of the amendment with a proper certificate of facsimile transmission affixed to the transmittal letter.

Under 37 C.F.R. § 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 C.F.R. § 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 C.F.R. § 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 transmittal letter bears a proper certificate of mailing, dated July 15, 2005, in compliance with the requirements of 37 C.F.R. § 1.8(a)(1) as set forth above. In addition, the person signing

the certificate, Registered Practitioner Michael Stewart, had reasonable basis to expect that the correspondence would be transmitted on July 15, 2005.

To further support the petition, petitioners have submitted their sending unit's confirmation report, showing that an eleven page document was successfully transmitted to the Office's centralized facsimile number on July 15, 2005.

Therefore, the response to the April 28, 2005 non-final Office action is considered timely filed. Accordingly, the petition is **GRANTED**, the Notice of Abandonment is hereby vacated, and the holding of abandonment withdrawn.

After the mailing of this decision, the application file will be forwarded to Technology Center A.U. 1713 for consideration of the amendment filed July 15, 2005 and resubmitted with the present petition.

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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MAR 10 2004

Paper No. 14

In re Application of :
Hideharu Ogawa : DECISION ON PETITION
Application No. 09/762,772 :
Filed: February 13, 2001 :
Attorney Docket No. 30394-2

This is a decision on the petition filed on August 22, 2003 by which petitioner requests withdrawal of the holding that the application stands abandoned for failure to timely file a proper reply to the final Office action dated November 27, 2002. The petition is being considered pursuant to 37 CFR 1.181, and no fee for the petition is required.

The petition is dismissed.

Petitioner alleges that a reply to the Office action in question was in fact timely filed on March 4, 2003, and that the response places the application in condition for allowance.

The reply to the Office action in question has been recently associated with the application file. The reply is entitled to a 37 CFR 1.8(a) certificate date of February 27, 2003, making the reply timely. However, under 37 CFR 1.113 and 1.116, only certain replies to a final Office action are considered to be a **proper** reply to a final rejection. Therefore, the reply has been forwarded to the examiner for consideration as to whether the reply filed on considered the reply filed on March 4, 2003 was proper under the above mentioned regulations. The examiner reports that the reply does not place the application in condition for allowance because the newly proposed limitations in claims 1, 2, 5 and 15 raise issues of indefiniteness. Further, the examiner reports that the newly added limitation that recites that the score management server transmits data representing the score of ... high-ranking players" is considered to be a new limitation that requires further search.

Petitioner was under an obligation, imposed by 37 CFR 1.113 and 1.116 to file a proper reply to the final within the meaning of these regulations. Petitioner had, therefore, a duty to monitor the status of the application and the reply that was filed, and to make inquiries as necessary regarding the reply and the application. Ultimately, even in the absence of any information regarding the reply, petitioner had a duty to file a timely reply that was in compliance with the regulations in order to forestall abandonment. In the absence of the filing a reply as required by 37 CFR 1.113 and 1.116, the application has been properly held to have become abandoned under 35 USC § 133 for failure to file a timely and proper reply to the final rejection.

For the foregoing reasons, it appears that there was no error on the part of the Office in holding that this application has become abandoned. It further appears that petitioner's remedy is to proceed pursuant to 37 CFR 1.137. However, petitioner is entitled to file a request for reconsideration of this decision, without fee, provided that such request is filed within two months of the date of this Decision. See 37 CFR 1.181(f).

PETITION DISMISSED

E. Rollins-Cross, Director
Technology Center 3700

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Paper No. 18

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OFFICE OF PETITIONS

In re Application of	:	
Hideharu Ogawa	:	
Application No. 09/762,772	:	ON PETITION
Filed: February 13, 2001	:	
Attorney Docket No. 39394-2	:	

This is a decision on the petition under 37 CFR 1.137(b), filed May 10, 2004, to revive the above-identified application.

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 306-3475.

The application file is being forwarded to Technology Center 3700 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Marianne E. Morgan
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Paper No. 7

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NOV 0 8 2001

OFFICE OF PETITIONS

NOTICE

In re Application of :
Thomas Rausch :
Application No. 09/762,782 :
Filed: March 30, 2001 :
Attorney Docket No. P/2107-162 :

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

MAY 13 2002

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New York, NY 10112-4498

In re Application of VAN SAARLOOS, Paul, Phillip, et al. U.S. Application No. 09/762,824 PCT No.: PCT/AU99/00665 Int. Filing Date: 16 August 1999 Priority Date: 14 August 1998 Attorney Dkt. No. A3418-PCT/USA-062635.0133 For: SURGICAL VISUAL FEEDBACK AND EYE FIXATION METHOD AND APPARATUS	:	DECISION ON PETITION UNDER 37 CFR 1.137(b) AND 37 CFR 1.47(b)

This is a decision on applicant's "Petition Under 37 CFR 1.137(b) For Revival Of Unintentionally Abandoned Application" and the "Petition Under 37 CFR 1.47(b)" to accept the application without the signatures of joint inventors Paul Phillip Van Saarloos and Jon Dishler filed 26 December 2001. Applicant has paid the required petition fees.

BACKGROUND

On 16 August 1999, applicant filed international application PCT/AU99/00665 which claimed a priority date of 14 August 1998 and which designated the United States. On 24 February 2000, a copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) by the International Bureau (IB).

A Demand was filed with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, i.e., 14 February 2001.

On 14 February 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied by, among other materials, payment of the basic national fee.

On 14 March 2001, the United Stated Designated/Elected Office mailed a Notification Of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the $130 surcharge for filing the declaration later than thirty months after the priority date were required. The notification set a one-month time limit in which to respond.

On 26 December 2001, applicants filed the "Petition Under 37 CFR 1.137(b) For Revival Of Unintentionally Abandoned Application" and the "Petition Under 37 CFR 1.47(b)" to accept

the application without the signatures of joint inventors Paul Phillip Van Saarloos and Jon Dishler considered herein.

DISCUSSION

A. Petition Under 37 CFR 1.137(b)

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 was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Items (2), (3), and (4) have been satisfied.

Regarding item (1) above, the petition under 37 CFR 1.47(b) is not grantable in its present form, as indicated below. Thus, all of the requirements of 37 CFR 1.137(b) for a complete response have not been fulfilled. The petition to revive is therefore **DISMISSED** without prejudice.

B. Petition under 37 CFR 1.47(b)

In order to comply with the proper response requirement of item (1) above for revival under 37 CFR 1.137(b), applicant submitted a petition under 37 CFR 1.47(b). In order for the item (1) proper response requirement to be satisfied, under the present circumstances, the petition under 37 CFR 1.47(b) must be grantable. A grantable petition under 37 CFR 1.47(b) must include: (1) the requisite petition fee under 37 CFR 1.17; (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The present submission satisfies items (1), (2), (3), (4) and (6). However, as discussed below, item (5) has not been satisfied.

Item (5) is discussed in section 409.03(f) of the MPEP, which states, in part:

> When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant must prove that:
> (A) the invention has been assigned to the applicant, or
> (B) the inventor has agreed in writing to assign the invention to the applicant, or
> (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

The basis of the 37 CFR 1.47(b) applicant's claim of proprietary interest is the "Statement Of Facts Establishing Proprietary Interest By Person Signing On Behalf Of Nonsigning Inventor" and attachments thereto. One of the attachments to this Statement is an assignment in which non-signing co-inventor Jon Dishler expressly assigns to The Lions Eye Institute Of Western Australia ("LEI") his interest in the international application being nationalized here. A separate attachment to the Statement is an assignment from LEI to Q-Vis Limited, the 37 CFR 1.48(b) applicant, of LEI's interest in the same international application. Thus, the submission provides a showing of the chain of title to the 37 CFR 1.47(b) applicant from co-inventor Dishler. With respect to co-inventor Van Saarloos, employment agreements between Dr. Van Saarloos and LEI have been provided as evidence of the 37 CFR 1.47(b) applicant's proprietary interest. However, both of these employment agreements contain some restrictions on the employers' right to intellectual property developed by Dr. Van Saarloos (i.e., intellectual property developed "within the existing or contemplated scope of any portion of the Institute's business;" or "within the scope of his employment"). The 37 CFR 1.47(b) applicant here has not provided evidence that the inventions underlying the present application fall within the scope of these employment agreements. Accordingly, the 37 CFR 1.47(b) applicant must provide further evidence to support its claim of proprietary interest with respect to Dr. Van Saarloos. Such evidence should include statements from any persons with first hand knowledge that the invention underlying the present application was made by the inventor during the period of his employment and within the course of the inventor's duties, and a legal memorandum to the effect that a court of competent jurisdiction would by the weight of authority in the appropriate jurisdiction award title in the invention to the 37 CFR 1.47(b) applicant. Until such further evidence is provided, item (5) of a grantable petition under 37 CFR 1.47(b) has not been satisfied.

Based on the above, petitioner has not satisfied all the requirements for a grantable petition under 37 CFR 1.47(b). Accordingly, it is inappropriate, on the present record, to accord the national stage application status under 37 CFR 1.47(b).

CONCLUSION

The petition under 37 CFR 1.137(b) is **DISMISSED** without prejudice.

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

The application remains **ABANDONED** with regards to national stage processing in the United States.

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 1.137(b)." No additional petition fee is required.

A proper response must include an acceptable petition under 37 CFR 1.47, or an oath/declaration signed by all of the named inventors in compliance with 37 CFR 1.497.

Please direct any 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 Legal Affairs Division of the PCT Legal Office.

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In re Application of
VAN SAARLOOS, Paul, Phillip, et al.
U.S. Application No. 09/762,824
PCT No.: PCT/AU99/00665
Int. Filing Date: 16 August 1999
Priority Date: 14 August 1998
Attorney Dkt. No. A3418-PCT/USA-062635.0133
For: SURGICAL VISUAL FEEDBACK AND EYE FIXATION METHOD AND APPARATUS

DECISION ON RENEWED PETITION UNDER 37 CFR 1.137(b) AND 37 CFR 1.47(b)

This decision is issued in response to the "Renewed Petition Under 37 CFR 1.137(b)" filed 12 November 2002. No additional petition fees are required.

BACKGROUND

The procedural background for this application is set forth in detail in the decision mailed 13 May 2002. In that decision, applicant's petition under 37 CFR 1.47(b) was dismissed without prejudice for failure to satisfy all the requirements for a grantable petition. Specifically, the 1.47(b) applicant had not supplied the required evidence to demonstrate its proprietary interest in this application with respect to inventor Paul Van Saarloos. The decision also dismissed applicant's accompanying petition under 37 CFR 1.137(b) on the basis that, until the petition under 37 CFR 1.47(b) was in a grantable form, the "required reply" requirement for a petition under 37 CFR 1.137(b) could not be considered satisfied.

On 15 November 2002, applicant filed the renewed petition considered herein, with accompanying materials.

DISCUSSION

A. Renewed Petition Under 37 CFR 1.47(b)

The previous decision stated that the following was required before the petition could be granted:

> the 37 CFR 1.47(b) applicant must provide further evidence to support its claim of proprietary interest with respect to Dr. Van Saarloos. Such evidence should include statements from any persons with first hand knowledge that the invention underlying the present application was made by the inventor during the period of his employment and within the course of the inventor's duties, and a legal memorandum to the effect that a court of competent jurisdiction would by the weight of authority in the appropriate jurisdiction award title in the invention to the 37 CFR 1.47(b) applicant.

The renewed petition includes a "Statement Of Facts In Support Of Filing On Behalf Of Nonsigning Inventors (37 CFR 1.47(b))" executed by Ian Jeffrey Constable which provides the required firsthand statement that Dr. Van Saarloos' invention took place during the course of his employment. The renewed petition also includes a legal memorandum which concludes that "it is our view that an Australian Court of competent jurisdiction would by the weight of authority in Australia award title in the Invention to Q-Vis Limited."

The renewed petition therefore satisfies the outstanding requirements for a grantable petition under 37 CFR 1.47(b). The petition is appropriately granted.

B. Petition Under 37 CFR 1.137(b)

The submission of a grantable petition under 37 CFR 1.47(b) satisfies the outstanding "required reply" requirement for a grantable petition under 37 CFR 1.137(b). Applicant has therefore now satisfied all the requirements for a grantable petition.

