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CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON MA 02210

In re Application of:
KETCHUM, GARY T.
Serial No.: 09/788,274
Filed: Feb. 16, 2001
Docket: 5018
Title: LEAK POINT WETNESS SENSOR FOR UROLOGICAL INVESTIGATIONS

DECISION ON PETITION TO REOPEN PROSECUTION UNDER 37 C.F.R. 1.198 AND WITHDRAW FINDING OF ABANDONMENT UNDER 37 C.F.R 1.181 & 1.198

This is a decision on the petition filed on Jul. 15, 2005 to reopen prosecution following the notification of abandonment on April 6, 2005. The petition is being considered under 37 CFR 1.181 and no fee is required. The petition fee paid, $130.00, will be refunded upon request.

The petition is **dismissed**.

In his Jul. 15, 2005 petition, the applicant requested re-opening prosecution and entry of RCE with a preliminary amendment to the claims. In support of his petition, the applicant argues that on pages 4-6 of the Board decision of Dec. 10, 2004, the Board indicated that disclosed invention differs from the Ketchum patent. However, the distinguished features are not recited in claim 1 and thus cannot be relied upon for patentability. The petitioner further stated that the current assignee became aware of such Board decision after acquiring the ownership rights to this patent application. Subsequently, the current petition with RCE and a preliminary amendment were filed.

The record shows that:

1) On Dec. 10, 2004 the Board affirmed the examiner's rejection of claims 1-4 in this application. No claims were found allowable in the application.
2) On April 6, 2005 the examiner sent out a letter of abandonment for failure to take further actions within two months from the date of the Board decision.
3) On Jul. 15, 2005, the applicant filed the present petition, arguing that that on pages 4-6 of the decision issued by the Board of Appeals and Interferences, the Board indicates certain features disclosed but not claimed were distinguishable over the prior art references of record. Therefore, the applicant requests the examiner to re-open prosecution and enter the RCE.

Applicable Rules

M.P.E.P. § 1214.06 states in relevant part:
"The time for seeking review of a decision of the Board by the Court of Appeals for the Federal Circuit or the U.S. District Court for the District of Columbia is . . . 2 months . . . . When the time for seeking court review (plus 2 weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review being sought, the examiner must take up the application for consideration. The situations which can arise will involve . . . :

I. NO CLAIMS STAND ALLOWED

The proceedings in an application . . . are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files."

M.P.E.P. § 1214.07 states in relevant part:
"Petitions under 37 CFR 1.198 to reopen or reconsider prosecution of a case after decision by the Board, where no court action has been filed, are decided by the Technology Center Director, MPEP § 1002.02(c).
The Director of the USPTO also entertains petitions under 37 CFR 1.198 to reopen certain cases in which an appellant has sought review under 35 U.S.C. 141 or 145. This procedure is restricted to cases which have been decided by the Board and which are amenable to settlement without the need for going forward with the court proceeding. Such petitions will ordinarily be granted only in the following categories of cases:

(A) When the decision of the Board asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable. . ."

Issue Presented

The issue presented in the present petition is whether the petition was filed timely to reopen prosecution.

Analysis

Petitioner stated that the assignee failed to realize the existence of the Board decision of Dec. 10, 2004 until an inspection of the application file after acquisition of the ownership right of the current application. The reason is insufficient to render the petition grantable under the current patent rules and regulations governing the re-opening of prosecution after the Board decision.

The petitioner also is of the opinion that the Board's decision of Dec. 10, 2004 indicated certain subject matter distinguishable over the prior art references and therefore request the prosecution be re-opened. Petitioner appears to believe that this portion of the Board decision would justify the prosecution be re-opened.

Petitioner's reasoning is also not persuasive because MPEP 1214.07 permits only if the appellant and the examiner can resolve curable defects during any further prosecution in this application. The petitioner mentioned nothing about curable defects. Moreover, by the time the present petition was filed, the application was already abandoned.

M.P.E.P. § 1214.06 states that an application is abandoned two months after a decision of the Board. Thus, on Feb. 11, 2005 the present application was abandoned following the Dec. 10, 2004 decision of the Board. The present petition was not filed on July 15, 2005, which was more than five months past the date of abandonment. This application remains abandoned for failure to take further action within two months from the decision of the Board.

Accordingly, the petition to reopen prosecution and withdraw abandonment is dismissed.

In order to reopen prosecution, the petitioner must first petition to withdraw abandonment under 37 C.F.R. 1.137 and include the applicable fee. At that point, the petitioner is invited to file the Request for Continued Examination with the amendment of claims 1-12.

Petitioner may file a request for reconsideration of this decision, without fee. However, such a request must be filed within two months of the date of this decision. 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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BOSTON, MA 02210

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OFFICE OF PETITIONS

In re Application of Ketchum :
Application No. 09/788,274 : Decision on Petition
Filing Date: February 16, 2001 :
Attorney Docket No. 101095-0030 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 21, 2006, to revive the above-identified application.

The petition is **granted**.

Petitioner failed to take appropriate action in a timely manner after the decision of December 10, 2004, by the Board of Patent Appeals and Interferences. Therefore, the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(c). As no claim was allowed, the-above-identified proceedings were terminated as of February 11, 2005. See MPEP 1214.06. A Notice of Abandonment was mailed April 6, 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.

Patricia Sheehan signed the instant petition. Sheehan was not an attorney or agent of record at the time the application became abandoned. Therefore, it appears Sheehan was not in a position to have firsthand or direct knowledge of the facts and circumstances of the delay. Nevertheless, the statement by Sheehan that the entire delay was unintentional is being treated as having been made as the result of a reasonable inquiry into the facts and circumstances of such delay.[1] 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 a portion of the delay 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.

Technology Center Art Unit 3764 will be informed of the instant decision and the application, including the RCE and amendment filed July 15, 2005, will be further examined in due course.

[1] See Changes to Patent Practice and Procedure, 62 *Fed. Reg.* at 53160 and 53178; 1203 *Off. Gaz. Pat. Office* at 88 and 103 (responses to comments 64 and 109) (applicant obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 CFR 1.137(b) to the Patent and Trademark Office).

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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755 Main Street,
P. O. Box 224
Monroe, CT 06468

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OFFICE OF PETITIONS

In re Application of :
Amit Mate, et al. :
Application No. 09/788,275 :
Filed: February 16, 2001 :
Attorney Docket No. 944-033.059 :

ON PETITION

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 **GRANTED**.

A "Notice of Allowance and Issue Fee Due" was mailed to applicant on July 12, 2004, which set a three-month shortened statutory period for reply. Since the issue fee was not timely paid, the application became abandoned on October 13, 2004.

The Office acknowledges receipt of the issue fee, which was submitted with the instant petition.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

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

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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PULSE-LINK, INC.
1969 KELLOGG AVENUE
CARLSBAD, CA 92008

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OFFICE OF PETITIONS

In re Application of :
Stephan W. Gehring :
Application No. 09/788,295 :
Filed: February 16, 2001 :
Attorney Docket No. FANT-P019 :

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed October 27, 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 Tradémark (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 months publication country on February 8, 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 months 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.

Any inquiries concerning this decision may be directed to Retta Williams at (571) 272-3229.

This application matter is being forwarded to Technology Center Art Unit 2135 for examination in due course.

Marianne Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100429

DATE : April 29, 2010

TO SPE OF : ART UNIT 1636

SUBJECT : Request for Certificate of Correction on Patent No.: 6,808,925

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:

/ Christopher S. F. Low /
Supervisory Patent Examiner, Art Unit 1636

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Paper No. 16

GLENN L WEBB
P.O. BOX 951
CONIFER CO 80433

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OFFICE OF PETITIONS

In re Application of :
Marty Williams, et al. :
Application No. 09/788,299 : ON PETITION
Filed: February 16, 2001 :
Attorney Docket No. Remora III :

This is a decision on the petition under 37 CFR 1.137(b), submitted by facsimile transmission on August 15, 2003, to revive the above-identified application.

The petition is GRANTED.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed October 21, 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 January 22, 2003.

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 3727 for processing the Request for Continued Examination under 37 CFR 1.114, submitted by facsimile on August 15, 2003.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6910609	2005-06-28	09/788,299	2001-02-16	10.18.02.USP

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	/Tracy M Heims 53010/	Date (YYYY-MM-DD)	2010-06-09
Name	Tracy M Heims	Registration Number	53010

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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In re Patent No. 6910609
Issue Date: June 28,2005
Application No. 09788299
Filed: February 16,2001
Attorney Docket No. 10.18.02.USP

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

This is a decision on the electronic petition, filed June 10,2010 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 10,2010 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : April 21, 2006

TO SPE OF : ART UNIT 2874

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/788301 Patent No.: 6,891,996

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: _____

SPE

2874
Art Unit

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OFFICE OF PETITIONS

NAVAL RESEARCH LABORATORY
ASSOCIATE COUNSEL (PATENTS)
CODE 1008.2
4555 OVERLOOK AVE SW
WASHINGTON DC 20375-5320

In re Application
Brown, et al.
Application No. 09/788,407
Filed: February 21, 2001
Atty Docket No. NC 80,124

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed November 11, 2004.[1] Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from zero (0) days to seventeen (17) days.

The application for patent term adjustment is **GRANTED** to the extent indicate 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 **nineteen (19) days.** A copy of the updated PAIR screen, showing the correct determination, is enclosed.

[1] This application for patent term adjustment was timely filed, as it was filed after the mailing of the Notice of Allowance and together with the payment of the issue fee.

On July 28, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is zero (0) days.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero (0) days based on an adjustment for PTO delay of one hundred twenty-seven (127) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by applicants' delays of sixty-two (62) days and twenty-eight (28) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b), and two hundred ten (210) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. 1.704(c)(7). The PTO delay of 127 days and applicants' delays of 62 and 28 days have been reviewed and found to be correct. The adjustment of 210 days is at issue.

The adjustment of 210 days has been found to be incorrect. A final Office action was mailed on July 16, 2003. Accordingly, pursuant to 37 C.F.R. § 1.704(b), applicants had until October 16, 2003 to file a response. Applicants filed an RCE on November 13, 2003, and were properly assessed delay of 28 days. However, the amendment submitted with the RCE was considered to be non-compliant, and a Notice of Non-Compliant Amendment was mailed on November 21, 2003. Applicants filed a proper amendment on December 1, 2003. Pursuant to 37 C.F.R. § 1.704(c)(7), applicant delay should have run for the period beginning on the day after the date the reply having an omission was filed (November 14, 2003) and ending on the date that the reply or other paper correcting the omission was filed (December 1, 2003). Accordingly, applicant delay with respect to this filing should have been assessed as eighteen (18) days, not two hundred ten (210) days as suggested by the PTO, and not twenty (20) days as suggested by applicants.

In view of the above, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **nineteen (19) days** (127 days of PTO delay, and 108 (62+28+18) days of applicant delay).

The $200 fee set forth in 37 C.F.R. § 1.18(e) has been charged to Deposit Account No. 50-0281, as authorized.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571) 272-3207.

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

Enclosure: Copy of Revised PAIR Screen

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Date : February 3, 2007

Patent No. : 7,146,374 B1
Inventor(s) : Molesky
Issued : December 5, 2006
Title : **AUTOMATED MULTI-LINE LABELING OF A TIME AXIS**
Docket No. : 19111.0013

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 37 CFR 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 Fee(s) Transmittal Form PTOL-85B. After payment of the issue fee, correction of assignment data submitted on the PTOL-85B can only be done by Certificate of Correction under 37 CFR 1.323, with a request under 37 CFR 3.81(b).

A request for a patent to be corrected to state the name of the assignee must:

A. state that the assignment was submitted for recordation as set forth in 37 CFR 3.11 before issuance of the patent;
B. include a request for a certificate of correction under 37 CFR 1.323 along with the fee set forth in 37 CFR 1.20(a); and
C. include the processing fee set forth in 37 CFR 1.17(i).

If the request is granted, Certificates of Correction Branch will be notified that a Certificate of Correction may be issued.

See Manual of Patent Examining Procedure, Section 1481.01 (Rev. 3) (Oct. 2005).

Applicant has not included items A and or C above, accordingly, the request for Certificate of Correction to add or change the assignee data is denied.

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: 571-273-8300
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.

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

BINGHAM MCCUTCHEN LLP
3000 K STREET, NW
BOX IP
WASHINGTON DC 20007

CBN/eme

DATE 8/24/07

APPLICATION NUMBER 09/788,471 (Pat. No. 6951010)

DOC CODE COCX

DOC DATE 6/1/06

DELIVER THE ATTACHED FILE/DOCUMENT TO THE TC SCANNING CENTER

CONTRACTOR: THE ATTACHED FILE/DOCUMENT MUST BE INDEXED AND SCANNED INTO IFW WITHIN **8** WORK HOURS; UPLOADING OF THE SCANNED IMAGES SHOULD OCCUR NO LATER THAN **16** WORK HOURS FOLLOWING RECEIPT OF THIS REQUEST

AFTER SCANNING, ORIGINAL DOCUMENTS SHOULD BE BOXED IN ACCORDANCE WITH INSTRUCTIONS

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6-13-06

TO SPE OF : ART UNIT 2192

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/788471 Patent No.: 6951016

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.

Check claims

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. 117

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

TUAN DAM
SUPERVISORY PATENT EXAMINER

2192

SPE Art Unit

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UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 5

E. Philip Koltos
Division of General Law, Office of the Solicitor
U.S. Department of the Interior
1849 C Street, NW
Washington, DC 20240

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SEP 13 2002

OFFICE OF PETITIONS

In re Application of :
Jerre Wayne Mohler :
Application No. 09/788,475 : ON PETITION
Filed: February 21, 2001 :
Attorney Docket No. FWS-3667 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 15, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice To File Corrected Application Papers mailed April 2, 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 June 3, 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

Sherry Brinkley
Petitions Examiner

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Division Newport
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Bldg 112T
Newport, RI 02841

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NOV 0 4 2004

OFFICE OF PETITIONS

In re Application of :
Jerre W. Mohler :
Application No. 09/788,475 : ON PETITION
Filed: February 21, 2001 :
Attorney Docket No. FWS-3667 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 12, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** 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(s) 1.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of November 3, 2003. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, a request for continued examination (RCE) under 37 CFR 1.114, or the filing of a continuing application. See MPEP 711.03(c)(III)(A)(2). Since the amendment submitted does

not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), a request for continued examination under 37 CFR 1.114, or the filing of a continuing application. A copy of the Examiner's Advisory Action is attached herewith.

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

By Mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
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Effective December 1, 2003, the Office of Petitions can no longer receive hand-carried correspondence, or facsimile transmissions of correspondence. The centralized location for hand-carried correspondence is the Customer Window located at:

U. S. Patent and Trademark Office
220 20th Street
Customer Window, Mail Stop Petitions
Crystal Plaza Two Lobby, Room 1B03
Arlington, VA 22202

The centralized facsimile number is **(703) 872-9306.**

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Examiner's Advisory Action

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OFFICE OF PETITIONS

In re Application of :
Jerre W. Mohler :
Application No. 09/788,475 : ON PETITION
Filed: February 21, 2001 :
Attorney Docket No. FWC-3667 :

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

The petition is **GRANTED**.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to Technology Center 2800.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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OFFICE OF PETITIONS

In re Application of	:	
Webb et al.	:	DECISION ON APPLICATION
Application No. 09/788,526	:	FOR
Filed: February 21, 2001	:	PATENT TERM ADJUSTMENT
Atty. Dkt. No. 07844-478001/P442	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(B)," filed on August 6, 2008. Applicants request that the initial determination of patent term adjustment be corrected by three (3) days from nine hundred twenty-one (921) days to nine hundred twenty-four (924) 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) at the time of mailing of the Notice of Allowance is NINE HUNDRED TWENTY-FOUR (924) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 6, 2008, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that that the patent term adjustment to date was 921 days. The instant application for patent term adjustment was timely filed.[1] The period of adjustment was 957 days of Office delay and 36 days of applicant delay.

Applicants assert that the calculation of 89 days of patent term adjustment for the mailing of a notice of allowance on May 6, 2008, four (4) months and 89 days after the filing of a request for continued examination on October 7, 2007, is incorrect because the request for continued examination was actually filed on October 4, 2007, not on October 7, 2007. Accordingly,

[1] PALM Records indicate that the issue fee was paid on August 6, 2008.

applicants assert that the patent term adjustment should be increased from 89 days to 92 days, as the notice of allowance mailed on May 6, 2008 was mailed four (4) months and 92 days after the filing of the request for continued examination filed on October 4, 2007.

Applicants' argument is well taken. Upon review of the record, the request for continued examination was in fact filed on October 4, 2007, not October 7, 2007. Accordingly, the period of adjustment under 37 CFR 1.703(a)(2) is the period from the date four (4) months after the request for continued examination was filed on October 4, 2007, until the date of mailing of the notice of allowance on May 6, 2008, or 92 days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is NINE HUNDRED TWENTY-FOUR (924) days (960 (957+3) days of PTO delay, reduced by 36 days of Applicant delay).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

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

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Encl: Revised PALM Calculation

Day : Wednesday

PALM INTRANET

Date: 1/7/2009
Time: 14:58:57

PTA Calculations for Application: 09/788526			
Application Filing Date:	02/21/2001	PTO Delay (PTO):	957
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	36
Post-Issue Petitions:	0	Total PTA (days):	924
PTO Delay Adjustment:	3		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
72	01/07/2009	ADJUSTMENT OF PTA CALCULATION BY PTO		89	
71	01/07/2009	ADJUSTMENT OF PTA CALCULATION BY PTO	92		
63	05/06/2008	MAIL NOTICE OF ALLOWANCE	89		52
62	05/05/2008	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
61	05/05/2008	ISSUE REVISION COMPLETED			
60	05/05/2008	DOCUMENT VERIFICATION			
58	05/05/2008	ALLOWED CASE RETURNED TO THE EXAMINER FOR CLERICAL PROCESSING			
57	12/26/2007	NOTICE OF ALLOWABILITY			
55	10/13/2007	DATE FORWARDED TO EXAMINER			
54	08/21/2007	RCE- AF PROCESSED			
53	10/13/2007	DATE FORWARDED TO EXAMINER			
52	10/07/2007	REQUEST FOR CONTINUED EXAMINATION (RCE)			
51	10/13/2007	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
50	10/04/2007	WORKFLOW - REQUEST FOR RCE - BEGIN			
49	09/07/2007	MAIL ADVISORY ACTION (PTOL - 303)			
48	09/06/2007	ADVISORY ACTION (PTOL-303)			
47	08/22/2007	DATE FORWARDED TO EXAMINER			
46	08/21/2007	AMENDMENT AFTER FINAL REJECTION			
45	08/10/2007	MAIL FINAL REJECTION (PTOL - 326)			
44	08/06/2007	FINAL REJECTION			
43	05/17/2007	DATE FORWARDED TO EXAMINER			
42	05/14/2007	RESPONSE AFTER NON-FINAL ACTION			
41	02/15/2007	MAIL NON-FINAL REJECTION			

40	02/13/2007	NON-FINAL REJECTION			
39	11/30/2006	DATE FORWARDED TO EXAMINER			
38	11/17/2006	RESPONSE AFTER NON-FINAL ACTION			
37	08/24/2006	MAIL NON-FINAL REJECTION			
36	08/21/2006	NON-FINAL REJECTION			
35	07/17/2006	REQUEST FOR REFUND			
34	06/16/2006	DATE FORWARDED TO EXAMINER			
33	06/12/2006	RESPONSE AFTER NON-FINAL ACTION			
32	03/20/2006	MAIL NON-FINAL REJECTION			
31	03/17/2006	NON-FINAL REJECTION			
30	03/03/2006	DATE FORWARDED TO EXAMINER			
29	02/21/2006	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
28	03/03/2006	DATE FORWARDED TO EXAMINER			
27	02/21/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)		3	20
26	03/03/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
25	02/21/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
24	02/01/2006	MAIL ADVISORY ACTION (PTOL - 303)			
23	01/30/2006	ADVISORY ACTION (PTOL-303)			
22	01/18/2006	DATE FORWARDED TO EXAMINER			
21	01/06/2006	AMENDMENT AFTER FINAL REJECTION			
20	11/18/2005	MAIL FINAL REJECTION (PTOL - 326)			
19	11/14/2005	FINAL REJECTION			
18	08/31/2005	DATE FORWARDED TO EXAMINER			
17	08/08/2005	RESPONSE AFTER NON-FINAL ACTION		2	15
16	08/08/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
15	05/06/2005	MAIL NON-FINAL REJECTION	66		11
14	05/03/2005	NON-FINAL REJECTION			
13	02/25/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
12	02/25/2005	DATE FORWARDED TO EXAMINER			
11	11/01/2004	RESPONSE AFTER NON-FINAL ACTION		31	9
10	11/01/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
9	07/01/2004	MAIL NON-FINAL REJECTION	802		-1
8	06/28/2004	NON-FINAL REJECTION			

7	04/05/2004	CASE DOCKETED TO EXAMINER IN GAU			
6	07/19/2001	CASE DOCKETED TO EXAMINER IN GAU			
5	06/21/2001	APPLICATION DISPATCHED FROM OIPE			
4	03/22/2001	APPLICATION IS NOW COMPLETE			
3	03/21/2001	CORRESPONDENCE ADDRESS CHANGE			
2	03/12/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	02/21/2001	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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OFFICE OF PETITIONS

In re Patent No. 7,502,825 :
Issued: March 10, 2009 :
Application No. 09/788,526 : ON APPLICATION FOR
Filed: February 21, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. 07844-478001/P442 :

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d), filed on May 4, 2009. Patentee requests that the determination of patent term adjustment be corrected from eight hundred ninety-eight (898) days to one thousand three hundred sixty-six (1,366) days.

The request for reconsideration of patent term adjustment is **DISMISSED** with respect to making any change in the patent term adjustment determination under 35 U.S.C. § 154(b) of 898 days.

BACKGROUND

On March 10, 2009, the application matured into U.S. Patent No. 7,502,825, with a revised patent term adjustment of 898 days. The Office determined that the 731 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b) overlaps with the 868 days of Office delay pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1) and (a)(2), accorded prior to the filing of the request for continued examination. As such, no additional days of patent term adjustment were entered at issuance under the three-year pendency provision. Given the additional 186 days of Office delay pursuant to 37 CFR 1.702(a)(2) and (4) accorded subsequent to the filing of the RCE, and the applicant delay of 156 days, the patent issued with a revised patent term adjustment of 898 (868 + 186 - 156) days.

On May 4, 2009, patentee timely submitted this request for reconsideration of the patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 1,366 days under the courts interpretation of the overlap provision as set forth in Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008). Patentee asserts that pursuant to Wyeth, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day."

Preliminarily, under the Wyeth analysis, the period of three year delay beginning on February 21, 2004 and ending on February 21, 2006, the date that an RCE was first filed, overlaps with the period of examination delay under 37 CFR 1.702(a)(1) and (a)(2) by 131 and 66 days, respectively. Patentee asserts that ~~the~~ Accordingly, the non-overlapping period of three year delay asserted by patentee is 534 (731 - (131 + 66) overlap) days, not 468 days as asserted by patentee. Patentee's argument will be articulated accordingly.

Accordingly, patentee maintains that the total non-overlapping PTO delay under § 154(b)(1)(A) & (B) is 1492 (898 + 731 - 197 overlap) days as these periods do not occur on the same day. Further, given the applicant delay of 156 days, patentee asserts entitlement to 1336 (1492 - 156) days of patent term adjustment.

OPINION

Patentee's interpretation of the period of overlap has been considered, but found inconsistent with the Office's interpretation of the overlap provision, 35 U.S.C. 154(b)(2)(A). 35 U.S.C. 154(b)(2)(A) limits the adjustment of patent term, as follows:

> to the extent that the periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

As explained in *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004), the Office

interprets 35 U.S.C. 154(b)(2)(A) as permitting either patent term adjustment under 35 U.S.C. 154(b)(1)(A)(i)-(iv), or patent term adjustment under 35 U.S.C. 154(b)(1)(B), but not as permitting patent term adjustment under both 35 U.S.C. 154(b)(1)(A)(i)-(iv) and 154(b)(1)(B). Accordingly, the Office implements the overlap provision as follows:

> If an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). 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 *Changes to Implement Patent Term Adjustment Under Twenty Year Term; Final Rule*, 65 Fed. Reg. 56366 (Sept. 18, 2000). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004), 1282 Off. Gaz. Pat. Office 100 (May 18, 2004). See also *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, 69 Fed. Reg. 34283 (June 21, 2004).

Further, as stated in the *Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. 154(b)(2)(A)*, the Office has consistently taken the position that if an application is entitled to an adjustment under the three-year pendency provision of 35 U.S.C. 154(b)(1)(B), the entire period during which the application was pending before the Office (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 relevant period 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).

This interpretation is consistent with the statute. Taken together the statute and rule provide that to the extent that periods of delay attributable to grounds specified in 35 U.S.C. 154(b)(1) and in corresponding §1.702 overlap, the period of adjustment granted shall not exceed the actual number of days the issuance of the patent was delayed.

In this instance, the relevant period 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) is the period during which the application was pending before the Office beginning on the application filing date under 35 U.S.C. 111(a), February 21, 2001, and ending on the date of filing of a request for continued examination (RCE), February 21, 2006 (not including any other periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)). The relevant period ends with the filing of the RCE as the three-year time frame specified in 35 U.S.C. 154(b)(1)(B) does not include the period subsequent to the filing of the RCE. 35 U.S.C. 154(b)(1)(B)(i).

Pursuant to 35 U.S.C. 154(b)(1)(A) and 37 CFR 1.702(a)(1) and (a)(2), 868 (802 + 66) days of patent term adjustment were accorded during the pendency of the application for Office delay prior to the filing of the request for continued examination. Pursuant to 35 U.S.C. 154(b)(1)(B) and 37 CFR 1.702(b), 731 days of patent term adjustment accrued for Office issuance of the patent more than 3 years after the filing date of the application.

The 731 days of patent term adjustment under 37 CFR 1.702(b) overlap with the 868 days of patent term adjustment under 37 CFR 1.702(a)(1) and (a)(2). Entry of both the 731 days and the 868 days is neither permitted nor warranted. 186 days of patent term adjustment were entered after the filing of the RCE). 1054 (868 + 186) days is the actual number of days issuance of the patent was delayed. Considering the applicant delay of 156 days, the patent term adjustment at issuance is 898 (1054 - 156) days.

Accordingly, at issuance, the Office properly entered no additional days of patent term adjustment for the Office taking in excess of three years to issue the patent.

CONCLUSION

In view thereof, the Office affirms that the revised determination of patent term adjustment at the time of the issuance of the patent is 898 days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

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

Anthony Knight
Supervisor
Office of Petitions

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FISH & RICHARDSON P.C.
P.O. Box 1022
MINNEAPOLIS, MN 55440-1022

Mail Date: 04/20/2010

Applicant	: Brandyn Webb	: DECISION ON REQUEST FOR
Patent Number	: 7502825	: RECALCULATION of PATENT
Issue Date	: 03/10/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/788,526	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 02/21/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1431** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

Prior to the issuance of the certificate of correction, the USPTO will afford patentee an opportunity to be heard and request reconsideration. Accordingly, patentee has **one month or thirty (30) days**, whichever is longer, to file a request for reconsideration of this patent term adjustment calculation. See 35 U.S.C. 154(b)(3)(B)(ii) and 37 CFR 1.322(a)(4). No extensions of time will be granted under 37 CFR 1.136.

Patentee should use document code PET.OP if electronically filing a request for reconsideration of this patent term adjustment calculation. The patentee must also include the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e). If patentee does not file a timely request for reconsideration of this patent term adjustment calculation including the information required by 37 CFR 1.705(b)(2) and the fee required by 37 CFR 1.18(e), the USPTO will issue a certificate of correction reflecting the PTA determination noted above.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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330 University Avenue
Toronto ON M5G 1R7 CA CANADA

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MAY 13 2005

OFFICE OF PETITIONS

In re Application of	:	
Gerald Cowley, et. al.	:	
Application No. 09/788,585	:	ON PETITION
Filed: February 21, 2001	:	
Attorney Docket No. 7248-51 MIS	:	

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on April 7, 2005, to revive the above-identified application.

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 October 25, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned January 25, 2005.

In response, petitioner submitted with the instant petition an authorization to charge, to the listed deposit account, $1,500 for the petition to revive fee, $1,400 for the issue fee, $300 for the publication fee and $3 for one advance order soft copy. As authorized, these fees have been charged to petitioner's deposit account.

The petition is **GRANTED**.

The application file is being referred to the Office of Publications for further processing into a patent.

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

Andrea Smith
Petitions Examiner
Office of Petitions
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. 6

Uniao Federal
Rua Santa Isabel
160-7 Andar
V. Buarque - CEP 01221-010
Sao Paulo, BR BRAZIL

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AUG 16 2006

OFFICE OF PETITIONS

In re Application of :
Fabio Gozzi :
Application No. 09/788,614 :
Filed: February 21, 2001 :
Title of Invention: FORMULATION :
OF A LIQUID COMPOSITION TO FORM :
AN ELECTRICAL INSULATOR, AN :
ANTIOXIDANT OR A DEGREASER :

This is a decision in response to the petition under 37 CFR 1.137(b), filed March 16, 2006, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Notice to File Corrected Application Papers (hereinafter "Notice"), mailed April 6, 2001, which set a two (2) month period for reply. No response having been received, the application became abandoned on June 7, 2001. A Notice of Abandonment was mailed on May 8, 2003.

With the instant petition, Petitioner has filed a reply to the Accordingly, the petition is granted.

The address on the petition is different from the address of record. If Petitioner desires to receive further correspondence with respect to this application, a change of correspondence address must be filed. A courtesy copy of this Decision is being forwarded to Petitioner at the address appearing on the petition; however, all future correspondence will be sent to address of record until instructions to the contrary are received.

This application is being forwarded to the Office of Initial Patent Examination for continued processing 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

CC: TRASKBRITT, P.C.
PO BOX 2550
SALT LAKE CITY, UT 84110

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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FISH & RICHARDSON P.C.
P.O. BOX 1022
MINNEAPOLIS, MN 55440-1022

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SEP 0 6 2005

OFFICE OF PETITIONS

In re Application of :
Hartvig W.J. Ekner et al :
Application No. 09/788,670 : DECISION GRANTING PETITION
Filed: February 21, 2001 : UNDER 37 CFR 1.137(f)
Attorney Docket No. 12135-006001/0113.00US :

This is a decision on the petition under 37 CFR 1.137(b), filed July 27, 2005, to accept an unintentionally delayed notification to 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 filed within TWO MONTHS from the mail date of this decision. Extensions of time are available pursuant to the provisions of 37 CFR 1.136(a).

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 petition fails to comply with item (1) above. More specifically, while notification has been given of the foreign filing, the petition fails to state the date of such foreign filing. Accordingly, the date of foreign filing must be supplied in order to grant the revival of the instant application.

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: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3220.

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

cc: FISH & RICHARDSON P.C.
1425 K STREET, N.W., 11TH FLOOR
WASHINGTON, DC 20005-3500

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
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

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MAY 17 2006

OFFICE OF PETITIONS

In re Application of :
Hartvig W.J. Ekner et al :
Application No. 09/788,670 : DECISION GRANTING PETITION
Filed: February 21, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. 1778.2110000 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed December 6, 2005, 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 February 15, 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 August 24, 2006 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (571) 272-3220.

This application is being referred to Technology Center Art Unit 2193.

Wan Laymon

Wan Laymon
Petitions Examiner
Office of Petitions

ATTACHMENT: Notice Regarding Rescission of Nonpublication Request

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

R. WHITNEY WINSTON
FISH & RICHARDSON P.C.
601 THIRTEENTH STREET, N.W.
WASHINGTON, D.C. 20005

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OCT 0 4 2001

OFFICE OF PETITIONS

In re Application of :
Kissell et al. :
Application No. 09/788,683 : ON PETITION
Filed: February 21, 2001 :
Attorney Docket No. 12135-004001/0116.00US :

This is a decision on the petition filed July 20, 2001 to accord a filing date of February 21, 2001, which is being treated as a petition under 37 CFR 1.181 to correct the file of the above-identified application.

The application was filed on February 21, 2001. However, on May 23, 2001, the Office of Initial Patent Examination mailed a "Notice" stating that the drawings of Figures 10A-13B described in the specification appeared to have been omitted.

In response, the present petition was filed. Petitioners argue that the application papers filed on February 21, 2001, included 13 sheets of drawings containing Figures 1-13B.

The 13 sheets of drawings, including Figures 1-13B filed on February 21, 2001, have been located in the USPTO and placed in the file of the present application. Accordingly, it is now apparent that Figures 10A-13 were not omitted on February 21, 2001.
The petition is granted.

Petitioners are advised that the Office has not received an oath or declaration. To avoid abandonment, an oath or declaration must be filed no later than December 24, 2001 with appropriate extension fees.[1]

The application is being forwarded to the Office of Initial Patent Examination for reprocessing with a filing date of February 21, 2001, using the thirteen (13) sheets of drawings containing Figures 1-13B filed on February 21, 2001, and for correction of Office record to indicate that thirteen (13) sheets of drawings were filed on that date.

[1] December 23, 2001 is a Sunday.

Telephone inquiries concerning this matter may be directed to Petitions Attorney E. Shirene Willis at (703)308-6712.

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
P.O. Box 1450
Alexandria, VA 22313-1450
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OCT 1 9 2005

OFFICE OF PETITIONS

STERNE, KESSLER, GOLDSTEIN & FOX
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

In re Application of	:	
Morten Stribaek et al	:	
Application No. 09/788,685	:	ON PETITION
Filed: February 21, 2001	:	
Attorney Docket No. 12135-008001/0111.00US	:	

This is a decision on the petition, filed October 18, 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 September 12, 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 2193 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).

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 19 2006

OFFICE OF PETITIONS

STERNE, KESSLER, GOLDSTEIN & FOX
1100 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005-3934

In re Application of	:	
Morten Stribaek et al	:	
Application No. 09/788,685	:	ON PETITION
Filed: February 21, 2001	:	
Attorney Docket No. 1778.2130000	:	

This is a decision on the petition, filed June 14, 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 March 29, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2193 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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

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

March 19, 2003

Moishe Garfinkle
P. O. Box 15855
Philadelphia, PA 19103

In re application of:
Moishe Garfinkle DECISION ON PETITION
Serial No.: 09/788,698
Filed: February 20, 2001
For: METHOD OF DIRECTLY MEASURING THE PERMITTIVITY OF GEOTEXTILE AND BIOTEXTILE FAB

This is a decision on the petition received on January 31, 2002, to withdraw the holding of abandonment in the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. 1.113 in timely manner to the Notice to File Missing Parts of Application mailed April 5, 2001. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned May 6, 2001. The notice of abandonment was mailed January 3, 2003.

On January 31, 2002, the office received a communication from applicant of record. Enclosed was an acknowledgment that the applicant never received the Notice to File Missing Parts mailed April 5, 2001.

The evidence submitted is sufficient to establish that the applicant never received the Notice to File Missing Parts mailed April 5, 2001

On page 5 of the application the claims were intertwined with the specification. The claims must start on a separate page by itself.

The petition is hereby GRANTED.

The office has a policy to wait almost a year from the date that the notice was mailed before abandonment. The time helps with documents that may be lost in the office.

A New Notice to File Missing Parts is enclosed with this Decision setting forth a new response period of two months from the date of the notice.

The office regrets any inconvenience this may have caused the client.

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

Doshie Day

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

OIPE
MAY 11 2001
PATENT & TRADEMARK OFFICE
JC900

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
09/788,747	02/20/2001	James E. Roddy	81619NAB

CONFIRMATION NO. 1317

FORMALITIES LETTER

OC000000006007118

Milton S. Sales
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EASTMAN KODAK CO.
MAY - 3 2001
PATENT LEGAL STAFF

Date Mailed: 04/25/2001

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:

- Substitute drawings in compliance with 37 CFR 1.84 because:
  - drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch);

A copy of this notice <u>MUST</u> 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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 7

JUDY C. JARECKI-BLACK, PH.D., J.D.
PATENT COUNSEL FOR AVIGENICS, INC.
425 RIVER ROAD
ATHENS, GA 30603

COPY MAILED

AUG 8 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
Robert D. Ivarie, Ph.D. et al :
Application No. 09/788,773 :
Filed: February 20, 2001 :
Attorney Docket No. AVI006 :

DECISION GRANTING PETITION

This is a decision on the paper styled "Petition To Correct Filing Receipt" filed June 21, 2001, which is properly treated as a petition under 37 CFR 1.10(d), requesting that the above-identified application be accorded a filing date of February 20, 2001, rather than the presently accorded filing date of February 21, 2001.

Applicants request the earlier filing date on the basis that the application was purportedly deposited with the U.S. Postal Service (USPS) as Express Mail on February 20, 2001. The petition is accompanied by a copy of the USPS Track/Confirm system information showing that the package bearing Express Mail label No. EF254699042US was accepted on February 20, 2001. The same Express Mail receipt number was referred to in the copy of the original Certificate of Express Mailing 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 February 20, 2001.

Receipt is acknowledged of the Sequence Listing, preliminary amendment, and Information Disclosure filed June 21, 2001 in response to the Notice mailed May 3, 2001.

The application is being returned to Initial Patent Examination Division for correction of the filing date to February 20, 2001.

Telephone inquires 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
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MAR 29 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

BARNES & THORNBURG
1313 Merchants Bank Building
11 South Meridian Street
Indianapolis IN 46204

In re Application of :
Katsunori Utsumi :
Application No. 09/788,777 :
Filed: February 20, 2001 :
For: PERSONAL INFORMATION VERIFICATION :
METHOD IN ELECTRONIC-COMMERCE SYSTEM

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in response to the Petition to Withdraw the Holding of Abandonment filed in the United States Patent and Trademark Office on February 24, 2004.

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

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____.

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

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

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

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

☒ Originally sent response filed February 16, 2004 has been found and matched with the application.

This application is being forwarded to the Supervisory Legal Instruments Examiner for entry of the response and then to the examiner for prompt action.

SNM/mjz: 3/26/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 8

KRIS T. FREDRICK
HONEYWELL INTERNATIONAL INC.
101 COLUMBIA ROAD
P O BOX 2245
MORRISTOWN, NJ 07962-2245

COPY MAILED

AUG 2 4 2001

OFFICE OF PETITIONS

In re Application of :
James M. O'Connor :
Application No. 09/788,781 : DECISION GRANTING PETITION
Filed: February 20, 2001 :
Attorney Docket No. 450-99-005 :

This is a decision on the petition filed June 13, 2001, requesting that the above-identified application be accorded a filing date of February 20, 2001.

This is also a decision on the petition requesting waiver of the two-month time period for responding to the Notice of Incomplete Nonprovisional Application of April 6, 2001.

On April 6, 2001, the Office of Initial Patent Examination mailed a Notice of Incomplete Nonprovisional Application (Notice), stating that the application had not been accorded a filing date as the application was filed without drawings and that the filing date would be the date of receipt of the omitted drawings.