CONCLUSION

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

The petition under 37 CFR 1.47(b) is **GRANTED**. The application is therefore accepted on behalf of the 37 CFR 1.47(b) applicant without the signatures of nonsigning inventors Paul Van Saarloos and Jon Dishler.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventors at the last known addresses of record as set forth in the petition, and a notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

The application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accordance with this decision. The 35 U.S.C. 371 date is 26 December 2001.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

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30 Rockefeller Plaza
New York, NY 10112-4498

In re Application of
VAN SAARLOOS, Paul, Phillip, et al.
U.S. Application No. 09/762,824
PCT No.: PCT/AU99/00665
Int. Filing Date: 16 August 1999
Priority Date: 14 August 1998
Attorney Dkt. No. A3418-PCT/USA-062635.0133
For: SURGICAL VISUAL FEEDBACK AND EYE FIXATION METHOD AND APPARATUS

DECISION ON RENEWED PETITION UNDER 37 CFR 1.137(b) AND 37 CFR 1.47(b)

This decision is issued in response to the "Renewed Petition Under 37 CFR 1.137(b)" filed 12 November 2002. No additional petition fees are required.

BACKGROUND

The procedural background for this application is set forth in detail in the decision mailed 13 May 2002. In that decision, applicant's petition under 37 CFR 1.47(b) was dismissed without prejudice for failure to satisfy all the requirements for a grantable petition. Specifically, the 1.47(b) applicant had not supplied the required evidence to demonstrate its proprietary interest in this application with respect to inventor Paul Van Saarloos. The decision also dismissed applicant's accompanying petition under 37 CFR 1.137(b) on the basis that, until the petition under 37 CFR 1.47(b) was in a grantable form, the "required reply" requirement for a petition under 37 CFR 1.137(b) could not be considered satisfied.

On 15 November 2002, applicant filed the renewed petition considered herein, with accompanying materials.

DISCUSSION

A. Renewed Petition Under 37 CFR 1.47(b)

The previous decision stated that the following was required before the petition could be granted:

> the 37 CFR 1.47(b) applicant must provide further evidence to support its claim of proprietary interest with respect to Dr. Van Saarloos. Such evidence should include statements from any persons with first hand knowledge that the invention underlying the present application was made by the inventor during the period of his employment and within the course of the inventor's duties, and a legal memorandum to the effect that a court of competent jurisdiction would by the weight of authority in the appropriate jurisdiction award title in the invention to the 37 CFR 1.47(b) applicant.

The renewed petition includes a "Statement Of Facts In Support Of Filing On Behalf Of Nonsigning Inventors (37 CFR 1.47(b))" executed by Ian Jeffrey Constable which provides the required firsthand statement that Dr. Van Saarloos' invention took place during the course of his employment. The renewed petition also includes a legal memorandum which concludes that "it is our view that an Australian Court of competent jurisdiction would by the weight of authority in Australia award title in the Invention to Q-Vis Limited."

The renewed petition therefore satisfies the outstanding requirements for a grantable petition under 37 CFR 1.47(b). The petition is appropriately granted.

B. Petition Under 37 CFR 1.137(b)

The submission of a grantable petition under 37 CFR 1.47(b) satisfies the outstanding "required reply" requirement for a grantable petition under 37 CFR 1.137(b). Applicant has therefore now satisfied all the requirements for a grantable petition.

CONCLUSION

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

The petition under 37 CFR 1.47(b) is **GRANTED**. The application is therefore accepted on behalf of the 37 CFR 1.47(b) applicant without the signatures of nonsigning inventors Paul Van Saarloos and Jon Dishler.

As provided in 37 CFR 1.47(b), a notice of the filing of this application will be forwarded to the nonsigning inventors at the last known addresses of record as set forth in the petition, and a notice of the filing of the application under 37 CFR 1.47(b) will be published in the Official Gazette.

The application is being forwarded to the National Stage Processing Branch of the International Division for further processing in accordance with this decision. The 35 U.S.C. 371 date is 26 December 2001.

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In re Application of LE et al. Application No.: 09/762,833 PCT No.: PCT/US97/12540 Int. Filing Date: 03 July 1997 Priority Date: 10 July 1996 Attorney Docket No.: TW-5922-A For: POLYMERIZATION WITH LIVING CHARACTERISTICS	DECISION ON PETITION

This is a decision on applicants' "PETITION UNDER 37 CFR 1.137(b)" filed 30 January 2001 in the above-captioned application. The petition fee under 37 CFR 1.17(m) has been charged to applicant's Deposit Account.

BACKGROUND

On 03 July 1997, applicants filed international application PCT/US97/12540 which claimed a priority date of 10 July 1996 and which designated the United States. A Demand was filed on 02 February 1998 with the International Preliminary Examination Authority prior to the 19th month from the earliest claimed priority date. As a result, the deadline for payment of the basic national fee was to expire 30 months from the priority date, or at midnight on 11 January 1999 (10 January 1999 was a Sunday).

On 30 January 2001, applicants filed a transmittal letter requesting entry into the national stage in the United States, which was accompanied by, *inter alia*: the basic national fee and a copy of the international application. Applicants also filed "Petition Under 37 CFR 1.137(b)" to revive the international application and an executed declaration and power of attorney.

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 was unintentional," and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

With regard to Item (1), the proper response was payment of the basic national fee.

As to Item (2), as noted above, the appropriate petition fee of $1240.00 as required by 37 CFR 1.17(m) has been charged to applicant's deposit account no. 04-1928.

With regard to Item (3), 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 United States Patent and Trademark Office).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

Deposit Account No.04-1928 has been charged a $130.00 surcharge fee under 37 CFR 492(e) for supplying an oath or declaration later than 30 months from the earliest claimed priority date.

CONCLUSION

All of the requirements of 37 CFR 1.137(b) have been met and applicant's petition to revive is **GRANTED**.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision.

Cynthia M. Kratz

Cynthia M. Kratz
Petitions Attorney
PCT Legal Office

Telephone: (703) 306-5467

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Paper No. 13

E. I. du Pont de Nemours & Company
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Wilmington, DE 19898

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OFFICE OF PETITIONS

In re Application of	:	ON PETITION
Tam Phuong Le et al.	:	
Application No. 09/762,833	:	
Filed: January 30, 2001	:	
Attorney Docket No. TW5922 A	:	

This is a decision on the petition under 37 CFR 1.137(b), filed May 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 in reply to the non-final Office action mailed August 16, 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 November 17, 2002.

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

The application file is being forwarded to Technology Center AU 1713.

Latrice Bond

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

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AUG 2 0 2004

In re Application of	:	
Le, Tam Phung, et al.	:	NOTICE OF WITHDRAWAL
Serial No. 09/762833	:	FROM ISSUE
Filed: January 30, 2001	:	UNDER 37 CFR 1.313(a)
For: POLYMERIZATION WITH LIVING	:	
CHARACTERISTICS	:	

The above-identified application is withdrawn from issue due to a potential interference. See 37 CFR 1.313 (a).

The above-identified application is hereby withdrawn from issue.

Telephone inquiries should be directed to David Wu (571) 272-1114.

The above-identified application is being forwarded to the examiner for prompt appropriate action, including notifying applicant of the new status of this application.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

E I du Pont de Nemours & Company
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cc: Allowed Files—Pk3-910

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OFFICE OF PETITIONS

In re Application of	:	
Le et al.	:	
Application No. 09/762,833	:	DECISION ON PETITION
Filed: January 30, 2001	:	
Attorney Docket No. 100519.00026	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 30, 2006, to revive the above-identified application.

The petition is **GRANTED**.

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.

Petitioner also remarks that although the status of the instant application has been listed as Expressly Abandoned, "applicants never expressly abandoned the pending application nor do they intend [to] abandon it." A request to expressly abandon the application was entered on September 15, 2006. However, a review of the application file shows that neither the required written declaration of abandonment nor a petition under 37 CFR 1.138 is of record and neither can be located. Petitioner submitted the instant petition to revive on October 30, 2006, immediately refuting the express abandonment. It appears the status of 'Express Abandonment' is incorrect.

A Revocation of Power of Attorney was submitted by the assignee on October 26, 2007. 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 (571) 272-3206.

This matter is being referred to Technology Center 1713 for further examination on the merits.

Liana Walsh
Petitions Examiner
Office of Petitions

cc: E.I. DU PONT DE NEMOURS AND COMPANY
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In re Application of EULER et al. Application No.: 09/762,863 PCT No.: PCT/US99/19601 Int. Filing Date: 25 August 1999 Priority Date: 26 August 1998 Attorney's Docket No.: 4463 For: THIN FILM STRAIN SENSORS BASED ON INTERFEROMETRIC OPTICAL MEASUREMENTS	DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Completion of Filing Requirements" under 35 U.S.C.§371 including a Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor, treated as a petition under 37 CFR 1.47(a), filed 02 May 2001. The communication, in effect, requests the acceptance of the application without the signature of named inventor, Gregg C. Huston. Applicants also request a one month extension of time, which is granted.

BACKGROUND

On 14 February 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national fee.

On 08 March 2000, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and requisite surcharge for filing the oath or declaration after the 30-month period was required. The Notification set a time period within which to respond and allowed for extensions of time under 37 CFR 1.136(a).

On 02 May 2001, applicants filed the instant petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition, in effect, requests status under 37 CFR

1.47(a) on the grounds that third-named inventor, Gregg **C**. Huston, is unavailable.

Submitted with the petition, *inter alia*, is the declaration of William B. Euler. Mr. Euler is the first named inventor in the above referenced application.

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).

Applicants satisfied Item (1) with the payment of the petition fee. As for Item (3), Mr. Euler's declaration gives last known address of Gregg **S**. Huston, not for Gregg C. Huston, the listed inventor identified on the publication of the international application. Thus, applicants have not satisfied Item (3) above since the international application identifies Gregg C. Huston as the third named inventor, not Gregg S. Huston.

Regarding item (4) above, applicants have provided a declaration executed by co-inventors William B. Euler and Gregory J. Otto on behalf of nonsigning inventor, Gregg **S**. Huston. However, as noted above, the international application identifies Gregg **C.** Huston, as the third named inventor, not Gregg S. Huston. Item (4) has not been satisfied. See 37 CFR 1.47 and MPEP 409.03 (a) and (b).

However, with regard to Item (2) above, Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), **Proof of Unavailability or Refusal**, states, in 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 that 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 <u>having firsthand knowledge of the facts recited therein</u>. 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.

(Emphasis added.)

The declaration of William Euler attempts to provide details of the *bona fide* attempts that were made to contact the non-signing inventor. Mr. Euler's declaration states on or about October 1999 that he 'attempted to contact Mr. Huston by phone and e-mail regarding the above-referenced application at his last known residence and was unsuccessful." (Decl., ¶4) Mr Euler also states that about October 1999, he "inquired of Mr. Huston's former home custodian to determine the new residence of Mr. Huston and was not successful."(Decl.,¶5)

Mr. Euler's declaration is lacking in significant details. Specifically, he gives no information as to the time of day when he went to the home, whether Mr. Huston could reasonably been have expected to be there, whether he left any written communication indicating that he would return the next day, etc. Nor does he give specific details regarding his attempts to reach Mr. Huston by telephone or e-mail. Without specific detail as to Mr. Euler's attempts, his declaration is insufficient to support Mr. Huston's unavailability or refusal to sign the declaration.

Furthermore, it is noted that the petition cannot be accepted on the grounds that Mr. Huston refuses to sign, in that before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the national stage application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. The declarations provided do not indicate that Mr. Huston was presented with or was attempted to be presented with a copy of all of the national stage application papers for this application as identified above. Evidence of a refusal to sign a declaration for this application without a copy of the specification, including claims, and any drawings being presented to the non-signing inventor is not convincing that Mr. Huston would have refused to execute the application.

Applicants have not fulfilled the requirements of items (2), (3) and (4) 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.

Should status under 37 CFR 1.47(a) not be successfully completed, the international application will be viewed as having become abandoned with respect to the United States.

Any reconsideration on the merits of this petition 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. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the

Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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Richard R. Cole
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RICHARD L. STEVENS
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BOSTON, MA 02110

In re Application of EULER et al. Application No.: 09/762,863 PCT No.: PCT/US99/19601 Int. Filing Date: 25 August 1999 Priority Date: 26 August 1998 Attorney's Docket No.: 4463 For: THIN FILM STRAIN SENSORS BASED ON INTERFEROMETRIC OPTICAL MEASUREMENTS	DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. 1.47(a)" including a Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 08 January 2002, in response to a decision mailed on 07 September 2001. The petition requests the acceptance of the application without the signature of named inventor, Gregg S. Huston.

BACKGROUND

On 14 February 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, basic national fee.

On 08 March 2000, a Notification of Missing Requirements was mailed to applicants indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and requisite surcharge for filing the oath or declaration after the 30-month period was required. The Notification set a time period within which to respond and allowed for extensions of time under 37 CFR 1.136(a).

On 02 May 2001, applicants filed a petition in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition, in effect, requested status under 37 CFR 1.47(a) on the grounds that third-named inventor, Gregg C. Huston, was unavailable. Submitted with the petition, *inter alia*, was the declaration of William B. Euler, the first named inventor in the above referenced application.

In a decision mailed 07 September 2001, applicants were advised that the petition to accept the application without the signature of Gregg C. Huston was dismissed because the

requirements of 37 CFR 1.47(a) had not been met. The decision set a two month deadline for response or by 07 December 2001, with extensions of time available under 37 CFR 1.136(a).

On 08 January 2002, applicants filed this renewed petition under 37 CFR 1.47(a) and correction of inventor Gregg C. Huston's middle initial. No certificate of mailing was filed with the renewed petition. Since the response was received in the USPTO more than four months after the mail date of the decision, a three (3) month extension of time is required. The $460 fee for a three month extension of time for a small entity will be charged to applicant's deposit account #19-0079 per his authorization.

DISCUSSION

As previously noted, 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).

Applicants previously satisfied Item (1) with the payment of the petition fee but had not satisfied items (2)-(4).

With regard to Item (3), attorney of record Richard L. Stevens attests that the middle name of inventor Gregg Huston as well as the number of his residential address were typed incorrectly on the application. Mr. Stevens indicates that the correct middle name and correct address are set forth in paragraph 2 of Mr. William B. Euler's declaration dated 02 May 2001. Paragraph 2 of the Euler declaration states: the last known address of Mr. Gregg S. Huston is 23 Tomahawk Trail, Wakefield, Rhode Island 02879. Mr. Stevens' explanation that the incorrect middle initial and street number was a typographical error is accepted. Item (3) above is satisfied.

Regarding item (4) above, applicants have provided a declaration executed by co-inventors William B. Euler and Gregory J. Otto on behalf of nonsigning inventor, Gregg S. Huston. In light of the explanation of the typographical error in the application with regard to Mr. Huston's middle initial given by counsel of record as indicated above, Item (4) is now satisfied.

The declaration of attorney Stevens indicates that on 01 October 2001, a copy of the above identified application and declaration and power of attorney was mailed to Mr. Huston at his last known address via certified mail. The envelope was returned undeliverable by the United States Postal Service with the notation "Moved, Left No Address". Counsel has not described what steps were taken to locate the whereabouts of the nonsigning inventor, i.e. Internet searches, contacts with his last known place of employment to locate a current employer or address. See MPEP 409.03(d) Inventor Cannot Be Reached. Without a statement

of facts by a person having first hand knowledge concerning the facts regarding such "diligent efforts", the petition under 37 CFR 1.47 cannot be granted.

Applicants have fulfilled the requirements of items (3) and (4) above. However, item (2) is not satisfied. 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. Applicant's deposit account no. 19-0079 will be charged for a three month extension of time or $460 for a small entity.

Should status under 37 CFR 1.47(a) not be successfully completed, the international application will be viewed as having become abandoned with respect to the United States.

Any reconsideration on the merits of this petition 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. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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In re Application of EULER et al. Application No.: 09/762,863 PCT No.: PCT/US99/19601 Int. Filing Date: 25 August 1999 Priority Date: 26 August 1998 Attorney's Docket No.: 4463 For: THIN FILM STRAIN SENSORS BASED ON INTERFEROMETRIC OPTICAL MEASUREMENTS	DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' second "Renewed Petition Under 37 C.F.R. 1.47(a)" including a Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 19 June 2002, in response to a decision mailed on 11 April 2002. The petition requests the acceptance of the application without the signature of named inventor, Gregg S. Huston.

BACKGROUND

On 08 January 2002, applicants filed a renewed petition under 37 CFR 1.47(a) and correction of inventor Gregg C. Huston's middle initial. A decision on the petition was mailed on 11 April 2002 dismissing the renewed petition on the grounds that counsel had not described what steps were taken to locate the whereabouts of the nonsigning inventor, i.e. Internet searches, contacts with his last known place of employment to locate a current employer or address and thus, the petition lacked the factual proof that the non-signing joint inventor refused to execute the application or could not be reached after diligent effort.

DISCUSSION

As previously noted, 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).

Applicants previously satisfied Items (1), (3) and (4).

With regard to Item (2), attorney of record Richard L. Stevens provides a statement of facts in support of filing on behalf of nonsigning inventor pursuant to 37 CFR 1.47(a). Mr. Stevens attests that on 06 May 2002, he contacted the Registrar's Office, Alumni Office, Chemistry Department and Professor William B. Euler of the University of Rhode Island (Mr. Huston's former employer) in an attempt to determine Mr. Huston's whereabouts without success. Mr. Stevens made further attempts using an Internet search for Gregory Huston to locate and contact him, to no avail, attaching copies of the search results to his statement.

Counsel has now described the steps he has taken to locate the whereabouts of the nonsigning inventor, i.e. Internet searches, contacts with his last known place of employment to locate a current employer or address, in an attempt to locate Mr. Huston, without avail. With this statement of facts by a person having first hand knowledge concerning the facts regarding such "diligent efforts", the petition under 37 CFR 1.47 can now be granted. Accordingly, it is appropriate to accord the national stage application status under 37 CFR 1.47(a) at this time.

CONCLUSION

The renewed 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 02 May 2001 and to mail a filing receipt. The application has an international filing date of 25 August 1999 under 35 U.S.C. 363, and a date of 02 May 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.

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Boris Milef
Legal Examiner
PCT Legal Office

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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

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 (Gregg Huston) 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/US99/19601 and was filed on 25 August 1999 in the names of William B. Euler, Otto J.Gregory and Gregg Huston for the invention entitled THIN FILM STRAIN SENSORS BASED ON INTERFEROMETRIC OPTICAL MEASUREMENTS. The national stage application is assigned number 09/762,863 and has a 35 U.S.C. 371(c) date of 02 May 2001.

12 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Gregg S. Huston
23 Tomahawk Trail
Wakefield, Rhode Island 02879

In re Application of
EULER et al.
Application No.: 09/762,863
PCT No.: PCT/US99/19601
Int. Filing Date: 25 August 1999
Priority Date: 26 August 1998
Attorney's Docket No.: 4463
For: THIN FILM STRAIN SENSORS BASED ON INTERFEROMETRIC OPTICAL MEASUREMENTS

Dear Mr. Huston:

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
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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

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 (Gregg Huston) 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/US99/19601 and was filed on 25 August 1999 in the names of William B. Euler, Otto J.Gregory and Gregg S. Huston for the invention entitled THIN FILM STRAIN SENSORS BASED ON INTERFEROMETRIC OPTICAL MEASUREMENTS. The national stage application is assigned number 09/762,863 and has a 35 U.S.C. 371(c) date of 02 May 2001.

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700.

Mailed: JUL 2 7 2004

rvk
Paper Number:_____

In re application of
Gray Anthony Jubb et al
Serial No. 09/762,870
Filed: March 22, 2001
For: BONDED FIBROUS MATERIALS :

DECISION ON PETITION

This is a response to the "REQUEST TO WITHDRAW HOLDING OF ABANDONMENT PURSUANT TO 37 C.F.R. 1.181", filed February 26, 2004. The request asks that the abandonment, as set forth in the Notice of Abandonment of January 27, 2004, for failure to timely file a proper response to the Office letter dated May 29, 2003 be withdrawn. The requester asserts that applicants timely filed a proper response and a Petition for Extension of Time to the Office letter of May 29, 2003 on December 01, 2003 (Note: November 29, 2003 fell on Saturday and December 01, 2003 is the next business day.).

DECISION

The instant request is accepted as a timely 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 presented is sufficient to establish that the applicants did file the proper response to the Office letter of May 29, 2003 in a timely manner. The evidence provided includes : 1) a copy of the Amendment in response to the Office letter of May 29, 2003 and Petition for a three-month Extension of Time with an executed Certificate of Mailing on December 01, 2003; 2) a copy of the returned stamped postcard confirming receipt of the Amendment and Petition for Extension of Time by the USPTO dated December 04, 2003 ; and 3) a copy of a check No. 34817 in the amount of $950.00 for the fee of three-month extension of time and a copy of PTO/SB/17 Fee Transmittal for FY 2004.

Therefore, the abandonment is hereby withdrawn, and the application is returned to

pending status. The case will be forwarded to the Technical Support Staff for entering of the Response of December 01, 2003 and then forwarded to the examiner for prompt consideration.

The Petition is **GRANTED**.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

JOHN S. PRATT,ESQ
KILPATRICK STOCKTON, LLP
SUITE 2800
1100 PEACHTREE STREET
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UNITED STATES PATENT AND TRADEMARK OFFICE

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

U.S. APPLICATION NO.		FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/763037		DUNN B	UF-219XC1

INTERNATIONAL APPLICATION NO.
PCT/US99/11940

I.A. FILING DATE	PRIORITY DATE
28 MAY 99	29 MAY 98

DORAN R PACE
2321 N W 41ST STREET SUITE A 1
GAINSVILLE, FL 32606

DATE MAILED: 22 MAY 2001

NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371(c)(4) for entry into the national stage in the United States of America. The period within which to correct the deficiency noted below and avoid abandonment is set in the accompanying Notification.

A new oath or declaration, properly identifying this application (preferably by the international application number and international filing date) is required. The oath or declaration does not comply with 37 CFR 1.497(a),(b) and (f) in that it:

1. [x] is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2. [ ] does not identify the application to which it is directed.
3. [ ] does not identify the inventor(s).
4. [ ] does not identify the citizenship of each inventor.
5. [ ] does not state that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b), AND 1.497(d) WHERE APPROPRIATE, WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. [ ] does not identify the mailing address of each inventor. If the residence is different from the mailing address, then the city and state or city and foreign country of residence of each inventor must also be given.

2. [ ] does not state that the person making the oath or declaration:

   a. [ ] has reviewed and understands the contents of the application, including the claims, as amended by any amendment specifically referred to in the oath or declaration.

   b. [ ] acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56.

3. [ ] does not identify the foreign application for patent or inventor's certificate for which a claim for priority is made pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.

Charita A. Burt, Paralegal
Telephone: 703-305-3734

FORM PCT/DO/EO/917 (March 2001)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

U.S. APPLICATION NO.		FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/763037		DUNN B	UF-219XC1

INTERNATIONAL APPLICATION NO.
PCT/US99/11940

I.A. FILING DATE	PRIORITY DATE
28 MAY 99	29 MAY 98

DATE MAILED: 22 MAY 2001

DORAN R PACE
2321 N W 41ST STREET SUITE A 1
GAINSVILLE, FL 32606

RECEIVED
MAY 30 2001

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):

- ☒ U.S. Basic National Fee.
- ☒ Copy of the international application.
- ☐ Oath or Declaration of inventors(s).
- ☐ Copy of Article 19 amendments.
- ☐ Priority Document.
- ☒ The International Preliminary Examination Report in English and its Annexes, if any.
- ☐ Translation of Annexes to the International Preliminary Examination Report into English.
- ☐ Indication of Small Entity Status.
- ☐ Translation of the international application into English.
- ☐ Translation of Article 19 amendments into English.
- ☐ Other:

2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- ☐ U.S. Basic National Fee.
- ☐ Copy of the international application.