In response, on June 13, 2001, applicant filed the present petitions with the requisite petition fees, six (6) sheets of drawings, and a declaration. Applicant submitted a copy of his postcard receipt acknowledging receipt of six (6) sheets of formal drawings in the United States Patent and Trademark Office (Office) on February 20, 2001. Applicant requested that the two-month time period for responding to the Notice be waived. Applicant further requested that the application, including the six (6) sheets of drawings, be accorded a filing date of February 20, 2001, and the petition fee be refunded.

Upon review of the record, no sheets of drawings deposited on February 20, 2001, have been located among the application papers. However, the evidence is convincing that the application papers deposited on February 20, 2001, included six (6) sheets of formal drawings, which were subsequently misplaced in the Office. Therefore, the application, including the six (6) sheets of drawings, was complete on filing and entitled to a filing date of February 20, 2001.

Accordingly, the petition to accord the application a filing date of February 20, 2001, is granted.

The Notice mailed April 6, 2001, was sent in error and is hereby vacated.

In view of the above decision granting applicant's petition to accord a filing date of February 20, 2001, the petition to waive the two-month period to respond to the Notice is dismissed as moot.

The petition fees totaling $260.00 will be credited to counsel's deposit account no. 13-2490.

The application file is being returned to the Office of Initial Patent Examination for further processing with a filing date of February 20, 2001, using the copy of the six (6) sheets of drawings supplied on June 13, 2001.

Any inquiries related to this decision should be directed to Petitions Attorney Christina T. Tartera at (703) 306-5589.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

CTT

UNITED STATES PATENT AND TRADEMARK OFFICE

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JJGJr: 06-03

Paper No: 8

CUMMINGS & LOCKWOOD
700 STATE STREET
P.O. BOX 1960
NEW HAVEN CT 06509-1960

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JUL 0 9 2003

OFFICE OF PETITIONS

In re Application of:
Hayes
Filed: 20 February, 2001
Application No. 09/788,833
Docket No. 432580.0008

ON PETITION

This is a decision on the petition filed herein on 11 April (supplemented on 2 July), 2003, under 37 C.F.R. §1.137(b)[1] to revive the above-identified application as having been abandoned due to unintentional delay.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

NOTE: As a matter of courtesy, it is noted that Petitioner fails to include in his petition (and the Preliminary Amendment filed as a reply in part to the Notice to File Missing Parts) his telephone number. The omission, while not a matter addressing required substance or form, does make it problematic to contact Petitioner with regard to this matter--particularly at times when contact databases may be temporarily unavailable.

[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.)

BACKGROUND

The record indicates that:

- Petitioner failed to file a timely and proper reply to the Notice of Missing Part mailed on 4 April, 2001, with a reply due (absent an extension of time) on or before Friday, 5 July, 2001;
- the application went abandoned at midnight 5 July, 2001;
- however, no Notice of Abandonment was mailed herein;
- a Petition to Make Special was filed on 25 March, 2002;
- with the instant petition to revive, Petitioner submitted a reply to the Notice of Missing Parts (signed oath or declaration and sought to satisfy the indication of informalities included in the Notice of Missing Parts), paid the surcharge for late submission, and made the statement of unintentional delay;
- Petitioner supplemented the statement of unintentional delay on 2 July, 2003

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

---

[2] 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[3] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5] And the Petitioner must be diligent in attending to the matter.[6]

(Moreover, it long has been the position of the Office that the use of the filing periods (such as in 37 C.F.R. §1.137(b)) as an "extension of time" is an "abuse" of the procedures for reviving abandoned applications, and is contrary to the meaning and intent of the regulation.[7] The Office has indicated that petitions to revive must be filed promptly after the applicant becomes aware of the abandonment.[8] Such does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[9]))

Petitioner has filed the petition (with fee), made the statement of unintentional delay and submitted the required replies (Issue Fee and publication fee).

Petitioner has satisfied the "fee, "statement," and "reply" requirements under the regulations.

The record (including the petition filed on 11 April, 2003, and supplemented on 30 June, 2003) does not necessitate a finding that the delay between midnight 5 July, 2001, and 11 April, 2003, was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on Petitioner's (Basam E. Nabulsi, Reg. No. 31,645) duty of candor and good faith when accepting Petitioner's

---

[4] See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[5] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[6] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[7] See: In re Application of S, 8 USPQ2d 1630, 1632 (Comm'r Pats. 1988). Where there is a question whether the delay was unintentional, the petitioner must meet a burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 C.F.R. §1.137(b). See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[8] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[9] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

representation[10] that the delay in filing the response was unintentional.[11]

CONCLUSION

Accordingly, the petition to revive under 37 C.F.R. §1.137(b) hereby is **granted**.

This application is being forwarded to OIPE for completion of processing there before being forward immediately to Technology Center 1700 to have addressed the Petition to Make Special filed on 25 March, 2002.

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

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

---

[10] See: Petition filed 25 August, 1997.

[11] See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the 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

MCCARTER & ENGLISH LLP
FOUR STAMFORD PLAZA
107 ELM STREET
STAMFORD, CT 06103

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MAR 0 3 2006

OFFICE OF PETITIONS

In re Patent No. 6,793,844	:	
Issued: September 21, 2004	:	
Application No. 09/788,833	:	ON PETITION
Filed: February 20, 2001	:	
Attorney Docket No. 97661.00008	:	

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 undersigned at (571) 272-3282.

Liana Chase
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE

October 14, 2003

Brian M. Berliner
O'Melveny & Myers
400 South Hope Street
Los Angeles, CA 90071-2899

In re application of:
KIM et al DECISION ON PETITION
Serial No.: 09/788,867
Filed: February 20, 2001
For: FAULT-TOLERANT ASSEMBLY OF PRINTING CIRCUIT BOARD

This is a decision on the petition received on February 7, 2003, to withdraw the holding of abandonment in the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. 1.113 in timely manner to the Notice to File Corrected Application Papers mailed March 23, 2001. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned May 24, 2001. The Notice of Abandonment was mailed on January 3, 2003.

On February 7, 2003, the office received a communication from the attorney of record. Enclosed was an acknowledgement that the attorney responded to the Notice to File Corrected Application Papers on April 6, 2001.

The evidence submitted is sufficient to establish that the petitioners responded to the Notice to File Corrected Application Papers on April 6, 2001.

The petition is hereby Granted.

The application has been completed for release to Technology Center 2841.

The office regrets any inconvenience this may have caused the client.

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

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAR 31 2004

Therox, Inc.
2400 Michelson Drive
Irvine, CA 92612

Paper No. 6

In re Application of	:	DECISION ON PETITION
Adib G. Daoud et al	:	TO WITHDRAW
Serial No. : 09/788,875	:	HOLDING OF
Filed : February 20, 2001	:	ABANDONMENT
For : System and Method for High Pressure Delivery of Gas-Supersaturated Fluids	:	

This is a decision on petitioner's request filed March 9, 2004, to review the holding of abandonment mailed February 23, 2004 for failure to respond to the Office action mailed July 22, 2003. There is no fee required for this petition.

In support of the request, petitioner has submitted a copy of a response to a restriction requirement, the response bearing a certificate of facsimile transmission dated August 20, 2003. Petitioner has also included a copy of a facsimile transmission report confirming transmission of the papers in question on August 20, 2003, and a statement from the person who facsimiled the response attesting to the submission of the response.

In view of the above, the Notice of Abandonment mailed February 23, 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 filed August 20, 2003.

Summary: Holding of Abandonment Withdrawn.

John E. Kittle, Director
Groups 3730 and 3760
Phone: (703) 308-0873

ak/3/18/04

NOTICE RE: CERTIFICATES OF CORRECTION

DATE 08/23/02 Paper No.: 8

TO : Supervisor, Art Unit 3700

SUBJECT : Certificate of Correction Request in Patent No.: 6375,659

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

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

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

THANK YOU FOR YOUR ASSISTANCE!

Note your decision, regarding the changes requested in the Request for Certificate of Correctic placing a check mark (+) in the box that reflects your decision, which corresponds to the question che above.

☒ **YES** ☐ **NO** ☐ **Comments below**

☐ **Comments:**

Supervisor 3732 Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 14, 2005

TO SPE OF : ART UNIT 1632

SUBJECT : Request for Certificate of Correction on Patent No.: 6,831,169

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.

Magdalene Talley

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9309 ext. 116

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

_____

_____

_____

_____

_____

Peter Paras — 1632

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

CARL J. ABRAHAM
3 BAKER HILL ROAD
GREAT NECK NY 11023

COPY MAILED

JUL 17 2008

In re Application of :
Effiong IBOK, et al :
Application No. 09/789,058 : ON PETITION
Filed: February 19, 2001 :
Attorney Docket No. :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 30, 2008, to revive the above-identified application.

The petition is **DISMISSED**.

The application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment mailed, October 5, 2006, which set a reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on November 6, 2006.

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(s) 3.

The statement of delay is not acceptable. In this regard, petitioner's attention is directed to 37 CFR 1.33(b), which states.

> (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);

(2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;

(3) An assignee as provided for under §3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

An unsigned amendment (or other paper) or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment (or other paper) is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

Therefore, as the petition is not signed by all the inventors and the record herein fails to disclose that petitioner herein (Effiong Ibok) was ever given a power of attorney to act on behalf of inventor Effiong Utuk, or that he is an assignee of the entire interest and has complied with the provisions of 37 CFR 3.73(b), the petition is considered to not contain a proper statement 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.

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

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

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

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

Telephone inquiries concerning this decision should be directed to 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
Alexandria, VA 22313-1450
www.uspto.gov

MEDSCAN TECHNOLOGIES INC.
1005 E. HOMESTEAD RD.
SUNNYVALE, CA 94087

COPY MAILED
OCT 27 2008

In re Application of :
Effiong IBOK, et al :
Application No. 09/789,058 : ON PETITION
Filed: February 19, 2001 :
Attorney Docket No. :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 30, 2008, to revive the above-identified application.

The petition is **DISMISSED**.

The application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment mailed, October 5, 2006, which set a reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on November 6, 2006.

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(s) 3.

The statement of delay is not acceptable. In this regard, petitioner's attention is directed to 37 CFR 1.33(b), which states.

> (b) Amendments and other papers. Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by:

(1) A registered patent attorney or patent agent of record appointed in compliance with § 1.32(b);

(2) A registered patent attorney or patent agent not of record who acts in a representative capacity under the provisions of § 1.34;

(3) An assignee as provided for under §3.71(b) of this chapter; or

(4) All of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

An unsigned amendment (or other paper) or one not properly signed by a person having authority to prosecute the application is not entered. This applies, for instance, where the amendment (or other paper) is signed by only one of two applicants and the one signing has not been given a power of attorney by the other applicant.

Therefore, as the petition is not signed by all the inventors and the record herein fails to disclose that petitioner herein (Effiong Ibok) was ever given a power of attorney to act on behalf of inventor Effiong Utuk, or that he is an assignee of the entire interest and has complied with the provisions of 37 CFR 3.73(b), the petition is considered to not contain a proper statement 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.

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

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

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

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

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

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
Alexandria, VA 22313-1450
www.uspto.gov

MEDSCAN TECHNOLOGIES INC.
1005 E. HOMESTEAD RD.
SUNNYVALE, CA 94087

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JAN 2 1 2009

In re Application of	:	
Effiong IBOK, et al	:	
Application No. 09/789,058	:	DECISION ON PETITION
Filed: February 19, 2001	:	
Attorney Docket No.	:	

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed November 25, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the Notice of Non-Compliant Amendment mailed, October 5, 2006, which set a reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on November 6, 2006.

The renewed petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) a reply to the Notice of Non- Compliant Amendment, (2) the petition fee of $770; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 3626 for appropriate action by the Examiner in the normal course of business on the reply received November 25, 2008.

Thurman Page
Petitions Examiner
Office of Petitions

cc : EFFIONG UTUK
P.O. BOX 143761
AUSTIN, TX 78714

UNITED STATES PATENT AND TRADEMARK OFFICE

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APR - 5 2004

#18

E.I. DUPONT DE NEMOURS AND COMPANY
LEGAL PATENT RECORDS CENTER
BARLEY MILL PLAZA 25/1182
4417 LANCASTER PIKE
WILMINTON, DE 19805

In re Application of
Kelley Norton et al.
Serial No.: 09/789,161
Filing Date: February 2, 2001
Attorney Docket No. BC1037 US NA

: WITHDRAWAL OF ABANDONMENT

This letter is in response to the Petition under 37 CFR ¶ 1.181, filed May 19, 2003, to withdraw the notice of abandonment.

A review of the file history shows that a rejection was mailed on August 16, 2002 setting a 3 month shortened statutory period of time. The Petitioner has provided the Office with a copy of the returned postcard receipt dated "February 3, 2003" from the US Patent and Trademark Office action along with a copy of an extension of time and a complete timely filed Amendment and response as required under 37 CFR ¶ 1.181. Based on the evidence provided by the Petitioner on "May 19, 2003" it is clear that the Office abandoned this application erroneously. The error is regretted as well as the delay in responding to applicants' Petition.

DECISION

The Petition is **GRANTED** in view of the response filed May 19, 2003.

The application will be forwarded to the Examiner for consideration of the Amendment.

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, PO Box 1450, Alexandria, VA 22313-1450 or by telephone at (571) 272-0512 or by facsimile transmission at (703) 872-9306.

J Burke for

Bruce Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

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OFFICE OF PETITIONS
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OBLON, SPIVAK, MCCLELLAND,
MAIER & NEUSTADT, PC
FOURTH FLOOR
1755 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

In re Application of
Brault
Application No. 09/789,162
Filed: February 21, 2001
Attorney Docket No. 203395US2

DECISION GRANTING
PETITION

This is a decision on the petition, filed on May 17, 2001, requesting that the above-identified application be accorded a filing date of February 21, 2001.

The petition is **GRANTED**.

The application was filed on February 21, 2001. However, on April 4, 2001, the Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application ("Notice"), stating that a filing date had not been accorded because the filed application did not include at least one claim as prescribed by 35 U.S.C. 112. The Notice further advises that an abstract is missing and that the margins in the submitted drawings do not comply with 37 CFR 1.84.

In response, the present petition was filed wherein Petitioner contends that 8 claims on pages 13-14 and an abstract on page 15 were included in the February 21, 2001 application. In support, the petition is accompanied by a copy of Applicant's postcard receipt which acknowledges receipt in the Office on February 21, 2001 of, *inter alia*, 17 pages of Specification and 8 Claims. The petition also encloses a certified "copy" of the application, allegedly filed on February 21, 2001, which contains 8 Claims and an Abstract.

In view of the above, the petition is thus granted.

The $130.00 petition fee paid on May 17, 2001 is not required and will be refunded.

In addition, the Office acknowledges receipt on May 17, 2001 of 3 sheets of formal drawings, containing Figures 1, 2a and 2b, intended for substituting the 1 sheet of drawings filed on February 21, 2001. However, there are only 2 drawings in the original application: "Fig. 1" and "Fig. 2." The original Figure 2 appears to have been transformed into two halves: "Fig. 2a" (the left half) and "Fig. 2b" (the right half). Furthermore, pages 5, 15-16 of the Specification refer to a Figure 2 without any references to Figures 2a or 2b. The newly-submitted 3 sheets of drawings have thus been placed in the file for review in due course by the primary examiner. Entry of these new sheets of drawings may be approved, if no new matter is included therein.[1]

---

[1] See MPEP 608.02(h).

The application is being returned to the Initial Patent Examination Division for further processing with a filing date of February 21, 2001, and using pages 13-17 supplied with the petition.

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.

Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE

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AUG 2 4 2005

Director's Office
Office of Patent Publication

DAVID H. JAFFER
PILLSBURY WINTHROP LLP
2475 HANOVER STREET
PALTO ALTO, CA 94304-1114

In re Application of
YIN, EDWARD M., et al.
Application No. 09/789,180
Filed: February 19, 2001
Attorney Docket No. 58884-027-5133
(ID0015US)

DECISION ON PETITION

This is a decision on the Petition To Request Withdrawal Of Holding Of Abandonment Based On Failure To Receive Office Action And Request To Reinstate Application, received in the United States Patent and Trademark Office (USPTO) on February 4, 2004.

The petition is **GRANTED**.

The Notice of Abandonment indicates that the application was held abandoned for failure to timely corrected drawings. However, the correct reason for the abandonment was for the applicant's failure to file a proper reply to the Office letter — Notice Regarding Drawings — mailed on July 21, 2003, which set a two-month time period to reply (not extendable).

Petitioner states that the Applicant has not received the Notice Regarding Drawings.

In absence of any irregularity in the mailing of the Notice, 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 practitioner did not receive the Office action, 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 must be attached to and referenced in practitioner's statement. See "Withdrawing the Holding of Abandonment When Office Action Are Not Received" MPEP 711.03(c) II

Petitioner has met the above-stated conditions. Accordingly, the holding of abandonment is hereby withdrawn and the patent application restored to pending status.

The Notice Regarding Drawings with the attached Notice Of Draftsperson's Patent Drawing Review will be re-mailed. The applicant will be given two-month time period from the mailing of the Notice in which to correct the informalities noted thereon.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LEO STANGER
P.O. BOX 1455
382 SPRINGFIELD AVE.
SUMMIT NJ 07901

MAILED

JUN 22 2009

OFFICE OF PETITIONS

In re Patent No. 6,883,104 :
Issue Date: April 19, 2005 :
Application No. 09/789,182 : NOTICE UNDER 37 CFR. 1.28(c)
Filed: February 20, 2001 :
Attorney Docket No. ROSCH-106 :

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 **DIMISSED.**

37 CFR 1.28(c) 2 (ii) states:

> (ii) *Itemization of the deficiency payment.* An itemization of the total deficiency payment is required. The itemization must include the following information:
>
> (A) Each particular type of fee that was erroneously paid as a small entity, (*e.g.*, basic statutory filing fee, two-month extension of time fee) along with the current fee amount for a non-small entity;
> (B) The small entity fee actually paid, and when. This will permit the Office to differentiate, for example, between two one-month extension of time fees erroneously paid as a small entity but on different dates;
> (C) The deficiency owed amount (for each fee erroneously paid); and

(D) The total deficiency payment owed, which is the sum or total of the individual deficiency owed amounts set forth in paragraph (c)(2)(ii)(C) of this section.

Inquiries related to this communication should be directed to the Michelle R. Eason at (571) 272-4231.

/Thurman K. Page/

Thurman Page
Petitions Examiner
Office of Petitions

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COMMISSIONER FOR PATENTS
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ERIC B. MEYERTONS
Meyertons, Hood, Kivlin, Kowert & Goetzel P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

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SEP 16 2004

OFFICE OF PETITIONS

In re Application of :
Foreman, et al. : DECISION ON APPLICATION FOR
Application No. 09/789,184 : PATENT TERM ADJUSTMENT
Filed: February 20, 2001 :
Atty. Dkt. No.: 5040-06317/EBM :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND APPLICATION FOR PATENT TERM ADJUSTMENT," filed April 19, 2004, requesting that the above-identified patent be accorded a patent term adjustment of 216 days. The required application fee has been charged to deposit account No. 50-1505 as authorized.

Applicants do not dispute the accuracy of the determination of patent term adjustment of 56 days as of the time of mailing of the Notice of Allowance mailed January 15, 2004.

Applicants instead request reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance as it relates to the Office's failure to issue the patent within 3 years of the filing date.

The provisions of 37 CFR 1.703(b) state:

> "The period of adjustment under § 1.702(b) is the number of days, if any, in the period beginning on the day after the date that is three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application and ending on the date a patent was issued…."

As the instant application to date has not issued as a patent, it would be premature to assess the amount of additional time granted for not issuing the application within three years of the filing of the application under 37 CFR 1.703(b).

Accordingly, a decision is being **held in abeyance** until after issuance of the patent as 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.

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 communication should accompany any such request. No additional application fee will be due in connection with a renewed request on the grounds that the Office failed to issue the patent within 3 years from the date the application was filed. Requests for reconsideration on other grounds must meet all requirements set forth under 37 CFR 1.705(d), including timely submission of the request and required application fee.

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

Telephone inquiries specific to this matter should be directed to Senior Petitions Attorney Alesia M. Brown at (703) 305-0310.

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

OIPE JC17
JUL 25 2001
PATENT & TRADEMARK OFFICE

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Foreman, et al.

Serial No.: 09/789,186

Filed: February 20, 2001

For: HOLDER FOR MOLD ASSEMBLIES AND MOLDS

§ Examiner: Unknown
§
§ Group Art Unit: 1714
§
§ Atty. Docket. No.: 5040-06301/EBM
§

CERTIFICATE OF MAILING
37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, Attn: BOX MISSING PARTS, Washington, D.C. 20231, on the date indicated below.

July 23, 2001
Date

Elda Gonzalez

RESPONSE TO NOTICE TO FILE MISSING PARTS OF APPLICATION - FILING DATE GRANTED, MAILED MAY 22, 2001

ATTN: Box Missing Parts
Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant encloses the following in response to the Notice to File Missing Parts of Application - Filing Date Granted:

(1) Copy of Form PTO-1533, Notice to File Missing Parts - Filing Date Granted (2 pages);

(2) Originally executed Election Under 37 C.F.R. §§ 3.71 and 3.73 and Power of Attorney (2 pages);

(3) Form PTO-1595 Assignment Recordation Cover Sheet (1 page);

(4) Originally executed Assignment (3 pages);

(5) Originally executed Declaration (3 pages);

(6) Originally executed Verified Statement (Declaration) Claiming Small Entity Status (37 CFR §§ 1.9(f) and 1.27(c)) – Small Business Concern (2 pages);

(7) Substitute drawings in compliance with the margin requirements of 37 C.F.R. § 1.84 (figures 1-53 on 47 sheets);

(8) Preliminary Amendment (2 pages);

(9) Fee Authorization in the amount of $460.00 to cover the filing fee for a small entity as follows (2 pages):

$ 355.00 -- basic filing fee;
$ 65.00 -- surcharge for late filing of declaration and fee;
$ 40.00 -- assignment recordation fee; and

(10) A return postcard.

If any extension of time is required, Applicant hereby respectfully requests the appropriate extension of time. If any fees are inadvertently omitted or if any additional fees are required or have been overpaid, please appropriately charge or credit those fees to Conley, Rose & Tayon, P.C. Deposit Account Number 50-1505/5040-06301/EBM.

Respectfully submitted,

Eric B. Meyertons
Reg. No. 34,876

Attorney for Applicant

CONLEY, ROSE & TAYON, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398
(512) 476-1400 (voice)
(512) 703-1250 (facsimile)

Date: July 23, 2001

OIPE JC176
JUL 25 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
09/789,186	02/20/2001	John T. Foreman	5040-06301

CONFIRMATION NO. 6022

FORMALITIES LETTER

OC000000006101520

ERIC B. MEYERTONS
CONLEY, ROSE & TAYON, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

Date Mailed: 05/22/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing.
  Applicant must submit $ **710** *to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).*
- Total additional claim fee(s) for this application is $27526.
  - **$22806** for **1267** total claims over 20.
  - **$4720** for **59** independent claims over 3 .
- The oath or declaration is missing.
  A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of $130 for a non-small entity, must be submitted with the missing items identified in this letter.
- **The balance due by applicant is $ 28366.**

The application is informal since it does not comply with the regulations for the reason(s) indicated below.

The required item(s) identified below must be timely submitted to avoid abandonment:

- Substitute drawings in compliance with 37 CFR 1.84 because:
  - drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch);

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 JC176
JUL 25 2001
PATENT & TRADEMARK OFFICE

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Lattis, et al.

Serial No.: 09/789,186

Filed: February 20, 2001

For: METHOD OF ENTERING PRESCRIPTION INFORMATION

§ Examiner: Unknown
§
§ Group Art Unit: 1714
§
§ Atty. Docket. No.: 5040-06325/EBM
§
§
§
§
§
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§
§

CERTIFICATE OF MAILING
37 C.F.R. § 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail on the date indicated above and is addressed to:

July 2, 2001
Date

Elda Gonzalez

FEE AUTHORIZATION

Commissioner for Patents
Washington, D.C. 20231

The Commissioner is hereby authorized to charge the following fees to Conley, Rose & Tayon, P.C. Deposit Account Number 50-1505/5040-06325/EBM:

$ 355.00 -- basic filing fee;
$ 65.00 -- surcharge for late filing of declaration and fee;
$ 40.00 -- assignment recordation fee;

Total Amount: $460.00

Attorney Docket No.: 5040-06325

The Commissioner is also authorized to charge any extension fee or other fees which may be necessary to the same account number. If the above mentioned account is found to have insufficient funds, the Commissioner is authorized to charge Conley, Rose & Tayon, P.C. Deposit Account Number 501623/5040-06325/EBM.

Respectfully submitted,

Eric B. Meyertons
Reg. No. 34,876

Attorney for Applicant

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(512) 476-1400 (voice)
(512) 703-1250 (facsimile)

Date: 7/23/01

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APR 0 5 2005

OFFICE OF PETITIONS

In re Application of	:	
Foreman et al.	:	
Application No. 09/789,190	:	DECISION ON APPLICATION
Filed: February 20, 2001	:	FOR
Atty Docket No.5040-06313/EBM	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND, APPLICATION FOR PATENT TERM ADJUSTMENT," filed September 15, 2004. Applicants request correction of the patent term adjustment from two hundred thirty-nine (239) days to five hundred thirty-nine (539) days solely on the basis of 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[1]. 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. Patentees may seek such consideration without payment

[1] Citing each adjustment and reduction of record, applicants otherwise agree with the determination of patent term adjustment of 239 days indicated in the notice of allowance.

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.

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

Kery A Fries
for

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

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AUSTIN, TX 78767-0398

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JUL 13 2005

OFFICE OF PETITIONS

In re Application of	:	
Foreman et al.	:	
Application No. 09/789,190	:	DECISION ON APPLICATION
Filed: February 20, 2001	:	FOR
Atty Docket No.5040-06313/EBM	:	PATENT TERM ADJUSTMENT
	:	

This is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND, APPLICATION FOR PATENT TERM ADJUSTMENT," filed May 19, 2005. Patentees request that the patent term adjustment indicated in the patent be corrected from two hundred thirty-six (236) days to seven hundred ninety (790) days.

The application for patent term adjustment is **GRANTED** to the extent indicated 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 three hundred fifty-six **(356)** days.

The initial "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND, APPLICATION FOR PATENT TERM ADJUSTMENT," requesting additional patent term on the basis that the Office had failed to issue the patent within 3 years of the filing date was filed on September 15, 2004. By decision mailed April 5, 2005, a decision on the request was held in abeyance until after the actual patent date. Patentees were given two 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. Patentees were advised that they may seek such consideration without payment of an additional fee.

On May 17, 2005, the application matured into U.S. Patent No. 6,893,245, with a revised patent term adjustment of 236 days. Within 2 months, patentees filed the instant request. Patentees request that the patent term adjustment indicated in the patent be increased by 452 days based on the Office taking in excess of three years to issue the patent. In addition, patentees request that the 120 days reduction entered for the filing of the initial request for reconsideration of patent term adjustment filed September 15, 2004 be removed.

The patent term adjustment has been reconsidered, and the request to increase the patent term by 452 is dismissed. Patentees are correct that the Office did not issue the patent within 3 years of its filing date of February 20, 2001. Specifically, the patent issued on May 17, 2005, three years and 452 days after its filing date. The period of delay under 35 U.S.C. 154(b)(1)(B) and § 1.702(b) is 452 days. See § 1.703(b).

However, as stated in the original decision, 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). In this instance, the periods of delay totaling 460 days attributable to grounds specified in § 1.702(a)(1),(a)(2) and (a)(4) overlap with the 452 days attributable to the delay in the issuance of the patent. Thus, the period of adjustment cannot exceed the actual number of days of delay of 460 days.

However, patentees are correct that § 1.704(e) is applicable. The reduction of 120 days is associated with the filing of the initial request for reconsideration of patent term adjustment. Under the circumstances, no additional reduction is warranted for this filing.

In view thereof, the patent should have issued with a revised patent term adjustment of 356 days.

No fee is required and none has been charged.

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 **THREE HUNDRED FIFTY-SIX (356)** days.

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

Kery A Fries
/pe

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

Enclosure: Copy of DRAFT Certificate of Correction

Day : Wednesday

PALM INTRANET

Date: 7/13/2005
Time: 08:41:08

PTA Calculations for Application: 09/789190			
Application Filing Date:	02/20/2001	PTO Delay (PTO):	460
Issue Date of Patent:	05/17/2005	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	224
Post-Issue Petitions:	0	Total PTA (days):	356
PTO Delay Adjustment:	120		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
51	07/13/2005	ADJUSTMENT OF PTA CALCULATION BY PTO	120		
47.5	04/27/2005	PTA 36 MONTHS			
47	05/17/2005	PATENT ISSUE DATE USED IN PTA CALCULATION	122		43
46	04/14/2005	RECEIPT INTO PUBS			
45	04/13/2005	DISPATCH TO FDC			
44	04/13/2005	APPLICATION IS CONSIDERED READY FOR ISSUE			
43	09/15/2004	ISSUE FEE PAYMENT VERIFIED		5	33
42	04/13/2005	RECEIPT INTO PUBS			
41	04/05/2005	PETITION DECISION - DISMISSED			
40	03/23/2005	RECEIPT INTO PUBS			
39	09/15/2004	PETITION ENTERED			
38	10/07/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
37	09/15/2004	MISCELLANEOUS INCOMING LETTER		120	
36	09/15/2004	ISSUE FEE PAYMENT RECEIVED			
35	08/11/2004	RECEIPT INTO PUBS			
34	06/25/2004	WORKFLOW - FILE SENT TO CONTRACTOR			
33	06/10/2004	MAIL NOTICE OF ALLOWANCE			
32	06/10/2004	ISSUE REVISION COMPLETED			
31	06/10/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
30	06/10/2004	CASE DOCKETED TO EXAMINER IN GAU			
29	06/09/2004	NOTICE OF ALLOWABILITY			
28	04/30/2004	INCOMING LETTER PERTAINING TO THE DRAWINGS			

27	04/30/2004	SUBSTITUTE SPECIFICATION FILED			
26	06/02/2004	DATE FORWARDED TO EXAMINER			
25	04/30/2004	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
24	04/30/2004	NOTICE OF APPEAL FILED		94	20
23	04/30/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
21	04/30/2004	WORKFLOW INCOMING AMENDMENT IFW			
20	10/27/2003	MAIL FINAL REJECTION (PTOL - 326)	223		15
19	10/20/2003	FINAL REJECTION			
18	11/18/2002	INCOMING LETTER PERTAINING TO THE DRAWINGS			
17	11/18/2002	NEW OR ADDITIONAL DRAWING FILED			
16	08/06/2003	DATE FORWARDED TO EXAMINER			
15	11/18/2002	RESPONSE AFTER NON-FINAL ACTION		5	13
14	11/18/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
13	08/13/2002	MAIL NON-FINAL REJECTION	115		-1
12	08/12/2002	NON-FINAL REJECTION			
11	06/27/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	06/27/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	02/26/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
8	01/14/2002	CASE DOCKETED TO EXAMINER IN GAU			
7	02/20/2001	PRELIMINARY AMENDMENT			
6	10/12/2001	APPLICATION DISPATCHED FROM OIPE			
5	05/22/2001	APPLICATION IS NOW COMPLETE			
4	05/21/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	05/18/2001	CORRESPONDENCE ADDRESS CHANGE			
2	03/15/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	02/20/2001	INITIAL EXAM TEAM NN			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

UNITED STATES PATENT AND TRADEMARK OFFICE

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PAPER NO.

ERIC B. MEYERTONS
CONLEY, ROSE & TAYON, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

COPY MAILED

AUG 1 9 2004

OFFICE OF PETITIONS

In re Application of
Galen Powers
Application No. 09/789,192
Filed: February 20, 2001
Atty Docket No. 5040-06330/EBM

DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND, APPLICATION FOR PATENT TERM ADJUSTMENT," filed February 23, 2004. Applicant requests that the determination of patent term adjustment (PTA) under 35 U.S.C. 154(b) be corrected from 69 days to 175 days. In part, applicant requests this correction on the basis that the Office has failed to issue the patent within three years of the application filing date.

To the extent that the application for patent term adjustment at the time of the mailing of the notice of allowance is being reconsidered, the application for patent term adjustment is **DISMISSED**.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance 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.

On November 18, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent

term adjustment to date is 69 days. This initial determination is based on a period of adjustment of 170 days pursuant to § 1.702(a)(1) reduced by periods of reduction of 3 days and 98 days both pursuant to § 1.704(b). Applicant agrees on the basis for adjustment pursuant to § 1.702(a)(1); however, applicant calculates the number of days as 169. Likewise, applicant agrees with the basis for the reduction of 98 days but calculates the number of days as 96. By their silence, applicant disputes the reduction of 3 days.

A review of the calculations confirms that the period of adjustment and periods of reduction entered by the Office are correct. The Office mailed a first Office action on October 7, 2002, fourteen months and 170 days after the filing date of this application, February 20, 2001. Applicant's response to the Office action mailed October 7, 2002 was not received in the Office until January 10, 2003, three months and 3 days after the mailing date of the Office action. Likewise, applicant's response to the Office action mailed April 8, 2003 was not received in the Office until October 14, 2003, three months and 98 days after the mailing date of the Office action. In this regard, applicant's attention is directed to 37 CFR 1.703(f), which provides that "[t]he date indicated on any certificate of mailing or transmission under § 1.8 shall not be taken into account in this calculation" of patent term adjustment. See also, Comment 10, *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000).

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is 69 days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Published Division has been advised of this decision. The application is being processed into a patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (703) 305-0309.

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

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COMMISSIONER FOR PATENTS
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CONLEY, ROSE & TAYON, P.C.
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AUSTIN, TX 78767-0398

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SEP 01 2005

OFFICE OF PETITIONS

In re Application :
Foreman, et al. :
Application No. 09/789,195 : PATENT TERM ADJUSTMENT
Filed: February 20, 2001 :
Dkt. No.: 5040-06328/EBM :

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND, APPLICATION FOR PATENT TERM ADJUSTMENT," filed March 15, 2004. This matter is being treated under 37 CFR 1.705(b) as an application for patent term adjustment.

The application for patent term adjustment (PTA) 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 is 63 days. A copy of the updated PAIR screen showing the correct determination is enclosed.

The above-identified application was filed February 20, 2001. An adjustment of 166 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(1). The adjustment began April 21, 2002, the day after the date that is fourteen months from the date upon which the application was filed, and ended October 3, 2002, the date of mailing of non-final Office action. See, 37 CFR 1.703(a)(1).

The adjustment of 166 days is reduced six days in accordance with 37 CFR 1.704(b). The adjustment began December 4, 2002, the day after the date that is three months after the date upon which the non-final Office action was mailed, and ended January 9, 2003, the date a response was filed.

Petitioners have advised that the adjustment of 166 days should be reduced an additional 97 days in accordance with 37 CFR 1.704(b). Review of the application history reveals that applicants are correct in that applicants failed to engage in

reasonable efforts to conclude prosecution in connection with the submission of a reply to the final Office action mailed March 27, 2003. In accordance with 37 CFR 1.704(b), the reduction began June 28, 2003, the day after the date that is three months from the date upon which the final Office action was mailed, and ended October 2, 2003, the date a response was filed.

Applicants further argue that the Office will have failed to issue a patent within three years of the filing date of the application in accordance with 37 CFR 1.702(b).

Applicants are advised that decision on the instant request for reconsideration of patent term adjustment ("PTA") under 37 CFR 1.702(b) 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 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 63 days.

The Office acknowledges receipt of the required application fee of $200.00. No additional fee will be required if applicant is solely requesting reconsideration of additional time related to failing to issue the patent within three years from the actual filing date of the application in accordance with 37 CFR 1.702(b).

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.

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

Enclosure: Copy of Adjustment PAIR Calculation

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

dss

Mailed: 2-27-06

In re application of:	:	
John T. Foreman et al.	:	DECISION ON
Serial No. 09/789,195	:	PETITION
Filed: February 20, 2001	:	
For: SYSTEM FOR PREPARING EYEGLASS LENSES WITH FILLING STATION	:	

This is a response to the REQUEST TO WITHDRAW HOLDING OF ABANDONMENT filed November 04, 2005.. The petition requests that the abandonment, as set forth in the Notice of Abandonment of October 19, 2005, for failure to timely file corrected drawings as required by the Notice of Allowability mailed on December 16, 2003 be withdrawn. The petitioner asserts that corrected drawings were timely filed on March 15, 2004(a copy of the drawings filed March 15, 2004 along with the USPTO dated stamped postcard receipt are attached to the instant request).

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 March 15, 2004 as evidenced by the copy of the USPTO date stamped return receipt postcard indicating receipt of the reply at the USPTO on March 15, 2004. Accordingly, any holding of abandonment for failure to timely file corrected drawings as required by the Notice of Allowability mailed December 16, 2003 is hereby vacated, and the application is returned to pending status.

The application shall be forwarded to Publications Branch for processing and consideration of the papers filed March 15, 2004.

The Petition is **GRANTED**.

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

MEYERTONS, HOOD, KIVLIN,KOWER, & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

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SHAWNA CANNON LEMON
MYERS BIGEL SIBLEY & SAJOVEC P.A.
P.O. BOX 37428
RALEIGH, NC 27627

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FEB 04 2004

OFFICE OF PETITIONS

In re Application of :
Richard C. Boucher Jr. :
Application No. 09/789,256 : NOTICE
Filed: February 20, 2001 :
Attorney Docket No. 5470-237CT

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 1615.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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Myertons, Hood, Kivlin, Kowert, & Goetzel PC
P.O. Box 398
Austin, Texas 78767-0398

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FEB 13 2006

OFFICE OF PETITIONS

In re Application of
Foreman et al.
Application No. 09/789,289
Filed: Feb. 2, 2001
Attorney Docket No. 5040-06319

: DECISION HOLDING PETITION IN
:ABEYANCE

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND APPLICATION FOR PATENT TERM ADJUSTMENT" filed August 8, 2005. Applicants are requesting that an additional five hundred and ninety-two days for the Office' failure to issue the application within three years of the filing date of such application.

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 also notes that at the time of the mailing of allowance, the amount of PTA is one hundred and fifty-four days. Applicants were in agreement with the five hundred and eighty-one (581) days of administrative delay based upon fourteen months to act upon the application under 37 CFR 1.702(a)(1) and to file a response to applicant within four months of response date under 37 CFR 1.702(a)(2). Applicants also were in agreement with the four hundred and twenty-seven (427) days of. Applicant delays under 37 CFR 1.704(c) (7) & (8) and 1.704(b).

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 Office delays in issuance of the patent more than four months past the payment of the issue fee and more than three years after the filing date 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/

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

cc: Pair calculation

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Paper No.

ERIC B. MEYERTONS
MEYERTONS, HOOD, KIVLIN, LOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN, TX 78767-0398

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FEB 08 2005

OFFICE OF PETITIONS

In re Application of	:	DECISION ON APPLICATION
John T. Foreman	:	FOR
Application No. 09/789,290	:	PATENT TERM ADJUSTMENT
Filed: February 20, 2001	:	
Atty Docket No. 5040-06315/EBM	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND APPLICATION FOR PATENT TERM ADJUSTMENT," filed April 26, 2004. Applicant requests that the patent term adjustment be increased by 167 days based on the Office's failure to issue a patent within 3 years of the actual filing date of the application. Applicant asserts that the proper patent term adjustment should be 215 days.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance 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.

As to the application for patent term adjustment at the time of mailing of the notice of allowance, this request is **DISMISSED**. However, for the reasons set forth herein, the patent term adjustment at the time of the mailing of the notice of allowance is being corrected to **zero (0)** days.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **zero (0)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 22, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 2 days. On April 26, 2004, the instant request for reconsideration was timely filed[1]. Applicant agrees with the Office's determination of a period of adjustment of 144 days for Office delay in mailing a first Office action. See § 1.703(a)(1). Applicant also agrees with the reduction of 96 days pursuant to § 1.704(b) for applicant's late filing of a notice of appeal. Given the assertion that the proper PTA is 215 days (311 - 96), applicant, in effect, disputes the reduction of 71 days for applicant delay. Applicant is silent as to the entry of a period of adjustment of 25 days associated with Office delay in mailing a notice of allowance.

The patent issuing from this application is subject to a terminal disclaimer.

The reduction of 71 days has been reviewed and found to be correct. § 1.704(c)(7) provides that:

> Submission of a reply having an omission (§1.135(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed;

On August 28, 2003 (certificate of mailing August 25, 2003), applicant filed a terminal disclaimer directed to prior U.S. Patent No. 6,464,484. In the advisory action mailed October 28, 2003, the examiner stated that no terminal disclaimers directed to a U.S. Patent and U.S. Pat. Apps., as stated in page 4 of applicant's response, could be found with the response or were in the file wrapper. A review of page 4 of applicant's response confirms that the response states that such terminal disclaimers were being submitted. However, no such terminal disclaimers were received in the Office on August 28, 2003 nor were such terminal disclaimers of record in the application. On November 7, 2003 (certificate of mailing October 4, 2003), applicant corrected the omission in the August 28, 2003 response and filed the omitted terminal disclaimers. The number of days in the period beginning on the day after the reply having an omission was filed, August 29, 2003, and ending on the date that the response including the omitted terminal disclaimers was filed, November 7, 2003, is 71 days.

Moreover, a review of the application history reveals that the entry of a period of adjustment of 25 days for Office delay in mailing the notice of allowance is incorrect. The mailing of the notice of allowance was not a delayed response to applicant's notice of appeal filed August 28, 2003. The notice of allowance mailed January 22, 2004, was mailed in response to and within four months of applicant's filing of a terminal disclaimer on November 7, 2003.

---

[1] The Issue Fee payment was received in the Office on April 26, 2004.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is **zero (0)** days (144 - 167).

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 updated PAIR screen

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P.O. BOX 398
AUSTIN, TX 78767-0398

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APR 0 6 2005

OFFICE OF PETITIONS

In re Application of	:	
Foreman et al.	:	
Application No. 09/789,303	:	DECISION ON APPLICATION
Filed: February 20, 2001	:	FOR
Atty Docket No. 5040-06310/EBM	:	PATENT TERM ADJUSTMENT
	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT; AND, APPLICATION FOR PATENT TERM ADJUSTMENT," filed June 1, 2004. Applicants request correction of the patent term adjustment from two hundred seventeen (217) days to four hundred thirty-one (431) days partly on the basis of the Office taking in excess of three years to issue the patent. Applicants also, in effect, dispute a reduction of 12 days for applicant delay.

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

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. 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 **two hundred twenty-nine (229)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On February 26, 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 226 days. Applicants timely filed the instant application for patent term adjustment[1]. Conceding that all other adjustments and reductions of record are correct, applicants, in effect, dispute the reduction of 12 days for applicant delay in responding to the Notice to File Missing Parts of Application mailed June 16, 2001.

A review of the application file reveals that the applicants' response to the Notice to File Missing Parts of Application mailed June 18, 2001, is of record in the application with a date of receipt by the Office of August 22, 2001, reflecting timely filing for purposes of compliance with 37 CFR 1.704(b). Furthermore, the response was complete and proper. Thus, the Office should not have assessed applicants a delay of twelve (12) days. The response was timely filed within the three-month period under 37 CFR 1.704(b) and accordingly, applicants' delay should have been assessed as zero "0" days. Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is two hundred twenty-nine (229) days.

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[1] Office records show that the Issue Fee payment was also received on June 1, 2004.

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/

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

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Paper No. 8

J. Nicholas Gross, Attorney at Law
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1385 Mission Street
San Francisco, CA 94103

MAIL

JUL 0 3 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:)
Liu, et al.)
Application No.: 09/789,336)
Filed: February 20, 2001)
For: xDSL MODEM WITH)
ASYNCHRONOUS TRANSFER MODE)
(ATM) LAYER & LATENCY REDUCTION)
IMPLEMENTED IN SOFTWARE)

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney of record filed June 5, 2002.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **DENIED**. Less than 30 days remain in the maximum time period which can be extended to file a response to the Office action of January 16, 2002.

All future communications from the Office will be directed to the above-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
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No. 12

Farjami & Farjami, LLP
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Irvine, Ca 92618

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OCT 2 4 2003

OFFICE OF PETITIONS

In re Application of :
Young Way Liu et al. :
Application No. 09/789,336 : ON PETITION
Filed: February 20, 2001 :
Attorney Docket No. ITEX 98-003C :

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the non-final Office action mailed January 16, 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 April 17, 2002.

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

The application file is being forwarded to Technology Center AU 2662 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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Paper No. 6

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SEP 16 2003

OFFICE OF PETITIONS

In re Application of
Shigeto Taga
Application No. 09/789,363
Filed: February 21, 2001
Attorney Docket No. 36856.431

DECISION ON PETITION

This is a decision on the "PETITION TO REVIVE UNINTENTIONALLY ABANDONED PATENT APPLICATION UNDER 37 CFR 1.137(b)," filed August 6, 2003, which is also considered as a petition to withdraw the holding of abandonment under § 1.181. Petitioner requests refund of the petition fee, asserting that a response was timely filed.

The petition under § 1.181 is **DISMISSED**. Accordingly, the petition fee is required and the request for refund is denied.

The petition under § 1.137(b) is **GRANTED**.

The above-identified application became abandoned for failure to timely file a reply to the Notice to File Missing Parts of Application mailed March 26, 2001. This Notice set a two-month period for reply, with extensions of time obtainable under § 1.136(a). No reply having been received in the Office and no extension of time obtained, the above-identified application became abandoned on May 27, 2001. A Notice of Abandonment was mailed on July 21, 2003.

In response, petitioner promptly filed[1] the instant petition (and petition fee under § 1.137(b)), asserting that the response to the Notice, an executed declaration and late surcharge, were timely filed on April 3, 2001. Given the assertion on petition, it is preliminarily considered whether the holding of abandonment should be withdrawn. In support of a conclusion that the responses were timely filed, petitioner submitted a copy of their itemized return postcard receipt, bearing a received stamp of April 3, 2001. However, the received stamp is not recognized as a USPTO date-stamp. Thus, the return postcard receipt is not *prima facie* evidence of timely filing of the responses.

---

[1] No action occurred in this application from March 26, 2001 to the mailing of a Notice of Abandonment on July 21, 2003. In this time period, it would have been reasonable for applicants' to file a status inquiry. Thus, it would not be inappropriate to consider the petition under § 1.181 (to the extent the instant petition is being so considered) as untimely, and to not consider this petition on the merits under § 1.181.

Furthermore, petitioner states that the petition includes copies of the declaration and the credit card payment form dated April 2, 2001, as both were purportedly filed April 3, 2001. However, the declaration does not include a certificate of mailing under § 1.8. The declaration of facts of Mrs. Sonia V. McVean attesting to having deposited the documents constituting the response in the U.S. Postal System with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents on April 2, 2001, is not an adequate substitute for a proper certificate of mailing under § 1.8. Accordingly, petitioner is not entitled to the benefits of certificate of mailing with reference to the filing of the declaration. A copy of the credit card payment form is not among the papers included in the petition for consideration. It is concluded that, by this evidence, petitioner has not shown that the response was timely filed, and as such, the abandonment should not be withdrawn.

Nonetheless, petitioner has met the requirements for a grantable petition under § 1.137(b). The petition includes the required reply in the form of an executed declaration and authorization to charge any required fees to Deposit Account No. 50-1353. Pursuant to this authorization, the late surcharge has been charged to the Deposit Account. The petition also includes payment of the petition fee.

37 CFR 1.137(b)(3) requires a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional." Petitioner's statement on petition varies from the language required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition, that this is a "PETITION TO REVIVE UNINTENTIONALLY ABANDONED PATENT APPLICATION UNDER 37 CFR 1.137(b)," is being construed as the statement required by 37 CFR 1.137(b)(3). Petitioner **must** notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

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

As stated by petitioner, no terminal disclaimer is required.

In view thereof, the petition under § 1.137(b) is granted.

However, the request for refund of the petition fee must be denied. 35 U.S.C. 41(a) (7) provides that a petition for the revival of an unintentionally abandoned application or for the unintentionally delayed payment of the issue fee must be accompanied by the petition fee set forth in 37 CFR 1.17(m), unless the petition is filed under 35 U.S.C. 133 or 151 (on the

basis of unavoidable delay), in which case the fee is set forth in 37 CFR 1.17(l). Thus, unless the circumstances warrant the withdrawal of the holding of abandonment (i.e., it is determined that the application is not properly held abandoned), the payment of a petition fee to obtain the revival of an abandoned application is a statutory prerequisite to revival of the abandoned application, and cannot be waived. It has already been concluded that the circumstances of the abandonment of this application have not been shown to warrant withdrawal of the holding of abandonment.

In addition, the phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), reprinted in 1982 U.S.C.C.A.N. 770 ("[t]he fees set forth in this section are due on filing the petition"). Therefore, the Office: (A) will not refund the petition fee required by 37 CFR 1.17(l) or 1.17(m), regardless of whether the petition under 37 CFR 1.137 is dismissed or denied; and (B) will not reach the merits of any petition under 37 CFR 1.137 lacking the requisite petition fee.

Accordingly, the petition fee will not be refunded.

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

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/789,386	02/21/2001	David Michalovich	GP-30165-C1

OIPE JC79
JUN 11 2001
PATENT & TRADEMARK OFFICE

CONFIRMATION NO. 8059

FORMALITIES LETTER

OC000000005947158

Ratner & Prestia
P.O. Box 980
Valley Forge, PA 19482-0980

Date Mailed: 04/09/2001

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

OIPE JUN 11 2001 PATENT & TRADEMARK OFFICE

GP-30165-C1

0360

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	David Michalovich, *et al.*	: Art Unit: 1631
Serial No.:	09/789,386	: Examiner:
Filed:	February 21, 2001	:
For:	NOVEL COMPOUNDS	:

RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS

FILING DATE GRANTED

Assistant Commissioner for Patents
Washington, DC 20231

S I R :

Responsive to the Formalities Letter dated April 9, 2001, enclosed is a copy of a substitute Specification in compliance with 37 CFR 1.52 with the proper margins.

Also enclosed is Part 2 of the Formalities Letter (copy to be returned with response).

Respectfully Submitted,

RATNER & PRESTIA

R L Andersen

Robert L. Andersen, Reg. No. 25,771
Attorneys for Applicants
Camille Jolly-Tornetta, Reg. No. P-48,592

Dated: June 8, 2001

Enclosures: Substitute Specification
Formalities Letter

Suite 301
One Westlakes, Berwyn
P.O. Box 980
Valley Forge, PA 19482-0980
(610) 407-0700

The Assistant Commissioner for Patents is hereby authorized to charge payment to Deposit Account No. **19-2387** of any fees associated with this communication.	I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231 on: **June 8, 2001** Fran Petrillo

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025-1030

COPY MAILED

NOV 0 8 2006

OFFICE OF PETITIONS

In re Application of Jamieson :
Application No. 09/789,401 : Decision on Petition
Filing Date: February 20, 2001 :
Attorney Docket No. 42390P10980 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 28, 2006, to revive the above-identified application.

The petition is **granted**.

The above-identified application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 1.17(c)) within the time period provided in 37 CFR 1.192(a). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed April 6, 2005, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. See 37 CFR 1.192(b) & 1.197(c). As no claim was allowed, the-above-identified application became abandoned on June 7, 2005. See MPEP 1215.04.

The instant petition requests revival of the application.

Petitioner has met the requirements to revive the above-identified application pursuant to 37 CFR 1.137(b). Therefore, the petition is granted and the application is revived.

Technology Center Art Unit 2815 will be informed of the instant decision and the examiner will review the Appeal Brief filed July 28, 2006, 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

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.

PATRICK J. S. INOUYE PS
810 3RD AVENUE
SUITE 258
SEATTLE WA 98104

COPY MAILED

MAR 0 3 2003

OFFICE OF PETITIONS

In re Application of :
Gust H. Bardy :
Application No. 09/789,416 : ON PETITION
Filed: February 20, 2001 :
Attorney Docket No. 003.0195.01 :

This is a decision on the petition, filed February 25, 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 16, 2002 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries 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 3762 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. _____

Date : March 3, 2003

TO : Director, Office of Publication and Dissemination

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Gust H. Bardy
Application No. : 09/789,416
Filed : February 20, 2001

The above-identified application has been assigned Patent No. 6,527,714 and an issue date of March 4, 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 March 4, 2003:

> "All reference to Patent No. 6,527,714 to Gust H. Bardy of Washington for AUTOMATED SYSTEM AND METHOD FOR ESTABLISHING A PATIENT STATUS REFERENCE BASELINE appearing in the Official Gazette of March 4, 2003 should be deleted since no patent was granted."

Karen Creasy

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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MICROSOFT CORPORATION
ATTN: PATENT GROUP DOCKETING DEPARTMENT
ONE MICROSOFT WAY
REDMOND WA 98052-6399

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JUN 13 2005

OFFICE OF PETITIONS

In re Application of :
Jerome Boss et al :
Application No. 09/789,434 : ON PETITION
Filed: February 20, 2001 :
Attorney Docket No. 1026-034/MMM :

This is a decision on the petition, filed June 9, 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 May 12, 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 2183 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).

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

Dr. Daniel P. Morris, Esq.
IBM Corporation
Intellectual Property Law Dept.
P.O. Box 218
Yorktown Heights NY 10598

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APR 1 6 2003

OFFICE OF PETITIONS

In re Application of :
Angelopoulos et al. :
Application No. 09/789,461 : ON PETITION
Filed: February 21, 2001 :
Attorney Docket No. YOR919940271US6 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 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 final Office action mailed July 30, 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 technically abandoned on November 1, 2002. The present petition precedes a mailing of a Notice of Abandonment.

A petition fee of $1300.00 for revival under 37 CFR 1.137(b), a fee of $320.00 for a Notice of Appeal, and a fee of $110.00 for a Terminal Disclaimer have been charged to applicant's deposit account.

The Notice of Appeal filed February 20, 2003 has been entered and made of record. Accordingly, the two-month period for filing the appeal brief, in triplicate, accompanied by the fee required by law, runs from the date of this decision.

Telephone inquiries concerning this decision should be directed to Phillip Gambel at (703) 305-4066.

The application file is being forwarded to Technology Center 1700, Art Unit 1714, for further processing to the applicant's amendment and Terminal Disclaimer, filed February 20. 2003.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

SCULLY, SCOTT, MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY , NY 11530

COPY MAILED

NOV 2 6 2001

OFFICE OF PETITIONS

In re Application of :
Insun Yun, Casey Ilsun Kim, Augustin Mateescu, Arthur L. Bergman, Wah Im, Jinhyong Seo, and Yongjin Chang :
Application No. 09/789,466 : DECISION AFFORDING STATUS
Filed: February 21, 2001 : UNDER 37 C.F.R. §1.47(a)
Attorney Docket No. **13355** :
Title: **METHOD AND SYSTEM FOR MAXIMIZING CREDIT CARD PURCHASING POWER AND MINIMIZING INTEREST COSTS OVER THE INTERNET** :

This is in response to the petition under 37 C.F.R. §1.47(a)[1], filed September 17, 2001.

The petition under 37 C.F.R. §1.47(a) is **GRANTED**.

The above-identified application was filed on February 21, 2001. On April 10, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), requiring an executed oath or declaration in compliance with §1.63, a surcharge for its late filing, and substitute drawings. This Notice set a two-month period for reply.

[1] A grantable petition under 37 C.F.R. §1.47(a) requires:
(1) the petition fee of $130;
(2) a surcharge of either $65 or $130 if the petition is not filed at the time of filing the application;
(3) a statement of the last known address of the non-signing inventors;
(4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
(5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
(6) a declaration which complies with 37 CFR §1.63.

In reply, applicant filed the instant petition (and fee). To make timely this reply, a three-month extension of time was charged to counsel's Deposit Account, as authorized. Accompanying the petition was a statement from the attorney of record, Kenneth King, a declaration executed by every inventor save Casey Kim, an addendum to the declaration where inventor Yun has signed on behalf of the non-signing inventor, a copy of the letter sent to inventor Yun, and a copy of the letter sent to the non-signing inventor which solicited his signature.

The statement of Mr. King sets forth that a copy of the application was sent to the last known address of the non-signing inventor, and that he has failed to contact Mr. King.

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

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition, not the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

After this decision is mailed, the application will be forwarded to Technology Center 2100 for further processing.

Normally, an oath or declaration which lacks the signature of a sole inventor carries with it the presumption that each of the signing inventors has signed on behalf of the non-signing inventor. The declaration associated with the present application has been amended to include the signature of Insun Yun on behalf of the non-signing inventor. **If the presumption that each of the signing inventors has signed on behalf of the non-signing inventor is incorrect, petitioner must notify the Office.**

The receipt of the substitute drawings is acknowledged.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

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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Casey Ilsun Kim
447 4th Street
No. 100
Palisades Park, NJ 07650

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NOV 2 6 2001

OFFICE OF PETITIONS

In re Application of :
Insun Yun, Casey Ilsun Kim, Augustin Mateescu, Arthur L. Bergman, Wah Im, Jinhyong Seo, and Yongjin Chang :
Application No. 09/789,466 : DECISION AFFORDING STATUS
Filed: February 21, 2001 : UNDER 37 C.F.R. §1.47(a)
Attorney Docket No. **13355** :
Title: **METHOD AND SYSTEM FOR MAXIMIZING CREDIT CARD PURCHASING POWER AND MINIMIZING INTEREST COSTS OVER THE INTERNET** :

Dear Mr. Kim:

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

As a named inventor you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent attorney or agent presenting written authorization from you. If you care to join the application, 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 CFR 1.63.

Telephone inquiries regarding this communication should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011. 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).

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

SCULLY, SCOTT, MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY , NY 11530

UNITED STATES PATENT AND TRADEMARK OFFICE

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ALEXANDRIA, VA 22313-1450
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Paper No. 11

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD MA 01742-9133

COPY MAILED

OCT 17 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of
Proctor, et al.
Application No. 09/789,476
Filed: February 20, 2001
Attorney Docket No. 2479.1068-001
For: METHOD FOR SEARCHING PILOT SIGNALS TO SYNCHRONIZE A CDMA RECEIVER WITH AN ASSOCIATED TRANSMITTER

This decision on the August 25, 2003 (certificate of mailing date August 22, 2003) petition under 37 CFR 1.78(a)(6) to accept an unintentionally delayed claim under 35 USC 119(e) for the benefit of a prior filed provisional application.

The petition is **GRANTED.**

The instant petition requests acceptance of a delayed claim of benefit of provisional application no. 60/184,363, filed February 23, 2000.

Generally, a claim of benefit under 35 U.S.C. 119(e) is required to be filed during the pendency of the nonprovisional application that seeks to claim the invention disclosed in an earlier-filed provisional application.[1] However, when the nonprovisional application is filed on or after November 29, 2000, as is in the instant case, the claim of benefit must be filed **not merely** during the pendency of the nonprovisional application, **but** within either 4 months of its filing date, or 16 months of the filing date of the provisional application, whichever is later.

The claim of benefit submitted with the instant petition is filed during the pendency of the nonprovisional application, but subsequent to 4 months of its filing date or 16 months of the filing date of the provisional application. Such a delayed claim of benefit under 35 U.S.C. 119(e) may be accepted under a petition that includes:

(1) The claim of benefit (in the form of a specific reference to the provisional application) in an application data sheet or in the first sentence of the

---

[1] Assuming the following conditions are also met: (1) the nonprovisional application is filed within 12 months of the filing date of the provisional application; (2) the provisional application is entitled to a filing date, has at least 1 common inventor as that named in the nonprovisional application, and discloses that common inventor's invention which is claimed in at least 1 claim of the nonprovisional application; (3) the basic filing fee for the provisional application has been paid. 35 U.S.C. 119(e)(1); 37 CFR 1.78(a)(4).

specification following the invention title, unless previously submitted;[2]

(2) The $1,300 surcharge set forth in 37 CFR 1.17(t);[3]

(3) A statement that the entire delay (between the time the claim of benefit was due and the filing of the claim) was unintentional.[4]

The petition meets the above requirements and is thus granted.

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

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(6) should not be construed as meaning that 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. § 119 and 37 CFR 1.78(a)(4) and (a)(5) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

This application is being forwarded to Technology Center Art Unit 2634 for further examination and for processing and consideration by the Examiner of applicant's claim under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(4) and (5) for the benefit of priority to the prior-filed provisional application.

Any inquiries concerning this decision may be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

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[2] 37 CFR 1.78(a)(5)(iii), (6)(I). The instant petition is accompanied by an amendment that includes, in the 1st sentence of the specification, a reference to the claim of benefit of the provisional application.

[3] 37 CFR 1.78(a)(6)(ii). The fee has been paid by check.

[4] 37 CFR 1.78(a)(6)(iii); contained in petition.

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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HAMILTON, BROOK, SMITH & REYNOLDS, P.C.
530 VIRGINIA ROAD
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CONCORD, MA 01742-9133

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APR 19 2006

OFFICE OF PETITIONS

In re Application of :
Proctor, et al. :
Application No. 09/789,476 : ON PETITION
Filed: February 20, 2001 :
Attorney Docket No. 2479.1068-001 :

This is a decision on the petition under 37 CFR 1.137(a), filed February 21, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 1.17(c)) within the time period provided in 37 CFR 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 February 3, 2005, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the date of abandonment for this application is April 4, 2005. A Notice of Abandonment was mailed on January 25, 2006.

Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

> The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68

(D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

Petitioner states, "Applicants prepared and timely filed an Appeal Brief together with (i) exhibits, (ii) a transmittal form, (iii) a petition for extension of time, (iv) check no. 56585 in the amount of $620 for all related filing fees, and (v) a return receipt postcard. (A copy of the Appeal Brief and related tiling papers filed with the USPTO under certificate of first class mail on May 3, 2005 is provided herein at Exhibit 1). All filed papers included at least the following indicia correctly identifying the application: Confirmation Number; Group Art Unit; Title; Attorney Docket Number; Examiner's name; and Filing date. The Application Serial Number, however, was incorrectly identified as '09/798,476' having digits '89' transposed (the correct Application Number is 09/789,476)."

Additionally, in support, petitioner has submitted a date-stamped, postcard receipt that indicates receipt in the USPTO of an appeal brief, extension of time and a check for $620.00 on May 5, 2005.

Furthermore, it is noted that the copy of the appeal brief and extension of time each contain an executed Certificate of Mailing under 37 CFR 1.8 that is dated May 3, 2005.

Please note MPEP 502:

> "A minor error in the identification of the application can be corrected by the Office provided the correct identification can be quickly discovered. Examples of minor errors are transposed numbers, typographical errors, and listing the parent application number. The failure to give any application number is not a minor error. The Office often experiences difficulty in matching incoming papers with the application file to which they pertain because insufficient or erroneous information is given. This applies especially to amendments, powers of attorney, changes of address, status letters, petitions for extension of time, and other petitions."

Accordingly, the petition is granted.

This application is being forwarded to Technology Center 2600 for review of the Appeal Brief filed February 21, 2006 (Originally filed May 5, 2005, Certificate of Mailing date: May 3, 2005).

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3228.

Edward J. Tannouse
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

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APR 10 2006
OFFICE OF PETITIONS

In re Application of :
Kazuaki Honda :
Application No. 09/789,520 : ON PETITION
Filed: February 22, 2001 :
Attorney Docket No.: 1341.1082/JDH :

This is a decision on the petition, filed April 7, 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 February 10, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

Telephone inquiries relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2129 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STITES & HARBISON PLLC
1199 NORTH FAIRVAX STREET
SUITE 900
ALEXANDRIA VA 22314

COPY MAILED
OCT 28 2008

In re Patent No. 7,084,859
Issue Date: August 1, 2006
Application No. 09/789,538
Filed: February 22, 2001
Attorney Docket No. P06663US01/RFH

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed August 4, 2008, which is being treated as a petition under 37 CFR 1.137(b) to accept an unintentionally delayed notification to 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 under 37 CFR 1.137(b) is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen-month publication country on March 31, 2004. 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. Therefore, pursuant to the provisions of 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), petitioner failed to timely notify the USPTO of the filing of a counterpart 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(b) to accept an unintentionally delayed notification to the USPTO of the filing of a counterpart application in an eighteen-month publication country 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 as provided by 35 U.S.C. § 122(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

This application matured into Patent No. 7,084,859 on August 1, 2006. Therefore, no further action being required, this patented file is being referred to Files Repository.

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

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

Karen Creasy
Petitions Examiner
Office of Petitions

cc:

TIMOTHY R. PRYOR
910 MONMOUTH ROAD
WINDSOR, ONTARIO N8Y3L7 CANADA

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : March 5, 2009

TO SPE OF : ART UNIT 2629
SUBJECT : Request for Certificate of Correction for Appl. No.: 09/789538 / 7089538

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: _____

RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECH[illegible] 2600

SPE 2629 **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

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON DC 20001

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JAN 24 2002

OFFICE OF PETITIONS

In re Application of
Chuang, Leung, Qiu, Wang, Timiri
Application No. 09/789,572
Filed: February 22, 2001
Attorney Docket No. 03493.00032
For: POWER CONTROL FOR WIRELESS PACKET PACKET WITH APPLICATION TO EDGE SYSTEM

: DECISION REFUSING STATUS
: UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed October 30, 2001.

The petition under 37 CFR 1.47(a) is **dismissed.**

Any request for reconsideration under 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. Failure to respond will result in the abandonment of this application. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(a).

The above-identified application was filed on February 22, 2001, without an executed oath or declaration. Accordingly, a "Notice to File Missing Parts of Application" was mailed on March 30, 2001, requiring an executed oath or declaration and a surcharge for the late filing of the oath or declaration.

On October 30, 2001, petitioner filed the instant petition and obtained a five (5) month extension of time to file a reply. In support of the petition, petitioner filed a "Joint Declaration for Patent Application." for all named inventors, with exception of inventor Wang.

A grantable petition under 37 CFR 1.47(a) requires:

(1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings);

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;

(3) the petition fee,

(4) a statement of the last known address of the non-signing inventor,

The instant petition lacks items (1) and (2) set forth above.

As to item (1), petitioner did not provide adequate documentation that diligent efforts were made to locate the non-signing inventor. A standard of what will suffice as "adequate documentation" is found in *Manuel of Patent Examining Procedure*, Section 409.03(d) and provides, in pertinent part, as follows:

> Where inability to find or reach a non-signing 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 non-signing inventor could not be found or reached should be part of the affidavit or declaration. It is important that affidavit or declaration contain statements of facts as opposed to conclusions.

Petitioner did not provide any evidence of petitioner's efforts to locate the non-signing inventors. The statements made in the instant petition relative to petitioner's efforts to locate the non-signing inventor do not satisfy the above-cited standard as these statements are vague and inconclusive. There is no indication that petitioner conducted a reasonably exhaustive search to obtain an accurate mailing address for the non-signing inventor, i.e., searches of national registries, the Internet, etc. Though petitioner's desire to proceed with the application while petitioner continues to locate the non-signing inventor is appreciated, status under 37 CFR 1.47(a) cannot be granted until petitioner has demonstrated that either the non-signing inventor refuses to sign the declaration or cannot be located so as to sign the declaration. Petitioner has not adequately demonstrated either, therefore; item (1) above has not been satisfied.

Petitioner is further advised that 37 CFR 1.47(a) requires that the complete application papers be sent to the last known address of the non-signing inventor. There is no indication that this was done. Rather the petition only states that ". . . correspondence . . . with respect to the application . . ." was sent to the last known address of the non-signing inventor. Petitioner must forward a complete copy of the application papers, including the specification, claims, and drawings, to the last known address of the non-signing inventor before status under 37 CFR 1.47(a) can be granted. Because the Office cannot ascertain from the petition whether this was done, it is further concluded that the requirements of item (1) above have not been met.

As to item (2) above, petitioner is advised that the declaration of inventor Leung is not acceptable because it is not the same as the declaration signed by the other signing inventors. Inventor Leung's declaration only lists four inventors; the declarations of the other named inventors lists five inventors. Inventor Leung's declaration is not valid because he has not made the same representation as to who the joint inventors are that the other named inventors made. A new declaration for inventor Leung must be provided with any petition for reconsideration filed.

It is noted that the title of the invention which is the subject of the above-cited application is represented in the specification as "Power Control for Wireless Packet Packet with Application to EDGE System" and represented on the declarations and other communication filed as "Power Control for Wireless Packet Voice with Application EDGE System." Petitioner must amend the specification to reflect the correct title of the invention accordingly.

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) 308-6919
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, Virginia

Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.

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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Paper No. 11

BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON DC 20001

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JUN 2 8 2002

OFFICE OF PETITIONS

In re Application of :
Chuang, Leung, Qiu, Wang, and Timiri :
Application No.: 09/789,572 :
Filed: February 22, 2001 :
Attorney Docket No: 03493.00032 : ON RENEWED PETITION
For: POWER CONTROL FOR WIRELESS PACKET :
PACKET WITH APPLICATION TO EDGE SYSTEM :

This is in response to the renewed petition under 37 CFR 1.47(a), filed March 25, 2002.

The petition is **MOOT.**.

The initial petition under 37 CFR 1.47(a) was filed on October 30, 200`, in response to a "Notice to File Missing Parts of Non-Provisional Application" (the "Notice") which indicated that a proper oath or declaration had not been filed and that a surcharge for either a late filing fee or oath or declaration was due and owing. A decision dismissing the petition of October 30, 2001, was mailed on January 24, 2002. The decision indicated that petitioner did not: 1)provide adequate evidence of petitioner's efforts to locate the non-signing inventor, 2) provide adequate evidence that the entire application was sent to the non-signing inventor for his review and signature, and 3) provide a proper declaration for inventor Leung. The decision also advised petitioner of the two-month period for reply beginning from the mailing date of the decision and that extension of time for reply were available pursuant to 37 CFR 1.136(a). On March 25, 2002, petitioner filed a renewed petition along with a declaration executed by all named inventors.

As petitioner has obtained the signature of all named inventors on the oath or declaration, there is no outstanding issue relative to the instant application that could be remedied by a petition filed pursuant to 37 CFR 1.47(a). The renewed petition is, therefore, rendered moot.

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

Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.

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 PATEN
UNITED STATES PATENT AND TRADEMARK OFFI
WASHINGTON, D.C. 2023
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Paper No. 7

MAIL

SEP 11 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Mord Michael Lewis
NAIPO (NORTH AMERICA
INTERNATIONAL PATENT OFFICE)
P.O. Box 506
Merrifield, VA 22116

In re Application of:
Shye-Lin Wu
Application No. 09/789,617
Filed: February 22, 2001
For: AN ENCRYPTION METHOD RELEVANT TO ALL ENCRYPTION PROCEDURES

DECISION ON REQUEST FOR WITHDRAWAL 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 agent.

The request filed August 18, 2003 meets all the requirements. Accordingly the request is **GRANTED**.

All future communications from the Office will 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.

James R. Matthews

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

cc: Winston Hsu

Best Available Copy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 9/6/06 Paper No.: 11

TO SPE OF : ART UNIT 3731

SUBJECT : Request for Certificate of Correction for Appl. No.: 9/789681 Patent No.: 6635073B2

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.

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

Comments: Request for ~~cos~~ certificate includes correction of five claims AND the inclusion of eight pages of specification missing from patent.

M J Hayes
SPE

3734
Art Unit

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

September 5, 2002

Norman D. Hanson
Fulbright & Jaworski
666 Fifth Ave.
New York, NY 10103

In re application of:
Valmori et al DECISION ON PETITION
Serial No.: 09/789,649
Filed: February 21, 200l
For: ISOLATED NONA-AND DECAPEPITDES
WHICH BIND TO HLA MOLECULES, AND
THE USE THEREOF

This is a decision on the petition received on March 8, 2002, to withdraw the holding of abandonment in the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. 1.113 in timely manner to the Notice to File Missing Parts of Application mailed May 7, 2001. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned on July 10, 2001. The notice of abandonment was mailed April 4, 2002.

On March 8, 2002, the office received a communication from the attorney of record. Enclosed was an acknowledgment that the attorney responded to the Notice to File Missing Part on May 21, 2001.

The evidence submitted is sufficient to establish that the petitioners responded to the Notice to File Missing Parts on May 21, 200l with a declaration, 8 sheets of drawings (figures 1-8) and a check in the amount of $130.

The drawing pages containing figures 2,5,6 and 7 did not comply with the guideline in 37 CFR 1.84 which went into effect November 29, 2000.

DOCKET DEPT.
RECEIVED
2002 SEP 17 A 11:07
FULBRIGHT & JAWORSKI L.L.P.
NEW YORK OFFICE

A Notice of Incomplete Reply was mailed to counsel on December 18, 200l to correct the drawing requirement.

Counsel responded on March 8, 2002 with a Letter-Response to Alleged Incomplete Reply. In the response of March 8, 2002 and the telephone communication of September 3, 2002. The petitioners stated, "It included proper figures (which were accepted in the parent application), as well as documentation relating to a transfer of sequences".

On September 4, 2002 the attorney of record faxed copies of the missed sized drawings as instructed by the telephone communication of September 3, 2002.

The petition is hereby GRANTED.

Enclosed is a copy of the drawing requirement issued November 29, 2000 for counsel's future use.

The application has been completed for release to Technology Center 1644.

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

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination.

Enclosure:

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) indicted 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 drawings filed are not acceptable because:

- The drawings have a line quality that is too light to be reproduced (weight of all lines and letters must be heavy enough to permit adequate reproduction) or text that is illegible (reference characters, sheet numbers, and view numbers must be plain and legible) (see 37 CFR 1.84(l) and (p)(1));
- There are missing lead lines. Lead lines are required for each reference character (except for those which indicate the surface or cross section on which they are placed, in which case the reference character must be underlined to make it clear that a lead line has not been left out by mistake) (see 37 CFR 1.84(q));
- The drawings contain excessive text. Suitable descriptive legends may be used, or may be required by the Examiner where necessary for understanding of the drawing but should contain as few words as possible (see 37 CFR 1.84(o)). Note Figure ___;
- The drawing figures contain text that is not in English (including, for example, a flow chart that was originally not in English that has been marked up to include the English text) (see 37 CFR 1.84(p)(2) and 37 CFR 1.52(d)(1)). Note Figure __;
- The drawing sheets do not have the appropriate margin(s) (see 37 CFR 1.84(g)). Each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (5/8 inch), and a bottom margin of at least 1.0 cm. (3/8 inch), Note sheet ___;
- The drawings are not on the correct size paper (see 37 CFR 1.84(f)) The size of the sheets on which drawings are made must be either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm (8 ½ by 11 inches);
- More than one figure is present and each figure is not labeled "Fig." with a consecutive Arabic numeral (1, 2, etc.) or an Arabic numeral and capital letter in the English alphabet (A, B, etc.)(see 37 CFR 1.84(u)(1));
- The application includes photographs of the invention subject matter that appear capable of illustration and which are illegible after scanning (see 37 CFR 1.84(b));
- The application contains color drawings or color photographs, but not a black and white copy of the drawings/photographs (see 37 CFR 1.84(a)(2)(iii) and 1.165(b));
- The drawings submitted to the Office are not electronically reproducible. Drawing sheets must be submitted on paper which is flexible, strong, white, smooth, non-shiny, and durable. (See 37 CFR 1.84(e)).

APPLICANT MUST SUBMIT ACCEPTABLE CORRECTED OR REPLACEMENT DRAWINGS THAT DO NOT CONTAIN THE ABOVE-IDENTIFIED INFORMALITIES.

OBJECTIONS TO THE DRAWINGS WILL NOT BE HELD IN ABEYANCE AND ANY REQUEST TO HOLD OBJECTIONS TO THE DRAWINGS IN ABEYANCE WILL NOT BE CONSIDERED A *BONA FIDE* ATTEMPT TO PROVIDE A COMPLETE REPLY. SEE 37 CFR 1.85(a) AMENDED EFFECTIVE NOVEMBER 29, 2000.

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
WASHINGTON, D.C. 20231
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DEC 05 2001

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

Paper No. 6

Nixon Peabody LLP
8080 Greensboro Drive, Suite 800
McLean, Virginia 22102

In re Application of: Jonathan Brunson)
Application No. 09/789,696)
Filed: February 22, 2001) **DECISION ON REQUEST FOR**
For: SYSTEMS AND METHODS FOR) **WITHDRAWAL AS ATTORNEY**
PERFORMING E-COMMERCE AND)
COMMUNICATIONS OVER A)
NETWORK)

This is a decision on the Request To Withdraw from Representation filed November 8, 2001.

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

The request is deficient in the following aspects: (1) the United States Patent and Trademark Office (Office) does not recognize firms - each attorney for whom withdrawal is requested must be individually listed; (2) there is no statement that Mr. Vick is signing on behalf and is ***authorized*** to sign on behalf of the other attorneys; (3) there is no indication that the applicant has been notified of the request for withdrawal. Therefore, the request is **DENIED**.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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FEB 01 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

Paper No. 8

Jason H. Vick
NIXON PEABODY LLP
8180 Greensboro Drive
Suite 800
McLean, Virginia 22102

In re Application of:	)	
Janathan E. BRUNSON	)	
Application No. 09/789,696	)	
Filed: February 22, 2001	)	
For: SYSTEMS AND METHODS FOR PERFORMING E-COMMERCE AND COMMUNICATIONS OVER A NETWORK	)	**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed December 14, 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.