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☐ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
  - ☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☐ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
- ☒ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
  - ☒ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

4. Additional claim fees of $_____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

5. ☐ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes MUST be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.

7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed: ☒ PCT/DO/EO/917 ☐ Notice of Defective Translation
☐ PTO-875 ☐ PCT/DO/EO/920

Charitta A. Burt, Paralegal
Telephone: 703-305-3734

FORM PCT/DO/EO/905 (March 2001)

30 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Keith G. Haddaway
Venable
PO Box 34385
Washington, DC 20043-9998

In re Application of MEARS et al. Application No.: 09/763,089 PCT No.: PCT/US99/18738 Int. Filing Date: 18 August 1999 Priority Date: 18 August 1998 Attorney Docket No.: 29925-152086 For: APPLICATOR AND DISPENSING DEVICE USING SAME	DECISION ON PETITION UNDER 37 CFR 1.181

This decision is in response to applicants' "Response to Notification and Request for Reconsideration," filed 29 May 2002. It has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 18 August 1999, applicants filed international application PCT/US99/18738, which claimed a priority date of 18 August 1998. A Demand for international preliminary examination, in which the United States was elected, was filed on 17 March 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 20 February 2001 (18 February 2001 being a Sunday and 19 February 2001 being a legal public holiday).

On 16 February 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, a first declaration of inventors identifying Harvey Levine and Lawrence Levine as the inventors and a second declaration of inventors identifying Christopher Mears and Richard F. Gray as inventors.

On 15 March 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that the oath or declaration submitted on 16 February 2001 was defective because the inventors were not identified.

On 15 June 2001, applicants submitted a response to the NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371. The response was accompanied by, *inter alia*, copies of two NOTIFICATION OF THE RECORDING OF A CHANGE (Form PCT/IB/306) from the International Bureau, a first page of a declaration identifying Christopher Mears and Richard Gray as inventors and signed by Christopher Mears, another first page of a declaration

identifying Christopher Mears and Richard Gray as inventors and signed by Richard Gray, and a second page of a declaration identifying Ralf Zissel, Harvey Levine, and Lawrence Levine as inventors and signed by Ralf Zissel.

On 03 July 2001, the USPTO mailed a NOTIFICATION OF A DEFECTIVE RESPONSE indicating that the response filed by applicants on 15 June 2001 did not complete the requirements set forth in the NOTIFICATION OF MISSING REQUIREMENTS mailed 15 March 2001.

On 20 July 2001, applicants submitted a "RESPONSE TO NOTIFICATION OF A DEFECTIVE RESPONSE" indicating that a supplemental response had been filed on 02 July 2001. The submission filed 20 July 2001 also included a second page of a Declaration signed by Harvey Levine and Lawrence Levine.

On 18 December 2001, the USPTO mailed a NOTIFICATION requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b) within a one-month extendable time period. The Notification indicated that each executed declaration must identify all of the inventors and each submitted declaration must be complete, even if executed by only one of the inventors. The Notification also indicated that the declaration signed by Mr. Zissel contained non-initialed and non-dated alterations and that the difference in the names of the inventor in the published international application (Ralph Zissel in the published international application) and the declaration signed by a Mr. Zissel (Ralf Zissel) must be explained.

On 18 January 2002, applicants filed a submission which was accompanied by, *inter alia*, four declarations of inventors.

On 29 March 2002, the Office mailed Notification again requiring the oaths or declaration as executed by the inventors.

On 29 May 2002, applicants submitted the instant response that has been treated as a petition under 37 CFR 1.181.

DISCUSSION

The declaration submitted 29 May 2002 comply with 37 CFR 1.497(a)-(b).

Applicants' requests for a refund of the one month extension fee and for the January submission to be deemed sufficient are refused. The declarations submitted must be the declarations as executed by the inventor. "The wording of an oath or declaration cannot be amended, altered or changed in any manner after it has been signed." MPEP §602.01. Affixing new pages to the declarations is considered a modification to the declaration subsequent to execution. The proper response to not receiving back all of the pages of the declaration from the inventor would be to contact the inventor and request that the rest of the declaration be forwarded.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.181 is **DISMISSED** without prejudice.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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 1.181."

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. date of **29 May 2002**.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

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UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Kevin M. Farrell
FARRELL & ASSOCIATES
P.O. Box 999
York Harbor, ME 03911

In re Application of
CHANDLER, Howard, Milne
U.S. Application No.: 09/763,154
PCT No.: PCT/AU99/00310
International Filing Date: 27 April 1999
Priority Date: 28 April 1998
Attorney's Docket No.: 0141-2004
For: SAMPLE COLLECTION METHOD

DECISION

This decision is issued in response to applicant's "Petition Under 37 CFR 1.10(e)" filed on 08 January 2001, which has been treated herein as a petition under 37 CFR 1.181 to confirm the filing of the present national stage application on 27 October 2000. No petition fee is required.

BACKGROUND

On 27 April 1999, applicant filed international application PCT/AU99/00310 which claimed a priority date of 28 April 1998 and which designated the United States. On 04 November 1999, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

A Demand was filed with the International Preliminary Examining Authority electing the United States prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 30 October 2000 (28 October 2000 was a Saturday).

On 27 October 2000, applicants claim to have filed with the USPTO by Express Mail a transmittal letter for entry into the national stage in the United States containing an authorization to charge Deposit Account No. 06-0130 for the basic national fee, and a copy of the international application.

On 08 January 2001, applicant filed the petition considered herein. Accompanying the petition are copies of the following: (1) the materials purportedly filed on 27 October 2000; (2) a stamped postcard receipt itemizing these materials and bearing a USPTO receipt stamp dated 27 October 2000; and (3) an Express Mail receipt bearing label number EK257451949US and a 27 October 2000 USPS stamp.

DISCUSSION

Section 503 of the MPEP states:

> 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.

Here, applicants have submitted a copy of a return postcard that identifies the present application (by attorney docket number, inventor, and title) and that specifically itemizes the "U.S National Stage Patent Application Transmittal, Specification (pgs 1-11); Claims (pgs 12-13); Abstract of the Disclosure (pg 14); and Express Mail Label EK257451949US." The postcard bears a PCT/PTO receipt stamp dated 24 April 1998, and the petition includes a statement that the attached materials are true copies of those originally filed.

Based on applicants' statements and the stamped return postcard, it is concluded that the materials accompanying the present petition and itemized on the return postcard were in fact originally filed on 27 October 2000, before the expiration of thirty months from the priority date. Accordingly, there is no need to address applicants' petition under 37 CFR 1.10(e).

CONCLUSION

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

Deposit Account No. 06-0130 has been charged the $1,000 basic national fee.

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 submission of an executed declaration in compliance with 37 CFR 1.497 and the $130 surcharge for filing the declaration later than thirty months after the priority date.

Leonard Smith
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PCT Legal Office

Richard M. Ross
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RMR/LS:rmr

View Images

(21) Int. Application Number: PCT/*AU99/00310*

(22) Int. Filing Date: 27 April 1999 (27.04.1999)

(30) Priority Data

PP 3237 28 April 1998 (28.04.1998) AU

(71)(72) Applicant and Inventor:

CHANDLER, Howard, Milne 857 Princes Point Road, Yarmouth, ME 04096 ; (US). [AU/US].

(74) Agent:

SLATTERY, John, M. Davies Collison Cave, 1 Little Collins Street, Melbourne, VIC 3000 ; (AU).

(81) Designated States:

AE, AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, CA, CH, CN, CU, CZ, DE DK, EE, ES, FI, GB, GD, GE, GH, GM, HR, HU, ID, IL, IN, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MD, MG, MK, MN, MW, MX, NO, NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, UA, UG, US, UZ, VN, YU, ZA, ZW ; ARIPO patent (GH, GM, KE, LS, MW, SD, SL, SZ, UG, ZW); Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM); European patent (AT, BE, CH, CY, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE); OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, GW,

(51) International Patent Classification[6]: G01N 1/10, 33/72, C12Q 1/28

A1

(11) Int. Publication Number: WO 99/56103

(43) Int. Publication Date: 04 November 1999 (04.11.1999)

(54) Title: SAMPLE COLLECTION METHOD

No Image Available.

(57) Abstract

A method for collecting a sample derived from faecal material, for example for occult blood testing, comprises contacting the faecal material with a fluid such as water and subsequently collecting a sample of the fluid with a brush or a brush-like device having flexible or semi-flexible bristles, wherein the sample of the fluid is collected within the bristles of the brush or brush-like device.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Kevin M. Farrell
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P.O. Box 999
York Harbor, ME 03911

In re Application of	:	
CHANDLER, Howard, Milne	:	
U.S. Application No.: 09/763,154	:	DECISION
PCT No.: PCT/AU99/00310	:	
International Filing Date: 27 April 1999	:	
Priority Date: 28 April 1998	:	
Attorney's Docket No.: 0141-2004	:	
For: SAMPLE COLLECTION METHOD	:	

This decision is issued in response to the "Re-Transmittal Of Verified Statement And Second Request For Reimbursement" filed 08 May 2001. No petition fee is required.

BACKGROUND

On 27 October 2000, applicant initiated the present national stage application. Among the materials submitted by applicants was the authorization to charge Deposit Account No. 06-0130 $1,000 as the large entity basic national fee.

On 08 May 2001, applicant filed the "Re-Transmittal Of Verified Statement And Second Request For Reimbursement" considered herein. This submission includes a copy of a verified statement claiming small entity status, a copy of a request for reimbursement seeking a refund of one half of the basic national fee (i.e., $500), and a copy of a return postcard itemizing these materials and bearing a USPTO receipt stamp dated 08 January 2001.

DISCUSSION

Based on applicant's statements and the stamped return postcard, it is conclude that the refund request and small entity statement accompanying the present submission were originally filed on 08 January 2001.

37 CFR 1.26 permits an applicant who has mistakenly paid an excess fee to seek a refund for such payment. Where an applicant has paid a full fee and subsequently seeks a refund based on small entity status, 37 CFR 1.28(a) states that the refund request and the assertion of small entity status must be must be made within three months of the payment of the full fee.

Here, the refund request was accompanied by a statement asserting small entity status and, as noted above, these materials were originally filed on 08 January 2001. This is less than three months after applicant's 27 October 2000 payment of the full fee. The assertion of small entity status complies with 37 CFR 1.27(c). Accordingly applicant is entitled to a refund of one half of the full basic national fee originally paid, that is, $500.

CONCLUSION

The refund request is **GRANTED**. Applicant has been granted a refund of $500. This refund has been credited to Deposit Account No. 06-0130.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accord with this decision.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Richard M. Ross
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Telephone: (703) 308-6155
Facsimile: (703) 308-6459

RMR/RC:rmr

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 29 2009

OFFICE OF PETITIONS

FOLEY & LARDNER LLP
P.O. BOX 80278
SAN DIEGO, CA 92138-0278

In re Patent No. 6,869,804	:	
Issued: March 22, 2005	:	
Application No. 09/763,154	:	NOTICE
Filed: January 17, 2002	:	
Atty Docket No. 054769-9701	:	

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 the undersigned at (571) 272-3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

26 FEB 2004

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SUGHRUE MION, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, D.C. 20037-3213

In re Application of	:	
FUJIKAWA, et al.	:	
U.S. Application No.: 09/763,194	:	DECISION ON PETITION
Filing Date: 20 February 2001	:	UNDER 1.182
Attorney's Docket No.: Q63075	:	
For: METHOD AND APPARATUS FOR SURFACE DISCHARGE PROCESSING, AND AN ELECTRODE FOR SURFACE DISCHARGE PROCESSING	:	

This decision is issued in response to applicant's "Petition Under 37 CFR 1.182 To Accept Application As Continuing Application Under 37 C.F.R. 1.53(b)" filed 02 September 2003. No petition fee is required.