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

cc: Jonathan E. Brunson
204 Duncan Road
Spring Lake, NC 28390

#6
6-6-03

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JUN 0 6 2003

TECHNOLOGY CENTER 2100

Paper No. 6

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

In re Application of: Roger K. Brooks	)	
Application No. 09/789,715	)	**DECISION ON REQUEST FOR**
Filed: February 20, 2001	)	**WITHDRAWAL AS ATTORNEY**
For: TRANSCASTING STREAMING MEDIA	)	
	)	

This is a decision on the Request To Withdraw from Representation filed May 27, 2003.

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

The request is **GRANTED**.

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

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

cc: Connie Wong, CEO
Vidiator Technology (US) Inc.
411 108th Ave NE - Suite 688
Bellevue, WA 98004

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

JAN 18 2006

Michael V. Drew
MeadWestvaco Corporation
299 Park Avenue Law department
New York, NY 10171

In re Application of
John A Gelardi
Application No. 09/789,757
Filed: February 22, 2001
For: MULTIPLE DISC PACKAGE

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on applicant's Petition to Withdraw the Holding of Abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office on May 6, 2005.

The petition is **DENIED**.

A review of the file record reveals that a Board of Patent Appeals and Interferences Decision was rendered on November 12, 2004 with a two-month response period. Applicant filed a response and a two month extension of time under 37 CFR 1.136(a) on April 4, 2005. The application was abandoned April 26, 2005.

Review of the file reveals that applicant filed his response to the Board Decision of November 12, 2004 after the two-month response period. This two-month shortened response period is not extendable under 37 CFR 1.136(a). Thus, the case is properly abandoned.

Applicant's petition, and evidence submitted, is insufficient to withdraw the holding of abandonment. Thus, there is no Office error and the application is properly abandoned.

The petition is **DENIED**.

for

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(571) 272-6619

RAR/jwk: 5/19/05

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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ARTHUR FREILICH
9045 CORBIN AVE, #260
NORTHRIDGE, CA 91324-3343

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JAN 0 5 2006

OFFICE OF PETITIONS

In re Application of :
Simmons, et al. :
Application No. 09/789,780 : ON PETITION
Filed: February 20, 2001 :
Attorney Docket No. **98/233** :

This is a decision on the petition under 37 CFR 1.78(a)(6) to accept the unintentionally delayed claim under 35 U.S.C §119(e) for the benefit of priority of the prior-filed provisional application set forth in the amendment filed concurrently with the instant petition.

The petition under 37 CFR 1.78(a)(6) is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(6) is only applicable to those applications filed on, or after, November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(5)(ii). In addition, the petition under 37 CFR 1.78(a)(6) must be accompanied by:

1. the reference required by 35 U.S.C § 119(e) and paragraph (a)(5) of this section to the prior-filed provisional 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 paragraph (a)(5)(ii) of this section and the date the claim was filed was unintentional.

The instant pending application was filed on February 20, 2001, and was pending at the time of the filing of the instant petition. A reference to the prior-filed provisional application has been included in an amendment to the first page of the specification, as required by 37 CFR 1.78(a)(5)(i).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed provisional application is submitted after the expiration of the period specified in 37 CFR 1.78(a)(5)(ii). 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. § 119(e). Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for benefit of priority under 35 U.S.C. § 119(e) to the prior-filed provisional application satisfies the conditions of 37 CFR 1.78(a)(6), 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)(6) should not be construed as meaning 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. § 119(e) 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 provisional application, accompanied this decision on petition.

This matter is being referred to Technology Center 2100, Art Unit 2137, for appropriate action on the amendment filed December 2, 2005, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 119(e) to the prior-filed provisional application.

Any inquiries concerning this decision may be directed to Kenya A. McLaughlin, Petitions Attorney, at (571)272-3222.

Frances Hicks
Petitions Examiner
Office of Petitions

Enclosure: Corrected Filing Receipt

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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JJGJR.: 06-05

Paper No: __

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

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JUN 27 2005

OFFICE OF PETITIONS

In re Application of :
Shteyn :
Application No. 09/789,906 : DECISION
Filing Date: 20 February, 2001 :
Attorney Docket No. US018019 :

This is a decision on the petition filed on 22 March, 2005, to revive the instant application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay, and, in light of the allegations, considered as a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

For the reasons set forth below, the petition:

- under 37 C.F.R. §1.181 is **DISMISSED**; and
- under 37 C.F.R. §1.137(b) is **DISMISSED**; and

NOTES:

(1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.137(b)."

(2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on7 July, 2004, with reply due absent extension of time on or before 7 October, 2004;
- the application went abandoned after midnight 7 October, 2004;
- the Office mailed the Notice of Abandonment on 25 February, 2005;
- Petitioner alleges but makes no documentary showing (*e.g.*, copy of paper and date-stamped receipt card (see: MPEP §503[1])) that Petitioner's Notice to the Office of a Change of Address was received and ignored by the Office, and caused the non-final Office action to be mailed by the Office to an outdated address for the Petitioner and Petitioner's non-receipt of the non-final Office action (a copy of the Office action is enclosed herewith);

---

[1] MPEP §503 provides in pertinent part:

§503 Application Number and Filing Receipt

* * *

A return postcard should be attached to *each* patent application for which a receipt is desired. It is important that the return postcard itemize all of the components of the application. If the postcard does not itemize each of the components of the application, it will not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO). It should be recognized that the identification of an application by application number does not necessarily signify that the USPTO has accepted the application as complete (37 C.F.R. §1.53(a)).

* * *

RETURN POSTCARD

If a receipt of any item (e.g., paper or fee) filed in the USPTO is desired, it may be obtained by enclosing with the paper a self-addressed postcard specifically identifying the item. The USPTO will stamp the receipt date on the postcard and place it in the outgoing mail. A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

The identifying data on the postcard should be so complete as to clearly identify the item for which receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify the type of paper being filed, e.g., new application, affidavit, amendment, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., and the number of pages being submitted. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. For example, merely listing on the postcard "a complete application" or "patent application" will not serve as a proper receipt for each of the required components of an application (e.g., specification (including claims), drawings (if necessary), oath or declaration and the application filing fee) or missing portions (e.g., pages, sheets of drawings) of an application if one of the components or portion of a component is found to be missing by the USPTO. Each separate component should be specifically and properly itemized on the postcard. Furthermore, merely incorporating by reference in the postcard receipt, the items listed in a transmittal letter will not serve as *prima facie* evidence of receipt of those items.

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all the items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the post-card initialed by the person receiving the items. Upon return of a postcard receipt from the USPTO, the postcard receipt should be promptly reviewed by the person who filed the items to ensure that every item specifically denoted on the postcard was received by the USPTO. If the postcard receipt has been annotated to indicate that a particular item denoted on the postcard was not received by the USPTO, the postcard receipt will not serve as *prima facie* evidence of receipt of that item in the USPTO. (Emphasis supplied.)

- Petitioner filed, contemporaneously with the instant petition (and fee) and made the statement of unintentional delay, but does not appear to have filed a reply to the Office action.

ANALYSIS

In a paper styled "Petition to Withdraw Holding of Abandonment Under 37 C.F.R. [§]1.137(b)"[2] (sic) Petitioner states: "Applicant's undersigned attorney erroneously believed that she submitted an amendment in response to the 12/3/03 [Office action] via facsimile. However, upon receipt of the Notice of Abandonment, Applicant's attorney notice the amendment for another application had been erroneously sent for the present application."(Petition, at page 1. Emphasis supplied.)

Thus, Petitioner acknowledges that the error was not that of the Office.

As to a Request to Withdraw
the Holding of Abandonment

Petitioner contends that the holding of abandonment should be withdrawn, and then makes no documentary support of the contention that the error in the matter was that of the Office, as would be required to support a request to withdraw the holding of abandonment under 37 C.F.R. §1.181.

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[3]

Thus, Petitioner also fails to satisfy the showing required under Delgar and thus to be considered

---

[2] Petitioner's attention is directed to MPEP §711.03(c)(I), which provides in pertinent part:

* * *

I. PETITION TO WITHDRAW HOLDING OF ABANDONMENT

A petition to revive an abandoned application * * * should not be confused with a petition from an examiner's holding of abandonment. Where an applicant contends that the application is not in fact abandoned (e.g., there is disagreement as to the sufficiency of the reply, or as to controlling dates), a petition under 37 CFR 1.181(a) requesting withdrawal of the holding of abandonment is the appropriate course of action, and such petition does not require a fee. 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 (accompanied by the appropriate petition fee) is necessary to revive the abandoned application.

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based on unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay. (Emphasis supplied.)

* * *

[3] See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

under the provisions of 37 C.F.R. §1.181.

As to Allegations
of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, the statement of unintentional delay, a proper reply, and–where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

Petitioner does not appear to have satisfied the reply requirement of a petition under 37 C.F.R. §1.137(b).

CONCLUSION

The petition:

- to withdraw the holding of abandonment under 37 C.F.R. §1.181 is **dismissed**; and
- under 37 C.F.R. §1.137(b) is **dismissed** and the petition fee ($1,500.00) is charged as authorized to Deposit Account 14-1270.

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

By mail: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(703) 872-9306
ATTN.: Office of Petitions

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

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

Encl: 1 July, 2004 Non-Final Office Action

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Paper No. 6

DAVID NEWMAN CHARTERED
CENTENNIAL SQUARE
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LA PLATA, MD 20646-2728

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APR 2 4 2003

OFFICE OF PETITIONS

In re Application of :
Elmer Yuen :
Application No. 09/789,958 : ON PETITION
Filed: February 22, 2001 :
Attorney Docket No. GBTI98US :

This is a decision on the petition under 37 CFR 1.137(b), filed February 3, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Corrected Application Papers mailed April 13, 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 June 14, 2001.

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

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

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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

20 MAY 2002

James F. Goedken
MARSHALL, O'TOOLE, GERSTEIN,
MURRAY & BORUN
6300 Sears Tower.
233 South Wacker Drive
Chicago, IL 60606-6402

In re Application of:
Robert John MITCHELL.
Application No. 09/790,001
Filed: February 21, 2001
For: SYSTEM FOR PROMOTING PRODUCTS

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

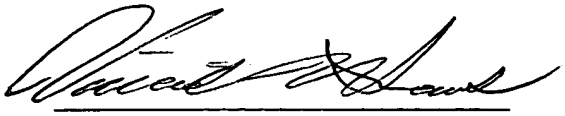
This is a decision on the Request To Withdraw from Representation filed January 29, 2002.

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.**

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

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
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#7

MARSHALL, O'TOOLE, GERSTEIN
MURRAY & BORUN
6300 Sears Tower
233 South Wacker Drive
Chicago, IL 60606-6402

MAILED

NOV 18 2002

Office of the Director
Group 3600

In re application of
Robert John Mitchell
Application No. 09/790,001 : DECISION ON REQUEST
Filed: February 21, 2001 : FOR WITHDRAWAL OF
For: SYSTEM FOR PROMOTING : ATTORNEYS
PRODUCTS

This is a decision on the request filed on June 19, 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. 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).

09/790,001

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks conditions (A) above. All the attorneys given power in the original Power of Attorney are not listed as withdrawn in the Request to Withdraw as Attorney. Also, the Request is signed by an attorney who has not been given power of attorney.

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

Rjb:11/8/02

UNITED STATES PATENT AND TRADEMARK OFFICE

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PRIEST & GOLDSTEIN
5015 SOUTHPARK DRIVE
SUITE 230
DURHAM NC 27713-7736

Certificate
SEP 23 2005
of Correction

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SEP 20 2005
OFFICE OF PETITIONS

In re Application Patent No. 6,369,313 :
Issue Date: April 9, 2002 :
Application No. 09/790,040 : DECISION ON PETITION
Filed: February 21, 2001 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 700.0006 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 24, 2005, to accept an unintentionally delayed claim under **35 U.S.C. § 120** for the benefit of priority to the prior-filed nonprovisional applications.

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.

---

[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 applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). 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 applications 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 prior-filed nonprovisional applications, accompanies this decision on petition.

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

This application is being forwarded to the Certificates of Correction Branch for appropriate processing of the requested Certificate of Correction.

Karen Creasy

Karen Creasy
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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PILLSBURY WINTHROP SHAW PITTMAN, LLP
P.O. BOX 10500
MCLEAN VA 22102

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DEC 11 2009

OFFICE OF PETITIONS

In re Patent No. 6,369,313	:	
Issue Date: April 9, 2002	:	
Application No. 09/790,040	:	ON PETITION
Filed: February 21, 2001	:	
Attorney Docket No. 700.0006	:	

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.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 19

KNOBBE, MARTENS, OLSON
& BEAR, LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH, CA 92660

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FEB 15 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of
Jonniaux et al.
Application No. 09/790,070
Filed: February 21, 2001
Attorney Docket No. VANM199.001AUS

This is a decision on the petition under 37 CFR 1.137(b), filed on January 10, 2002 (Certificate of Mailing date November 27, 2001), to revive the above-identified application.

The petition is **DISMISSED**.

The application was filed on February 21, 2001. On April 9, 2001, the Office of Initial Patent Examination (OIPE) mailed a Notice to File Missing Parts of Nonprovisional Application ("4/9/01 Notice"), stating that the following items were missing: an oath or declaration; a computer-readable form (CRF) copy of the sequence listing;[1] and a statement that the sequence listing information recorded on the CRF copy is identical to that in the paper copy submitted with the application on February 21, 2001.[2] Applicants were given an extendable 2-month reply period within which to submit the missing items.[3]

A Declaration and Power of Attorney was filed on June 29, 2001. On October 29, 2001, OIPE mailed a Notice of Incomplete Reply (Nonprovisional), advising Applicants that the statement and the CRF copy of the sequence listing, both required for compliance with the sequence rules in 37 CFR 1.821, were still missing. These items were not submitted during the 2-month reply period set forth in the 4/9/01 Notice, and no extension of time under 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on June 10, 2001 for failure to timely submit a proper and complete reply to the 4/9/01 Notice.[4] This petition precedes the mailing of a notice of abandonment.

---

[1] 37 CFR 1.821(e).

[2] 37 CFR 1.821(f).

[3] The 2-month period for responding to a Notice to File Missing Parts is not identified on the Notice as a statutory period subject to 35 U.S.C. 133. Thus, extensions under 37 CFR 1.136(a) of up to 5 months, i.e., through 11/9/01 at the maximum, are permitted. See MPEP 710.02(d) (Aug. 2001).

[4] See MPEP 2422.07 (Aug. 2001) (37 CFR 1.821(g) requires compliance with 37 CFR 1.821(b)-(f), at the time the application is filed or within the reply period set in a notice requiring compliance. Failure to comply will result in abandonment of the application.).

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); (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 the accompanying fee for a utility application filed before June 8, 1995, as required by 37 CFR 1.137(d).[5] As explained below, the instant petition lacks item (1), a proper and complete reply to the 4/9/01 Notice.

The instant petition encloses a substitute paper copy of the sequence listing with amendments; a statement that this substitute sequence listing does not contain new matter beyond the disclosure in the filed application;[6] a CRF copy of the sequence listing indicated as a "substitute" CRF copy of the sequence listing;[7] and a statement that the substitute sequence listing is the same as the "substitute" CRF copy of the sequence listing. However, the CRF copy of the sequence listing submitted with the instant petition is damaged, as indicated in the attached courtesy copy of the CRF Problem Report, rendering it impossible for the Office to determine its contents. The petition is thus dismissed.

A renewed petition (no fee), due within **TWO (2) MONTHS** from the mailing date of this decision,[8] **must** contain:

-a substitute CRF copy of the sequence listing;

-a statement that no new matter beyond the disclosure in the originally filed application is introduced;[9]

-a statement that the content of the substitute CRF copy of the sequence listing is the same as that in the substitute paper copy of the sequence listing submitted with the instant petition;[10]

and should be addressed to:

---

[5] Not applicable to this application.

[6] 37 CFR 1.821(g).

[7] The application as filed on 2/21/01 did not include a CRF copy of the sequence listing. Therefore, the CRF copy submitted with the instant petition is not a substitute.

[8] Extensions of time under 37 CFR 1.136(a) are permitted.

[9] Also see MPEP section 2422.07 (Aug. 2001).

[10] The paper copy does not need to be re-submitted unless further changes within the original disclosure are made.

Assistant Commissioner for Patents
Attn: 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 $1,280 petition fee, and a preliminary amendment.

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.

Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

RC Tang
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

#12

COMMISSIONER FOR PATENTS
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Paper No. 12

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& BEAR, LLP
620 NEWPORT CENTER DRIVE
SIXTEENTH FLOOR
NEWPORT BEACH, CA 92660

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JUN 05 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of
Jonniaux et al.
Application No. 09/790,070
Filed: February 21, 2001
Attorney Docket No. VANM199.001AUS

This is a decision on the renewed petition under 37 CFR 1.137(b), filed on March 15, 2002, to revive the above-identified application.

The petition is **GRANTED.**

The application became abandoned on June 10, 2001 for failure to timely comply with the sequence rules in 37 CFR 1.821 as required by an April 9, 2001 Notice to File Missing Parts of Nonprovisional Application ("4/9/01 Notice"). The January 10, 2002 petition to revive under 37 CFR 1.137(b) was dismissed on February 15, 2002 because the CRF copy of the sequence listing, which is one of the missing items noted in the 4/9/01 Notice, was damaged, rendering it impossible for the Office to determine its contents.

The instant renewed petition encloses: (1) a substitute CRF copy of the sequence listing, which has been entered; and (2) statements that no new matter beyond the disclosure in the originally filed application is introduced, and that the content of the substitute CRF copy of the sequence listing is the same as that in the substitute paper copy of the sequence listing submitted with the January 10, 2002 petition. Applicants have fully complied with the 4/9/01 Notice. The renewed petition is thus granted.

No petition fee is owed.

The application file is being forwarded to Technology Center 1600 for examination in due course.

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

RC Tang
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KNOBBE MARTENS OLSON & BEAR
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

COPY MAILED

NOV 0 8 2004

OFFICE OF PETITIONS

In re Application of :
Jean-Luc Jonniaux et al :
Application No. 09/790,070 :
Filed: February 21, 2001 :
Attorney Docket No. VANM199.001AUS :

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 matter is being referred to Technology Center AU 1652.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

PENNIE & EDMONDS LLP
1667 K STREET N.W.
WASHINGTON, DC 20006

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MAY 0 8 2002

OFFICE OF PETITIONS

In re Application of :
Klaus Stehle et al :
Application No. 09/790,113 : LETTER
Filed: February 21, 2001 :
Attorney Docket No. 10628-003-999 :

This is in response to the paper filed April 29, 2002 under 37 CFR 1.27(c) seeking status as a small entity.

The Statement Claiming Small Entity Status of April 29, 2002 has been made of record and small entity status has been accorded.

The application file is being forwarded to Technology Center 2100.

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
DIW 08-01

Paper No. 4

AUDLEY A. CIAMPORCERO JR.
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

COPY MAILED

AUG 2 1 2001

OFFICE OF PETITIONS

In re Application of :
Shelley et al. :
Application No. 09/790,122 : DECISION GRANTING PETITION
Filed: 21 February, 2001 :
Attorney Docket No. CRD-0890 :

This is a decision on the petition filed on 7 May, 2001, requesting that the above-identified application, including pages 2 and 12 of the specification, be accorded a filing date of 21 February, 2001.

On 21 February, 2001, the application was filed.

On 10 April, 2001, Initial Patent Examination Division mailed a "Notice of Omitted Item(s) in a Nonprovisional Application" stating that the application had been accorded a filing date of 21 February, 2001, but that pages 2 and 12 of the specification (description and claims) appeared to have been omitted.

In response, on 7 May, 2001, a copy of the application, the present petition, and authorization to charge the petition fee were filed. Petitioners argue that pages 2 and 12 were filed with the other application papers on 21 February, 2001, but were subsequently misplaced in the U.S. Patent and Trademark Office (Office). In support, a copy of petitioners' postcard receipt was supplied on 21 February, 2001. The postcard receipt shows an Office date stamp of 21 February, 2001, and acknowledges receipt of 13 pages of specification. Petitioners request that the application, including pages 2 and 12, be accorded a filing date of 21 February, 2001.

A review of the record reveals that no page 2 and 12 of the specification have been located among the application papers deposited on 21 February, 2001. However, the evidence is convincing that the application papers deposited on 21 February,

2001, included page 2 and 12 of the specification, which were subsequently misplaced in the Office. Therefore, the application, including pages 2 and 12 of the specification, is entitled to a filing date of 21 February, 2001.

The "Notice of Omitted Item(s)" mailed on 10 April, 2001, was sent in error and is hereby vacated.

In view of the above, the petition is granted. No petition fee has been charged and none is due.

The application will be processed and examined using the copy of pages 2 and 12 supplied on 7 May, 2001. The copy of the other application papers supplied with the present petition will not be used for processing or examination, but will be retained in the application file.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 21 February, 2001, using the application papers filed on 21 February, 2001, and the copy of pages 2 and 12 filed on 7 May, 2001.

Telephone inquires should be directed to Petitions Attorney Douglas I. Wood at 703-308-6918.

for Manuel Antonakas

Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SCULLY SCOTT MURPHY & PRESSER
400 GARDEN CITY PLAZA
GARDEN CITY NY 11530

COPY MAILED

OCT 0 7 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Toru Kido et al :
Application No. 09/790,235 :
Filed: February 21, 2001 :
Attorney Docket No. 14339 :

This is a decision on the petition, filed September 10, 2004, and supplemented on October 6, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on July 15, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The application will be forwarded to Technology Center AU 2682 to 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).

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

BARNES & THORNBURG
1313 MERCHANTS BANK BUILDING
11 SOUTH MERIDIAN STREET
INDIANAPOLIS, IN 46204

COPY MAILED

JUN 14 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of :
Tatsuto Ono et al. :
Application No. 09/790,266 : NOTICE
Filed: February 21, 2001 :
Attorney Docket No. 29554-67781 :

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 2100.

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

Michael J. Marcin
FAY KAPLUN & MARCIN, LLP
150 Broadway, Suite 702
New York, NY 10038

MAILED

MAY 15 2007

Technology Center 2100

In re Application of:
Remi COTE, et al.
Application No. 09/790,283
Filed: February 22, 2001
For: SYSTEM AND METHOD FOR DYNAMIC ADDITION AND REMOVAL OF OBJECT INTERFACES

DECISION ON PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the petition, filed on 17 August 2005, under 37 CFR § 1.181(a) to withdraw the holding of abandonment of the above-identified application.

The petition is **GRATNED**.

This application was held abandoned for failure to timely file a proper response to the final Office Action mailed 26 January 2004. A Notice of Abandonment was mailed on 25 July 2005.

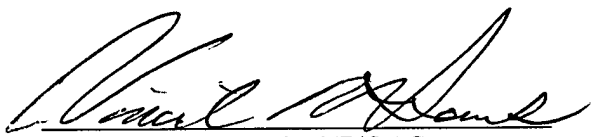
Petitioner states that a Notice of Appeal and Petition for One-Month Extension of Time was in fact timely facsimile transmitted on 20 May 2004. To support this assertion, petitioner provides a copy of the "Auto-Reply Facsimile Transmission" which acknowledges receipt by the U.S. Patent and Trademark Office (USPTO) on 20 May 2004. The copy of the "Auto-Reply Facsimile Transmission" Sheet did list (1) Notice of Appeal, (2) a Transmittal and (3) an Amendment. The Transmittal included an authorization to charge one-month extension fee. Petitioner also provides copies of the Notice of Appeal, the Petition for One-month Extension of Time and the Amendment filed on 20 May 2004.

The original Notice of Appeal and Petition for One-month Extension of Time, acknowledged as having been received in the USPTO on 20 May 2004, is not of record in the application.
The copies of the original Notice of Appeal, the Petition for One-month Extension of Time and the Amendment are considered timely

For the above stated reasons, the petition is **GRANTED**. The Notice of Abandonment mailed 25 July 2005 is hereby withdrawn.

The application is being forward to the Technology Center Support Staff to process and enter the Amendment, the Notice of Appeal and the Appeal Brief filed 22 July 2004. From there, the application will be forwarded to examiner for appropriate action.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.



Vincent N. Trans, SPRE/QAS
Technology Center 2100
Computer Architecture, Software, and
Information Security

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Baker Botts L.L.P.
44th Floor
30 Rockefeller Plaza
New York, NY 10112-4498

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NOV 16 2005

OFFICE OF PETITIONS

In re Application of :
Stuart Aaronson, et al. :
Application No. 09/790,284 : ON PETITION
Filed: February 22, 2001 :
Attorney Docket No. AP33017070165.0584 :

This is a decision on the petition filed June 30, 2005, under 37 CFR 1.137(b), which is being treated as a petition under 37 CFR 1.181, to withdraw the holding of abandonment.

The petition is **GRANTED**.

A Final Office action was mailed to application on September 24, 2004, which set a three-month shortened statutory period for reply. As no reply was allegedly received, the application became abandoned on December 25, 2004.

Petitioner asserts that a Request for Continued Examination (RCE), an amendment, and a request for three-month extension of time, were filed via certificate of mailing under the provisions of 37 CFR 1.8 on March 24, 2005. However, there was a typographical error in the application number on the RCE, but the application number was correct on the other documents.

A review of the file record shows that the RCE was associated with the application, in spite of the incorrect application number being listed. Furthermore, there were enough identifiers on the documents for the Office to correctly associate the papers with the proper file.

In view of the above, the application was improperly held abandoned. Since the petition to revive is unnecessary, the fee of $750 will be credited to petitioner's deposit account in due course.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

The application file is being referred to Technology Center 1600 for consideration of the RCE received in the Office on March 28, 2005.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions

OIPE JC10 FEB 28 2002 PATENT & TRADEMARK OFFICE

1645 1600 0300 sector 1 #5

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
09/790,289	02/23/2001	Caroline Barry	68 US2 CIP

CONFIRMATION NO. 7809

FORMALITIES LETTER

OC000000007251438

RECEIVED
APR 15 2002
TECH CENTER 1600/2900

COPY OF PAPERS ORIGINALLY FILED

John Lucas, Ph.D., J.D.
GENSET CORP.
10665 Sorrento Valley Road
San Diego, CA 92121-1609

Date Mailed: 01/02/2002

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is missing.
  A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) of $130 for a non-small entity, must be submitted with the missing items identified in this letter.
- **The balance due by applicant is $ 130.**

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

03/05/2002 JADDO1 00000049 09790289

01 FC:105 130.00 OP

#5

Docket/Matter No. 68.US2.CIP

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
APR 15 2002
TECH CENTER 1600/2900

In re the Application of:		
Applicant	: Caroline Barry, Ilya Chumakov	Grp./A.U. : 1645
Appl. No.	: 09/790,289	Examiner : Unassigned
Filed	: February 21, 2001	
Title	: PG-3 AND BIALLELIC MARKERS THEREOF	

COPY OF PAPERS ORIGINALLY FILED

Assistant Commissioner of Patents
Box: Missing Parts
Washington, D.C. 20231

RESPONSE TO THE NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

Sir:

In response to the Notice To File Missing Parts Of Nonprovisional Application dated January 2, 2002, enclosed please find the following documents:

	Document	Quantity
1)	Copy of the Notice To File Missing Parts Of Nonprovisional Application	1 page
2)	Declarationfor Utility or Design Patent Application signed by Caroline Barry and Ilya Chumakov	2 pages
3)	Our check in the amount of $130.00 in payment of the surcharge	
4)	Assignment executed by Caroline Barry and Ilya Chumakov; Assignment Recordation Cover Page	3 pages
5)	Our check in the amount of $40.00 in payment of the recordation fee	
6)	Return Receipt Postcard	

Please charge any additional fees, or credit overpayment to Deposit Account No. 50-1181.

RECEIVED
APR 15 2002
TECH CENTER 1600/2900

Respectfully submitted,

GENSET CORPORATION

Date: 2/13, 2002 By: John Lucas

John Lucas, Ph.D., J.D.
Reg. No. 43,373

10665 Sorrento Valley Road
San Diego, CA 92121-1609

Telephone: (868) 597-2610
Facsimile: (858) 597-2600
e-mail: john.lucas@genxy.com

Certificate of Mailing

Date of Deposit: February 14, 2002

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, on the Date of Deposit shown above, postage prepaid and in an envelope addressed to the Assistant Commissioner for Patents, Box Missing Parts, Washington, D.C. 20231.

John McClure
Signature

C H McClure
Typed or Printed Name of Person Signing Certificate

OIPE JC105
FEB 28 2002
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APR 15 2002
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#5

Please type a plus sign (+) inside this box → [+]

PTO/SB/21 (08-00)
Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

Application Number	09/790,289
Filing Date	February 21, 2001
First Named Inventor	Caroline BARRY, et al.
Group Art Unit	1645
Examiner Name	Unassigned
Attorney Docket Number	68.US2.CIP

ENCLOSURES *(check all that apply)*

- [x] Fee Transmittal Form
  - [x] Fee Attached
- [ ] Amendment / Reply
  - [ ] 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
  - [x] Response to Missing Parts under 37 CFR 1.52 or 1.53
- [x] Assignment Papers *(for an Application)*
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] Petition to Convert to a Provisional Application
- [ ] Power of Attorney, Revocation Change of Correspondence Address
- [ ] Terminal Disclaimer
- [ ] Request for Refund
- [ ] CD, Number of CD(s) _____
- [ ] After Allowance Communication to Group
- [ ] Appeal Communication to Board of Appeals and Interferences
- [ ] Appeal Communication to Group *(Appeal Notice, Brief, Reply Brief)*
- [ ] Proprietary Information
- [ ] Status Letter
- [x] Other Enclosure(s) *(please identify below)*: Return Receipt Postcard

Remarks

COPY OF PAPERS ORIGINALLY FILED

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm *or* Individual name	John Lucas, Ph.D., J.D. Reg. No. 43,373
Signature	John Lucas
Date	2/13/02

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, DC 20231 on this date: FEB. 14, 2002

Typed or printed name	C. M. McClure		
Signature	C. M. McClure	Date	02/14/2002

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, 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.

#5

OIPE JC105
FEB 28 2002
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PTO/SB/17 (10-01)
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TECH CENTER 1600/2900

FEE TRANSMITTAL for FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT ($) 170.00

Complete if Known	
Application Number	09/790,289
Filing Date	February 21, 2001
First Named Inventor	Caroline BARRY, et al.
Examiner Name	Unassigned
Group Art Unit	1645
Attorney Docket No.	68.US2.CIP

METHOD OF PAYMENT

1. ☐ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number: 50-1181

Deposit Account Name: Genset Corp.

☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status. See 37 CFR 1.27

2. ☒ **Payment Enclosed:**

☒ Check ☐ Credit card ☐ Money Order ☐ Other

FEE CALCULATION

1. BASIC FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
101	740	201	370	Utility filing fee	
106	330	206	165	Design filing fee	
107	510	207	255	Plant filing fee	
108	740	208	370	Reissue filing fee	
114	160	214	80	Provisional filing fee	

SUBTOTAL (1) ($) 0.00

2. EXTRA CLAIM FEES

			Extra Claims		Fee from below	= Fee Paid
Total Claims		-	=	X		=
Independent Claims		-	=	X		=
Multiple Dependent						=

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
103	18	203	9	Claims in excess of 20
102	84	202	42	Independent claims in excess of 3
104	280	204	140	Multiple dependent claim, if not paid
109	84	209	42	** Reissue independent claims over original patent
110	18	210	9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($) 0.00

**or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	130
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for *ex parte* reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	400	216	200	Extension for reply within second month	
117	920	217	460	Extension for reply within third month	
118	1,440	218	720	Extension for reply within fourth month	
128	1,960	228	980	Extension for reply within fifth month	
119	320	219	160	Notice of Appeal	
120	320	220	160	Filing a brief in support of an appeal	
121	280	221	140	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidable	
141	1,280	241	640	Petition to revive - unintentional	
142	1,280	242	640	Utility issue fee (or reissue)	
143	460	243	230	Design issue fee	
144	620	244	310	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Processing fee under 37 CFR 1.17(q)	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	40.00
146	740	246	370	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	740	249	370	For each additional invention to be examined (37 CFR § 1.129(b))	
179	740	279	370	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	

Other fee (specify) _____

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($) 170.00

SUBMITTED BY

Complete *(if applicable)*

Name (Print/Type)	John Lucas, Ph.D., J.D.	Registration No. (Attorney/Agent)	43,373	Telephone	(858) 597-2600
Signature	John Lucas			Date	2/13/02

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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AMB 05-03

Paper No. 14

Russell E. Fowler, II
ICE MILLER
One American Square
Box 82001
Indianapolis, IN 46282-0002

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MAY 0 5 2003

OFFICE OF PETITIONS

In re Application of
Bori, et al.
Application No. 09/790,335
Filed: February 22, 2001
Attorney Docket No.: D-126
For: ELECTRIC MACHINE END TURN CONNECTORS

PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed February 11, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTH** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency decision.

The application became abandoned April 23, 2001 for failure to timely reply to the Notice to File Corrected Application Papers ("Notice") mailed February 22, 2001. The Notice set a two (2) month shortened statutory period of time for reply. Notice of Abandonment was mailed January 11, 2003.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition lacks item (3) set forth above. Petitioner has failed to present a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a) was unavoidable.

The Office may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 C.F.R. 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533 at 538, 213 U.S.P.Q. (BNA) 977 at 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 U.S.P.Q. 2d 1130 (N.D. Ind. 1987).

Petitioner attributes the delay in timely responding to the Notice to a docketing error made by a paralegal. Petitioner, however, has failed to establish that the docketing error was the sole cause of the delay at issue.

In accordance with MPEP 700.03(c), a delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that: (1) the error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (3) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

Petitioner states that a reliable routine was in place. According to petitioner, the business routine in place involves use of the PATTSY docketing system wherein USPTO deadlines are entered into the PATTSY system. Docket entries made by paralegals are reviewed by a registered patent attorney. Petitioner further states that after a paralegal makes a docket entry, the file is delivered to the attorney responsible for the file, along with a printout of the PATTSEY record that includes the new docket entry. Petitioner states this process serves as a "double checking procedure" to help ensure that clerical docket entries made by paralegals are

correct.

Petitioner states that the entry in question was made by Colleen McPherson who has more than five (5) years experience in petitioner's intellectual property group. McPherson declares that upon receipt of a filing receipt for the instant application, she "mistakenly failed to docket the substitute drawing deadline associated with the Notice to File Corrected Application Papers that was included with the filing receipt." McPherson further declares that due to this docketing error the attorney then responsible for the instant application never received notice on his weekly docket report that substitute drawings were due on or before May 22, 2001.

While petitioner has established that a docketing error occurred, it cannot be said that the docketing error caused the delay in responding to the Notice. The business routine in place, as described by both petitioner and McPherson, would seem to mandate attorney oversight of docket entries made by McPherson, a paralegal. Such oversight would have involved a review of the docket entry made by McPherson by the attorney assigned to the instant application. Such a review would have revealed the docket entry error. Hence, the delay in responding to the Notice must be attributed to the attorney charged with reviewing docket entries made by paralegals. An act or omission on the part of an attorney cannot constitute unavoidable delay. Such action, while perhaps unintentional in nature, precludes a finding of unavoidable delay, even if such action was the result of a good faith error. See, In re Maldague, 10 USPQ2d 1477, 1478 Comm'r Pat. 1988).

ALTERNATE VENUE

Petitioner may wish to consider filing a petition stating that the entire delay was unintentional. Petitioner's attention is directed to 37 C.F.R. § 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 C.F.R. § 1.137(b) must be accompanied by the required petition fee, statement of unintentional delay, reply, and, if applicable, a terminal disclaimer (and fee).

The filing of a petition under 37 C.F.R. § 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to

revive under 37 C.F.R. § 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 C.F.R. § 1.137(b).

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

By mail:	**Mail Stop Petition** 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 may be directed to the undersigned at (703) 305-0310.

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

Paper No. 8

Russell E. Fowler, II
ICE MILLER
One American Square
Box 82001
Indianapolis, IN 46282-0002

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OCT 1 5 2003

OFFICE OF PETITIONS

In re Application of	:	
Bori, et al.	:	DECISION ON APPLICATION FOR
Application No. 09/790,335	:	PATENT TERM ADJUSTMENT
Filed: February 22, 2001	:	
Atty. Dkt. No.: D-126	:	

This is a decision on the renewed petition under 37 CFR 1.137(b) filed May 22, 2003.

The application became abandoned April 23, 2001 for failure to timely reply to the Notice to File Corrected Application Papers ("Notice") mailed February 22, 2001, 2001. The Notice set a two (2) month shortened statutory period for reply. Notice of Abandonment was mailed January 11, 2003. A petition under 37 CFR 1.137(a) was filed February 11, 2003 and dismissed May 5, 2003.

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 Notice mailed February 22, 2001 is accepted as having been unintentionally delayed.

This application is being forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding the content of this decision should be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

7/1/08

Patent No. :7310618
Ser. No. :09/790374
Inventor(s) :Brian L. Libman
Issued : 12/18/07
Title : AUTOMATED LOAN EVALUATION SYSTEM
Docket No. :

Re: Request for Certificate of Correction

Consideration has been given your request for the issuance of a certificate of correction for the above-identified patent under the provisions of Rule(s) 1.322 and/or 1.323.

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

MORGAN LEWIS & BOCKIUS LLP
1111 PENNSYLVANIA AVE. N.W.
WASHINGTON, D.C. 20004

HR

UNITED STATES PATENT AND TRADEMARK OFFICE

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MORGAN LEWIS & BOCKIUS, LLP
1111 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20004

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OFFICE OF PETITIONS

In re Patent No. 7,310,618 :
Issue Date: December 18, 2007 :
Application No. 09/790,374 : ON PETITION
Filed: February 21, 2001 :
Patentee(s): Brian L. Libman :

This is a decision on the request under 37 CFR 3.81[1] filed September 19, 2008, to correct the name of the assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

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.

Finance records show that petitioner's deposit account was charged $130 twice for the processing fee on June 3, 2008 and again on September 19, 2008. However, since a renewed request under 37 CFR 3.81 requires no further fee, $130 will be refunded to petitioner's deposit account.

Since the address given in the instant petition differs from the address of record, a courtesy copy of this decision is being mailed to the address given in the petition.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3226. Inquiries regarding the issuance of a Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

Andrea Smith
Petitions Examiner
Office of Petitions

cc: David C. Lee
Morgan, Lewis & Bockius, LLP
101 Park Avenue
New York, NY 10178

[1] *See Official Gazette of June 22, 2004*

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FISH & RICHARDSON PC
P O BOX 1022
MINNEAPOLIS, MN 55440-1022

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OFFICE OF PETITIONS

In re Application of :
Richard A. Dreissigacker et al :
Application No. 09/790,432 : DECISION GRANTING PETITION
Filed: February 21, 2001 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 06337-004002 :

This is a decision on the petition, filed June 30, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 8, 2006 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 3764 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the Information Disclosure Statement.

Frances Hicks
Petitions Examiner
Office of Petitions

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

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ASHLEY LAURENT, INC.
5914 W. COURTYARD DRIVE
SUITE 200
AUSTIN, TX 78730

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OFFICE OF PETITIONS

In re Application of :
Yang, Xuechen :
Application No. 09/790,437 : ON PETITION
Filed: February 21, 2001 :
Attorney Docket No. M-16823 US :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 9, 2007, to revive the above-identified application.

The petition is **GRANTED.**

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an Amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the response has been accepted as having been unintentionally delayed.

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 solely to the address currently of record until such time as appropriate instructions are received to the contrary.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

This matter is being referred to Technology Center 2600 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3206.

Liana Walsh
Petitions Examiner
Office of Petitions

Cc:

TOM CHEN
MACPHERSON KWOK CHEN & HEID LLP
2033 GATEWAY PLACE, SUITE 400
SAN JOSE, CA 95110

UNITED STATES PATENT AND TRADEMARK OFFICE

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MACPHERSON KWOK CHEN & HEID LLP
2033 GATEWAY PLACE
SUITE 400
SAN JOSE CA 95110

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OFFICE OF PETITIONS

In re Application of	:	
Yang, Xuechen	:	
Application No. 09/790,437	:	DECISION ON PETITION
Filed: February 21, 2001	:	
Attorney Docket No. M-16823 US	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed March, 28, 2008, 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 the Issue Fee Transmittal with payment of the issue and publication fees, (2) the petition fee, and (3) a proper statement of unintentional delay.

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. 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 the Office of Data Management for processing into a patent.

Liana Walsh
Petitions Examiner
Office of Petitions

cc:

TOM CHEN
MACPHERSON KWOK CHEN & HEID LLP
18200 VON KARMEN, SUITE 725
IRVINE, CA 92612

UNITED STATES PATENT AND TRADEMARK OFFICE

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GLENN PATENT GROUP
3475 EDISON WAY, SUITE L
MENLO PARK, CA 94025

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SEP 02 2008

In re Application of :
FLINT, Andrew et al. :
Application No. 09/790,453 : DECISION ON PETITION
Filed: February 22, 2001 : TO WITHDRAW
Attorney Docket No. **ISAA0006** : 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 May 01, 2008.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to Glenn Patent Group has been revoked by the applicant of the patent application on June 03, 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 Michelle R. Eason at 571-272-4231.

Michelle R. Eason
Paralegal Specialist
Office of Petitions

cc: **MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C**
ATTN: PATENT INTAKE CUSTOMER NO. 76615
ONE FINANCIAL CENTER
BOSTON MA 02111

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P.O. Box 1450
Alexandria, VA 22313-1450
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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Clarence A. Green
Perman & Green
425 Post Road
Fairfield CT 06430

In re Application of
Jukka Vialen, et al.
Application No. 09/790,469
Filed: February 22, 2001
For: **METHOD AND ARRANGEMENT FOR OPTIMIZING THE RE-ESTABLISHMENT OF CONNECTIONS IN A CELLULAR RADIO SYSTEM SUPPORTING REAL TIME AND NON-REAL TIME COMMUNICATIONS**

DECISION ON PETITION
TO WITHDRAW HOLDING OF
ABANDONMENT

This is a decision on the petition filed October 21, 2005 which is being treated as a Petition to Withdraw Holding of Abandonment pursuant to 37 C.F.R.§ 1.181(a). No fee is required.

The application was abandoned, inadequately noted by the examiner as "Note PTOL-461", which ultimately is a form for notifying appellant of a defective Notice of Appeal or Defective Brief". In the instant case, a review of the file record does not reveal an Appeal Brief. Therefore, apparently the application was abandoned for failure to file appellant's brief. A Notice of Abandonment was mailed October 6, 2005.

Petitioner asserts that a proper response was timely filed. In support of the petition, Petitioner has submitted, a copy of Appellant's Brief and a date-stamped post card receipt evidencing receipt of the Brief within the United States Patent & Trademark Office, Board of Patent Appeals and Interferences on May 13, 2005.

The original correspondence filed was not matched with the file and cannot be located. However, M.P.E.P. § 503 states, "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the U.S.PTO of all the items listed thereon on the date stamped thereon by the PTO." Accordingly, it is concluded that the response was timely filed in the Patent and Trademark Office but not matched with the application file.

In view of the above stated reasons, the holding of abandonment is withdrawn.

The petition is **GRANTED.**

The application file will be forwarded TC2600's Technical Support Staff for entry of the Brief which accompanied the petition; thereafter it will be forwarded to the examiner for consideration in appropriate turn.

Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

STMICROELECTRONICS, INC.
1310 ELECTRONICS DRIVE, MS 2346
CARROLLTON TX 75006-5039

In re Application of	:	
Francois Talliet	:	DECISION ON PETITION TO
Application No. 09/790,504	:	WITHDRAW HOLDING OF
Filed: 30 November, 1999	:	ABANDONMENT
FOR: GENERAL PROTECTION OF AN	:	
INTEGRATED CIRCUIT AGAINST	:	
PERMANENT OVERLAODS AND	:	
ELECTROSTATIC DISCHARGES	:	

This is a decision on the petition filed on 12 May, 2006 (certificate of mailing date 16 February, 2006), to withdraw the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the Notice to File Missing Parts of Nonprovisional Application mailed on 11 April, 2001, which set a two (2) month shortened period for reply. On 16 August, 2001 (certificate of mailing date 13 August, 2001), a reply including a declaration, a two (2) month extension of time, and authorization to charge the basic filing fee and additional claim fee(s) to counsel's deposit account was filed. A petition under 37 CFR 1.181 to withdraw the Notice was also filed.

On 22 April, 2005, a decision dismissing the petition to withdraw the Notice was mailed. The decision indicated that the Office of Initial Patent Examination would charge the basic filing fee, additional claim fee(s), and late-filing surcharge to counsel's deposit account.

On 19 December, 2005, a Notice of Abandonment Under 37 CFR 1.53(f) or (g) was mailed, stating the application became abandoned for failure to timely file a reply to the Notice mailed on 11 April, 2001. Specifically, the Notice of Abandonment stated that no reply had been received.

Petitioner asserts that a response to the Notice mailed on 11 April, 2001, was timely filed. Specifically, petitioner cites the reply filed on 16 August, 2001 (certificate of mailing date 13 August, 2001) as a timely and proper reply.

On review, petitioner's contention is well taken. A review of the file reveals that the response received on 16 August, 2001 (certificate of mailing date 13 August, 2001), included a declaration, a two (2) month extension of time,[1] and authorization to charge the statutory basic filing fee and any additional claim fee(s) and "any under or over payment" to counsel's deposit account.

As such, the showing of record is that a proper and timely response to the Notice mailed on 11 April, 2001, was filed on 16 August, 2001.

The showing of record is that a response was timely filed, and there is no abandonment in fact. Any inconvenience caused to applicant is regretted.

The holding of abandonment is withdrawn, and the Notice of Abandonment is vacated.

The statutory basic filing fee, additional claim fee(s), and late-filing surcharge required by the Notice mailed on 11 April, 2001, will be charged by the Office of Initial Patent Examination in due course.

The application is being referred to the Office of Initial Patent Examination for further processing, including charging the proper fees to counsel's deposit account.

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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[1] As 11 August, 2001, fell on a Saturday, the response filed with a certificate of mailing dated 13 August, 2001, was timely filed.

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. Box 1450
Alexandria, VA 22313-1450
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PRAXAIR, INC.
LAW DEPARTMENT - M1 557
39 OLD RIDGEBURY ROAD
DANBURY, CT 06810-5113

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JAN 23 2008

OFFICE OF PETITIONS

In re Application of :
Victor Sedov :
Application No. 09/790,585 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. 20999-1 :

This is a decision on the petition under 37 CFR 1.137(b), filed on October 24, 2007, to revive the above-identified application.

The application became abandoned for failure to timely respond to the Notice of Allowance and Fee(s) Due mailed June 21, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b), in that, petitioner has supplied (1) the reply in the form of $1,440 for payment of the issue fee; (2) the petition fee of $1,540; and (3) a proper statement of unintentional delay. Therefore, the petition is **GRANTED**.

As authorized, $30 for ten (10) advance order soft copies submitted on October 24, 2007 has been charged to petitioner's deposit account.

This application file is being referred to the Office of Data Management to be processed into a patent.

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

Andrea Smith
Petitions Examiner
Office of Petitions

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

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OFFICE OF PETITIONS

In re Application of :
Tomoko Eguchi et al :
Application No. 09/790,601 : DECISION GRANTING PETITION
Filed: February 23, 2001 : UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 35.C15155 :

This is a decision on the petition, filed October 6, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on September 10, 2001 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 2878 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

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

Paper No.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

COPY MAILED

JAN 0 9 2006

OFFICE OF PETITIONS

In re Patent No. 6,794,365	:	DECISION ON REQUEST
Al-Obeidi et al.	:	FOR RECONSIDERATION OF
Issue Date: September 21, 2004	:	PATENT TERM ADJUSTMENT
Application No. 09/790,641	:	and
Filed: February 23, 2001	:	NOTICE OF INTENT TO ISSUE
Atty Docket No. 02481.1736	:	CERTIFICATE OF CORRECTION

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed November 18, 2004. Patentees request that the patent term adjustment indicated in the patent be corrected from one hundred forty-six (146) days to one hundred eighty-two (182) days. The status request filed December 21, 2005 is acknowledged. The instant petition was recently forwarded to the undersigned for consideration.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **one hundred eighty-two (182)** days.

On September 21, 2004, the above-identified application matured into U.S. Patent No. 6,794,365. The instant request for reconsideration filed November 18, 2004 was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 146 days.

Patentees dispute the reduction of 36 days due to "Workflow-Drawings finished" as there were no drawings in the case. Patentees assert that the only reduction warranted is for 29 days for applicant delay in filing a response to the final rejection mailed April 13, 2004.

Patentees are correct. A review of the PALM calculations for this application reveals that the initial determination of PTA of 154 days was increased by 28 days for the Office taking in excess of three years to issue the patent (3 years and 211 days), but reduced by 36 days for applicants' submission of drawings after the mailing of the notice of allowance. See 37 CFR 1.704(c)(10). However, a review of the application record supports a conclusion that no drawings (or any other paper, aside from the instant petition) were filed in this application after the mailing of the notice of allowance. There were no drawings in this application.

In view thereof, the patent term adjustment indicated in the patent should have been one hundred eighty-two (182) days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by ONE HUNDRED EIGHTY-TWO (182) days.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

COPY MAILED

MAR 11 2009

OFFICE OF PETITIONS

In re Application of :
Hirayama, et al. :
Application No. 09/790,660 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. 1794-0133P :
For: INALGAN EMITTING LIGHT IN ULTRAVIOLET SHORT-WAVELENGTH REGION AND PROCESS FOR PREPARING THE SAME AS WELL AS ULTRAVIOLET LIGHT-EMITTING DEVICE USING THE SAME

This is a decision on the petition under 37 CFR 1.181, filed September 26, 2008, requesting that the Office withdraw the holding of abandonment of the above-identified application.

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

This application became abandoned as a result of petitioners' alleged failure to timely file a proper follow-up submission within two (2) months of the Notice of Appeal filed February 27, 2008. A Notice of Abandonment was mailed on September 5, 2008.

Petitioners request withdrawal of the holding of abandonment based on the assertion that a petition for a five month extension of time and an Appeal Brief were timely filed on September 26, 2008. The undersigned finds this argument completely convincing, as these documents are present in the application file and Office financial records show that the required five month extension of time fee and the required Appeal Brief fee were charged on mailroom date September 26, 2008. Per 37 CFR 41.37 and MEP 1205.01, the two month period to file an Appeal Brief, or other appropriate submission, after the filing of a Notice of Appeal, is extendable up to 5 months. Therefore, the five month extension of time and the Appeal Brief were timely filed on September 26, 2008 .

The petition under 37 CFR 1.181 is **granted**, the holding of abandonment is withdrawn, and the September 5, 2008 Notice of Abandonment is **vacated**. No petition fee has been or will be charged in connection with this matter.

The application file will be forwarded to Technology Center A.U. 2811 for consideration of the Appeal Brief, filed on September 26, 2008.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

Dorsey & Whitney, LLP
Intellectual Property Department
370 Seventeenth Street
Suite 4700
Denver, CO 80202-5647

MAIL

OCT 0 9 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:)
Kelly J. WICAL)
Application No. 09/790,668)
Filed: February 23, 2001)
For: SWITCHED SESSION MANAGEMENT USING LOCAL PERSISTENCE IN AN AUTOMATED AND DISTRIBUTED REPLICATION SYSTEM)

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed September 3, 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 Lance L. Vietzke alone and does not contain a clear indication that Mr. Vieztke 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.

FOR

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

Paper No. 6

MAR 1 0 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Sean S. Wooden
DORSEY & WHITNEY LLP
1001 Pennsylvania Avenue, N.W.
Suite 400 South
Washington, DC 20004

In re Application of:
Kelly J. Wical
Application No. 09/790,668
Filed: February 23, 2001
For: SWITCHED SESSION MANAGEMENT USING LOCAL PERSISTENCE IN AN AUTOMATED AND DISTRIBUTED REPLICATION SYSTEM

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed February 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 February 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: Pat Lennon, General Counsel
NO BOUNDARIES NETWORK, INC.
6639 Southpoint Parkway
Suite 104
Jacksonville, FL 32216

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 27

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

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JUN 0 9 2004

OFFICE OF PETITIONS

In re Application of
Patrick J. Finlay et al
Application No. 09/790,676
Filed: February 23, 2001
Attorney Docket No. 2105.2230

: DECISION GRANTING PETITION
: UNDER 37 CFR 313(c)(2)

This is a decision on the petition, filed June 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 March 2, 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.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 3727 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment and Information Disclosure Statement.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 28

Date : June 9, 2004

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of **Application No. 09/790,676**

Applicant(s) : Patrick J. Finlay et al
Application No. : 09/790,676
Filed : February 23, 2001

The above-identified application has been assigned Patent No. 6,755,317 and an issue date of June 29, 2004.

It is hereby directed that this application be withdrawn from issue at the request of the applicant. Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of June 29, 2004:

"All reference to Patent No. 6,755,317 to Patrick J. Finlay et al of Connecticut for CONTAINER WITH STRUCTURAL RIBS appearing in the Official Gazette of June 29, 2004 should be deleted since no patent was granted."

Frances Hicks

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

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

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Commissioner for Patents
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Alexandria, VA 22313-1450
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DIW Apr-07

CAPITOL PATENT & TRADEMARK LAW FIRM, PLLC.
P.O. BOX 1995
VIENNA VA 22183

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APR 25 2007

OFFICE OF PETITIONS

In re Application of :
Patil et al. : DECISION ON PETITION
Application No. 09/790,677 :
Filed: 23 February, 2001 :
Attorney Docket No. METHODS AND :
SYSTEMS FOR TRACKING WIRELESS :
DEVICES :

This is a decision in reference to the "PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR 1.181(a) et seq." filed on 1 February, 2007.

The petition is **GRANTED**.

The application became abandoned on 13 April, 2006, for failure to timely file a response to the non-final Office action mailed on 12 January, 2006, which set a three (3) month statutory period for reply. Notice of Abandonment was mailed on 16 August, 2006.

Petitioners assert that a Change of Correspondence Address was filed on 2 December, 2003, but that the Office action mailed on 12 January, 2006, was subsequently mailed to the previous address of record due to Office error.

A review of the official record reveals on 23 February, 2001, a declaration and power of attorney was filed appointing John E. Curtin, Reg. No. 37,602, as an associate attorney.[1] On 2 December, 2003, a change of correspondence address signed by attorney Curtin was filed. However, the change of correspondence address was never entered, and all correspondence continued to be mailed to the previous address. As such, the Office action mailed on 12 January, 2006, was sent to the previous address. As such, the showing of record is that the Office erred in mailing the non-final Office action mailed on 12 January, 2006,

[1] MPEP 403.01 states that the associate attorney may specify or change the correspondence address to which communications about the application are to be directed. Associate powers of attorney are not accepted after June 25, 2004, but any associate power of attorney filed before June 25, 2004, will continue to have effect.

to the previous address rather than the current correspondence address. As the error in mailing is due to an Office error, it is appropriate to remail the non-final Office action to the current correspondence address.

As such, there is no abandonment in fact. The holding of abandonment is withdrawn, and the Notice of Abandonment is vacated.

The Office apologizes for any inconvenience to petitioner.

The revocation and power of attorney and change of correspondence address is accepted. All future correspondence will be mailed to the new address of record.

The application is referred to the Technology Center Technical Support Staff for remailing of the non-final Office action mailed on 12 January, 2006. The time period for reply to the Office action will be reset to run from the date the non-final Office action is remailed.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

Encl: Notice Regarding Change of Power of Attorney
Notice of Acceptance of Power of Attorney

#6 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

OCT 21 2002

Dorsey & Whitney, LLP
Intellectual Property Department
370 Seventeenth Street
Suite 4700
Denver, CO 80202-5647

MAILED

OCT 21 2002

Office of the Director
Group 3600

In re application of
Kelly J. Wical
Application No. 09/790,680 :
Filed: February 23, 2001 :
For: CACHING SYSTEM USING TIMING QUEUES BASED ON LAST ACCESS TIME :

DECISION ON REQUEST FOR WITHDRAWAL OF ATTORNEY

This is a decision on the request filed on September 12, 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. 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 conditions A) and B) above.

As to condition 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, since this office does not recognize law firms.

As to condition B), the reason given, "that the assignee is in bankruptcy and therefore cannot pay legal fees" is not acceptable. While non-payment of fees is a valid reason for withdrawal under 37 CFR 10.40(c)(1)(vi), the mere fact of a client declaring bankruptcy is not. Furthermore, there is no indication in the file record of the assignee being the "client", and responsible for payment of legal fees. The file record would appear to indicate that the applicant is the client by virtue of his conferring power of attorney to the attorneys listed in the declaration.

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868
Facsimile No.: (703) 605-0586

snm: 10/20/02

#8 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

MAR 19 2003

Dorsey & Whitney, LLP
Intellectual Property Department
370 Seventeenth Street
Suite 4700
Denver, CO 80202-5647

MAILED

MAR 19 2003

OFFICE OF THE DIRECTOR
TC 3600

In re application of
Kelly J. Wical
Application No. 09/790,680 :
Filed: February 23, 2001 :
For: CACHING SYSTEM USING TIMING QUEUES BASED ON LAST ACCESS TIME :

DECISION ON REQUEST FOR WITHDRAWAL OF ATTORNEY

This is a decision on the renewed request filed on February 10, 2003, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

Under 37 CFR 1.36 an attorney may withdraw only upon application to and approval by the Commissioner. It should be noted that a withdrawal is effective when approved, not when filed. Besides giving due notice to his or her client and delivering to the client all papers and property to which the client is entitled as specified under 37 CFR 10.40, approval of such a request requires that the following conditions be met:

A) Each attorney of record must sign the notice of withdrawal, or the notice must contain a clear indication of one attorney signing on behalf of another, because the Office does not recognize law firms;

B) A proper reason for the withdrawal as enumerated in 37 CFR 10.40(b) or subsection (1)-(6) of 37 CFR 10.40(c) must be provided; and

C) If withdrawal is requested in accordance with 37 CFR 10.40(c) above, there must be at least 30 days between approval of the withdrawal and the later of the expiration date of a time period for reply or the expiration date of the period which can be obtained by a petition and fee for extension of time under 37 CFR 1.136(a).

A request for withdrawal as attorney was filed on September 12, 2002. The request was not approved in a decision mailed October 21, 2002 wherein it was held that the above identified application lacked conditions A) and B) above.

The renewed request to withdraw as attorney is not accepted in the above-identified application because the request still lacks conditions A) and B) above.

As to condition A), there is a single attorney signing the request on behalf of attorneys associated with Customer Nos. 20686 and 27082. There are currently ten attorneys of record in this application based upon the original declaration. However, four of the ten attorneys are not associated with either customer numbers. If less than all the attorneys wish to withdraw and a portion of the originally listed attorneys wish to retain power, any renewed request must so state, otherwise the person signing must be signing on behalf of all the attorneys of record.

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 for

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868
Facsimile No.: (703) 605-0586

SNM/tpl: 3/14/03

#3

Sector

OTPE 3615
APR 23 2001
PATENT & TRADEMARK

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NUMBER
09/790,746	02/22/2001	Hideji Tajima	10287.40

CONFIRMATION NO. 5184

FORMALITIES LETTER

OC000000005887104

WARREN B. KICE
Haynes and Boone LLP
Suite 3100
901 Main Street
Dallas, TX 75202-3789

Date Mailed: 03/21/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of $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 $ 65.**

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

04/25/2001 BSAYAS11 00000022 09790746
01 FC:205 65.00 OP

OIPE JC16
APR 23 2001
PATENT & TRADEMARK OFFICE

#3

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Registered application of:		: Group Art Unit:	2851
Inventor Name:	Hideji Tajima	: Examiner:	TBD
Serial Number:	09/790,746	: Case:	10287.40
Filed:	February 22, 2001	: Warren B. Kice HAYNES AND BOONE, L.L.P.	
Title:	APPARATUS FOR POSITIONING SUBSTANCES FOR DETECTION AND FILM FOR POSITIONING SUBSTANCES FOR DETECTION AND MANUFACTURING METHOD OF CARRIER FOR SUBSTANCES FOR DETECTION	: 901 Main Street, Suite 3100 : Dallas, Texas 75202-3789	

RESPONSE AND TRANSMITTAL OF NOTICE OF MISSING PARTS OF APPLICATION

Commissioner of Patents
ATTENTION: BOX MISSING PARTS
Washington, D. C. 20231

Dear Sir:

In response to the Notice of Missing Parts of Application Filing Date Granted mailed **March 21, 2001** regarding the above-identified application, enclosed are the following:

1. The return copy of the Notice of Missing Parts of Application;
2. executed Declaration;
3. an original and one copy of this Transmittal letter;
4. check in the amount of $65.00;
5. a return postcard.

The Commissioner is hereby authorized to charge any further fees associated with this communication or to credit any overpayment to Deposit Account No. 08-1394.

Respectfully submitted,

Date: 4/18/01

Warren B. Kice
Registration No.22,732

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231

on April 19, 2001
Sandra Kubin
SANDRA KUBIN

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

Vonnie Chism Hill
4566 Benoit Drive
Memphis, TN 38141

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NOV 0 8 2005

OFFICE OF PETITIONS

In re Application of :
Vonnie Chism Hill :
Application No. 09/790,778 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. N/A :

This is a decision on the petition under 37 CFR 1.137(b), filed September 14, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency 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(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 Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item(s) (1).

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of October 22, 2004. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the

filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b). A copy of the Examiner's Advisory Action is attached herewith.

In reviewing the application file, it appears that applicant is somewhat unfamiliar with the patent prosecution procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection of the invention disclosed. Applicant is **strongly** advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The USPTO cannot aid in selecting an attorney or agent. Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U. S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U. S. Government Printing Office, Washington, D.C. 20402. A list of registered attorneys is also available on the USPTO web site at www.uspto.gov.

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

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

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

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3223.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions

Attachment: Copy of Examiner's 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

VONNIE CHISM HILL
4566 BENOIT DRIVE
Memphis TN 38141

COPY MAILED
MAR 16 2006
OFFICE OF PETITIONS

In re Application of :
Vonnie Chism HILL :
Application No. 09/790,778 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed March 1, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed July 28, 2004, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 29, 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 Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item(s) (1).

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of July 28, 2004. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2)), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination (RCE) and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). Since the amendment submitted does not *prima facie* place the application in condition for allowance, the reply required must be a Notice of Appeal (and appeal fee), RCE, or the filing of a continuing application under 37 CFR 1.53(b). See the enclosed PTOL-303.

The Office regrets any confusion which may have resulted from the error in the previous decision which stated that "the above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed October 22, 2004". The final Office action was, in fact, mailed July 28, 2004 to petitioner's current correspondence address.

In reviewing the application file, it appears that petitioner is somewhat unfamiliar with patent prosecution procedure. For petitioner's convenience a copy of sections 714.12 and 714.13 of the Manual Of Patent Examination Procedure (MPEP) are being enclosed. These sections of the MPEP discuss the procedures for handling an amendment after final rejection.

Furthermore, while an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection of the invention disclosed. Petitioner is strongly advised to secure the services of a registered patent attorney or agent to prosecute the application, since the value of a patent is largely dependent upon skilled preparation and prosecution. The USPTO cannot aid in selecting an attorney or agent. Applicant is advised of the availability of the publication "Attorneys and Agents Registered to Practice Before the U. S, Patent and Trademark Office." This publication is for sale by the Superintendent of documents, U. S. Government Printing Office, Washington, D.C. 20402. A list of registered attorneys is also available on the USPTO website at www.uspto.gov.

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

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

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

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-7099.

David Bucci
Petitions Examiner
Office of Petitions

Encl.: Advisory Action Before the Filing of an Appeal Brief, PTOL-303
MPEP Sections 714.12 and 714.13

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/790,778	**Applicant(s)** HILL, VONNIE CHISM	
	Examiner Mark Fadok	**Art Unit** 3625	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1,2 and 5*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Continuation of 3. NOTE: As noted in the previous office action the subject matter that applicant chooses to introduce defines an invention that is distinct from the original. .

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

VONNIE CHISM HILL
4566 BENOIT DRIVE
Memphis TN 38141

COPY MAILED

FEB 0 5 2007

OFFICE OF PETITIONS

In re Application of	:	
Vonnie Chism Hill	:	
Application No. 09/790,778	:	ON PETITION
Filed: February 23, 2001	:	
Attorney Docket No.	:	

This is a decision on the request for reconsideration under the unintentional provisions of 37 CFR 1.137(b), filed 06/20/2006, 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 July 28, 2004. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extensions of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is October 29, 2004.

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, and the submission required by 37 CFR 1.114; (2) the petition fee of $750; and (3) a proper statement of unintentional delay.

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 AU3625 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.

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 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 appropriate instructions are received to the contrary.

David Bucci
Petitions Examiner
Office of Petitions

cc: Edwina Thomas Washington,
111 South Highland Street, Suite 262
Memphis, TN 38111

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5-12-2005

TO SPE OF : ART UNIT 3751

SUBJECT : Request for Certificate of Correction on Patent No.: 6,866,437 / 09790794

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.

Magdalene Talley

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:

JUSTINE R. YU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. 6,866,437 B2

DATED: March 15, 2005

INVENTOR: Jean-Louis H. GUERET

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

Claim 31, at col. 9, line 45, replace "claim 1," with --claim 1;--;

Claim 31, at col. 9, line 46, replace "portion the" with --portion of the--; and

Claim 35, col. 9, line 67, replace "an" with --and--.

MAILING ADDRESS OF SENDER

Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
901 New York Avenue, N.W.
Washington, D.C. 20001-4413

Patent No. 6,866,437 B2

No. of additional copies
@ .30¢ per page

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

YOUNG & THOMPSON
745 SOUTH 23RD STREET
2ND FLOOR
ARLINGTON VA 22202

COPY MAILED

JUN 14 2005

OFFICE OF PETITIONS

In re Application of :
Autere et al. :
Application No. 09/790,807 : DECISION ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. P00337US :

This is a decision on the petition under 37 CFR 1.137(b), filed April 8, 2005, to revive the above-identified application.

This above-identified application became abandoned for failure to timely file a reply to a non-final Office Action mailed August 26, 2004. The non-final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR 1.136(a). Accordingly, this application became abandoned on November 27, 2004. This decision precedes the mailing of a Notice of Abandonment.

This petition is hereby **GRANTED**.

The Office hereby acknowledges the receipt of the amendment and drawings submitted with the instant petition.

This application is being 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

Bruce M. Green
Oyen Wiggs Green & Mutala
601 West Cordova Street, #480
Vancouver, BC V6B 1G1
CANADA

COPY MAILED

NOV 0 3 2003

OFFICE OF PETITIONS

In re Application of :
Dan R. Bulley :
Application No. 09/790,870 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. D311 0001 :

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

The petition is granted.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the Notice to File Missing Parts of Non-Provisional Application (Notice) mailed March 19, 2001. A Two (2) month extension of time under the provisions of 37 CFR 1.136 was received on July 30, 2001. Accordingly, the application became abandoned on July 31, 2001.

The application file is being forwarded to the Office of Initial Patent Examination 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
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

EZRA L. SCHACHT
1620 WEST MAIN STREET
HOUSTON TX 77006-4712

COPY MAILED

NOV 1 0 2008

OFFICE OF PETITIONS

In re Application of	:	
Jesse Mungia	:	
Application No. 09/790,995	:	ON PETITION
Filed: February 22, 2001	:	
Attorney Docket No. MUNG/0001	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 28, 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 February 6, 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). A one (1) month extension of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is June 7, 2007. The Notice of Abandonment was mailed November 27, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $405, and the submission required by 37 CFR 1.114; (2) the petition fee of $770; and (3) a proper statement of unintentional delay.

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

This application is being referred to Technology Center AU 3692 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Chris Bottorff
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Steven C. Becker
FOLEY & LARDNER
Firstar Center
777 East Wisconsin Avenue
Milwaukee, WI 53202-5367

COPY MAILED

JUL 16 2009

OFFICE OF PETITIONS

In re Application of	:	
Karl-Heinz Krause	:	
Application No. 09/790,998	:	DECISION ON PETITION
Filed: February 22, 2001	:	TO WITHDRAW
Attorney Docket No. 089339-0315	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed June 9, 2009.

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 James G. Morrow on behalf of all attorneys of record. All attorneys/agents have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

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

Terri Williams
Petitions Examiner
Office of Petitions

cc: **Karl-Heinz Krause**
Augraben 41
Nuernberg, 90475
Germany

cc: **Siemens c/o John Musone**
4400 Alafaya Trail
Orlando, FL 32826-2399

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
09/790,998	02/22/2001	Karl-Heinz Krause	089339-0315

CONFIRMATION NO. 4489

POWER OF ATTORNEY NOTICE

Steven C. Becker
FOLEY & LARDNER
Firstar Center
777 East Wisconsin Avenue
Milwaukee, WI 53202-5367

Date Mailed: 07/15/2009

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 06/09/2009.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

/tswilliams/

Office of Data Management, Application Assistance Unit (571) 272-4000, or (571) 272-4200, or 1-888-786-0101

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

William R. Gustavson
Suite 1185
9330 LBJ Freeway
Dallas, TX 75243

MAILED

JUN 05 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re Application of :
Donald R. Smith :
Application No. 09/791,051 :
Filed: February 22, 2001 :
For: WALL ADAPTER :

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

This is in response to applicant's petition to withdraw the holding of abandonment, filed in the United States Patent and Trademark Office on January 27, 2003 and supplemented on May 27, 2003.

The petition is **GRANTED**.

A review of the file record indicates that an Office action was mailed on July 8, 2002 wherein a three-month shortened statutory period for response was set. Since no timely response to the July 8, 2002 Office action was received, the application was held to be abandoned, although a Notice of Abandonment has not yet been mailed.

Applicant's petition includes a copy of a response having a Certificate of Mailing dated October 8, 2002. A statement by William R. Gustavson was received on May 27, 2003, which attests to the personal knowledge of mailing the response on the date indicated on the Certificate of Mailing. 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
Special Programs Examiner
Patent Technology Center 3600
Telephone No.: (703) 308-2121
Facsimile No.: (703) 605-0586

RAR/tpl: 5/28/03

OIPE JC144 SEP 1 3 2001 PATENT & TRADEMARK OFFICE

Attorney's Docket No. 9022.24 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Boles, et al.
Serial No.: 09/791,125
Filed: 22 February 2001
For: *METHOD FOR DETECTING MITOCHONDRIAL DYSFUNCTION*

September 10, 2001

BOX MISSING PARTS
Commissioner for Patents
Washington, DC 20231

SUBMITTAL OF DECLARATION UNDER 37 C.F.R. § 1.63

Sir:

In response to the Notice to File Missing Parts dated May 23, 2001, enclosed is a Declaration and Power of Attorney for the above-identified application which has been executed by the named inventors.

A check in the amount of $65.00 is enclosed to cover the surcharge under 37 C.F.R. § 1.16(e). Any additional fee or credit may be charged to our Deposit Account No. 50-0220.

Respectfully submitted,

Kenneth D. Sibley
Registration No. 31,665

20792
PATENT TRADEMARK OFFICE

Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box Missing Parts, Commissioner for Patents, Washington, DC 20231, on September 10, 2001.

Vickie Diane Prior

Vickie Diane Prior
Date of Signature: September 10, 2001

☒ A check in the amount of 195.00 to cover the fee is enclosed.

☐ Payment by credit card (Form PTO-2038) is enclosed.

☐ Charge Deposit Account No. 50-0220 for any additional extension and/or fee required or credit for any excess fee paid.

Respectfully submitted,

Kenneth D. Sibley
Registration No. 31,665

20792
PATENT TRADEMARK OFFICE

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Box Missing Parts, Commissioner For Patents, Washington, DC 20231, on September 10, 2001.

Vickie Diane Prior
Date of Signature: September 10, 2001

OIPE SEP 13 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
09/791,125	02/22/2001	Richard G. Boles	9022.24

CONFIRMATION NO. 7362

20792
MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

FORMALITIES LETTER

OC000000006106243

Date Mailed: 05/23/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is missing.
  A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of $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 $ 65.**

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

09/14/2001 EABUBAK1 00000040 09791125
01 FC:205 65.00 OP

09/791125

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 12/15/04

TO SPE OF : ART UNIT 1634

SUBJECT : Request for Certificate of Correction on Patent No.: 6,759,196

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.

Certificates of Correction Branch

Thank You For Your Assistance

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

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

Comments:

The mistake was an inadvertant omission by the examiner in the examiner's amendment.

Jehanne Sitton
JEHANNE SITTON
PRIMARY EXAMINER
4/21/05

W. Gary Jones
Supervisory Patent Examiner
Technology Center 1600
SPE

1634
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

Best Available Copy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 6/8/04

Paper No.: ~~#~~ 19

TO SPE OF : ART UNIT: 1623

SUBJECT : Request for Certificate of Correction on Patent No.: 6077336

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.

yes!!

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:

Requested change(s) are to correct typos.

EB
6/10/04

SPE

1623
Art Unit

Best Available Copy

SCAN! **Please forward case and paper to address shown below.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 8/8/08

TO SPE OF : ART UNIT 1624 James Wilson

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/791134 Patent No.: 6671336

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.

☑ Approved — All changes apply.

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

☐ Denied — State the reasons for denial below.

Comments: Request to correct apparent printing errors in claims 24 and 27 is reasonable.

EB
8/12/08

James O. Wilson
SPE

1624
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 7/24/08 Paper No.: _____

TO SPE OF : ART UNIT 1624

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/791134 Patent No.: 6677336

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580
You can fax the Directors/SPE response to 571-270-9990

_____
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: _____

_____

_____

_____

_____

_____ 1624

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 1/22/09

TO SPE OF : ART UNIT 1624 James Wilson

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/791134 Patent No.: 6677336

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 Look at First Certificate of Correction FOR Claim 26. Thanks

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: 2nd Submission for Scanning

JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

SPE

1624
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

IBM CORPORATION
INTELLECTUAL PROPERTY LAW
11501 BURNET ROAD
AUSTIN, TX 78758

COPY MAILED

JAN 21 2009

In re Application of
Rabindranath Dutta et al
Application No. 09/791,152
Filed: February 22, 2001
Attorney Docket No. AUS920010028US1

ON PETITION

This is a decision on the petition filed December 10, 2008 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 submit the Issue fee and Publication fee in a timely manner in reply to the Notice of Allowance mailed August 18, 2008, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on November 19, 2008.

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 issue fee is accepted as having been unintentionally delayed.

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

This matter is being referred to the Office of Data Management 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
P. O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

U.S. PATENT OPERATIONS/RBW
DEPT. 4300, M/S 27-4-A
AMGEN, INC.
ONE AMGEN CENTER DRIVE
THOUSAND OAKS, CA 91320-1799

COPY MAILED

MAY 0 2 2008

OFFICE OF PETITIONS

In re Application of :
Rajendra V. Deshpande et al :
Application No. 09/791,153 : ON PETITION
Filed: February 22, 2001 :
Attorney Docket No. A-633A :

This is a decision on the petition under 37 CFR 1.137(b), filed December 19, 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 Restriction Requirement mailed February 22, 2007 which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on March 23, 2007.

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

This matter is being referred to Technology Center AU 1644 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COOK ALEX McFARRON MANZO
CUMMINGS & MEHLER LTD
SUITE 2850
200 WEST ADAMS STREET
CHICAGO IL 60606

MAILED

JUL 19 2010

OFFICE OF PETITIONS

In re Patent No. 7,612,753
Jun Koyama
Application No. 09/791,182
Issue Date: November 3, 2009
Filed: February 23, 2001
Attorney Docket No. SEL 240

: DECISION ON
: REQUEST FOR RECONSIDERATION
: of PATENT TERM ADJUSTMENT
: and
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the petition under 37 CFR 1.705(d), filed December 31, 2009, requesting that the patent term adjustment indicated on the above-identified patent be corrected to indicate that the term of the above-identified patent is extended or adjusted by eight hundred forty-nine (849) days.

The petition to correct the patent term adjustment indicated on the above-identified patent to indicate that the term of the above-identified patent is extended or adjusted by eight hundred forty-nine (849) days is **GRANTED**.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by **eight hundred forty-nine (849)** days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Cliff Congo, at (571) 272-3207.

Anthony Knight
Supervisor
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,612,753 B2

DATED : **November 3, 2009**

INVENTOR(S) : Koyama

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 511 days.

Delete the phrase "by 511 days" and insert – by 849 days--

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 4-22-05

TO SPE OF : ART UNIT 2882

SUBJECT : Request for Certificate of Correction on Patent No.: 6863440

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 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:

The requested changes to col. 12, lines 7-9, and Col. 12, line 9, cannot be entered because they delete the limitation to "ear locator."

SPE 2882 **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. : 6,863,440

DATED : March 8, 2005

INVENTOR(S) : Sildve et al.

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

Col. 9, line 26, change "the" to --a--.

Col. 10, line 42, delete "aligned with and rotatable about" to --positioned in--.

Col. 11, line 55, after "providing" insert --a--.

N/E Col. 12, lines 7-9, delete "step of providing includes providing at least one ear locator aligned with the axis of rotation and".

N/E Col. 12, line 9, after "rotation" (second occurrence) insert --and rotates--.

Col. 12, line 28, change "patent" to --patient--.

MAILING ADDRESS OF SENDER:

PATENT NO. 6,863,440

No. of additional copies

This collection of information is required by 37 CFR 1.322, 1.323, and 1.324. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: **Attention Certificate of Corrections Branch, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 10122005

DATE : 10-6-05

09791189

TO SPE OF : ART UNIT 2882

SUBJECT : Request for Certificate of Correction on Patent No.: 6863440

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.