BACKGROUND

On 20 February 2001, applicants filed a transmittal letter to initiate a U.S. patent application. The transmittal letter specifically stated that it was intended to initiate a continuation application of PCT/JP99/02379. The transmittal letter was specific in stating that the filing was made under 37 CFR 1.53(b), and the accompanying declaration claimed priority to the PCT application under 35 U.S.C. 120. The submission included, among other materials, a specification (including claims) and drawings.

On 19 March 2001, the USPTO issued a "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 that the application had been accepted as a national stage filing under 35 U.S.C. 371.

On 21 March 2001, the USPTO issued a filing receipt which also indicated that the application was considered a "371 of PCT/JP99/02379."

On 23 September 2003, applicant filed the present petition seeking to have the present application treated as a continuation application filed under 35 U.S.C. 111(a) rather than a national stage application under 35 U.S.C. 371.

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). See 37 CFR 1.494(f):

> The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states that:

> If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

Applicant's original transmittal letter, filed 20 February 2001, specifically identified the accompanying submission as a continuation application of PCT/JP99/02379 filed under 37 CFR 1.53(b). Accordingly, the submission was not "clearly identified as a submission to enter the national stage under 35 U.S.C. 371." The present application should therefore have been treated as a continuation application filed under 35 U.S.C. 111(a), rather than a national stage application under 35 U.S.C. 371.

CONCLUSION

Applicant's petition is **GRANTED**.

The present application will be treated as a U.S. application filed under 35 U.S.C. 111(a) as a continuation of international application PCT/JP99/02379. This application will be assigned a filing date of 20 February 2001.

A corrected filing receipt will be issued, and the Group Art Unit will be informed of this decision.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

04 MAR 2004

Image

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In re Application of	:	
FUJIKAWA, et al.	:	
U.S. Application No.: 09/763,194	:	DECISION ON PETITION
Filing Date: 20 February 2001	:	UNDER 1.182
Attorney's Docket No.: Q63075	:	(CORRECTED)
For: METHOD AND APPARATUS FOR SURFACE DISCHARGE PROCESSING, AND AN ELECTRODE FOR SURFACE DISCHARGE PROCESSING	:	

This decision is issued in response to applicant's "Petition Under 37 CFR 1.182 To Accept Application As Continuing Application Under 37 C.F.R. 1.53(b)" filed 02 September 2003. No petition fee is required.

BACKGROUND

On 20 February 2001, applicants filed a transmittal letter to initiate a U.S. patent application. The transmittal letter specifically stated that it was intended to initiate a continuation application of PCT/JP99/02379. The transmittal letter was specific in stating that the filing was made under 37 CFR 1.53(b), and the accompanying declaration claimed priority to the PCT application under 35 U.S.C. 120. The submission included, among other materials, a specification (including claims) and drawings.

On 19 March 2001, the USPTO issued a "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 that the application had been accepted as a national stage filing under 35 U.S.C. 371.

On 21 March 2001, the USPTO issued a filing receipt which also indicated that the application was considered a "371 of PCT/JP99/02379."

On 23 September 2003, applicant filed the present petition seeking to have the present application treated as a continuation application filed under 35 U.S.C. 111(a) rather than a national stage application under 35 U.S.C. 371.

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). See 37 CFR 1.494(f):

> The documents and fees submitted ... must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371, otherwise the submission will be considered as being made under 35 U.S.C. 111.

In addition, section 1893.03(a) of the MPEP states that:

> If there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111(a) or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111(a).

Applicant's original transmittal letter, filed 20 February 2001, specifically identified the accompanying submission as a continuation application of PCT/JP99/02379 filed under 37 CFR 1.53(b). Accordingly, the submission was not "clearly identified as a submission to enter the national stage under 35 U.S.C. 371." The present application should therefore have been treated as a continuation application filed under 35 U.S.C. 111(a), rather than a national stage application under 35 U.S.C. 371.

CONCLUSION

Applicant's petition is **GRANTED**.

The present application will be treated as a U.S. application filed under 35 U.S.C. 111(a) as a continuation of international application PCT/JP99/02379. This application will be assigned a filing date of 20 February 2001.

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) mailed 19 March 2001 is hereby **VACATED**.

A corrected filing receipt will be issued, and the Group Art Unit will be informed of this decision.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

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)
6461079	2002-10-08	09763197	2001-04-25	2001-1103

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

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

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

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

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Benoit Castel/	Date (YYYY-MM-DD)	2007-02-08
Name	Benoit CASTEL	Registration Number	35041

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

Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

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In re Patent No. 6461079
Issue Date: October 8,2002
Application No. 09763197
Filed: April 25,2001
Attorney Docket No. BO-42150

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

This is a decision on the electronic petition, filed February 8,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of February 8,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 4/7/06

TO SPE OF : ART UNIT 1624

SUBJECT : Request for Certificate of Correction for Appl. No.: 09763213 Patent No.: 6867214

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

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

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

Valerie Jones

Certificates of Correction Branch

703-308-9390 ext. 114

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

SPE

1624

Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

FEB 1 2 2002

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Patrick J. G. Stiennon
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Madison, Wisconsin 53701-1507

In re Application of: LAN, Xuekui, et al. U.S. Application No.: 09/763,214 Attorney's Docket No.: VALMET-5210 For: METHOD AND APPARATUS FOR THE HIGH SPEED APPLICATION OF COATING TO A TRAVELING PAPER WEB	: : : : : : :	DECISION ON SECOND RENEWED PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

In decisions mailed on 11 May 2001 and 06 September 2001, this Office dismissed applicants' petition under 37 CFR 1.137(b) for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had failed to provide adequate evidence that the delay in filing the present continuation application was unintentional.

On 16 October 2001, applicants filed the second renewed petition considered herein. This second renewed petition contains a further explanation of the facts underlying applicants failure to timely enter the national stage in the United States. Based on applicants' statements in the second renewed petition, and the statements and materials included with applicants' prior submissions, applicants' assertion that the failure to timely enter the national stage in the United States was unintentional is accepted.

Applicants have therefore now satisfied all the requirements for a grantable petition under 37 CFR 1.137(b). Accordingly, the petition is **GRANTED**.

International application PCT/97/17417 is being revived for purposes of continuity only and since continuity has been established by this decision, the international application is again abandoned in favor of the present continuing application.

Finally, applicants should note that the proper U.S. application number for the present application is 09/763,214. All future correspondence with respect to this application should refer to such application number.

This application is being forwarded to the Office of Initial Patent Examination for treatment as a filing under 35 U.S.C. 111(a) with a filing date of 02 February 2001.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

RMR/RC:rmr

SEP 06 2001

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Madison, Wisconsin 53701-1507

In re Application of: LAN, Xuekui, et al. U.S. Application No.: 09/763,214 Attorney's Docket No.: VALMET-5210 For: METHOD AND APPARATUS FOR THE HIGH SPEED APPLICATION OF COATING TO A TRAVELING PAPER WEB	DECISION ON RENEWED PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

On 11 May 2001, this Office mailed a decision dismissing without prejudice applicants' petition under 37 CFR 1.137(b). The petition was dismissed for failure to satisfy all the requirements of a grantable petition. Specifically, applicants had failed to provide adequate evidence that the delay in filing the present continuation application was unintentional.

On 18 June 2001, applicants filed the renewed petition under 37 CFR 1.137(b) considered herein. This renewed petition included copies of the exhibits to the original petition (which were not present in the application file), as well as an additional statement by James Lowe (the attorney identified as being responsible for this application during the relevant time period).

These materials, however, still do not provide adequate evidence that the delay in filing the present application was unintentional. Mr. Lowe states: "I downloaded data from Beloit's docket system into my own docket system." However, Mr. Lowe does not provide a copy of the data downloaded from the Beloit docket system. In addition, Mr. Lowe's statement refers to his docket system, which alerted him to the thirty month deadline for entering the national stage, but which apparently did not "provide a specific indication of the necessity of entering the national phase in the United States." Some further explanation is required as to how Mr. Lowe's docketing system works, that is, how the system could alert him to the thirty month deadline for national stage entry but not alert him to the thirty month deadline for entry into the national stage in the United States. In addition, Mr. Lowe has attached as exhibit D to his statement a redacted letter to Greg Wedel of Beloit Technologies, Inc. in which Mr. Lowe asks for instructions regarding what countries to enter the national stage in. Applicants do not, however, provide a copy of the response received from Beloit Technologies in response to this inquiry. This response must be provided and must be accompanied by whatever further information applicants have with respect to the specific instructions provided by Beloit Technologies in response to the letter attached as Exhibit D.

Based on the above, applicants have not satisfied the final requirements for a grantable petition under 37 CFR 1.137(b). Accordingly, the renewed petition 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 "Second Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

RMR/LS:rmr

MAY 1 1 2001

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Madison, Wisconsin 53701-1507

In re Application of LAN, Xuekui, et al. U.S. Application No.: 09/763,214 Attorney's Docket No.: VALMET-5210 For: METHOD AND APPARATUS FOR THE HIGH SPEED APPLICATION OF COATING TO A TRAVELING PAPER WEB	DECISION ON PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

This decision is issued in response to applicants' "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed on 02 February 2001. Applicants have paid the required petition fee.

BACKGROUND

International application PCT/US97/17417 became abandoned under 35 U.S.C. 371(d) at midnight on 30 December 1999 (thirty months after the priority date) for failure to pay the basic national fee.

On 02 February 2001, applicants filed the present application under 35 U.S.C. 111(a) as a continuation of international application PCT/US97/17417, and the petition to revive international application PCT/US97/17417 considered herein. The petition to revive was filed for the purpose of establishing continuity between the international application and the present continuation application.

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). Here, applicants have satisfied items (1) and (2), and item (4) is not applicable. However, applicants have failed to satisfy item (3).

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, the filing of the present continuing application under 35 U.S.C. 111 is accepted as the appropriate response under 37 CFR 1.137(b). See MPEP § 711.03(c).. Accordingly, applicants have submitted the "required reply." Item (1) is satisfied.

Item (2) is the required petition fee. The Petition For Revival was accompanied by payment of the $1,240 petition fee. Item (2) is satisfied.

As for item (3), the petition 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. However, applicants have also submitted a "Detailed Statement of How Delay in Discovering the Abandoned Status Occurred" (hereinafter "Statement"). The Statement is incomplete in that it refers to a number of exhibits, none of which are present in the application file. In addition, the Statement raises issues regarding the intent of applicants in abandoning this application with respect to the United States. Specifically, it states that, in December 1999, James Lowe (the attorney identified in the Statement as being responsible for this application during the relevant time period):

> contacted a European associate and instructed the associate to enter the national phase in Europe. Mr Lowe allowed the U.S. international phase application to become abandoned through failure to enter the national stage.

Present counsel goes on to state that "I have spoken to Mr. Lowe and he was unaware of the need to enter the United States national phase to prevent abandonment of the pending U.S. application." However, since Mr. Lowe evidently was aware of the need to timely file the national stage application in Europe, and clearly had an adequate docketing system in place with respect to this application, his failure to initiate a national stage in the United States raises an issue as to whether or not the failure to enter the national stage in the United States was intentional. To resolve this issue, applicants must submit a statement from Mr. Lowe explaining in more detail his failure to timely enter the national stage in the United States. Applicants must also submit the exhibits referred to in the present Statement which, as noted above, are not present in the application file. Based on the above, the present petition does not satisfy item (3) of a grantable petition under 37 CFR 1.137(b).

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 not satisfied all the requirements for a grantable petition under 37 CFR 1.137(b). The Petition For Revival must be dismissed.

CONCLUSION

The Petition For Revival 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 Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

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RMR/BM:rmr

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JAN 12 2004

#15

SHANKS & HERBERT
TRANSPOTOMAC PLAZA
1033 NORTH FAIRFAX STREET SUITE 306
ALEXANDRIA VA 22314

In re Application of	:
Mark B Anderson et al	:
Serial No.: 09/763,216	: PETITION DECISION
Filed: February 20, 2001	:
Attorney Docket No.: 0059-01	:

This is in response to the petition under 37 CFR 1.181, filed October 24, 2003, for withdrawal of abandonment of the above identified application based on filing of a timely reply. The delay in acting on this petition is regretted.