Can 2nd request be Approved

E Yam

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:

_____

_____

_____

_____

_____

_____ 2882

SPE **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

MAILED

MAR 11 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

André L. Marais
Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Boulevard, 7th Floor
Los Angeles, CA 90025-1026

Paper No. 6

In re application of
Jay Farhat et al.
Application No. 09/791,239
Filed: February 21, 2001
For: METHOD AND SYSTEM TO FACILITATE FINANCIAL SETTLEMENT OF SERVICE ACCESS BETWEEN MULTIPLE PARTIES

: **DECISION ON PETITION**
: **TO MAKE SPECIAL**
: **(ACCELERATED EXAMINATION)**

This is in response to the renewed petition filed on December 13, 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 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**.

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703) 308-2121

rar/tpl: 2/26/03

05-21-02 09/791,254 - 052002 0360

Express Mail Label No.: EV058165502US
Date of Deposit: May 20, 2002

Attorney Docket No. 15966-652 (CURA-152)

OIPE SC117 MAY 2 0 2002 PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS:	Peyman et al.		
SERIAL NUMBER:	09/791,254	EXAMINER:	Not Yet Assigned
FILING DATE:	February 23, 2001	ART UNIT:	1646
TITLE:	Novel Nuclear Factor Polypeptides and Nucleic Acids Encoding Same		

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

TRANSMITTAL LETTER

Transmitted herewith for filing in the above-identified application are the following documents:

Copy of Notice to File Corrected Application Papers (1 page);
Statement in Support of Substitute Specification (1 page);
Response to Notice to File Corrected Application Papers (1 page);
Substitute Specification (113 pages); and
Return postcard.

The Commissioner is hereby authorized to charge any fee that may be due, or to credit any overpayment, to Deposit Account No. 50-0311, Reference No. 15966-652 (CURA-152). A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

KE Kyle, Reg No 44,848

Date: May 20, 2002

Ivor R. Elrifi, Reg. No. 39,529
Attorney for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

30623
PATENT TRADEMARK OFFICE

TRA 1670097v1

Express Mail Label No. EV058165502US Date of Deposit: May 20, 2002

09791254 .052002

OIPE
MAY 2 0 2002
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
09/791,254	02/23/2001	John A. Peyman	15966-652 (Cura-152)

CONFIRMATION NO. 2685

FORMALITIES LETTER

OC000000007689235

IVOR R. ELRIFI
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY and POPEO, P.C.
One Financial Center
Boston, MA 02111

Date Mailed: 03/21/2002

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.

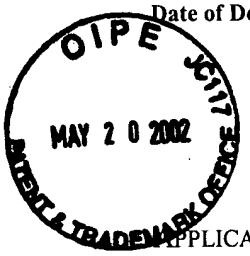
Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

09/791254 - 052002

Express Mail Label No.: EV058165502US
Date of Deposit: May 20, 2002

Attorney Docket No. 15966-652 (CURA-152)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS:	Peyman, et al.		
SERIAL NUMBER:	09/791,254	EXAMINER:	Not Yet Assigned
FILING DATE:	February 23, 2001	ART UNIT:	1646
FOR:	Novel Nuclear Factor Polypeptides and Nucleic Acids Encoding Same		

May 20, 2002
Boston, Massachusetts

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS

In response to the Notice To File Corrected Application Papers mailed March 21, 2002, Applicants submit herein a copy of the Notice to File Corrected Application Papers, Substitute Specification (113 pages); and a Statement in Support of Substitute Specification (1 page). This filing is in compliance with 37 C.F.R. §§ 1.121(b)(3), 1.125.

Please replace the previously filed specification with the attached substitute specification, pages 1-113.

This response is due on or before May 21, 2002. Although Applicants believe no fees are due with this filing, the Commissioner is authorized to charge any fees that may be due to Deposit Account No. 50-0311, Reference No. 15966-652 (CURA-152).

Respectfully submitted,

I.R. Elrifi, Reg No 44,848

Ivor R. Elrifi, Reg. No. 39,529
Attorney for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

Express Mail Label No.: EV058165502US
Date of Deposit: May 20, 2002

Attorney Docket No. 15966-652 (CURA-152)

OIPE C117
MAY 20 2002
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS:	Peyman, *et al.*		
SERIAL NUMBER:	09/791,254	EXAMINER:	Not Yet Assigned
FILING DATE:	February 23, 2001	ART UNIT:	1646
FOR:	Novel Nuclear Factor Polypeptides and Nucleic Acids Encoding Same		

STATEMENT IN SUPPORT OF SUBSTITUTE SPECIFICATION
(37 CFR 1.125(b)(1))

Pursuant to 37 CFR 1.125(b)(1), I hereby state that the content of the substitute specification and the specification filed on February 23, 2001 are the same. Applicants hereby submit this substitute specification in response to the Notice to File Missing Parts mailed on March 21, 2002, which specifically requested a substitute specification in compliance with 37 CFR 1.52. The correction of the margins is the only amendment made to the specification at this time. Thus, this submission includes no new matter.

Applicants believe that no fee is required for the filing of the present submission. However, the Commissioner is hereby authorized to charge any additional fees that may be due, or credit any overpayment, to Deposit Account No. 50-0311, Ref. No.15966-652 (CURA-152).

Respectfully submitted,

K E Elrifi, Reg No. 44,848

Ivor R. Elrifi, Reg. No. 39,529
Attorney for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

Date: May 20, 2002

09/15/01 ~ # 0300

Express Mail Label No.: EL831680565US
Date of Deposit: September 13, 2001

PATENT APPLICATION
Attorney Docket No. 15966-652 (Cura-152)

Box Seq

OIPE
SEP 13 2001
PATENT & TRADEMARK

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS :	Peyman et al.		
SERIAL NUMBER :	09/791,254	EXAMINER :	Not Yet Assigned
FILING DATE :	February 23, 2001	ART UNIT :	Not Yet Assigned
FOR :	NOVEL NUCLEAR FACTOR POLYPEPTIDES AND NUCLEIC ACIDS ENCODING SAME		

BOX SEQUENCE
Assistant Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL LETTER

Transmitted herewith in response to the June 13, 2001, Notice to Comply, in the present application are the following documents:

1. Copy of NOTICE TO COMPLY form (1 page);
2. Preliminary Amendment (1 page);
3. Sequence Listing (32 pages);
   a. Statement in Support of CRF (1 pg.);
   b. Electronic Copy (1 disk);
4. Petition for One-Month Extension of Time (1 page);
5. Check #10170 in the amount of $55.00 to cover the Petition fee; and
6. Return Postcard.

Applicants believe the Response to Notice to Comply is due on or before September 13, 2001, with the one-month extension. Although Applicants believe that no further fees are due in connection with this submission, the Commissioner is authorized to credit any overpayment or charge any deficiencies to Deposit Account No. 50-0311, Reference No. 15966-652 (Cura-152). A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

Dated: September 13, 2001

Ivor R. Elrifi, Reg. No. 39,529
Kristin E. Konzak, Reg. No. 44,848
Attorney/Agent for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

OIPE JC127 SEP 13 2001 PATENT & TRADEMARK OFFICE

Express Mail No: EL831680565US Mailed: September 13, 2001

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
09/791,254	02/23/2001	John A. Peyman	15966-652 UTILITY (Cura-1

CONFIRMATION NO. 2685

MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY and POPEO, P.C.
One Financial Center
Boston, MA 02111

RECEIVED
JUN 18 2001
MINTZ LEVIN, BOSTON
PATENT DOCKET DEPT.

FORMALITIES LETTER

OC000000006179029

Date Mailed: 06/13/2001

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:

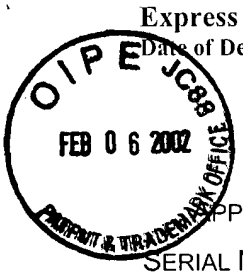
- **For Rules Interpretation, call (703) 308-4216**
- **To Purchase PatentIn Software, call (703) 306-2600**
- **For PatentIn Software Program Help, call (703) 306-4119 or e-mail at patin21help@uspto.gov or patin3help@uspto.gov**

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202
PART 2 - COPY TO BE RETURNED WITH RESPONSE

Express Mail Label No.: EK005153737US
Date of Deposit: February 6, 2002

PATENT APPLICATION
Attorney Docket No. 15966-652 (CURA-152)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS :	Peyman et al.		
SERIAL NUMBER :	09/791,254	EXAMINER :	Not Yet Assigned
FILING DATE :	February 23, 2001	ART UNIT :	1646
FOR :	NOVEL NUCLEAR FACTOR POLYPEPTIDES AND NUCLEIC ACIDS ENCODING SAME		

BOX MISSING PARTS
Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO NOTICE TO FILE MISSING PARTS

In response to the Notice To File Missing Parts mailed November 19, 2001, Applicants submit herein the executed Combined Declaration and Powers of Attorney; payment of the surcharge of $65.00 as set forth in 37 C.F.R. §1.16(e); a copy of Notice to File Missing Parts, Petition for One-Month Extension of Time; and payment of the One-Month Extension of Time of $55.00. This response is due on or before February 19, 2002, with a one-month extension.

The Commissioner is authorized to charge any additional fees that may be due, or credit any overpayment of same, to Deposit Account No. 50-0311, Reference No. 15966-652 (CURA-152).

Respectfully submitted,

Date: February 6, 2002

Leon M. Coughlin Reg. No. 48,593
for Ivor R. Elrifi, Reg. No. 39,529
Attorney/Agent for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

TRA 1626877v1

02-08-02

Express Mail Label No.: EL[redacted]153737US
Date of Deposit: February 6, 2002

PATENT APPLICATION
Attorney Docket No. 15966-652 (CURA-152))

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS :	Peyman et al.		
SERIAL NUMBER :	09/791,254	EXAMINER :	Not Yet Assigned
FILING DATE :	February 23, 2001	ART UNIT :	1646
FOR :	NOVEL NUCLEAR FACTOR POLYPEPTIDES AND NUCLEIC ACIDS ENCODING SAME		

BOX MISSING PARTS
Assistant Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL LETTER

Transmitted herewith for filing in the above-referenced patent application are the following documents:

1. Copy of Notice to File Missing Parts of Nonprovisional Application (1 pg.);
2. Response to Notice to File Missing Parts (1 pg.);
3. Check No. 11583 in the amount of $65.00 to cover Missing Parts fee;
4. Combined Declaration and Power of Attorney for Patent Application (2 declarations, 3 pgs each = 6 total pgs..);
5. Petition for One-Month Extension of Time (1 pg.);
6. Check No. 11584 in the amount of $55.00 to cover the Extension fee; and
7. Return postcard.

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at 617-542-6000, Boston, Massachusetts.

The Commissioner is authorized to charge any additional fees that may be due, or to credit any overpayment, to the undersigned's account, Deposit Account No. 50-0311, Ref. No.15966-652 (CURA-152). A duplicate copy of this transmittal letter is enclosed herewith.

Respectfully submitted,

Date: February 6, 2002

Ivor M. Coughlan Reg. No. 48,593
for Ivor R. Elrifi, Reg. No. 39,529
Attorney/Agent for Applicants
c/o MINTZ, LEVIN
One Financial Center
Boston, Massachusetts 02111
Tel: (617) 542-6000
Fax: (617) 542-2241

TRA 1626872v1

KEK

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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
09/791,254	02/23/2001	John A. Peyman	15966-652 (Cura-152)

OIPE JC68
FEB 0 6 2002
PATENT & TRADEMARK OFFICE

CONFIRMATION NO. 2685

FORMALITIES LETTER

OC000000007092320

IVOR R. ELRIFI
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY and POPEO, P.C.
One Financial Center
Boston, MA 02111

RECEIVED
NOV 26 2001
MINTZ LEVIN, BOSTON
PATENT DOCKET DEPT.

Date Mailed: 11/19/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

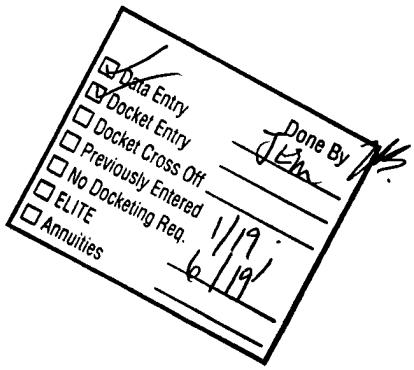
Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(l) 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 $ 65.**

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



02/12/2002 MBERHE 00000115 09791254
01 FC:205 65.00 OP

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

CENTRAL COAST PATENT AGENCY
PO BOX 187
AROMAS, CA 95004

COPY MAILED

JUL 0 8 2002

OFFICE OF PETITIONS

In re Application of :
Coussement :
Application No. 09/791,282 : ON PETITION
Filed: February 22, 2002 :
Attorney Docket No. P4646 :

This is a decision on the petition filed June 13, 2002, to accord the above-identified application a filing date of February 22, 2001, instead of February 21, 2002.

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 February 22, 2002.

A petition fee is unnecessary for a petition under 37 CFR 1.10. Therefore, a refund of the $130 petition fee will be scheduled.

The file is now being forwarded to the Office of Initial Patent Examination to accord the application a filing date of February 22, 2002.

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
www.uspto.gov

Paper No. 6

CENTRAL COAST PATENT AGENCY
PO BOX 187
AROMAS, CA 95004

COPY MAILED

AUG 2 2 2002

OFFICE OF PETITIONS

In re Application of :
Coussement :
Application No. 09/791,282 : ON PETITION
Filed: February 22, 2001 :
Attorney Docket No. P4646 :

Corrected Decision:

This is a decision on the petition filed June 13, 2002, to accord the above-identified application a filing date of February 22, 2001, instead of February 21, 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 February 22, 2001.

A petition fee is unnecessary for a petition under 37 CFR 1.10. Therefore, the $130 petition fee has been refunded.

The file is now being forwarded to the Office of Initial Patent Examination to accord the application a filing date of February 22, 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

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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SEP 21 2007

OFFICE OF PETITIONS

GENERAL INSTRUMENT CORPORATION DBA THE CONNECTED
HOME SOLUTIONS BUSINESS OF MOTOROLA, INC.
101 TOURNAMENT DRIVE
HORSHAM PA 19044

In re Application of :
Del Sordo : DECISION ON PETITION
Application No. 09/791,290 :
Filed: February 23, 2001 :
Atty. Dkt. No.: GIC-617 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 12, 2006, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is not a final agency decision.

This application became abandoned September 19, 2005 for failure to timely submit an appeal brief in response to the Notice of Appeal filed July 18, 2005. Notice of Abandonment was mailed July 17, 2006.

The instant petition has not been reviewed on the merits as it fails to comply with 37 CFR 1.34(b). Practitioner is not associated with the customer number indicated in the power of attorney previously submitted. Thus, it would appear that practitioner has not been empowered to represent applicant. Accordingly, in acting in a representative capacity, practitioner is required to set forth his registration number in the paper submitted.

Any renewed petition must be properly executed in accordance with 37 CFR 1.33 and/or 1.34.

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: (51) 273-8300

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

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago IL 60610

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JUN 0 2 2005

OFFICE OF PETITIONS

In re Application of :
Okochi et al. :
Application No.09/791,293 : DECISION ON APPLICATION
Filed: February 23, 2001 : FOR
Attorney Docket No. 9281-3874 : PATENT TERM ADJUSTMENT
:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed March 11, 2004. Applicants request that the patent term adjustment be corrected to add an additional 298 days in part on the basis that the Office is taking in excess of three years to issue the patent[1].

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

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the

[1] Applicants request 189 additional days of PTA based on the difference between the 3-year date and the projected issue date.

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 four hundred one **(401)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 16, 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 383 days. Applicants maintain that the period of adjustment for Office delay in issuing the first Office action under 35 U.S.C. 132 should be 470 days, not 379 days. Applicants maintain that the 1.702(a)(1) delay should be calculated using the date of mailing of a second Office action *sua sponte* mailed by the Office to correct an error in the first Office action. Further, applicants maintain that their response to the second Office action, which restarted the time period for reply, was received within 3 months and thus, there should not be an entry of a reduction of 18 days for applicant delay in responding to the first Office action.

Applicants' arguments have been considered, but not found entirely persuasive. A non-final Office action was mailed on May 7, 2003, fourteen months and 379 days after the application filing date. Pursuant to 35 U.S.C. 154(b)(1)(A), applicants are only entitled to day-to-day restoration of term lost as a result of delay created by the Office, after the first 14 months of pendency of the application before the Office, to the extent that the Office failed to make an objection or argument under 35 U.S.C. 132 until May 7, 2003. The fact that the correspondence was subsequently corrected does not alter the fact that the Office did mail an action under 35 U.S.C. 132 to the applicants on May 7, 2003. Accordingly, in this case, it is correct for the Office to use the date of May 7, 2003 in calculating the period of adjustment due to the examination delay in initially

acting on this application. See Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 54366 (September 18, 2000).

Thus, it is concluded that, in this instance, the mailing of a second action under 35 U.S.C. 132 did not constitute a delay by the Office in the issuance of the patent within the meaning of 35 U.S.C. 154(b).

Nonetheless, applicants are correct that there should not be an entry of 18 days for applicant delay in responding to the first Office action. The second Office action restarted the period for reply. Accordingly, the period of reduction for applicant delay should be calculated based on any delay in responding to the second Office action. As applicants responded within 3 months to the second Office action, there was no applicant delay within the meaning of § 1.704(b). Entry of a period of reduction of 18 days is incorrect.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is four hundred one (401) 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 (including the days accorded for delay in issuing the patent pursuant to § 1.702(a)(4)) 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 fee under 37 CFR 1.18(e) is required and will not be waived.

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

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.

Brinks Hofer Gilson & Lione
P.O. Box 10395
Chicago, IL 60610

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MAR 0 6 2006

OFFICE OF PETITIONS

In re Patent No. 6,916,119	:	DECISION ON REQUEST FOR
Issue Date: July 12, 2005	:	RECONSIDERATION OF
Application No. 09/791,293	:	PATENT TERM ADJUSTMENT
Filed: February 23, 2001	:	and
Atty Docket No. 9281-3874	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the "PETITION FOR RECONSIDERATION OF THE PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)," filed September 14, 2005. Patentees request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from five hundred eighteen (518) days to seven hundred forty-six (746) days.

The application for patent term adjustment is **GRANTED to the extent indicated herein**.

On July 12, 2005, the application matured into U.S. Patent No. 6,916,119, with a revised patent term adjustment of 518 days. On September 14, 2005 (with a certificate of mailing dated September 12, 2005), patentees timely submitted this request for reconsideration of patent term adjustment (with required fee), asserting that the correct number of days of Patent Term Adjustment is 746 days. Patentees find no reason in the file for the reduction of patent term adjustment and request recalculation. Patentees dispute the reductions, pursuant to 1.704(c)(10), of 120 days associated with the filing of an application for patent term adjustment under § 1.705(b) and of 108 days for the filing of an Information Disclosure Statement (IDS).

These reductions have been reconsidered. The reduction of 120 is found to be incorrect. 37 CFR § 1.704(e) expressly provides that:

> Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

A review of the application history confirms that the 120 reduction is associated with the filing of the application for patent term adjustment under § 1.705(b) on March 11, 2004. No other paper was filed on that date. The reduction of 120 days has been removed.

However, the reduction of 108 days is found to be correct. Applicant's arguments have been considered, but not found persuasive. Pursuant to 37 CFR § 1.704(c), circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

> (10) Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:
>
> (i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper; or
>
> (ii) Four months;

Petitioner does not dispute that the IDS was filed after the mailing of the notice of allowance or that the Office mailed a response to the IDS on March 3, 2005. Moreover, a review of the IDS as filed reveals that it was not accompanied by a § 1.704(d) statement. Petitioner does not argue that the IDS included a

§ 1.704(d) statement. Accordingly, the reduction of 108 days falls squarely within the basis for reduction set forth in 1.704(c)(10)(counting the number of days in the period beginning on November 22, 2004, the date of filing of the IDS and ending on March 9, 2005, the date of mailing of the Office's response).

The rules make clear that the only exception to entry of a reduction for filing an IDS under circumstances that otherwise constitute a failure to engage in reasonable efforts to conclude prosecution is compliance with § 1.704(d). To ensure that a period of reduction would not be entered for filing the IDS, patentees could have filed the IDS within the period set forth in § 1.704(d) and included the § 1.704(d) statement.

In view thereof, the patent term adjustment indicated in the patent should be six hundred thirty-eight (638) days.

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). The request for reconsideration of the reduction of 108 days is a request on a new basis pursuant to § 1.705(d). The fee for such consideration is required. No additional fees are required.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. See 35 U.S.C. § 254 and 37 CFR § 1.322. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by SIX HUNDRED THIRTY-EIGHT (638) days.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 6,916,119 B2

DATED : July 12, 2005

INVENTOR(S) : Okochi 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 (518) days

Delete the phrase "by 518" and insert – by 638 days--

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

EXXON CHEMICAL COMPANY
P.O. BOX 2149
BAYTOWN, TX 77522-2149

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MAY 2 6 2004

OFFICE OF PETITIONS

In re Application of	:	
Deckman et al.	:	
Application No. 09/791,300	:	ON PETITION
Filed: February 22, 2001	:	
Attorney Docket No. 2000B008	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed February 3, 2004, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply within three months to the non-final Office action mailed September 10, 2002. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on December 11, 2002. A Notice of Abandonment was mailed on April 25, 2003.

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

The file is now being forwarded to Technology Center 1700 for further examination on the merits.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAR 16 2004

Nadege M. Lagneau, Ph.D.
Patent Group
CHOATE, HALL & Stewart
Exchange Place
53 State Street
Boston, MA 02109

In re Application of	:	
Feng et al	:	
Serial No. 09/791,339	:	DECISION ON PETITION
Filing Date: February 23, 2001	:	
Attorney Docket No.: 2001180-0041	:	

This is in response to applicant's "Petition under 37 CFR 1.84(a)(2)" filed December 11, 2003. the delay is regretted.

A review shows that requirements under 37 CFR 1.84(a)(2)(iii) have been met. Accordingly, petition is granted.

Petition Granted.

The formal drawings, which include a color photograph, are accepted and being entered.

Bruce Kisliuk
Director, TC1600

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

Steven F. Weinstock
Abbott Laboratories
100 Abbott Park Road
Dept. 377/AP6A
Abbott Park, IL 60064-6008

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APR 2 5 2003

OFFICE OF PETITIONS

In re Application of :
Zhenkun Ma, et al. :
Application No. 09/791,408 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. 6666.US.02 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 7, 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 May 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 on August 7, 2002.

Receipt is acknowledged of the Information Disclosure Statement filed with the instant petition on April 7, 2003.

Telephone inquiries concerning this decision should be directed to Cheryl Gibson-Baylor at (703)308-5111, or in her absence, Sherry D. Brinkley at (703)305-9220.

The application file is being forwarded to Technology Center 1600, Art Unit 1623.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry D. Brinkley
Petitions Examiner

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

Paper No. 17

STEVEN F. WEINSTOCK
ABBOTT LABORATORIES
100 ABBOTT PARK ROAD
DEPT. 377/AP6A
ABBOTT PARK, IL 60064-6008

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AUG 1 3 2004
OFFICE OF PETITIONS

In re Application of :
Ma et al. :
Application No. 09/791,408 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. 6666.US.02 :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 29, 2004, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply within three months to the final Office action mailed May 20, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on August 21, 2003. A Notice of Abandonment was mailed on January 22, 2004.

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

The file is now being forwarded to Technology Center 1600 for further examination on the merits.

Telephone inquiries should be directed to the undersigned at (703) 306-0482. Any telephone inquiries after approximately **September 24, 2004** should be directed to the undersigned at (571) 272-3282.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 10

BRINKS HOFER GILSON & LIONE
P O BOX 10395
CHICAGO, IL 60611

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MAR 0 6 2003

OFFICE OF PETITIONS

In re Application of :
Rufolf Schnorr von Carolsfeld et al :
Application No. 09/791,421 : DECISION GRANTING PETITION
Filed: February 23, 2001 : UNDER 37 CFR 1.137(f)
Attorney Docket No. 6270/55 :

This is a decision on the petition, filed February 19, 2003, to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f).

The petition is **GRANTED**.

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.

Petitioner states that a Canadian patent application was filed on January 29, 2002, claiming priority to the continuation-in-part applications (09/931,145; 09/931,427; and 09/931,527), which CIP applications include the disclosure of the subject application, plus additional disclosure. However, petitioner asserts that, while the claims in the Canadian patent correspond to the claims of the CIP applications, the claims do not correspond to the claims of the subject application. Petitioner is of the opinion that the invention disclosed in the instant application is not the subject of the Canadian patent for the reasons stated in the petition; namely, that the term "invention" and the phrase

"directed to the invention" refer to the "claimed invention" of the subject application rather than the entire disclosure. Therefore, petitioner does not believe that a petition is necessary in this instance.

Petitioner is advised that it is his responsibility to make a determination as to whether or not the invention of this application is the subject of an application filed in another country and should not place that burden upon the U.S. Patent and Trademark Office. Nevertheless, in reviewing the arguments presented by petitioner, it is concluded that the disclosed invention of this application is the subject of the Canadian application filed on January 29, 2002. Therefore, this application became abandoned by operation of law for failure to timely notify the U.S. Patent and Trademark Office of this filing within 45 days subsequent to the filing of the subject application in a foreign country.[1]

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.

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 June 12, 2003 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

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[1] 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). Accordingly, whether or not a petition to revive is necessary, a fee is required for a determination of the facts presented in the petition.

This application is being forwarded to Technology Center Art Unit 2132 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
www.uspto.gov

Paper No. 9

CHERSKOV & FLAYNIK
THE CIVIC OPERA BUILDING
20 NORTH WACKER DRIVE, SUITE 1447
CHICAGO, IL 60606

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JUN 1 4 2004

OFFICE OF PETITIONS

In re Application of
Singh et al.
Application No. 09/791,422
Filed: February 23, 2001
Attorney Docket No. 0003/00800

ON PETITION

This decision concerns the May 19, 2004 petition under 37 CFR 1.137(b). The petition asserts timely response to an Office action and is being properly treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment in the above-referenced application.

The petition is **GRANTED.**

The application was held abandoned as of November 21, 2003 for failure to timely submit a proper reply to the August 20, 2003 non-final Office Action.

The instant petition asserts that a timely response, in the form of an amendment, was filed on December 22, 2003 (Monday) along with a request for a 1-month extension of time and the requisite extension-of-time fee.

In support, the petition is accompanied by copies of the purportedly mailed amendment and the transmittal letter. The transmittal letter bears a December 22, 2003 certificate of mailing. In addition, the petition encloses a copy of counsel's postcard receipt, indicating receipt in the USPTO for this application on December 29, 2003 of an amendment and a check for an extension of time.

In view of the above, the Office concludes that an amendment and a payment for a 1-month extension of time were indeed filed on December 29, 2003, but the amendment was later misplaced.[1] Accordingly, the application was not abandoned. The holding of abandonment in this application is hereby withdrawn and the April 27, 2004 Notice of Abandonment vacated. The petition is thus granted.

No petition fee is owed, and none was enclosed with the instant petition.

The application file is being returned to Technology Center 1700 for continued examination.

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

RC Tang
Petitions Attorney
Office of Petitions

---

[1] The $55 (small entity) for a 1-month extension of time was posted to the account for this application on 1/6/04, with a USPTO "mailroom date" of 12/29/03. This further evidences timely filing of the amendment.

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CHERSKOV & FLAYNIK
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CHICAGO IL 60606

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AUG 2 2 2005

OFFICE OF PETITIONS

In re Application of
Dileep SINGH et al
Application No. 09/791,422
Filed: February 23, 2001
Attorney Docket No. 0003/00800

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed July 6, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The 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 November 19, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on February 20, 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 an amendment placing the case in condition for allowance; (2) the petition fee of $750; and (3) an adequate statement of unintentional delay have been received. Accordingly, the reply to the final Office action of November 19, 2004 is accepted as having been unintentionally delayed.

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 petition varies from the language required by 37 CFR 1.137(b)(3), the statement contained in the petition is being construed as the statement required by 37 CFR 1.137(b)(3). Petitioner must notify the Office if this is not a correct interpretation of the statement contained in the petition.

Telephone inquiries concerning this decision should be directed to Amelia Au at (571) 272-7414. All other inquiries concerning either the examination or status of the application should be directed to the Technology Center.

The application file is being referred to Technology Center Art Unit 1731 for appropriate action.

Frances Hicks
Lead 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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SIEMENS CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830

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AUG 15 2006

OFFICE OF PETITIONS

In re Application of	:	
Eric K. Ogren	:	
Application No. 09/791,454	:	ON PETITION
Filed: February 22, 2001	:	
Attorney Docket No. 01P7495US	:	

This is a decision on the petition under 37 CFR 1.137(b), filed March 3, 2006, to revive the above-identified application.

The petition is **GRANTED**.

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

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed January 25, 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 April 26, 2005.

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

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

This matter is being forwarded to Technology Center AU 2616 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Siemens Corporation
Attn: Elsa Keller, Legal Department
170 Wood Avenue South
Iselin, NJ 08830

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

Ian F. Burns
P.O. Box 20038
Reno NV 89515-0038

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SEP 2 3 2002

OFFICE OF PETITIONS

In re Application of :
Seelig, et al. :
Application No. 09/791,463 : ON PETITION
Filed: February 22, 2001 :
Attorney Docket No. 619.380 :

This is a decision on the petition under 37 CFR § 1.137(b), filed August 23, 2002, 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 26, 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 27, 2001. A Notice of Abandonment was mailed on September 6, 2002, after the Notice of Abandonment was received.

The substitute drawings filed August 23, 2002, are noted and made of record.

The address as cited on the instant petition differs from the address of record. Although a courtesy copy of this decision is being mailed to the address as cited on the instant petition, petitioner is advised that all future correspondence will be mailed solely to the address of record until appropriate written instructions to the contrary are received.

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
Office of the Deputy Commissioner
for Patent Examination Policy

cc:
Ian F. Burns & Associates, PC
1575 Delucchi Lane
Suite 222
Reno, NV 89502

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, DC 20231
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Paper No. 15

MAIL

SEP 0 2 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Laura M. Slenzak
SIEMENS CORPORATION
186 WOOD AVENUE SOUTH
ISELIN, NJ 08830

In re Application of :
Jussi Myllymaki et. al. : Withdrawal From issue
Application No. 09/791,595 :
Filed: February 25, 2001 :
Title: WIRELESS COMMUNICATION SYSTEM AND METHOD TO PROVIDE GEO-SPATIAL RELATED EVENT DATA

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(a).

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 Daniel Wu at (703) 308-6730.

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

Jin F. Ng
Director, Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450
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MATTINGLY STANGER MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD, SUITE 370
ALEXANDRIA, VA 22314

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OFFICE OF PETITIONS

In re Application of :
Minour Ashizawa et al :
Application No. 09/791,618 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. NIT-256

This is a decision on the petition, filed June 13, 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 September 2, 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 Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 2876 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
Office of the Deputy Commissioner
for Patent Examination Policy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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OFFICE OF PETITIONS

In re Application of
Yamada et al.
Application No. 09/791,634
Filed: February 26, 2001
Attorney Docket No. 100503.01

DECISION DISMISSING PETITION
UNDER 37 CFR 1.181

This is a decision on the petition under 37 CFR 1.181, filed September 29, 2005, to withdraw the holding of abandonment.

On June 8, 2005, the Board of Patent Appeals and Interference rendered a decision, which affirmed the examiner's decision rejecting the appealed claims. Petitioner did not seek court review of the decision within two months of the date of the decision. Therefore, the proceedings as to the rejected claims were terminated. See 37 CFR 1.197(b). As no claim was allowed, the above-identified application became abandoned on August 9, 2005. See MPEP 1214.06. A Notice of Abandonment was mailed on August 9, 2005.

In the present petition, the practitioner stated he received a Notice of Abandonment dated August 9, 2005, holding the above-identified application abandoned for failure to respond to the Oral Hearing on June 8, 2005. The practitioner argued that no response to the Oral Hearing was required, but rather, a reply to the Decision on Appeal was due on September 29, 2005, two months from the July 29, 2005 mailing date of the Decision on Appeal. The practitioner enclosed a copy of the first page of the Decision on Appeal as evidence that the due date for filing a response was September 29, 2005. The practitioner requested that the Office withdraw the Notice of Abandonment and consider the Request for Continued Examination filed with the present petition on September 29, 2005.

The Office notes that proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action. See 37 CFR 1.197 and 1.304. The Office further notes:

> The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) **is two months from the date of the decision of the Board of Patent Appeals and Interferences**. If a request for rehearing or reconsideration of the decision is filed within the time period provided

> under § 41.52(a), § 41.79(a), or § 41.127(d) of this title, the time for filing an appeal or commencing a civil action shall expire two months after action on the request.

37 CFR 1.304(a)(1) (emphasis added).

The record indicates that the Board of Patent Appeals and Interference rendered its decision on June 8, 2005. Pursuant to 37 CFR 1.304(a)(1), the practitioner had two months from the June 8, 2005 decision date, not from the July 29, 2005 mailing date, to take appropriate action. Therefore, the period expired for seeking court review of the decision at midnight on August 8, 2005, not on September 20, 2005, as the practitioner argued.

The Office has concluded that the USPTO correctly mailed the Notice of Abandonment, and thus, the holding of abandonment will not be withdrawn. The petition under 37 CFR 1.181 is **dismissed**. The above-identified application will remain in its abandoned status.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The request for reconsideration should include a cover letter entitled "Renewed Petition under 37 CFR 1.181 to Withdraw the Holding of Abandonment." Extensions of time are permitted under 37 CFR 1.136(a).

ALTERNATIVE VENUE

Petitioner may wish to consider filing a petition under 37 CFR 1.137(b) to revive an unintentionally abandoned application instead of filing a request for reconsideration of this decision.

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. In nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. 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), **an additional** $1,500.00 for a large entity and $750.00 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 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 set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

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

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

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

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 19928
ALEXANDRIA VA 22320

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OFFICE OF PETITIONS

In re Application of	:	
Yamada et al.	:	DECISION DISMISSING PETITION
Application No. 09/791,634	:	UNDER 37 CFR 1.181
Filed: February 26, 2001	:	
Attorney Docket No. 100503.01	:	

This is a decision on the renewed petition under 37 CFR 1.181, filed March 13, 2006, to withdraw the holding of abandonment in the above-identified application.

On August 9, 2005, the Office mailed a Notice of Abandonment, indicating that the above-identified application was abandoned in view of the decision by the Board of Patent Appeals and Interference rendered on June 8, 2005, and because the period for seeking court review of the decision had expired and there were no allowed claims. The practitioner argued that no response to the Oral Hearing of June 8, 2005, was required. Rather, a reply to the Decision on Appeal was due on September 29, 2005, two months from the July 29, 2005 mailing date of the Decision on Appeal. The practitioner indicated that applicants received a Notice of Hearing Confirmation, stating that the Board of Patent Appeals and Interferences Appeal would hear the appeal for this application on June 8, 2005. Applicants submitted a copy of the Notice as evidence that the Appeal was heard on June 8, 2005. Additionally, applicants submitted a copy of the first page of the Decision on Appeal as evidence that the due date for filing a response was September 29, 2005. Applicants requested that the Office withdraw the Notice of Abandonment and consider the Request for Continued Examination and submission filed on September 29, 2005.

The Office notes that proceedings on an application are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action. See 37 CFR 1.197 and 1.304. The Office further notes:

> The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (§ 1.302) or for commencing a civil action (§ 1.303) is two months from the date of the decision of the Board of Patent Appeals and Interferences. If a request for rehearing or reconsideration of the decision is filed within the time period provided

> under § 41.52(a), § 41.79(a), or § 41.127(d) of this title, the time for filing an appeal or commencing a civil action shall expire two months after action on the request.

37 CFR 1.304(a)(1).

After a further review of the record, the Office concurs with the practitioner's assertion that applicants had two months from the decision date of July 29, 2005, to take appropriate action. On September 29, 2005, applicants filed a response, which was within the period for seeking court review of the decision. Accordingly, the Office mailed the Notice of Abandonment in error. The petition to withdraw the holding of abandonment is **granted**. Furthermore, the decision of January 31, 2006, is vacated.

The application is restored to pending status in view of the fact that a response was timely filed on September 29, 2005.

This matter is being referred to Technology Center Art Unit 1771.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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.
09/791,687	02/26/2001	Joseph Hirschberg	01/21600	9873

7590 03/17/2005

G.E. EHRLICH (1995) LTD.
c/o ANTHONY CASTORINA
SUITE 207
2001 JEFFERSON DAVIS HIGHWAY
ARLINGTON, VA 22202

EXAMINER	
NASHED, NASHAAT T	

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 03/17/2005

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DECISION ON PETITION

In re Application of
Joseph HIRSCHBERG et al
Serial No. 09/791,687
Filed: February 26, 2001
For: POLYNUCLEOTIDE MOLECULE FROM HAEMATOCOCCUS PLUVIALIS ENCODING A POLYPEPTIDE HAVING A β-C-4-OXYGENASE ACTIVITY FOR BIOTECHNOLOGICAL PRODUCTION OF (3S, 3's) ASTAXANTHIN AND ITS SPECIFIC EXPRESSION IN CHROMOPLASTS OF HIGHER PLANTS

This is a decision on the request for acceptance of color drawings under 37 C.F.R. §§ 1.84(a)(2) and (b)(2) filed January 29, 2004.

The petition has been reviewed and it is found to be in compliance with the requirements as set forth in 37CFR §§1.84 (a)(2) and b (2). Black and white copies of the color drawings are provided in the application and triplicates of the color drawings of each figure have also been provided. The Brief Description of the Drawings section of the specification is amended to insert as the first paragraph to state

The file of this patent contains at least one drawing executed in color photograph. Copies of this patent with color photograph(s) will be provided by the U. S. Patent and Trademark Office upon request and payment of the necessary fee.

The required fee for the petition has been paid.

PETITION GRANTED.

Ponnathapura N. Achutamurthy
Supervisory Patent Examiner
Art Unit 1652

Sol Sheinbein
G. E. Erlich (1995) Ltd
c/o ANTHONY CASTERINA
SUITE 207
2001. Jefferson Davis Highway
Arlington, Virginia 22202

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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MATTINGLY, STANGER & MALUR, P.C.
104 East Hume Avenue
Alexandria, VA 22301

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SEP 01 2006

OFFICE OF PETITIONS

In re Patent of	:	
Yonezawa et al.	:	
Application No. 09/791,691	:	DECISION
Filed: February 26, 2001	:	ON PETITION
Title of Invention:	:	
SHOPPING BASKET PRESENTATION	:	
METHOD FOR AN ONLINE SHOPPING	:	
SYSTEM	:	

This is a decision on the Petition to Withdraw Holding of Abandonment Under 37 CFR §1.181(a), filed January 12, 2006. The delay in treating this petition is regretted.