A review of the file history shows that the examiner mailed a Notice of Allowance and Issue Fee Due and a Notice of Allowability to applicants on October 25, 2002, setting a three month statutory period for payment of the Issue Fee. The Issue Fee was paid on February 5, 2003. On February 5, 2003, Publications Division mailed a letter requesting submission of corrected application papers as chemical structures were too small to read, setting a 30 day period for reply. A Notice of Abandonment was mailed to applicants on October 3, 2003, when no reply was received. Applicants state that RCE papers were filed on March 4, 2003, accompanied by the required fee and a request for a three month suspension of action. Copies of these papers are provided with the petition. In view of the evidence presented the Notice of Abandonment was mailed in error and is withdrawn and the application is restored to pending status with the mailing of this decision

The petition is **GRANTED**.

The three month suspension of action requested is granted and runs from the date of mailing of this decision after which 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 703-308-3824 or by facsimile sent to the general Office facsimile number.

Bruce M. Kisliuk
Director, Technology Center 1600

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Richard D. Conard
BARNES & THORNBURG
11 South Meridian Street
Indianapolis, IN 46204

In re Application of	:	
GRUENDER, Hartmut, et al.	:	
U.S. Application No.: 09/763,240	:	DECISION ON PETITION TO
PCT No.: PCT/US99/18794	:	CORRECT INVENTORSHIP
International Filing Date: 19 August 1999	:	
Priority Date: 20 August 1998	:	
Attorney's Docket No.: 3566-67654	:	
For: DRIVE SYSTEM FOR VENEER SLICER	:	

This decision is issued in response to applicants' "Petition To Correct Inventorship In Patent Application Under 37 CFR 1.48(b)" filed on 15 February 2001, which has been treated as a request to correct inventorship under 37 CFR 1.497(d). Applicant has paid the required processing fee.

BACKGROUND

On 19 August 1999, applicants filed international application PCT/US99/18794 which claimed a priority date of 20 August 1998 and which designated the United States. The international application identified Hartmut GRUENDER, Juergen F. TROST, and Daniel J. RASTATTER as the inventors.

On 26 January 2000, 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 payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 20 February 2001.

On 15 February 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment for the basic national fee, a declaration executed only by Hartmut GRUENDER, and the petition to correct inventorship considered herein.

DISCUSSION

The petition to correct inventorship seeks to delete Juergen F. TROST and Daniel J. RASTATTER as inventors. The petition asserts that this correction is appropriate because the invention to which Mr. TROST and Mr. RASTATTER contributed is no longer being claimed in this national stage application, with the remaining claims representing solely the invention of Mr.

GRUENDER. The petition was filed under 37 CFR 1.48(b); however, it is 37 CFR 1.497(d), not 37 CFR 1.48(b), which applies when the inventorship in a national stage application filed under 35 U.S.C. 371 differs from that set forth in the international application (see 37 CFR 1.48(f)(1)).

37 CFR 1.497(d) states:

> (d) 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 assignees (see § 3.73(b) of this chapter).

Here, as noted above, the declaration filed on 15 February 2001 names an inventive entity different from that set forth in the international application. Specifically, it fails to include two inventors (Juergen F. TROST and Daniel J. RASTATTER) who were listed as inventors the international application. Accordingly, before the declaration filed on 15 February 2001 can be accepted, applicants must submit the materials set forth in 37 CFR 1.497(d).

A review of the materials filed by applicants' on 15 February 2001 reveals that this submission does not satisfy all the requirements of 37 CFR 1.497(d). Specifically, item (2) has been satisfied (payment of the processing fee), while items (1) and (3) have not.

Before the declaration filed on 15 February 2001 may be accepted as complying with 37 CFR 1.497, applicants must submit: (1) the statement required under 37 CFR 1.497(d)(1), executed by both Juergen F. TROST and Daniel J. RASTATTER; and (2) the written consent of the assignee, as required by 37 CFR 1.497(d)(3), or a statement from applicants that no such assignee exists.

Because applicants have failed to satisfy all the requirements of 37 CFR 1.497(d), the request to correct inventorship cannot be granted at this time. The declaration filed on 15 February 2001 is therefore defective under 37 CFR 1.497 for failure to identify all the inventors currently on record for this application.

CONCLUSION

The submission under 37 CFR 1.497(d) is **DISMISSED** without prejudice.

The declaration filed on 15 February 2001 is defective. In order to make the change of inventorship required to render the declaration acceptable, applicants must submit the materials required by 37 CFR 1.497(d), as discussed above.

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 1.497(d)." Failure to file a timely and proper response will result in abandonment of the application.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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RMR/LS:rmr

SEP 05 2001

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In re Application of	:	
GRUENDER, Hartmut, et al.	:	
U.S. Application No.: 09/763,240	:	DECISION ON RESPONSE TO
PCT No.: PCT/US99/18794	:	DENIAL OF PETITION TO
International Filing Date: 19 August 1999	:	CORRECT INVENTORSHIP
Priority Date: 20 August 1998	:	
Attorney's Docket No.: 3566-67654	:	
For: DRIVE SYSTEM FOR VENEER SLICER	:	

In a decision mailed 15 May 2001 by this Office, applicants "Petition To Correct Inventorship In Patent Application Under 37 CFR 1.48(b)" was treated as a request to correct inventorship under 37 CFR 1.497(d). The request was dismissed for failure to satisfy all the requirements of 37 CFR 1.497(d).

On 18 June 2001, applicants filed the "Response To Denial Of Petition To Correct Inventorship" considered herein as a renewed petition. The renewed petition notes that the terms of 37 CFR 1.497(d) cannot be complied with because no "error" in inventorship has occurred here. Rather, applicants assert that the filed declaration fails to include two of the inventors who were named on the international application because the claims invented by these two inventors are to be removed from the national stage application by preliminary amendment. Applicant is correct that, under these circumstances, the terms of 37 CFR 1.497(d) referred to in the previous decision are inapplicable here. To the extent that the previous decision required the submission of materials under 37 CFR 1.497(d), such decision is **VACATED**.

However, a request to convert inventorship under 37 CFR 1.48(b) is applicable, by its terms, only to non-provisional applications. A U.S. national stage application becomes a non-provisional application only after the requirements under 35 U.S.C. 371, including 35 U.S.C. 371(c)(4), have been complied with (see 37 CFR 1.9). As conceded by petitioner, the inventors of the subject matter claimed upon filing the international application were correctly identified as Hartmut GRUENDER, Juergen F. TROST and Daniel J. RASTATTER. Accordingly, an oath or declaration by these three inventors in compliance with 37 CFR 1.497 is required.

CONCLUSION

Applicants' request under 37 CFR 1.48(b) will be held in abeyance pending the submission of a fully executed oath or declaration in compliance with 37 CFR 1.497.

The declaration filed on 15 February 2001 remains defective based on its failure to identify and be executed by all the inventors named in the international application as filed. Applicants are required to submit an oath or declaration in compliance with 37 CFR 1.497, as well as the $130 surcharge for failing to file a proper declaration within thirty months of the priority date

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to file a timely and proper response will result in abandonment of the application.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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RMR/BM:rmr

MAR 0 1 2002

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Indianapolis, IN 46204

In re Application of	:	
GRUENDER, Hartmut, et al.	:	
U.S. Application No.: 09/763,240	:	DECISION ON PETITION TO
PCT No.: PCT/US99/18794	:	SUSPEND RULES UNDER
International Filing Date: 19 August 1999	:	37 CFR 1.183
Priority Date: 20 August 1998	:	
Attorney's Docket No.: 3566-67654	:	
For: DRIVE SYSTEM FOR VENEER SLICER	:	

This decision is issued in response to the "Petition To Suspend 37 CFR 1.9 To The Extent That It Requires Execution Of The Declaration By Messrs Trost And Rastatter" filed 25 October 2001, which has been treated as a petition under 37 CFR 1.183. Applicants have paid the required petition fee.

BACKGROUND

The procedural background for this application has been set forth in pevious decisions mailed by this Office on 15 May 2001 and 05 September 2001.

The 05 September 2001 decision held in abeyance applicants' request to convert inventorship under 37 CFR 1.48(b). The decision stated that 37 CFR 1.48(b) only applies to non-provisional applications, and it noted that a U.S. national stage application does not become a non-provisional application until the requirements of 35 U.S.C. 371 have been complied with. Because applicants here had not submitted a declaration satisfying 35 U.S.C. 371(c)(4), the request under 37 CFR 1.48(b) could not be considered.

On 25 October 2001, applicants filed the petition considered herein. This petition seeks waiver of 37 CFR 1.9 and any other rules which prevent immediate action on applicants' request to correct inventorship under 37 CFR 1.48(b).

DISCUSSION

Here, as set forth in the 05 September 2001 decision, the rules preclude a change in inventorship under 37 CFR 1.48(b) until the declaration required by 35 U.S.C. 371(c)(4) has been submitted. This is because, as noted in the previous decision, 37 CFR 1.48(b) applies only to "nonprovisional" applications, defined in 37 CFR 1.9 as "a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage

from an international application **after compliance with 35 U.S.C. 371**" (emphasis added). Thus, until applicants have complied with 35 U.S.C. 371 by submitting a declaration executed by all the applicants listed in the international application, the application is not a "nonprovisional" application which can be acted on under 37 CFR 1.48(b). See 37 CFR 1.41(a)(4):

> The inventors who submitted an application under 37 CFR § 1.494 or § 1.495 are the inventors in the international application designating the United States (§ 1.48(f)(1) does not apply to applications entering the national stage)

Applicants argue that there is a conflict between 37 CFR 1.9 and 35 U.S.C. 363, which states that "an international application designating the United States has the effect of a national application for a patent regularly filed in the United States." However, the general rule that an international application "has the effect" of a national application does not change the fact that the terms of the specific rule which applicants seek to apply (37 CFR 1.48) preclude the rule from being applied to an international application not in compliance with 35 U.S.C. 371.

With respect to applicants request for a waiver of the rules, 37 CFR 1.183 grants the Commissioner the authority to suspend or waive the requirements of the regulations in "an extraordinary situation, when justice requires." However, applicants have provided no evidence that this is an "extraordinary" situation, or that "justice requires" a waiver of the rules. To the contrary, applicants here have a number of options by which they could correct the inventorship as desired without requiring a waiver of the rules. Applicants could submit a declaration under 37 CFR 1.497 executed by all the named inventors, at which time the petition under 37 CFR 1.48(b) could be acted upon. If the signature of all the inventors cannot be obtained on the declaration, applicants can file a petition under 37 CFR 1.47(a). In the alternative, applicants could file a continuation application naming only Hartmut GRUENDER as inventor.

Under these circumstances, where applicants have numerous options within the rules to obtain the desired correction of inventorship, a waiver of the rules under 37 CFR 1.183 is not warranted.

CONCLUSION

Applicants' petition under 37 CFR 1.183 is **DISMISSED** without prejudice.

Applicants' request under 37 CFR 1.48(b) continues to be held in abeyance pending the submission of a fully executed oath or declaration in compliance with 37 CFR 1.497.

The declaration filed on 15 February 2001 remains defective based on its failure to identify and be executed by all the inventors named in the international application as filed. Applicants are required to submit an oath or declaration in compliance with 37 CFR 1.497, as well as the required $130 surcharge.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to file a timely and proper response will result in abandonment of the application.

Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

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2 9 AUG 2002

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In re Application of
GRUENDER, Hartmut
U.S. Application No.: 09/763,240
PCT No.: PCT/US99/18794
International Filing Date: 19 August 1999
Priority Date: 20 August 1998
Attorney's Docket No.: 3566-67654
For: DRIVE SYSTEM FOR VENEER SLICER

DECISION ON PETITION TO CORRECT INVENTORSHIP (37 CFR 1.48(b))

In a decision mailed by this Office on 01 March 2002, applicants' petition to suspend the rules was dismissed, and applicants were informed that the petition to correct inventorship under 37 CFR 1.48(b) remained in abeyance pending submission of a declaration in compliance with 37 CFR 1.497.