The petition is **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under [insert the applicable code section]." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background

The above-identified application became abandoned for failure to timely and properly reply to the non-final Office action, mailed June 3, 2005. The Office action set a three (3) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No reply having been filed, this application became abandoned on September 4, 2005. A Notice of Abandonment was mailed December 15, 2006.

The instant petition

Applicants files the instant petition and asserts that the office action was mailed to an incorrect correspondence address. Applicant asserts that a Change of Correspondence Address was filed March 14, 2003, and also asserts that a copy of the Change of Correspondence Address has been included with the instant petition.

A review of the petition papers reveals that Applicant has filed what appears to be a coversheet for a Change of Correspondence Address that has an Office stamp evidencing receipt of a Change of Correspondence Address by this Office on May 14, 2003; however, no Change of Correspondence Address has been located among the petition papers filed.

Conclusion

The petition is dismissed without prejudice. Petitioner should file a Request for Reconsideration and include a copy of the Change of Correspondence Address.

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

By mail: Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

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

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

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

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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LACASSE & ASSOCIATES, LLC
1725 DUKE STREET
SUITE 650
ALEXANDRIA, VA 22314

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JUN 07 2005

OFFICE OF PETITIONS

In re Application of :
Musk : DECISION ON PETITION
Application No. 09/791,723 :
Filed: February 26, 2001 :
Atty. Dkt. No.: 11-3 US :

This is a decision on the petition under 37 CFR 1.137(a), filed February 3, 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 mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency decision.

This application became abandoned September 26, 2004 for failure to timely reply to the non-final Office action mailed June 25, 2004. The non-final Office action set a three (3) month shortened statutory period of time for reply. No petition for extension of time was timely submitted. Notice of Abandonment was mailed January 13, 2005.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The present petition lacks requirement (3) above. Petitioner has failed to present a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The Office may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner attributes the failure to timely reply to the non-final Office action to docketing error. In accordance with MPEP 700.03(c), "[a] delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of "unavoidable" delay, provided it is shown that: (1) the error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; and (3) the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care."

Petitioner has failed to set forth the nature of the docketing error alleged. Petitioner has merely stated that docketing errors occurred on or about June 24, 2004. Thus, it cannot be said that a nexus has been established between the alleged docketing error and the failure to timely respond to the non-final Office action mailed June 25, 2004. Petitioner has not established that there was a business routine in place for performing the clerical function to which the alleged docketing

error is attributed. To the extent that such a business routine was in place at the time of the alleged docketing error, petitioner has not established that the business routine could be reasonably relied upon to such as to avoid the docketing error alleged. Petitioner has not adequately established that the person to whom the docketing error is attributed was sufficiently trained and experienced with regard to the business function and routine such that reliance upon such employee represented the exercise of due care.

Any renewed petition must be supported by evidence that sufficiently establishes that delay in timely responding to the non-final Office action can be attributed to a docketing error. Petitioner is required to establish that the error was the cause of the delay at issue to wit petitioner should provide some explanation and detail of the alleged error. Petitioner may with to provide declarations or statement of facts from those with first hand knowledge of the alleged docketing error. Petitioner must further establish that there was a business routine in place for performing the clerical function that could reasonably be relied upon to avoid errors in its performance. Petitioner should provide details of the business routine in place. Petitioner must also establish that the employee to whom the alleged docketing error is attributed was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care.

Such evidence should consist of specific information regarding petitioner's business practice in place for docketing. Petitioner may wish to provide supporting documentary evidence in the form of docketing reports, file jackets, etc., that would support petitioner's allegation that the delay in responding to the non-final Office action was caused by a docketing error. Declarations should be submitted, where appropriate, that factually and accurately detail the business routine in place for docketing and the alleged cause of the delay. Further, petitioner must establish that the employee to whom the error is attributed was sufficiently trained and supervised with regards to docketing procedures.

ALTERNATE VENUE

Petitioner is should consider filing a petition stating that the delay was unintentional. Petitioner's attention is directed to

Application No. 09/791,723

37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

By mail:	**Mail Stop Petition** Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(703) 872-9306
By hand:	U.S. Patent and Trademark Office Customer 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) 272-3205.

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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LACASSE & ASSOCIATES, LLC
1725 DUKE STREET
SUITE 650
ALEXANDRIA, VA 22314

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SEP 14 2005

OFFICE OF PETITIONS

In re Application of :
Musk : DECISION ON PETITION
Application No. 09/791,723 :
Filed: February 26, 2001 :
Atty. Dkt. No.: 11-3 US :

This is a decision on the renewed petition under 37 CFR 1.137(a), filed July 20, 2005, to revive the above-identified application. The petition is **GRANTED**.

This application became abandoned September 26, 2004 for failure to timely reply to the non-final Office action mailed June 25, 2004. The non-final Office action set a three (3) month shortened statutory period of time for reply. No petition for extension of time was timely submitted. Notice of Abandonment was mailed January 13, 2005. A petition under 37 CFR 1.137(a) was filed February 3, 2005 and dismissed June 7, 2005.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The instant petition has been reviewed and found in compliance with the provisions of 37 CFR 1.137(a). See, MPEP 711.03(c) as relates to abandonment attributable to docketing error. Accordingly, the failure to timely submit a proper reply to the Office communication is accepted as having been unavoidably delayed.

This application is being forwarded to Technology Center 2800 for further processing.

Telephone inquiries concerning this matter may be directed to the undersigned at 571-272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON VA 22209-9889

FEB 1 2005

In re Application of:
Ichiro Ishimaru et al.
Serial No.: 09/791,742
Filed: February 26, 2001
Attorney Docket No.: **520.39698X00**

DECISION ON PETITION
FOR REFUND

This is a decision on the petition under 37 CFR § 1.181, filed September 20, 2004, requesting a partial refund of the fees for filing a three month extension of time filed concurrently therewith.

The petition is **DENIED**.

A Final Office action was mailed on March 19, 2004, setting a three-month shortened statutory period for response thereto. A proposed After Final Amendment was timely filed on June 21, 2004. This petition was filed on September 20, 2004, along with a three-month extension of time, and Notice of Appeal. An Advisory Action in response to the After Final Amendment was mailed on September 21, 2004 indicating that claims 2 - 8 were allowable. A second proposed After Final Amendment was filed on November 22, 2004. A Notice of Allowability was mailed on January 5, 2005.

Petitioner states that according to PAIR the After Final Amendment was processed by Technology Center 2800 on July 2, 2004 but not forwarded to the examiner until September 2, 2004. Petitioner asserts that this delay of two full months required the filing of papers and fees that should not otherwise have been necessary. Petitioner requests a refund of $840, presumably for the extension of time for the second and third months.

A proper reply under 37 C.F.R. § 1.113 to a final rejection consists 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 C.F.R. § 1.114. Pursuant to 37 C.F.R. § 1.113, the time for reply to a Final Office action does not stop unless a timely filed proposed After Final Amendment places the application in condition for allowance.

Since the period for filing a response to a Final Office action does not stop until a timely filing of an amendment that places the application in condition for allowance, it is incumbent upon an applicant to take steps to ensure against abandoning of his/her application. Because the first proposed After Final Amendment did not place the application in condition for allowance, the response required may be a Notice of Appeal and requisite fees for appeal and any required extension of time. While it is regrettable that the Advisory Action was not promptly mailed, failure to timely receive the Advisory Action does not save the application from becoming abandoned if a proper response along with any appropriate fees, including extension of time fees, were not submitted within the maximum statutory period. In the instant application, the amendment filed on June 21, 2004 did not place the application in condition for allowance. Accordingly, Petitioner was required to file for a further extension of time to extend the period for reply to six months in order to timely file the Notice of Appeal on September 20, 2004.

Authorization to refund fees is set forth under 37 CFR 1.26, which states, in part, as follows:

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

The record reveals that fees for the extension of time requested and the Notice of Appeal were necessary to keep the application pending and, thus, were not paid by mistake or in excess. Accordingly, the request for refund must be denied.

The application has been allowed and the issue fee and publication fee are due by April 5, 2005.

Any inquiry regarding this decision should be directed to Hien H. Phan, Special Program Examiner, at (571) 272-1606.

Janice A. Falcone

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

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NOV 22 2004

McDermott, Will & Emory
600 13th Street, N.W.
Washington, DC 20005-3096

Paper No.

In re Application of
Frederica V. Coates
Serial No. : 09/791,773
Filed : February 26, 2001
For : Protective Undergarments Having Anchored Pocketed-Sling Structures and Manufacturing Methods Thereof

: DECISION ON PETITION
: TO WITHDRAW
: HOLDING OF
: ABANDONMENT
:

RECEIVED
NOV 26 2004
McDERMOTT, WILL & EMERY

This is a decision on petitioner's request filed February 13, 2004, to review the holding of abandonment mailed January 15, 2004, for failure to file a proper response to the Office action mailed June 23, 2004, an *Ex parte Quayle* action. There is no fee required for this petition.

A review of the file indicates that an action in the form of an *Ex parte Quayle* action was mailed June 2, 2003. Applicant was given a shortened statutory period for response of two months from that date. The action enumerated a number of objections to the drawings, specification, and claims. All claims were indicated as being allowable over the art of record. Applicant filed a timely response on August 4, 2003 (the 2nd of August being a Saturday and the 3rd being a Sunday). The response was extensive and appears to address every point raised by the examiner in the action mailed June 2, 2003. On October 16, 2003 an Advisory action was mailed to applicant denying entry of the amendment indicating that the amendment raised new issues that would require further consideration and/or search and because the amendment did not "place the application in better form by materially reducing or simplifying the issues". Applicant was informed that the period for reply expired two months from the mailing date of the *Ex parte Quayle* action, but that extensions of time were available under 37 CFR 1.136(a). Applicant filed a supplemental amendment along with a three month-extension of time request, on November 3, 2004. On January 15, 2004, another Advisory action was mailed to applicant indicating that the supplemental amendment would not be entered, again indicating that the amendment raised new issues and did not place the application in better form by materially reducing or simplifying the issues. On January 15, 2004, a Notice of Abandonment was mailed as well holding the application abandoned for failure to file a proper response to the *Ex parte Quayle* action.

Petitioner asserts that he is not aware of any statute or rule that authorizes the examiner to treat an *Ex parte Quayle* action as a final action for prosecution purposes.

It is well settled policy that when an application is in condition for allowance except as to matters of form, such as correction of the specification, drawings, etc., the issuance of an *Ex parte Quayle* action is in order. This type of action closes prosecution as to the merits but not to formal matters.

Amendments touching the merits are to be treated in a manner similar to amendments after final rejection, but prosecution as to formal matters may continue. See section 714.04 of the MPEP.

In view of the above, it is clear that Advisory actions of October 16, 2003 and January 15, 2004 were improper treatments by the examiner of the timely responses submitted by the applicant. Because the responses were submitted prior to a final rejection and dealt strictly with formal matters, they are entered as a matter of right and will be so entered in this case. Accordingly, the Notice of Abandonment mailed January 15, 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 Legal Instruments Examiner for entry of the responses filed August 4, 2003, November 3, 2003, and the response filed with the instant petition. Thereafter, the application will be forwarded to the examiner for further action consistent with this decision.

Summary: Holding of Abandonment Withdrawn.

John E. Kittle, Director
Groups 3730 and 3760
Phone: (703) 308-0873

ak/11/15/04

#6
6/13/03

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JUN 13 2003

TECHNOLOGY CENTER 2100

Paper No. 6

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, VA 22209

In re Application of: Michael W. Leddige, et al.	)	
Application No. 09/791,810	)	**DECISION ON REQUEST FOR**
Filed: February 26, 2001	)	**WITHDRAWAL AS ATTORNEY**
For: METHOD AND ASSEMBLY HAVING A MATCHED FILTER CONNECTOR	)	

This is a decision on the Request To Withdraw from Representation filed June 2, 2003.

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

The request is **GRANTED**.

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

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

cc: Kenyon & Kenyon
1500 K Street, N.W.
Suite 700
Washington, DC 20005-1257

SPE: K. Williams

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6/21/06

TO SPE OF : ART UNIT 2625

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/791,861 Patent No.: 7022195

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

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

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

Lamonte M. Newsome
Certificates of Correction Branch
703-308-9390 ext. 112

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

Kimberly A. Williams 2625

SPE **Art Unit**

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ELEVENTH STREET
WASHINGTON DC 20001-4597

MAIL

JUN 1 3 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Kenneth P. Hinckley, et al.
Serial No.: 09/791,899
Filed: March 26, 2001
For: **POSITIONAL SCROLLING**

DECISION *SUA SPONTE*
WITHDRAWING HOLDING
OF ABANDONMENT

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

A final Office action was mailed on October 21, 2003 setting a shortened statutory period for filing a reply. A response to the outstanding final Office action was timely filed on January 5, 2004. While the response to the Final rejection has been deemed to be timely filed, petitioner should note that a proper response to a Final Office action must consist of either an amendment which places the case in condition for allowance, a Notice of Appeal, or the filing of a continuation application. See 37 CFR 1.113 and 1.116. A Notice of Abandonment has not been mailed.

Applicants provided to the Office a copy of an interview summary dated April 15, 2004 for the subject application. The interview summary was not located in the contents of the file. Within the body of the interview summary, the examiner makes of record the following statements "In regards to application 09/791,899, an after final amendment was submitted by the applicant in January. At this time the applicants' representative is not required to submit a response as Examiner has not responded to the after final amendment. The application will NOT be abandoned."

Absent any further explanation from the record, given that the examiner indicated that no response was required by the applicants and that the application would not be abandoned, then it will be considered that the examiner intended to withdraw the finality of the Office action mailed October 21, 2003. Thus, applicants' amendment would have been entered and no time period would be pending against applicants.

Accordingly, although no petition or request to withdraw the holding of abandonment has been filed, the holding of abandonment is hereby withdrawn and the application restored to pending status. The finality of the October 21, 2003 Office action is hereby withdrawn.

Any inconvenience to the applicant is regretted.

The application is being forwarded to the Technology Center's technical support staff for entry of the April 15, 2004 interview summary. From there the application will be forwarded to the examiner for appropriate action in due course.

Dwayne Bost
Special Programs Examiner
Technology Center 2600
Communications

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)
6,431,470	2002-08-13	09/791,944	2001-02-23	

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

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

SURCHARGE

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

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

◉ The assignee of record of the entire interest

The Assignee of record of the entire interest			
Under 37 CFR 3.71 an assignee becomes of record by filing a statement in compliance with 37 CFR 3.73(b). Signature requirements are set forth in 37 CFR 1.4(d), and the undersigned certifies that he / she is empowered to act on behalf of the assignee of the entire interest			
Signature	/Evan Epstein/	Date (YYYY-MM-DD)	2007-06-28
Name	Evan Epstein		
Enter Reel and Frame Number		Remove	
Reel Number	015552	Frame Number	0601
Click ADD for additional Reel Number and Frame Number		Add	

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

Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent No. 6431470
Issue Date: August 13,2002
Application No. 09791944
Filed: February 23,2001
Attorney Docket No. 99-090A

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

This is a decision on the electronic petition, filed June 28,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 28,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

ROPES & GRAY
ONE INTERNATIONAL PLACE
BOSTON MA 02110-2624

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SEP 12 2002

OFFICE OF PETITIONS

In re Application of
Peter C. Keck et al
Application No. 09/791,946
Filed: February 22, 2001
Attorney Docket No. CIBT-P03-566

ON PETITION

This is a decision on the petition under 37 CFR 1.78(a)(3), filed July 22, 2002, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 08/872,859, filed June 11, 1997.

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). 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.

[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 February 22, 2001, and was copending at the time of filing of the instant petition. Further, copendency exists between the instant application and between each of the prior-filed nonprovisional applications noted in the amendment (for which an additional claim for benefit of priority is now being sought for nonprovisional Application No. 08/872,859). A reference to the prior-filed applications 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 reference to prior-filed nonprovisional Application No. 08/872,859 was not included in the manner specified in 37 CFR 1.78(a)(2) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2).

A reference to add the above-noted, prior-filed applications on page one following the first sentence of the specification has been included in an amendment filed on July 22, 2002. However, the amendment is not acceptable as drafted since it improperly incorporates by reference prior-filed nonprovisional Application No 08/872,859. 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 a 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 a 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 appli-cations, 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.

See also MPEP 201.06(c) pages 200-36 - 200-37.

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment deleting the incorporation by reference statement is required.

In order to expedite consideration, petitioner may wish to submit the substitute amendment by facsimile transmission to the number indicated below and to the attention of Karen Creasy .

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

By mail:	Commissioner for Patents Box DAC Washington, D.C. 20231
By FAX:	(703) 308-6916 Attn: Office of Petitions
By hand:	Crystal Plaza Four, Suite 3C23 2201 South Clark Place Arlington, VA 22202

Any questions concerning this matter may be directed to Karen Creasy at (703) 305-8859 .

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
www.uspto.gov

Fax Cover Sheet

Date: 14 Oct 2003

To: Ms. Takeuchi	**From:** Jeffrey Siew
Application/Control Number: 09/791,946	**Art Unit:** 1637
Fax No.: ~~617-951-7050~~ 212 497-3625	**Phone No.:** 703-305-3886
Voice No.: ~~617-951-7000~~ 212 497-3650	**Return Fax No.:** 703-308-4556
Re: petition copy	**CC:**

☒ **Urgent** ☐ **For Review** ☐ **For Comment** ☐ **For Reply** ☐ **Per Your Request**

Comments:
per your request a copy of dismissal of petition.

examiner Siew JS

Number of pages 4 **including this page**

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Paper No. 18

ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSTON MA 02110-2624

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APR 19 2004

OFFICE OF PETITIONS

In re Application of
Peter C. Keck et al
Application No. 09/791,946
Filed: February 22, 2001
Attorney Docket No. CIBT-P03-566

: 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 November 20, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

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 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 application was filed on February 22, 2001, and was pending at the time of filing of the instant petition.

---

[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 reference to the prior-filed applications was not included in the manner specified in 37 CFR 1.78(a)(2)(i) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2)(ii).

The instant petition does not comply with item (1)

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See Manual of Patent Examining Procedure, 8th ed., August 2001), Section 201.11, Reference to First Application. The amendment filed November 20, 2003, states that the instant application is a continuation-in-part of U.S. Application No. 08/872,859, filed June 11, 1997. However, Application No. 08/872,859, was not pending when the instant application was filed, since it issued on August 29, 2000.

For the above-noted reason, the petition under 37 CFR 1.78(a)(3) cannot be granted.

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

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

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

By hand: Customer Window located at:

2011 South Clark Place
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 Karen Creasy at (703) 305-8859 .

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

cc:

ROPES & GRAY LLP
45 ROCKEFELLER PLAZA
NEW YORK, NY 10111

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 23

ROPES & GRAY LLP
ONE INTERNATIONAL PLACE
BOSON MA 02110-2624

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MAY 2 7 2004

OFFICE OF PETITIONS

In re Application of :
Peter C. Keck et al :
Application No. 09/791,946 : DECISION ON PETITION
Filed: February 22, 2001 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. CIBT-P03-566 :

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed May 14, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications 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.

---

[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 February 22, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional applications 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).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional applications 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 applications 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 applications 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 applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, 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 applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications 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 Filing Receipt, which includes the priority claim to the prior-filed nonprovisional applications, 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 1637 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications.

Karen Creasy

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

ATTACHMENT: Filing Receipt

cc:

ROPES & GRAY LLP
45 ROCKEFELLER PLAZA
NEW YORK, NY 10111

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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PATTON BOGGS LLP
1801 CALFORNIA STREET
SUITE 4900
DENVER CO 80202

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MAR 2 6 2009

OFFICE OF PETITIONS

In re Application of
TUCKER, Dennis et al.
Application No. 09/791,964
Filed: February 23, 2001
Attorney Docket No. **020436.0107PTUS**

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 March 10, 2009.

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. The Office requires the practitioner(s) requesting withdrawal to certify that he, she, or they have: (1) given reasonable notice to the client, prior to the expiration of the response period, that the practitioner(s) intends to withdraw from employment; (2) delivered to the client or a duly authorized representative of the client all papers and property (including funds) to which the client is entitled; and (3) notified the client of any responses that may be due and the time frame within which the client must respond, pursuant 37 CFR 10.40(c).

The request was signed by Brain Hart on behalf of all attorneys of record who are associated with customer No. 24283. All attorneys/agents associated with the Customer Number 24283have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence address of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is an outstanding Office action mailed January 06, 2009 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **DENNIS TUCKER**
1144 LAKEWAY DR.
IRVING TX 75060

cc: **MR. STEWART H. THOMAS**
THOMAS & DEES, PPLC
300 CRESCENT COURT
SUITE 1000
DALLAS TX 75201

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OFFICE OF PETITIONS

DIGEO, INC C/O STOEL RIVES LLP
201 SOUTH MAIN STREET, SUITE 1100
ONE UTAH CENTER
SALT LAKE CITY UT 84111

In re Application of: Stephen Perlman
Application No.: 09/792,019
Filed: February 20, 2001
Attorney Docket No. 04259P011

: DECISION ON PETITION

This is a decision on the petition under 37 CFR §1.137(b), filed August 7, 2006.

This above-identified application became abandoned for failure to timely file a proper response to a final Office Action which was mailed on January 20, 2004. The final Office Action set a three (3) month shortened statutory period for reply. No extensions of time were obtained under the provisions of 37 CFR §1.136(a). Accordingly, this application became abandoned on April 21, 2004. A Notice of Abandonment was mailed on September 21, 2004.

The requirements for a grantable petition under 37 CFR §1.137(b) have been met. This petition is hereby **Granted**.

The Request for Continued Examination (RCE) and the amendment submitted with the instant petition 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 16

Richard L. Morello
336 Bay Meadows Drive
Naples FL 34113

MAILED

MAR 1 4 2003

Technology Center 2600

In re Application of :
Richard L. Morello :
Application No. 09/792,027 :
Filed: February 26, 2001 :
For: **WATER LEAK DETECTION AND SUPPRESSION** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on January 22, 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.

Power of Attorney to petitioner was revoked by the applicant before the instant request was filed.

Accordingly, the instant request is **DISMISSED AS MOOT**.

A courtesy copy of this decision is being mailed to petitioner at the address on the petition, however, all future communications from the Office will be directed to the 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.

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

cc: Oblon, Spivak, McClelland, Maier & Neustadt, P. C.
1940 Duke Street
Alexandria, VA 22314

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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OFFICE OF PETITIONS

FITZPATRICK CELLA HARPER & SCINTO
1290 AVENUE OF THE AMERICAS
NEW YORK NY 10104-3800

In re Patent No. 6,857,067 :
Issue Date: February 15, 2005 :
Application No. 09/792,045 : DECISION ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. 02800.000001. :

This is a decision on the petition under 37 CFR 1.378(c), filed October 9, 2009 to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent and the petition under 37 CFR 1.182 filed November 18, 2009 and the Supplemental petition filed November 18, 2009 to expedite processing of the petition to revive.

The petition to expedite is **GRANTED**.

The requisite $400.00 fee for the petition to expedite processing under 37 CFR 1.182 submitted November 18, 2009 has been accepted. Additionally, the Supplemental petition filed November 18, 2009 included an additional unnecessary 37 CFR 1.378(c) petition warranting no further action.

The petition to accept the unintentionally delayed payment of the maintenance fee is **GRANTED**.

This patent expired on February 16, 2009 for failure to pay the three and one-half year maintenance fee. Since this petition was submitted within twenty-four months after the six-month grace period provided in 37 CFR 1.362(e), the petition was timely filed under the provisions of 37 CFR 1.378(c).

The maintenance fee is hereby accepted and the above-identified patent is reinstated as of the mail date of this decision.

Additionally, the file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a request to change the address of record should be filed. Petitioner should note that a change of correspondence address would not affect the fee address. Therefore, if petitioner desires to receive future correspondence, which **may** be mailed regarding

maintenance fees for the above-identified patent, the "fee address" and/or "customer number" forms should be submitted. 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) 272-7751.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Martin S. Edelman
4602 Jefferson Ridge Way
Marietta, GA 30066

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
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APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/792,087	02/23/2001	John Semen	AN-7075-B

CONFIRMATION NO. 8620

OC000000010440526

Mr. Philip M. Pippenger
Patent & Trademark Division
Albemarle Corporation
451 Florida Street,
Baton Rouge, LA 70801-1765

Date Mailed: 07/08/2003

NOTICE REGARDING RESCISSION OF NONPUBLICATION REQUEST

Applicant's rescission of the previously-filed nonpublication request is acknowledged. The rescission has been reflected in the Office's computer records so that the earliest possible projected publication date can be assigned.

The projected publication date is 10/16/2003.

If the applicant filed the application with a nonpublication request and then subsequently filed an application directed to the invention disclosed in the application with the nonpublication request in another country, or under a multilateral international agreement, that requires publication of applications eighteen months after filing, applicant was required to provide notice of foreign filing within 45 days after the date of the filing of such foreign or international application. If the rescission did not contain the notice of foreign filing (e.g., the PTO/SB/36, version 10/01 was not used), or if the notice of foreign filing was not filed within the 45 day period, the application is ABANDONED, and a petition under 37 CFR 1.137(b)/(f) is required to be filed. (See 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c).)

Any petition, filed with the rescission, under 37 CFR 1.137(b)/(f) to revive the application is being forwarded to the Office of Petitions for a decision. Note that the filing of the petition will not operate to stay any period of reply that may be running against the application.

Questions regarding petitions to revive should be directed to the Office of Petitions at (703) 305-9282. Questions regarding publications of patent applications should be directed to the patent application publication hotline at (703) 605-4283 or by e-mail pgpub@uspto.gov.

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. 8

Mr. Philip M. Pippenger
Patent & Trademark Division
Albermarle Corporation
451 Florida Street
Baton Rouge, LA 70801-1765

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JUL 1 1 2003

OFFICE OF PETITIONS

In re Application of
John Semen
Application No. 09/792,087
Filed: February 23, 2001
Attorney Docket No. AN-7075-B

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(b)

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

The petition is **GRANTED**.

Petitioner states that the instant non-provisional application is the subject of an application filed in a foreign country on September 18, 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 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 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 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 Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of October 16, 2003 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 1714 for examination in due course.

Marianne E. Morgan
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
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MARCY HOEFLING
ALBEMARLE CORPORATION
451 FLORIDA BLVD
BATON ROUGE LA 70801

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FEB 09 2005

OFFICE OF PETITIONS

In re
John Semen
Application No. 09/792,087
Filed: February 23, 2001
Patent No. 6,821,456
Issued: November 23, 2004

: DECISION REGARDING
: PATENT TERM ADJUSTMENT

This decision is in response to the "Statement Pursuant to MPEP § 2733," filed August 9, 2004, requesting correction of the patent term adjustment (PTA) indicated on the patent.

The request is **DISMISSED**.

On May 19, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is four hundred sixty-six (466) days. On August 9, 2004, Applicants submitted the instant "Statement Pursuant to MPEP § 2733". Applicants state that they believe there was an error in the patent term adjustment calculation, in particular because the instant application is subject to a terminal disclaimer, and because the instant application "underwent a period of technical abandonment."

The Office initially determined a patent term adjustment of four hundred sixty-six (466) days based on an adjustment for PTO delay

of five hundred thirty-three (533) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by sixty-seven (67) days of applicant delay.

The provisions of § 154(b), for adjustment due to examination delay, apply to original applications, other than designs, filed on or after May 29, 2000. The Office calculates patent term adjustment for examination delay in all eligible applications. In calculating the patent term adjustment, the Office does not differentiate between applications that have terminal disclaimers and those that do not. Nor does the Office undertake the burdensome task of reviewing every application with a terminal disclaimer to determine if the patent term adjustment accorded would adjust the term beyond the expiration date specified in the disclaimer.

Rather, on issuance of the application, in compliance with 35 U.S.C. § 154(b) and 37 C.F.R. § 1.703(g), it is indicated in the patent that the patent term adjustment indicated therein is subject to any disclaimer. Moreover, it is also stated therein that the patent is subject to a terminal disclaimer.

With respect to applicant's second argument, it is true that the above-identified application became abandoned 45 days after September 18, 2001, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 C.F.R. § 1.213(c), for failure to notify the USPTO of a foreign filing. However, because prosecution in the application continued, it can not be said that applicant failed "to engage in reasonable efforts to conclude processing or examination." 37 C.F.R. § 1.704(c).

Accordingly, the Determination of Patent Term Adjustment was correct in stating that the patent term adjustment was four hundred sixty-six (466) days at the time of the mailing of the Notice of Allowance.

As the application file has already issued into a patent, the file is being returned to Files Repository.

Telephone inquiries specific to this letter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner

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

Saliwanchik Lloyd & Salwanchik
A Professional Association
2421 N.W. 41st Street
Suite A-1
Gainesville, FL 32606-6669

MAILED

OCT 10 2002

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re application of
Christopher Fey, et.al.
Application No. 09/792,101 : DECISION ON REQUEST
Filed: February 23, 2001 : FOR WITHDRAWAL OF
For: METHOD, SYSTEM, AND COMPUTER : ATTORNEY
PROGRAM FOR HEALTH DATA
COLLECTION, ANALYSIS, REPORT
GENERATION AND ACCESS

This is a decision on the request filed on July 16, 2002, under 37 CFR 1.36 and MPEP 402.06, requesting permission to withdraw as the attorney of record in the above-identified application.

The request is **NOT APPROVED**.

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

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

09/792,101

The request to withdraw as attorney is not accepted in the above-identified application because the request lacks condition (A) above. The original Power of Attorney appointed Seth Blum. Requestor requests withdrawal of the attorneys/agents associated with Customer Number 23557. Seth Blum is not associated with Customer Number 23557.

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

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

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JUN 2 0 2005

OFFICE OF PETITIONS

In re Application of :
Richard Bryan Sagar :
Application No. 09/792,145 : ON PETITION
Filed: February 21, 2001 :
Attorney Docket No. US018017 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 22, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b)[1] must be accompanied by: (1) the required reply,[2] unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lack(s) item(s) (1).

Office records do not show receipt of the required reply to the nonfinal Office action mailed July 22, 2004.

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[1] As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

[2] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

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

By hand: Customer Window located at:

Randolph Building
401 Dulany Street
Alexandria, VA 22314

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
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STANDARDS
P.O. BOX 3001
BRIARCLIFF MANOR NY 10510

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OFFICE OF PETITIONS

In re Application of :
Richard Bryan Sagar :
Application No. 09/792,145 : DECISION GRANTING PETITION
Filed: February 21, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. US018017 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed August 22, 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 reply to the Nonfinal Rejection of July 27, 2004, is accepted as having been unintentionally delayed.

Petitioner may request a refund of the petition fee paid on August 22, 2006, since the petition fee was previously paid on March 22, 2005. A copy of this decision should accompany the request to the Office of Finance Refund.

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

This matter is being referred to Technology Center AU 2143.

Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUN - 6 2003

Paper No. 9

In re Application of :
Jeremy Roschelle *et al* : DECISION ON PETITION
Application No. 09/792,159 :
Filed: February 21, 2001 :
Attorney Docket No. SRI/4338-2

This is a decision on the petition filed on May 14, 2003 by which petitioners request withdrawal of the holding that this application stands abandoned for failure to file a reply to the Office letter dated July 18, 2002. The petition is being considered under 37 CFR 1.181, and no fee is required.

The petition is granted.

It appears from the record, and from the petition, that on March 29, 2002, the assignee in this application filed a Power of Attorney by Assignee, which also included a change of correspondence address. This change of address pre-dated the mailing of the Office action in question, but was apparently not entered into the record. Therefore, the Office action in question was not mailed to the proper correspondence address. Based upon this circumstance, it is clear that the application is not abandoned.

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for Patent Examining Group 3710 for re-mailing a complete copy of the Office letter dated July 18, 2002, together with all attachments thereto including references. The period for reply to the re-mailed Office action will run THREE MONTHS from the date upon which the action is re-mailed, and can be extended up to the statutory maximum of six months under the provisions of 37 CFR 1.136(a). It is noted that the current correspondence address of record is correct in view of the filing on October 30, 2002 of a second revocation and change of correspondence address, and the entry thereof on November 8, 2002..

PETITION GRANTED.

E. Rollins-Cross, Director, Patent
Examining Groups 3710 and 3720

Mosher, Patterson & Sheridan, LLP
595 Shrewsbury Avenue
Suite 100
Shrewsbury, NJ 07702

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LARRY OREMLAND, ESQ.
5055 E. BROADWAY
SUITE C214
TUCSON, AZ 85711

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JUL 3 0 2004

OFFICE OF PETITIONS

In re Application of :
Angelo Yializis :
Application No. 09/792,197 : ON PETITION
Filed: February 21, 2001 :
Attorney Docket No. D-94039A1B :

This is a decision on the petition under 37 CFR 1.137(b), filed July 13, 2004, to revive the above-identified application.

The petition is **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 March 2, 2004, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on June 3, 2004.

It is not apparent whether the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, in accordance with 37 CFR 1.34(a), the signature of Lawrence R. Oremland 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 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.[1]

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

[1] It is noted that the Office of Finance records for this file discloses that a $1330 fee was assessed to the issue fee on July 14, 2004. Since petitioner has claimed small entity status, the overpayment of $665 will be credited to petitioner's deposit account number 50-1905 as authorized.

The application file is being forwarded to the Publishing Division for further processing.

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

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Jenkens & Gilchrist, P. C.
1445 Ross Avenue
Suite 3200
Dallas, TX 75202

MAIL

MAY 0 1 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:
Keith A. Liljestrand et al.
Application No.: 09/792,207
Filed: FEBRUARY 23, 2001
For: APPARATUS AND METHOD FOR PROVIDING ENHANCED TELECOMMUNICATIONS SERVICES

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw as Attorney or Agent of record filed on March 19, 2002.

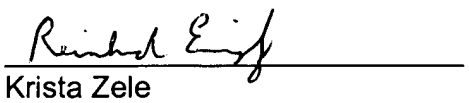
A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

All the above requirements are met and the request is **GRANTED**.

All the attorney(s) listed in power of attorney as originally filed are withdrawn from the record.

The correspondence address will be changed. All future communications from the United States Patent and Trademark Office (Office) will be directed to the address listed below 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.

The application file is being returned to the 2600 Technology Center's central files to await an action by the Examiner.



For Krista Zele
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: PULSAR COMMUNICATIONS, INC.
8111 LBJ FREEWAY
SUITE 1150
DALLAS, TX 75251

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 12

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MAY 15 2003

OFFICE OF DIRECTOR
GROUP

Wagner Murabito & Hao LLP
Two North Market Street, 3rd Floor
San Jose, CA 95113

In re Application of:
Hill *et al.*
Application No. 09/792,219
Filed: February 23, 2001
Attorney Docket No. BEAR-P003

DECISION ON PETITION
TO WITHDRAW HOLDING
OF ABANDONMENT

This is a decision on the petition filed March 12, 2003, to withdraw the holding of abandonment of the above-identified application. No petition fee is required.

The petition is **granted.**

The application was held abandoned for failure to submit a proper reply to the Ofice action mailed May 6, 2002. A Notice of Abandonment was mailed on January 8, 2003.

Petitioner asserts that on August 6, 2002, a response including an amendment and a drawing amendment. To support this assertion, petitioner has submitted a copy of the response bearing a certificate of mailing under 37 CFR 1.8(a) having a date of deposit of August 6, 2002, and a copy of a return postcard which properly identifies and acknowledges receipt of each item of the response by the Patent and Trademark Office on August 12, 2002.

A review of the application file record reveals that the originally submitted response was not properly matched with the application file at the time the Notice of Abandonment was mailed but has since been matched therewith. Accordingly, the application is not abandoned in fact.

For the above stated reason, the petition is **granted**. The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The $130 petition fee filed with the petition is unnecessary. Accordingly, the petition fee will be refunded as a credit to deposit account number 23-0085 in due course.

The application file is being forwarded to the Technology Center 2800 support staff for refund of the petition fee and entry of the response. From there, the application will be forwarded to the examiner for further examination.

Inquiries regarding this decision should be directed to Ed Glick at (703) 308-4858.

Edward J. Glick, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
P.O. Box 1450
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James A. Sheridan
MOSER, PATTERSON & SHERIDAN, LLP
350 Cambridge Avenue
Suite250
Palo Alto CA 94306

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OFFICE OF PETITIONS

In re Application of
Wang, et al.
Application No. 09/792,224
Filed: February 23, 2001
Attorney Docket No. 807006/JAS

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 18, 2005, to revive the above-identified application.

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 non-final Office action mailed August 18, 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) being obtained and no timely reply being received, this application became abandoned on November 19, 2004. A Notice of Abandonment was mailed on August 4, 2005.

Petitioners have submitted an amendment as the reply, an acceptable statement of the unintentional nature of the delay in responding to the August 18, 2004 non-final Office action, and the required revival petition and fee. Therefore, the petition is granted.

It is noted that the address listed on the petition differs from the correspondence address of record. Practitioner may wish to change the address of record. A courtesy copy of this decision will be mailed to the address listed on the petition. However, unless a proper change of correspondence is filed, all future correspondence regarding this application will be mailed to the above-listed correspondence address of record.

The application file is being forwarded to Technology Center AU 2131 for further processing.

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

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

cc: JAMES A. SHERIDAN
3040 POST OAK BLVD.
SUITE 1500
HOUSTON, TX 77056-6582

UNITED STATES PATENT AND TRADEMARK OFFICE

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Alexandria, VA 22313-1450
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APR 29 2008

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

In re Application of	:	
Stephen Dao Hui Hsu et al.	:	
Application No. 09/792,226	:	DECISION ON PETITION
Filed: February 22, 2001	:	TO WITHFRAW
Attorney Docket No. 6002-03301	:	FROM RECORD
	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 CFR 1.36(b) filed May 30, 2006.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that the power of attorney to the firm of Blakely, Sokololff, Taylor & Zafman LLP has been revoked by the assignee of the patent application on August 25, 2006. Accordingly, the request to withdraw under 37 CFR 1.36(b) is moot.

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

Telephone inquiries concerning this decision should be directed to Carl Friedman at 571-272-6842.

Carl Friedman
Petitions Examiner
Office of Petitions

Cc: MEYERTONS, HOOD, KIVLIN, KOWERT & GOETZEL, P.C.
P.O. BOX 398
AUSTIN TX 78767-0398

UNITED STATES PATENT AND TRADEMARK OFFICE

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Rosemarie F. Jones, Esq.
HELLER EHRMAN WHITE &
McAUIFFE, LLP
275 Middlefield Road
Menlo Park, CA 94025-3506

MAILED

JUN 0 5 2005

Technology Center 2100

In re Application of:
Tsakiris et al.
Application No. 09/792,233
Filed: February 23, 2001
For: METHODS AND SYSTEMS FOR CREATING USER-DEFINED PERSONAL WEB CARDS

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed August 23, 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.

for

Vincent N. Trans
Special Program Examiner 5/31/05
Technology Center 2100

cc: E. Arlin Torbert, CEO
MOBILEID, INC.
200 Middlefield Road
Suite 104
Menlo Park, CA 94025

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

ELLIS & VENABLE, PC
101 NORTH FIRST AVE.
SUITE 1875
PHOENIX, AZ 85003

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MAY 22 2003

OFFICE OF PETITIONS

In re Application of :
Gilbert L. Dahl :
Application No. 09/792,269 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. PHLV0587-001 :

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed September 10, 2002, which set a shortened statutory period for reply of three (3) months. An Advisory action was mailed December 20, 2002 indicating that the reply filed on December 11, 2002 failed to place the application in condition for allowance. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on December 11, 2002.