On 23 May 2002, applicants filed a fully executed declaration in compliance with 37 CFR 1.497. The declaration was accompanied by the $130 surcharge for filing the declaration after the thirty month deadline and the required extension fee to make the submission a timely response to the 01 March 2002 decision. Applicants' submission completes the requirements for entry into the national stage under 35 U.S.C. 371; the 35 U.S.C. 371 date for the present application is **23 May 2002**.

Applicants' completion of the 35 U.S.C. 371 requirements permits action on the previously filed petition to correct inventorship under 37 CFR 1.48(b). Such petition was accompanied by the statement required under 37 CFR 1.48(b)(1) and the processing fee required under 37 CFR 1.48(b)(2). Applicants have therefore satisfied the requirements for a grantable petition under 37 CFR 1.48(b).

The petition under 37 CFR 1.48(b) is **GRANTED**.

The inventorship on the present application is corrected so as to remove inventors Juergen F. TROST and Daniel J. RASTATTER; the sole inventor on this application is now Hartmut GRUENDER.

The application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accord with this decision. The 35 U.S.C. 371 date is **23 May 2002**. The sole inventor is **Hartmut GRUENDER.**

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05 FEB 2003

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In re Application of	:	
GRUENDER, Hartmut	:	
U.S. Application No.: 09/763,240	:	CORRECTION TO DECISION ON
PCT No.: PCT/US99/18794	:	PETITION TO CORRECT
International Filing Date: 19 August 1999	:	INVENTORSHIP MAILED
Priority Date: 20 August 1998	:	29 AUGUST 2002
Attorney's Docket No.: 3566-67654	:	
For: DRIVE SYSTEM FOR VENEER SLICER	:	

In a decision mailed by this Office on 29 August 2002, applicants' petition under 37 CFR 1.48(b) was granted. That decision contained a typographical error in that it identified the filing date of applicants' declaration (and the corresponding 35 U.S.C. 371 date) as 23 May 2002.

A review of the application file reveals that the the correct filing date for the declaration is 28 May 2002. Accordingly, the 29 August 2002 decision is hereby **CORRECTED** to the extent that the 35 U.S.C. 371 date for the application is corrected to 28 May 2002.

The application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accord with this decision. The 35 U.S.C. 371 date is **28 May 2002**. The sole inventor is **Hartmut GRUENDER.**

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SEP 2 6 2001

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#3

Henry I. Schanzer
29 Brookfall Road
Edison, NJ 08817

In re Application of
CARROLL, et al.
Application No.: 09/763,247
PCT No.: PCT/US00/14652
Int. Filing Date: 26 May 2000
Priority Date: None
Attorney Docket No.: OPT 33-27
For: WAVE ENERGY CONVERTERS UTILIZING PRESSURE DIFFERENCES

DECISION ON PETITION

UNDER 37 CFR 1.137(b)

This decision is in response to applicant's "Petition For Revival of an International Application For Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 20 February 2001 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 26 May 2000, applicant filed international application PCT/US00/14652 and claimed priority to U.S. provisional application 60/136,189 filed "5 May 1999." A Demand for international preliminary examination was not filed prior to the expiration of nineteen months from the priority date.

On 10 July 2000, the International Bureau (IB) mailed a "Invitation to Correct Priority Claim" (Form PCT/IB/316) indicating that the priority claim failed to comply with PCT Rule 4.10 because the filing date did not fall within the period of 12 months preceding the international filing date.

On 20 February 2001, applicant filed the present petition to revive.

On 22 May 2001, the International Bureau mailed applicant a "Notification Relating to Priority Claim" (Form PCT/IB/318) notifying applicant that the priority claim for the present application is considered not to have been made as the applicant's notice was received after the expiration of the prescribed time limit under Rule 26bis.1(a).

DISCUSSION

As there is no priority claim for the present international application, the twenty month period for paying the U.S. basic national fee was not to expire until 26 January 2002. Applicant provided this payment along with the present petition on 20 February 2001.

CONCLUSION

For the reasons stated above, the petition for revival is **DISMISSED as moot**. The petition fee will be refunded in due course.

Applicant is advised that early processing under 35 U.S.C. 371(f) can not proceed as a compliant oath or declaration of the inventors has not been filed.

This application is being returned to the United States Designated/Elected Office (US/DO/EO) for processing of the application at the expiration of 20 months from the international filing date.

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Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

Enclosure: Copy of form PCT/IB/318

UNITED STATES PATENT & TRADEMARK OFFICE
Washington, D.C. 20231

REQUEST FOR PATENT FEE REFUND

1 Date of Request: 10-12-01

2 Serial/Patent # 09/763247

	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		5-16-01	$ 620.00
	Issue			$
	Cert of Correction/Terminal Disc.			$
	Maintenance			$
	Assignment			$
	Other			$

7 TOTAL AMOUNT OF REFUND $620.00

8 TO BE REFUNDED BY:

✓ Treasury Check

Credit Deposit A/C #:

9 [ ][ ]--[ ][ ][ ][ ]

10 REASON:

	Overpayment
	Duplicate Payment
✓	No Fee Due (Explanation):

SEE DECISION dated 9-26-01

11 REFUND REQUESTED BY:

TYPED/PRINTED NAME: Barbara Campbell TITLE: Paralegal

SIGNATURE: Barbara Campbell PHONE: 305-3631

OFFICE: PCT DO/EO

****

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APPROVED: [signature] DATE: 1/24/02

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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(01/90)

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HENRY I SCHANZER
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EDISON NJ 08817

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OFFICE OF PETITIONS

In re Application of	:	
Carroll et al.	:	
Application No. 09/763,247	:	ON PETITION
Filed: 15 October, 2001	:	
For: Wave Energy Converters	:	
Utilizing Pressure Differences	:	

This is a decision on the petition filed on 23 January, 2004, which requests under 37 C.F.R. §1.182 that a previously filed terminal disclaimer be withdrawn. The petition fee has been received.

The petition is granted.

Petitioner asserts that the terminal disclaimer filed 12 November, 2003, is no longer required. As the examiner has concurred, the requested relief can be favorably considered.

This application is being forwarded to Technology Center 2800 for correction of PALM and file records consistent with this decision.

Telephone inquiries relative to this decision should be directed to the undersigned at (703) 308-6918.

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

MAY 15 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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Carl Oppedahl
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In re Application of CRAIG, Randall H. U.S. Application No.: 09/763,250 PCT No.: PCT/US99/27771 Int. Filing Date: 22 November 1999 Priority Date: 15 June 1999 Attorney Docket No.: HRCMP002USNP For: APPARATUS FOR CALCULATING TIME PERIODS	DECISION UNDER 37 CFR 1.10(c)

This decision is in response to the documents titled "Request for Corrected Filing Date" submitted by applicant via facsimile on 06 March 2001 which is treated as a petition under 37 CFR 1.10(c). No fee is required.

BACKGROUND

On 22 November 1999, applicant filed international application PCT/US99/27771 claiming priority to a United States patent application filed 15 June 1999. A Demand for the international preliminary examination was not filed. Accordingly, the twenty-month period for paying the basic national fee in the United States expired at midnight on 15 February 2001.

On 15 February 2001, applicant filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 using Express Mail. The United States Designated/Elected Office (DO/EO/US) listed the date of receipt of these documents as 16 February 2001.

On 06 March 2001, applicants filed the instant petition which was accompanied by *inter alia*, a copy of Express Mail label No. EL556131513US, and a copy of the USPS Track/Confirm page for Express Mail No. EL556131513US.

DISCUSSION

Any correspondence received by the Patent and Trademark Office delivered by "Express Mail" will be considered filed in the office on the date of deposit with the USPS. 37 CFR 1.10(a). Moreover, 37 CFR 1.10(c) states that:

> 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.

In the instant petition, applicant submitted a copy of Express Mail label No. EL556131513US which has a "Date In" listed as "2 15 01." The aforementioned Express Mail label is also located in the above-identified file and is stamped by the USPTO Mail Center as received on "FEB 15 2001." In addition, the transmittal letter (Form PTO-1390) lists the Express Mail label number at the bottom of the first page. Moreover, the USPS Track/Confirm page also confirms that Express Mail No. EL556131513US was accepted by the USPS on "February 15 4:35 p.m."

In light of the evidence, it appears that the DO/EO/US erroneously listed the 35 U.S.C. 371(c) date as 16 February 2001.

CONCLUSION

The petition to correct the filing date pursuant to 37 CFR 1.10(c) is **GRANTED**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing including issuing a corrected filing receipt indicating a 35 U.S.C. 371(c) date of **15 February 2001**.

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James Thomson
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Paper No. 12

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COPY MAILED

NOV 2 5 2002

OFFICE OF PETITIONS

In re Application of :
Toshio Miyata :
Application No. 09/763,286 :
Filed: August 28, 2001 :
Attorney Docket No. SHIM-008 :

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
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AUG 18 2004

Ostrolenk, Faber, Gerb & Soffen, LLP
1180 Avenue of the Americas
New York, NY 10036-8403

Paper No. 10

In re Application of Daniel Engvall et al Serial No. : 09/763,312 Filed : April 24, 2001 For : Transportable Apparatus for Treating Meniere's Disease	: DECISION ON PETITION : TO WITHDRAW : HOLDING OF : ABANDONMENT :

This is a decision on petitioner's request filed July 16, 2004 to review the holding of abandonment mailed February 11, 2003, for failure to respond to the Office action mailed June 28, 2002. The request indicates that a first request was filed November 25, 2003. The November 25, 2003 request is not in the file. The basis for the request is that applicant did not receive the communications mailed June 28, 2002 and February 11, 2003. There is no fee required for this petition.

In order to overcome the presumption of delivery of an Office action, a practitioner must submit the following: (1) a statement from the practitioner stating that the Office action was not received by practitioner; (2) a statement attesting to the fact that a search of the file jacket and docket record indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received and docketed. See 1156 OG 53.

The request filed July 16, 2004 includes elements (1) and (2) but not element (3). However, since an inspection of the file reveals that the Office inadvertently changed the correspondence address for the instant application (there is no record in the file of a request to have the correspondence address changed), the communications in question were mailed to an incorrect address, element (3) is not necessary and will not be required. The request is therefore GRANTED and the holding of abandonment withdrawn. Upon the mailing of this decision, the application will be forwarded to the Legal Instruments Examiner to have the correspondence address corrected and to have the Office action of June 28, 2002 re-mailed setting forth a new time period for response.

Summary: Holding of Abandonment Withdrawn.

John E. Kittle, Director
Groups 3730 and 3760
Phone: (703) 308-0873
ak/08/02/04

MAR 2 6 2002

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In re Application of SIM et al	:	
U.S. Application No.: 09/763,338	:	
Int. Application No.: PCT/AU00/00937	:	DECISION
Int. Filing Date: 07 August 2000	:	
Priority Date: 06 August 1999	:	
Attorney Docket No.: 4670/1	:	
For: NETWORK RESOURCE MONITORING AND	:	
MEASUREMENT SYSTEM AND METHOD	:	

This application is before the PCT Legal Office for consideration of issues arising under 35 U.S.C. 371.

BACKGROUND

On 07 August 2000, applicant filed international application PCT/AU00/00937, which claimed priority of an earlier Australia application filed 06 August 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 15 February 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 2001, 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 06 February 2002.

On 16 February 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed. Form PCT/DO/EO/905 set a response deadline of thirty-two (32) months from the priority date, i.e. 06 April 2002.

On 13 December 2001, the DO/EO/US mailed a Notification of Abandonment, which stated that the application is abandoned for failure to timely respond to the Notification of Missing Requirements.

DISCUSSION

The Notification of Abandonment was mailed in error.

CONCLUSION

For the reasons above, the Notification of Abandonment mailed 13 December 2001 is hereby VACATED.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) to await applicant's response to the Notification of Missing Requirements mailed 08 May 2001.

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PCT Legal Office

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MAY 17 2002

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In re Application of SIM et al	:	
U.S. Application No.: 09/763,338	:	
Int. Application No.: PCT/AU00/00937	:	DECISION
Int. Filing Date: 07 August 2000	:	
Priority Date: 06 August 1999	:	
Attorney Docket No.: 4670/1	:	
For: NETWORK RESOURCE MONITORING AND	:	
MEASUREMENT SYSTEM AND METHOD	:	

This is in response to applicant's "Petition Under 37 C.F.R. 1.47(b) in Support of Filing on Behalf of Non-Signing Inventors" filed 17 April 2002.

BACKGROUND

On 07 August 2000, applicant filed international application PCT/AU00/00937, which claimed priority of an earlier Australia application filed 06 August 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 15 February 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 2001, 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 06 February 2002.

On 16 February 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 17 April 2002, applicant filed the present petition under 37 CFR 1.47(b). The petition states that none of the six joint inventors can be found after diligent effort.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

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, the petition states that a diligent effort was made to locate the missing inventors. However, applicant has provided no specific details of any efforts to contact the inventors. Applicant should provide a declaration of facts signed by the person having firsthand knowledge of the purported attempts to find the inventors. Documentary evidence of the purported attempts should also be provided.

With regard to item (3) above, the petition does not state the last known addresses of the nonsigning inventors.

With regard to item (4) above, when an assignee files an application under 37 CFR 1.47(b), ownership of the application must be established. See MPEP 324. Under 37 CFR 3.73(b)(1), ownership of the application may be established by: (i) submitting documentary evidence of a chain of title from the original owner to the assignee; or (ii) specifying by reel and frame number where such evidence is recorded in the USPTO. In the present case, applicant has

provided a copy of an assignment agreement establishing a chain of title from the inventors to the assignee Red Sheriff, Limited.

MPEP 409.03(b) states in relevant part,

> A corporation may authorize any person, including an attorney or agent registered to practice before the U.S. Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath or declaration is signed by a registered attorney or agent on behalf of a corporation, either proof of the attorney's or agent's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney or agent may simply state that he or she is authorized to sign on behalf of the corporation.

In the present case, the petition is accompanied by a declaration signed by attorney/agent James Woods, who is registered to practice before the USPTO. The petition is accompanied by a statement signed by Mr. Woods which states that he is authorized to sign on behalf of the assignee Red Sheriff, Limited.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the Patent and Trademark Office, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, item (A) applies. The petition is accompanied by a copy of an assignment agreement which indicates that the invention has been assigned to the 37 CFR 1.47(b) applicant Red Sheriff, Limited.

With regard to item (6) above, applicant has made an adequate showing that the filing of the application under 37 CFR 1.47(b) is necessary to preserve the rights of the parties.

CONCLUSION

Because applicant has failed to satisfy items (2) and (3) above, the petition under 37 CFR 1.47(b) 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. 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 1.47(b)". 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.

Sincerely

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30 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of SIM et al	:	
U.S. Application No.: 09/763,338	:	
Int. Application No.: PCT/AU00/00937	:	COMMUNICATION
Int. Filing Date: 07 August 2000	:	
Priority Date: 06 August 1999	:	
Attorney Docket No.: 4670/1	:	
For: NETWORK RESOURCE MONITORING AND	:	
MEASUREMENT SYSTEM AND METHOD	:	

This is in response to papers filed 16 December 2002.

Although the present response appears to be a bona fide attempt to reply to the decision mailed 17 May 2002, the response does not address all of the deficiencies set forth in the decision.

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. 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 1.47(b)". 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.

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21 OCT 2003

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In re Application of SIM et al	:	
U.S. Application No.: 09/763,338	:	
Int. Application No.: PCT/AU00/00937	:	DECISION
Int. Filing Date: 07 August 2000	:	
Priority Date: 06 August 1999	:	
Attorney Docket No.: 4670/1	:	
For: NETWORK RESOURCE MONITORING AND	:	
MEASUREMENT SYSTEM AND METHOD	:	

This is in response to applicant's "Petition Under 37 CFR 1.47(a)" filed 05 September 2003.

BACKGROUND

On 07 August 2000, applicant filed international application PCT/AU00/00937, which claimed priority of an earlier Australia application filed 06 August 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 15 February 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 2001, 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 06 February 2002.

On 16 February 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 17 April 2002, applicant filed a petition under 37 CFR 1.47(b).

On 17 May 2002, this Office mailed a decision dismissing the 17 April 2002 petition.

On 16 December 2002, applicant filed a response to the 17 May 2002 decision.

On 30 January 2003, this Office mailed a communication in reply to applicant's 16 December 2002 response.

On 05 September 2002, applicant filed the present petition under 37 CFR 1.47(a).

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, applicant has submitted a declaration signed by four of the six joint inventors, each on his/her own behalf and on behalf of the nonsigning inventors.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal 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 nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> 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 that conclusion is based should be stated in the 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.

The petition states that inventors Lim Or Sim and Yee Han Cheong refuse to sign the application papers. Although applicant has submitted evidence of Sim and Cheong's purported refusal to sign the declaration, applicant has not sufficiently established that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to the nonsigning inventors for signature. The affidavit of David Moore states that declarations were sent to the nonsigning inventors (see Moore's affidavit, ¶2-3) but does not state that the specification, claims, and drawings were ever presented to the nonsigning inventors.

With regard to item (3) above, applicant has provided the requisite petition fee.

With regard to item (4) above, the petition states the last known addresses of the nonsigning inventors.

CONCLUSION

Because applicant has failed to satisfy item (2) 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. 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 1.47(a)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to 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.

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03 JUN 2004

#12

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In re Application of SIM et al	:	
U.S. Application No.: 09/763,338	:	
Int. Application No.: PCT/AU00/00937	:	DECISION
Int. Filing Date: 07 August 2000	:	
Priority Date: 06 August 1999	:	
Attorney Docket No.: 4670/1	:	
For: NETWORK RESOURCE MONITORING AND	:	
MEASUREMENT SYSTEM AND METHOD	:	

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 26 February 2004.

BACKGROUND

On 07 August 2000, applicant filed international application PCT/AU00/00937, which claimed priority of an earlier Australia application filed 06 August 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 15 February 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 2001, 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 06 February 2002.

On 16 February 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 17 April 2002, applicant filed a petition under 37 CFR 1.47(b).

On 17 May 2002, this Office mailed a decision dismissing the 17 April 2002 petition.

On 16 December 2002, applicant filed a response to the 17 May 2002 decision.

On 30 January 2003, this Office mailed a communication in reply to applicant's 16 December 2002 response.

On 05 September 2002, applicant filed a petition under 37 CFR 1.47(a).

On 21 October 2003, this Office mailed a decision dismissing the 05 September 2002 petition.

On 26 February 2004, applicant filed the present renewed petition under 37 CFR 1.47(a).

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.

Applicant has previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

> Where a refusal 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 nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> 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 that conclusion is based should be stated in the 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.

The petition states that inventors Lim Or Sim and Yee Han Cheong refuse to sign the application papers. Applicant has sufficiently established that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to the nonsigning inventors for signature (see supplemental affidavit of David Moore, ¶¶2-3). Furthermore, applicant has submitted evidence of Sim and Cheong's refusal to sign the declaration (see original affidavit of David Moore). Therefore, it would be reasonable to conclude that inventors Lim Or Sim and Yee Han Cheong refuse to join in the application.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is GRANTED.

This application has an international filing date of 07 August 2000 and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 05 September 2003.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventors at the last known addresses of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

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03 JUN 2004

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Lim Or Sim and Yee han Cheong
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In re Application of SIM et al
U.S. Application No.: 09/763,338
Int. Application No.: PCT/AU00/00937
Int. Filing Date: 07 August 2000
Priority Date: 06 August 1999
For: NETWORK RESOURCE MONITORING AND MEASUREMENT SYSTEM AND METHOD

Dear Lim Or Sim and Yee han Cheong:

You are named as joint inventors in the above-captioned United States national stage 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 inventors.

As named inventors, 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 set forth in 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 choose 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.

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Attorney Docket No.: 4670/1

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Mailed: 7/18/05

In re application of
Paulus De Lange et al.
Serial No. 09/763,355
Filed: February 21, 2001
For: FLUIDIZED BED METHOD AND REACTOR FOR THE TREATMENT OF CATALYSTS AND CATALYSTS CARRIERS

DECISION ON PETITION

This is a decision on the PETITION UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION mailed January 14, 2005.

On June 18, 2004, a non-final office action was mailed by the examiner, rejecting claims 1-5 under 35 USC 102 over two separate references. Applicants responded to this office action with a response filed on October 29, 2004. This response contained an amendment to independent claim 1 and cancelled dependent claim 4. The subject matter of claim 4 was inserted into claim 1. A final rejection was then mailed January 14, 2005 rejecting claims 1-3, 5 and 16 over a newly cited reference.

On February 9, 2005, the instant petition under 37 CFR 1.181 was timely filed to formally request the withdrawal of finality of the January 14, 2005 office action.

Applicants position for the withdrawal of the finality is that the new grounds of rejection in the final office action were not necessitated by Applicant's amendments to the claims.

DECISION

Section 706.07 of the MPEP states:

706.07(a) Final Rejection, When Proper on Second Action

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Turning to the rejections in the first office action, it is noted that the references relied upon did not meet the claimed limitations found in originally filed claim 4 regarding the calcination and/or activation of the catalysts. These limitations were then added to independent claim 1 which overcame the originally relied upon references. Accordingly, the newly applied rejection in the final office action was not necessitated by the amendment because such limitations were present in the originally filed claims.

Because the new grounds of rejection was not necessitated by amendment, the petition for withdrawal of finality is **GRANTED**

Applicants have filed an amendment in response to the outstanding office action. This amendment will be treated as a response to a non-final office action and will be entered. The examiner will take appropriate action in response to the amendment.

JMStone

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In re Application of	:	
Webb et al.	:	
Application No.: 09/763360	:	DECISION ON
PCT No.: PCT/GB99/04354	:	
Int. Filing Date: 21 December 1999	:	PETITION UNDER
Priority Date: 21 December 1998	:	
Attorney's Docket No.: 3036/49686	:	37 CFR 1.137(b)
For: Acoustically Activated Marketing Device	:	

This is in response to the petition under 37 CFR § 1.137(b)" filed on 21 February 2001.

BACKGROUND

This international application was filed on 21 December 1999, and claimed an earliest priority date of 21 December 1998. A copy of the international application was transmitted to the USPTO on 29 June 2000. No Demand electing the United States was filed prior to the elapse of 19 months from the international filing date. Accordingly, the twenty-month time period to pay the basic national fee in the United States expired as of midnight on 21 August 2000. This international application became abandoned with respect to the United States for failure to timely pay the required basic national fee.

Applicant filed the instant petition and accompanying fees and papers on 21 February 2001.

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; (2) the petition fee as set forth in § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this

paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Regarding requirement (1), the petition was accompanied by the required reply in the form of the basic national fee.

Concerning requirement (2), the petition is accompanied by the required petition fee.

Regarding requirement (3), the petition includes a statement that "the abandonment of the application was unintentional." This statement 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 37 CFR 1.137(b) 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).

As to requirement (4), no terminal disclaimer is required because the international filing date of this application was later than 08 June 1995.

DECISION

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

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for continued processing, including the preparation and mailing of a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring the filing of an executed oath or declaration of the inventors and a surcharge under 37 CFR 1.492(e).

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OFFICE OF PETITIONS

In re Patent No. 7,371,568	:	
Issue Date: May 13, 2008	:	
Application No. 09/763,362	:	ON PETITION
Filed: April 23, 2001	:	
Attorney Docket No. 081356/0158	:	

This is a decision on the petitions under 37 CFR 1.182, filed December 30, 2009, (a) requesting issuance of a duplicate Letters Patent and (b) for expedited consideration thereof for the above-identified patent.

The petitions under 37 CFR 1.182 are **GRANTED**.

The Office of Data Management is directed to issue duplicate Letters Patent.

A copy of this decision is being forwarded to the Office of Data Management for issuance of the duplicate Letters Patent.

Any questions concerning this matter may be directed to the undersigned at (571) 272-4584. Any questions concerning issuance of the duplicate Letters Patent should be directed to Niomi Farmer at (703)756-1556.

JoAnne Burke
Petitions Examiner
Office of Petitions

cc: Niomi Farmer, P/ODM, Randolph Square Building, 9th Floor, 09/D30-B
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