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

The application file is being forwarded to Technology Center 3600, Art Unit 3654 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
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No.36

EDWARDS & ANGELL, LLP
P.O. BOX 55874
BOSTON MA 02205

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JUN 1 0 2004

OFFICE OF PETITIONS
ON PETITION

In re Application of :
Larsen et al :
Application No. 09/792,286 :
Filed: February 22, 2001 :
Attorney Docket No. 55461-C(45487) :

This is a decision on the petition, filed May 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 January 30, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The application will be forwarded to Technology Center AU 1654 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CLARK & ELBING LLP
101 FEDERAL STREET
BOSTON MA 02110

COPY MAILED

OCT 18 2005

OFFICE OF PETITIONS

In re Application of :
Bjarne D. Larsen et al :
Application No. 09/792,286 : ON PETITION
Filed: February 22, 2001 :
Attorney Docket No. 50412/018002 :

This is a decision on the petition, filed October 14, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on July 19, 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 1654 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.

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101 FEDERAL STREET
BOSTON MA 02110

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DEC 23 2008

OFFICE OF PETITIONS

In re Patent No. 7,250,397	:	
Larsen et al.	:	DECISION ON REQUEST
Issue Date: July 31, 2007	:	FOR RECONSIDERATION OF
Application No. 09/792,286	:	PATENT TERM ADJUSTMENT
Filed: February 22, 2001	:	and
Attorney Docket No. 50412/018002	:	NOTICE OF INTENT TO ISSUE
	:	CERTIFICATE OF CORRECTION

This is a decision on the "REQUEST FOR CORRECTION OF PATENT TERM ADJUSTMENT," filed on October 3, 2007. Patentees request that the Patent Term Adjustment for the above-identified patent be increased by 194 days from 308 days to 502 days.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED IN PART**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of three hundred forty-four (344) days.

On July 31, 2007, the above-identified application matured into U.S. Patent No. 7,250,397. The instant request for reconsideration filed on October 3, 2007 (certificate of mailing date October 1, 2007) was timely filed within 2 months of the date the patent issued.[1] See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 308 days.

[1] Since September 30, 2007, fell on a Sunday, the reply filed on Monday, October 1, 2007, is considered timely filed. 37 CFR 1.7.

Patentees contend that the reduction of 25 days for the filing of a miscellaneous letter after the mailing of the notice of allowance, from the date the letter was filed on February 7, 2006,[2] should be removed. Patentees note that the paper filed on February 7, 2006, was a copy of an amendment after a notice of allowance originally filed on January 13, 2006, and note that applicants were already charged 120 days of patent term adjustment for the filing of the amendment on January 13, 2006.

Patentees' contention is not well taken in accordance with the "Clarification of 37 C.F.R. §1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance Has Been Mailed," 1247 OG 111 (June 27, 2001). The OG Notice states that:

> Accordingly, the Office is publishing this notice to provide guidance in interpreting the provisions of 37 CFR 1.704(c)(10) to clarify that submission of certain papers after a "Notice of Allowance," which do not cause substantial interference and delay in the patent issue process, are not considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application. The following are examples of such papers: (1) Issue Fee Transmittal (PTOL-85B), (2) Power of Attorney, (3) Power to Inspect, (4) Change of Address, (5) Change of Status (small/not small entity status), (6) a response to the examiner's reasons for allowance, and (7) letters related to government interests (e.g., those between NASA and the Office). Therefore, the submission of these papers after a Notice of Allowance will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and would not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10).

A duplicate copy of a previously-submitted amendment after the mailing of a notice of allowance is not among those examples. Nonetheless, it is concluded that under the circumstances, the duplicate copy of the amendment after the mailing of the notice of allowance filed on February 7, 2006 after the first filing of the amendment on January 13, 2006, should not be considered "a failure to engage in reasonable efforts" to conclude processing or examination of an application and should not result in

[2] The petition references a paper filed on February 7, 2007. However, the amendment in question was filed with payment of the issue fee on February 7, 2006.

reduction of the patent term adjustment pursuant to 37 CFR 1.704(c)(10). Specifically, the Office acknowledged receipt of the copy of the amendment filed on February 7, 2006, on March 13, 2007, but failed to acknowledge receipt of the original amendment filed on January 13, 2006. Further, applicant was charged 120 days of patent term adjustment in connection with the amendment filed on February 7, 2006.

Patentee further submits entitlement to additional patent term adjust because of Office delay in providing an initialled Form PTO-1449 until March 12, 2004, in response to an IDS filed with an RCE on August 14, 2003.

Patentee's argument is not well taken. Patentee concedes that a Notice of Allowance acknowledging receipt of the IDS was mailed on December 17, 2003. Accordingly, the notice of allowance mailed on December 17, 2003, is a notification under § 151 and properly stops the clock for determining examination delay pursuant to 37 CFR 1.702(a)(2).

It is further noted that a request for continued examination, amendment, and petition to withdraw from issue were filed on October 14, 2005. Applicant was charged 31 days of patent term adjustment for this filing. On November 3, 2005, a Notice of Allowance in response to the RCE was mailed. Accordingly, the period of reduction under 37 CFR 1.704(c)(10) is the period from October 14, 2004 to November 3, 2005, or 20 days, rather than 31 days.

In view thereof, the patent term adjustment indicated on the patent should be three hundred forty-four (344) days (610 days of PTO delay and 266 (302-25-11) days of applicant delay).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being referred to the Certificate of Correction Branch for issuance of a certificate of correction 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 THREE HUNDRED FORTY-FOUR (344) days.

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

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 : 7,250,397 B2

DATED : July 31, 2007

INVENTOR(S) : Bjarne Due Larsen

DRAFT

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

On the cover page,

[*] Notice: Subject to any disclaimer, the term of this patent is extended or adjusted under 35 USC 154(b) by (308) days

Delete the phrase "by 308 days" and insert – by 344 days--

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)
6668106	2003-12-23	09792287	2001-02-23	213453-00018

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	/Mark W. Hrozenchik/	Date (YYYY-MM-DD)	2008-07-14
Name	Mark W. Hrozenchik	Registration Number	45316

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. 6668106
Issue Date: December 23,2003
Application No. 09792287
Filed: February 23,2001
Attorney Docket No. 83761 0276070

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

This is a decision on the electronic petition, filed July 14,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 14,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

MAIL

MAY 0 7 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

C. Douglas McDonald
P.O. Box 3239
Tampa, FL 33601-3239

In re Application of:
Digiano, Christopher J., et al.
Application No. 09/792,290
Filed: February 21, 2001
For: SYSTEM, METHOD AND COMPUTER PROGRAM PRODUCT FOR ENHANCING AWARENESS OF FELLOW STUDENTS' STATE OF COMPREHENSION IN AN EDUCATIONAL ENVIRONMENT USING NETWORKED THIN CLIENT DEVICES

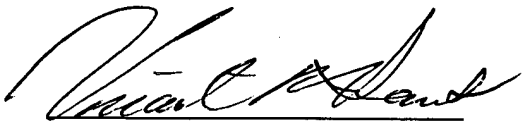
DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed February 20, 2002.

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

The request filed February 20, 2002 meets all the requirements. Accordingly the request is **GRANTED**.

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



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

cc: Joseph A. Capraro, Jr. Esq.
TESTA, HURWITZ AND THIBEAULT, LLP
125 High St, High Tower
Boston, MA 02210

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

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

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MAR 1 2 2002

OFFICE OF PETITIONS

In re Application of :
Eric R. Fossum et al :
Application No. 09/792,292 : NOTICE
Filed: February 22, 2001 :
Attorney Docket No. 08305-086001 / :
99-46 :

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989).** Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED.**

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center AU 2612.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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WEST PALM BEACH FL 33402-3188

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JAN 12 2007

OFFICE OF PETITIONS

In re Application of
Patrick Pirim
Application No. 09/792,294
Filed: February 23, 2001
Attorney Docket No. **20046H-000310US**

ON PETITION

This is a decision on the petition filed October 2, 2006 under 37 CFR 1.137(b),[1] to revive the above-identified application.

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

This application became abandoned June 12, 2006 for failure to timely pay the issue fee on or before June 9, 2006. Accordingly, a Notice of Abandonment was mailed August 17, 2006.

The issue fee, publication fee and petition fee have all been applied. All other requirements of 37 CFR 1.137(b) having now been met, this application file is being forwarded to the Publishing Division to be processed into a patent.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

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

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : April 20, 2010

TO SPE OF : ART UNIT 1795

SUBJECT : Request for Certificate of Correction for Appl. No.: 09792305
Patent No.: 7662513

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 – 9D40-C
Palm Location 7580

_____
Certificates of Correction Branch
703-756-1573

Thank You For Your Assistance

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

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

Comments: _____

_____

_____

_____

_____

_____ _____
/Patrick Joseph Ryan/

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

SPE, Art Unit 1795

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

Brent E. Vecchia
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
Seventh Floor
12400 Wilshire Boulevard
Los Angeles, CA 90025-1026

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OCT 0 2 2006

OFFICE OF PETITIONS

In re Application of:	:	
Lakshmi Arunachalam	:	
Application No. 09/792,323	:	DECISION ON
Filed: February 23, 2001	:	PETITION
Attorney Docket Number:	:	
002435.P001DXD	:	

This is a decision on the petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b), filed December 27, 2005. The delay in treating this petition is regretted.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to reply in a timely manner to the nonfinal Office action, mailed March 11, 2005. 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 June 12, 2005. A Notice of Abandonment was mailed September 20, 2005.

With the instant petition, Applicant has filed an Amendment in response to the non-final Office action.

This application is being referred to Technology Center 2154 for processing of the Amendment 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 DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, DC 2023

June 24, 2002

Alex L. Yip
Kaye, Scholer, Fierman, Hays & Handler
425 Park Ave.
New York, NY 10022

In re application of:
M. L. Obradovich et al PETITION
Serial No.: 09/792,349
Filed: February 23, 200l

For: MULTIMEDIA INFORMATION AND CONTROL SYSTEM FOR AUTOMOBILES

This is a decision on the petition received May 25, 2001, to grant the filing date in the above application.

The Notice of Incomplete Nonprovisional Application mailed May 16, 2001 was sent in error. The Notice has been withdrawn from the application. The application has been forwarded to Technology Center 2856 for review.

The petition is hereby GRANTED.

The office regrets any inconvenience this may have caused counsel.

The petition fee of $130 has been credited to Deposit Account 50-0988.

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

Doshie Day

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination.

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

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MAR 14 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

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

Paper No. 5

In re application of
Jay Farhat et al.
Application No. 09/792,358
Filed: February 21, 2001
For: METHOD AND SYSTEM TO BROKER A SERVICE ACCESS TRANSACTION

: **DECISION ON PETITION**
: **TO MAKE SPECIAL**
: **(ACCELERATED EXAMINATION)**

This is in response to the petition filed on December 16, 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 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**.

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703) 308-2121
(703) 605-0586 (facsimile)

RAR/tpl: 3/12/03

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

Terry B. Morris
P.O. Box 1993
Prairieville, LA 70769-1993

COPY MAILED

MAY 30 2006

OFFICE OF PETITIONS

In re Application of
Ornstein
Application No. 09/792,372
Filed: February 23, 2001
Attorney Docket No. MAO-PT004.1

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed January 31, 2006, to revive the above-identified application.

This application became abandoned for failure to reply timely to the Notice of Non-Compliant Amendment mailed January 31, 2005, which set a one-month extendable period to reply. Accordingly, this application became abandoned on March 1, 2005. A Notice of Abandonment was mailed on December 12, 2005.

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

The petition is **granted.**

The assignee, MAO, submitted a revocation and appointment of power of attorney and a change of correspondence address on April 26, 2004. A second change of correspondence address was submitted with the present petition. The Office notes: "Under 37 CFR 1.33(a)(2), where an executed oath or declaration under 37 CFR 1.63 has been filed by any of the inventors, the correspondence address may be changed by (A) a registered attorney or agent of record, (B) an assignee as provided for under 37 CFR 3.73(b), or (C) all of the applicants (37 CFR 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with 37 CFR 3.71." MPEP 601.03. Pursuant to 37 CFR 3.73(b)(1): In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. To establish ownership, the assignee must submit to the USPTO a signed statement identifying the assignee by either:

> (i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may

be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

Upon reviewing the documents submitted on petition, the assignee did not submit a copy of an executed assignment evidencing the chain of title from the original owner to the assignee. Moreover, the assignee did not submit a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number). For these reasons, the Office will not revoke the current power of attorney or change the correspondence address of record until the assignee submits a completed "Statement Under 37 CFR 3.73(b)" (Form PTO/SB/96). Accordingly, the Office does not recognize the power of attorney to Terry B. Morrison to prosecute the subject application.

The appropriate form accompanies this decision for the assignee's convenience. As a one- time courtesy, a copy of the decision will be mailed to the address listed in the petition. Thereafter, the Office will mail all communications to the address of record.

The matter is being referred to Technology Center Art Unit 3711.

Telephone inquiries should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Cc: Mao Inc
1636 Popps Ferry Road, STE 224
Biloxi, MS 39532

Enclosures: "Statement Under 37 CFR 3.73(b)" (Form PTO/SB/96) and Privacy Act Statement

PTO/SB/96 (12-05)
Approved for use through 07/31/2006. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

STATEMENT UNDER 37 CFR 3.73(b)

Applicant/Patent Owner: _____

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

Entitled:

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

states that it is:

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

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

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

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

OR

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

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

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

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

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

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

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

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

_____ _____
Signature Date

_____ _____
Printed or Typed Name Telephone Number

_____
Title

This collection of information is required by 37 CFR 3.73(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Privacy Act Statement

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 08

C. Douglas McDonald
Carlton Fields, P.A.
P.O. Box 3239
Tampa, FL 33601-3239

MAILED

OCT 05 2001

OFFICE OF DIRECTOR
GROUP

In re Application of: :
Sheedy *et al.* :
Application No. 09/792,382 : DECISION ON REQUEST TO
Filed: February 21, 2001 : WITHDRAW FROM RECORD
Docket Number: INV1P007 :

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed June 18, 2001.

A review of the application file record indicates that the power of attorney to the attorneys of Carlton Fields, P.A., who are identified in the Declaration and Appointment of Attorney filed on May 25, 2001, has been revoked by the assignee of this patent application.

For the above-stated reason, the request is **dismissed** as moot.

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

Inquiries related to 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

cc: Dominic M. Kotab
Silicon Valley Intellectual Property Group
P.O. Box 721120
San Jose, California 95172-1120

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

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8403

COPY MAILED

OCT 3 0 2001

OFFICE OF PETITIONS

In re Application of	:	
Yet Chan	:	DECISION GRANTING
Application No. 09/792,392	:	PETITION
Filed: February 23, 2001	:	
Attorney Docket No. P/1941-10	:	

This is a decision on the petition under 37 CFR 1.10, filed September 24, 2001, requesting that the above-identified application be accorded a filing date of February 23, 2001, rather than the presently accorded filing date of February 22, 2001.

Petitioner alleges that the application was deposited in Express Mail service on February 23, 2001. A search of the USPS Express Mail Information Database indicates that a package bearing Express Mail label No. EL583735805US was accepted by the USPS on February 23, 2001, at 7:20 PM. The same Express Mail label number was placed on the original application papers located in the official file.

In view of the above, the petition is **granted**. No petition fee is necessary.

This application file will be forwarded to the Office of Initial Patent Examination for correction of the filing date to **February 23, 2001.**

Telephone inquiries should be directed to the undersigned at (703) 306-5589.

Christina T. Tartera

Christina T. Tartera
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

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

COPY MAILED

DEC 22 2006

OFFICE OF PETITIONS

In re Application of	:	
FALK, et al.	:	
Application No. 09/792,396	:	DECISION ON PETITION
Filed: February 23, 2001	:	TO WITHDRAW
Attorney Docket No. 50004:1USU1	:	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 November 21, 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 Brett A. Hertzberg on behalf of all attorneys of record who are associated with Customer No. 23552. All attorneys/agents associated with the Customer No. 23552 have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There is no outstanding Office action that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at 571-272-6825.

Patricia Volpe
Petitions Examiner
Office of Petitions

cc: KEVIN BERNHARD FALK
305 – 525 9TH STREET
NEW WESTMINISTER,
V3M 5T9/CANADA

cc: VIVONET, INC.
PMB 433
1225 EAST SUNSET DRIVE
SUITE 145
BELLINGHAM, WA 98226-3554

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 7-20-

Paper No.: _____

TO SPE OF : ART UNIT 2814

SUBJECT : Request for Certificate of Correction for Appl. No. 6956250 B2 (09/792409

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**.

Drawings: Please response A/S/A/P

Thanks

E. M. James

Certificates of Correction Branch

703-308-9390 ext. 116

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: _____

_____

_____

_____

_____

_____ 2814

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

Marc A. Sockol
SQUIRE, SANDERS & DEMPSEY L.L.P.
Two Renaissance Square
Suite 2700
40 North Central Avenue
Phoenix, AZ 85044-4498

MAIL

JUN 0 2 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
Terrell et al.
Application No. 09/792,428
Filed: February 21, 2001
For: SECURE MULTIPROTOCOL INTERFACE

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed March 03, 2005.

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

The request is **GRANTED**.

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

for

Vincent N. Trans
Special Program Examiner
Technology Center 2100

cc: Hillel T. Cohn, Esq.
Morrison & Foerster LLP
555 West Fifth Street, Suite 3500
Los Angeles, CA 90013-1024

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAR – 3 2005

In re Application of	:	
Xian-Cheng Jiang et al	:	NOTICE OF WITHDRAWAL
Serial No. 09/792,448	:	FROM ISSUE
Filed: Februcary 23, 2001	:	UNDER 37 CFR 1.313(b)
For: PLASMA PHOSPHOLIPID TRANSFER	:	
PROTEIN (PLTP) DECFICIENCY	:	
REPRESENTS AN ANTI-ATHEROGENIC	:	
STATE AND PLTP INHIBITOR HAS	:	
ANTI-ATHEROSCLEROSIS ACTION	:	

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

John P. White, Esq.
Cooper & Dunham LLP
1185 Avenue of the Americas
New York NY 10036

cc: Allowed Files, PK3-910
Drafting Branch, PK3-910

OIPE JC#65
JUN 08 2001
PATENT & TRADEMARK OFFICE

Sector
Box/Seq.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Paz Einat, et al

Serial No.: 09/792,471

Filed: February 23, 2001

For: METHOD FOR IDENTIFYING GENES

Attorney Docket No.: 0168.00101

RESPONSE TO NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

Box: Missing Parts
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Enclosed herewith are the following:

1. Copy of Notice to File Missing Parts of Nonprovisional Application;
2. Executed Declaration;
3. Our check in the amount of $65.00 in payment of the required surcharge;
4. Sequence Listing; and
5. Statement Regarding Sequence Listing.

Please charge our Deposit Account No. 11-1449 for any additional fees or credit our account for any overpayment.

Respectfully submitted,

KOHN & ASSOCIATES

Amy E. Rinaldo
Registration No. 45,791
3500 Northwestern Hwy.
Suite 410
Farmington Hills, Michigan 48334
(248) 539-5050

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: the Assistant Commissioner for Patents, Washington, D.C. 20231, BOX MISSING PARTS on June 6, 2001.

Angel Webb

JC105
JUN 0 8 2001
PATENT & TRADEMARK OFFICE

Dec, Fee, Seq (Strmt) List
7-30-01

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
09/792,471	02/23/2001	Paz Einat	0168.00101

CONFIRMATION NO. 5526

FORMALITIES LETTER

OC000000006128769

Kohn & Associates
Suite 410
30500 Northwestern Hwy.
Farmington Hills, MI 48334

Date Mailed: 05/30/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The signature of the following inventor(s) is missing from the oath or declaration:
  Zehava Grosman
- 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 $ 65.**

- 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 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.

06/12/2001 AZERGAW1 00000088 09792471
01 FC:205 65.00 OP

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
JUN 0 8 2001
PATENT & TRADEMARK OFFICE

Attorney's Docket No. 0168.00101 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Paz Einat, et al.

Serial No.: 09/792,471 Group Art Unit: 1655

Filed: 02/23/01 Examiner:

For: METHODS FOR IDENTIFYING GENES

Box Sequence
Assistant Commissioner for Patents
Washington, DC 20231

SUBMISSION OF SEQUENCE LISTING/STATEMENT

1. This replies to the Notice of Filing Missing Parts dated May 30, 2001.

   X A copy of the communication is enclosed.

2. I, Amy E. Rinaldo, state the following:

3. Submitted herewith is/are:

   X A. Sequence Listing(s) for all sequences in the specification.

   Each sequence Listing is assigned a separate identifier.

   X B. A copy of each Sequence Listing submitted for this application in computer readable form.

   ____ C. Preliminary Amendment inserting the Sequence Listing into the application.

CERTIFICATE OF MAILING UNDER 37 CFR 1.8(a) and 1.10

I hereby certify that on the date shown below this correspondence is being deposited with the United States Postal Service in an envelope addressed to: Box Sequence List, Assistant Commissioner for Patents, Washington, DC 20231

37 CFR 1.8(a)
X sufficient postage as first class mail.

37 CFR 1.10*
____ as "Express Mail Post Office to Addressee"
Mailing Label No. _____

Angel M. Webb

DATED: June 6, 2001

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

FOGG AND ASSOCIATES, LLC
P.O. BOX 581339
MINNEAPOLIS, MN 55458-1339

COPY MAILED

APR 0 1 2004

OFFICE OF PETITIONS

In re Application of :
David M. Tolchiner :
Application No. 09/792,501 : DECISION ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. 19319/101/101 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 20, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to file a proper reply to the final Office action mailed November 29, 2002, which set a three (3) month shortened statutory period for reply. No response was received within the allowable period and the application became abandoned on February 30, 2003. A Notice of Abandonment was mailed on June 5, 2003.

The Notice of Appeal, filed February 20, 2004, has been entered and made of record. Accordingly, the two-month period for filing an appeal brief in triplicate (accompanied by the fee required by 37 CFR 1.17(c)), runs from the date of this decision.

The Power of Attorney received February 20, 2004, is noted and made of record.

The application file is being forwarded to Technology Center 1700 for further processing.

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

Kenya A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

Enclosure: "Notice Regarding Change of Power of Attorney"

UNITED STATES PATENT AND TRADEMARK OFFICE

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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

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FEB 27 2007

OFFICE OF PETITIONS

In re Application of :
Hafiz Khalid Rehman Bhutta :
Application No. 09/792,525 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. BHUTTA.001A :

This is a decision in response to the petition, filed October 30, 2006, 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 March 23, 2006. This decision precedes the mailing of a Notice of Abandonment. On October 30, 2006, the present petition was filed, as well as a Terminal Disclaimer and fee, an amendment and a 3-month petition for extension of time.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of amendment; (2) the petition fee of $750; and (3) the requisite statement of unintentional delay.

However, an extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. *See* In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $510 extension of time fee submitted with the petition on October 30, 2006 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

Further, since this application was filed as a utility application after June 8, 1995, no terminal disclaimer is required. Therefore, *the terminal disclaimer filed October 30, 2006 is not accepted* and the fee paid therefor is being credit to counsel's deposit account.

The application is being referred to Technology Center AU 3622 for consideration of the amendment filed October 30, 2006.

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

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BECKMAN COULTER, INC.
4300 N. HARBOR BOULEVARD
BOX 3100
FULLERTON CA 92834-3100

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OFFICE OF PETITIONS

In re Application of :
Mikolajczyk et al. :
Application No. 09/792,534 : DECISION ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. 1582C-451 (81841.0181) :

This is a decision on the petition under 37 CFR 1.137(a), filed July 21, 2004, to revive the above-identified application. The petition was recently forwarded to the Office of Petitions. The Office immediately reviewed the merits of the petition upon its receipt. The Office sincerely apologizes for any inconvenience.

On May 27, 2003, the Office mailed a Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures, which set a one-month extendable period to respond. Accordingly, the application became abandoned on June 28, 2003. On May 26, 2004, the Office mailed a Notice of Abandonment.

As petitioner has met the requirements of 37 CFR 1.137(a), the petition is **granted.**

The Office of Initial Patent Examination has been advised of this decision and to process the application using the amendment filed on November 19, 2002. If the amendment of November 19, 2002, contains any errors, a new Notice to Comply will be mailed and a new time period will be set.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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SUITE 2100
MINNEAPOLIS MN 55402

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OFFICE OF PETITIONS

In re Application of	:	
Merrill A. Biel	:	DECISION ON PETITION
Application No. 09/792,578	:	TO WITHDRAW HOLDING OF
Filed: 23 February, 2001	:	ABANDONMENT
Atty Docket No. 22,272-19	:	

This is a decision on the petition, filed on 25 May, 2005, to withdraw the holding of abandonment in the above-identified application.

The petition is **granted**.

This application was held abandoned for failure to timely file an Appeal Brief in response to the Notice of Appeal filed on 23 August, 2004 (certificate of mailing 18 August, 2004), which set a two (2) month shortened period for reply. In the apparent absence of a timely filed response, the application was held abandoned and a Notice of Abandonment was mailed on 17 May, 2005.

Petitioner asserts that a timely response was filed. In support, petitioner has supplied a copy of the reply, consisting of an Appeal Brief and a three (3) month extension of time. The response contains a certificate of mailing dated 24 January, 2005.

A review of the official file reveals that on 31 January, 2005, an Appeal Brief and three (3) month extension of time were timely received. Additionally, the Appeal Brief received on 31 January, 2005, bears a valid certificate of mailing dated 24 January, 2005.[1] As such, the showing of record is that a response was timely filed, and there is no abandonment in fact. Any inconvenience caused to applicant is regretted.

[1] Since 23 January, 2005, fell on a Sunday, the response filed with a Certificate of Mailing or Transmission dated 24 January, 2005, was timely filed.

The Notice of Abandonment is vacated, and the holding of abandonment is withdrawn.

The $510.00 extension of time fee charged on 25 May, 2005, was charged in error and will be credited to counsel's deposit account, No. 50-1212.

The application file is being forwarded to Technology Center Art Unit 3739 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

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OFFICE OF PETITIONS

In re Application of	:	
Merrill A. Biel	:	DECISION ON PETITION TO
Application No. 09/792,578	:	WITHDRAW HOLDING OF
Filed: 23 February, 2001	:	ABANDONMENT
Attorney Docket No. 22,272-19	:	

This is a decision on the petition to withdraw the holding of abandonment, filed on 5 February, 2007 (certificate of mailing date 16 October, 2006).

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed on 30 January, 2006, which set a one (1) month shortened period for reply. Notice of Abandonment was mailed on 11 October, 2006.

Petitioner asserts that a response to the Notification mailed on 30 January, 2006, was timely filed. In support, petitioner has supplied a copy of a transmittal letter and a corrected Appeal Brief, each of which contains a Certificate Under 37 CFR 1.8 dated 28 March, 2006, signed by registered patent attorney John F. Klos.

It is noted that the transmittal letters accompanying the corrected Appeal Brief and the petition miscaption the

application number as "09/782,578". The petition and the Appeal Brief themselves, however, contain the correct application number. Under current Office procedure, a response that has an incorrect serial number is handled in accordance with M.P.E.P. § 508.03. If a paper having an incorrect serial number contains sufficient information to identify the correct application and was timely received at the Office, the holding of abandonment will be withdrawn. In reviewing the papers which were submitted, it is concluded that there was sufficient information thereon to associate the papers with the present application file.

The corrected Appeal Brief filed on 30 March, 2006, and petition filed on 18 October, 2006, (certificate of mailing date 16 October, 2006), have been located in the Office, and have been associated with the instant application file.

As petitioner has provided convincing evidence that a timely reply to the Notification mailed on 30 January, 2006, was filed, the showing of record is that a response was timely filed, and there is no abandonment in fact. Any inconvenience caused to applicant is regretted.

As a one (1) month extension of time is required in order for the reply filed with an extension of time on 30 March, 2006, to be a timely reply to the Notification mailed on 30 January, 2006, which set a one (1) month shortened period for reply, a one (1) month extension of time has been charged to counsel's deposit account.

The application is being referred to Technology Center Art Unit 3735 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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MAY 18 2007

FULBRIGHT & JAWORSKI L.L.P.
80 SOUTH EIGHTH STREET
SUITE 2100
MINNEAPOLIS MN 55402

In re Application of:
Biel, Merrill A.
Serial No. 09/792578
Filed: February 23, 2001
Docket: 22,272-19
Title: Photodynamic cellular and acellular organism eradication utilizing a photosensitive material and surfactant

DECISION ON PETITION
UNDER 37 CFR § 1.181

This is a decision on the petition filed on February 22, 2007 under 37 CFR § 1.181 and submitted to Technology Center 3700. Petitioner requests withdrawal of the Notice of Abandonment mailed on October 11, 2006. No fee is required for the petition.

The petition is dismissed as moot.

The Office of Petitions rendered a decision May 04, 2007 in an identical petition submitted to that Office. The petition was granted. In view thereof, a decision on the present petition to Technology Center 3700 is moot.

PETITION DISMISSED.

Any inquiry regarding this decision should be directed to Allan N. Shoap, Special Programs Examiner, at (571) 272-4514.

for Karen M. Young
Frederick R. Schmidt, Director
Technology Center 3700

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Dority & Manning, P.A.
One Liberty Square
55 Beattie Place, Ste 1600
Greenville, SC 29601

Paper No. 13

In re Application of
Wanda W. Jackson
Serial No. : 09/792,584
Filed : February 23, 2001
For : Adjustable Scroll Absorbent Article and Method

: DECISION ON PETITION
: TO WITHDRAW
: HOLDING OF
: ABANDONMENT
:

This is a decision on petitioner's request filed September 15, 2004, to review the holding of abandonment mailed April 16, 2004, for failure to pay the issue fee as required in the Notice of Allowability and the Notice of Allowance and Fee(s) Due mailed December 5, 2003. The basis for the request is that applicant did not receive the communication mailed December 5, 2003. There is no fee required for this petition.

Petitioner asserts that the communications of December 5, 2003 as well as the Notice of Abandonment mailed April 16, 2004 were mailed to an incorrect address. An inspection of the file reveals that the Office did indeed receive a Power of Attorney and Change of Correspondence Address on August 25, 2003, and prepared and mailed a Notice of Acceptance of Power of Attorney to the proper address. However, the communications of December 5, 2003 and April 16, 2004, were mailed to an incorrect address.

In view of the above, it is clear that petitioner did not receive the communications in question and the request to withdraw the holding of abandonment is GRANTED and the holding of abandonment is hereby withdrawn. Upon the mailing of this decision, the application will be forwarded to the Legal Instruments Examiner to correct the records to reflect the proper correspondence address and to remail the Notice of Allowability with a new Notice of Allowance and Fee(s) Due.

Summary: Holding of Abandonment Withdrawn.

John E. Kittle, Director
Groups 3730 and 3760
Phone: (571) 272-2975

ak/11/23/04

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Stephen E Bondura
Dority & Manning P.A.
55 Beattie Place
Suite 1600
Greenville SC 29601

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MAR 21 2007

Director's Office
Group 3700

In re Application of: JACKSON
Appl. No.: 09/792,584
Filed: February 23, 2001
For: ADJUSTABLE SCROLL ABSORBENT ARTICLE AND METHOD

: DECISION ON PETITION

This is a decision on the petition filed on May 5, 2006 by which petitioner requests withdrawal of a holding of abandonment for failure to timely pay the issue fee as required by the Notice of Allowance and Issue Fees Due (PTOL-85), remailed on September 25, 2005. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioner alleges that he never received a copy of the Notice of Allowance and Issue Fees Due or Notice of Formal Drawings Required remailed on September 25, 2005. In support of petitioner's allegation he has supplied a copy of the law firm's docket dating from July 1, 2005 to September 30, 2005.

Review of office records show that the Notice of Allowance and Issue Fees Due were remailed to applicant along with a Notice of Formal Drawings Required on June 25, 2005. This remailing was pursuant to the decision rendered in the petition decision of December 2, 2004. Applicant's failure to respond to this mailing generated the currently standing Notice of Abandonment mailed by the Office on June 15, 2006.

While the Patent Application Location and Monitoring system (PALM) indicates this mailing occurred, no copy of the mailing is seen in the physical file wrapper or in the Image File Wrapper (IFW) system. Therefore it cannot be determined if the remailing address was indeed the correct address of record at the time of mailing. The evidence furnished by petitioner lacks in showing receipts of mail for the law firm in the critical dates of June 27 – June 30, 2005: presumably when any correspondence mailed on June 25, 2005 (Saturday) would have most likely been received. However it is reasonable to assume that if such papers were received, response due notations would occur within the three month time frame. Review of the evidence submitted shows no response due notations for the instant file, attorney docket number KCX-

750-CIP(13629.1) during the critical September 25, 2005 – September 30, 2005 time frame. Further, no entries for this docket number appear in the entire three-month evidentiary submission. Therefore, it can be reasonably concluded from the evidence submitted that petitioner did not in fact receive the remailed Notice of Allowance and Issue Fees Due or Notice of Formal Drawings Required remailed on September 25, 2005

Accordingly, the Notice of Abandonment is hereby withdrawn and vacated. The application is being forwarded to the Head Supervisory Applications Examiner of Technology Center 3700 to have the application's status restored to pending and for remailing of the Notice of Allowance and Issue Fees Due. It is noted that the drawings appear acceptable by current standards.

Any inquiry regarding this decision should be directed to Special Programs Examiner J. Harrison at 571-272-4449.

PETITION GRANTED

Frederick R. Schmidt, Director
Technology Center 3700

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 4

Dennis S. Fernandez
FERNANDEZ & ASSOCIATES LLP
1047 El Camino Real
Suite 201
Menlo Park, CA 94025

In re Application of:
Ott, Michael
Application No. 09/792,599
Filed: February 23, 2001
For: METHOD AND SYSTEM FOR DETERMINISTIC PSEUDO-RANDOM VALID ENTRY RESOLUTION

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed July 15, 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 signed by Dennis S. Fernandez alone and does not contain a clear indication that Mr. Fernandez 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.

FOR James R. Matthews

Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

UNITED STATES PATENT AND TRADEMARK OFFICE

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MICHAEL L. GENCARELLA, ESQ.
MARTINE & PENILLA, LLP
710 LAKEWAY DR., SUITE 170
SUNNYVALE, CA 94085

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FEB 22 2005

OFFICE OF PETITIONS

In re Application of :
Michael L. Ott :
Application No. 09/792,599 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. ALTEP067 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 26, 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 January 22, 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 April 23, 2004.

In view of the submission of the petition fee in the large entity amount of $1370.00, status as a small entity has been removed.

The Revocation of Power of Attorney and Change of Correspondence Address has been accepted and recorded.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 2100, Art Unit 2124 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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M. Robert Kestenbaum
11011 Bermuda Dunes NE
Albuqueurque NM 87111

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OFFICE OF PETITIONS

In re Application of :
Wegmann et al. :
Application No. 09/792,607 : DECISION ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. (Z) 00019 P US :

This is a decision on the petition under 37 CFR §1.137(b), filed November 5, 2004, to revive the above-identified application.

This above-identified application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office Action of June 4, 2003. The final Office Action set a three (3) month shortened statutory period for reply. An amendment after final office action was submitted with a two month extension of time fee on October 14, 2003. An Advisory Action mailed on December 4, 2003 informed petitioner the amendment submitted did not place the application in condition for allowance. Accordingly, this application became abandoned on November 4, 2003. A Notice of Abandonment was mailed on September 29, 2004.

The requirements for the filing of a grantable petition under 37 CFR §1.137(b) have been met. This Petition is hereby **Granted**.

Petitioner has requested a refund of the Notice of Appeal fee in the amount of $320 and a two month extension of time fee in the amount of $420. A review of the record shows a Notice of Appeal was filed on December 27, 2003. However, a Notice of Appeal fee was not charged.

Further review of the record shows petitioner submitted an untimely request for a two month extension of time on April 22, 2004. However, pursuant to 37 CFR §1.136, an extension of time must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988) Petitioner's six (6) month statutory period expired on December 4, 2003. Petitioner was ineligible for any extensions of time. Accordingly, the $420 will be refunded.

This application is being forwarded to Technology Center 2800 for further processing of the Request for Continued Examination (RCE) and the amendment submitted with the instant petition.

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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32ND FLOOR
300 S. WACKER DRIVE
CHICAGO IL 60606

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In re Application of	:	
Belardinelli et al.	:	
Application No. 09/792,617	:	ON PETITION
Filed: February 23, 2001	:	
Attorney Docket No. MBHB 00-078-B	:	

This is a decision on the petition, filed September 22, 2003 and again on June 29, 2004, which is being treated as a petition under 37 CFR 1.181, requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **DISMISSED**.

This application was held abandoned for failure to timely respond to the Office action of January 7, 2003, which set a three (3) month shortened statutory period for reply. Accordingly, a reply was due on or before April 7, 2003. A Notice of Abandonment was mailed August 13, 2003.

Petitioner states that a continuation application was filed on July 3, 2003. Further, an authorization of Applicant's attorneys under 37 CFR 1.136(a)(3) to treat any future reply in this or any related application filed pursuant to 37 CFR 1.53 requiring an extension of time as incorporating a request therefore was in the transmittal letter submitted upon filing of the instant application.

Petitioner asks for the abandonment to withdrawn and insists the Office should have charged the $930.00 three-month extension of time necessary for copendency between the instant application and the continuing application, based on the above statement.

However, as stated in MPEP 201.06(c), section X,

> *Under 37 CFR 1.136(a)(3), an authorization to charge all required fees, fees under 37 CFR 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time for its timely submission. A continuing application filed under 37 CFR 1.53(b) is a new application which is assigned a new application number and filing date and is maintained separately from the file of the prior application. The filing of a continuing application is not a paper directed or placed in the file of the prior application and is not a "reply" to the last Office action in the prior application. Thus, a petition for an extension of time and the fee set forth in 37 CFR 1.17 are required to be filed as a separate paper in the prior application.*

The mere filing of a continuing application does not constitute a reply to the Office action. As such, the conditional authorization to charge a necessary extension of time included in the original transmittal letter is also not valid reply and does not warrant a withdrawal of the holding of abandonment. The petition is hereby dismissed.

Petition may wish to pursue revival of the application under the unintentional provisions of 37 CFR 1.137(b). A grantable petition under 37 CFR 1.137(b) must be accompanied by:

(1) the required reply,[1]
(2) the petition fee,
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

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

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

By hand: Customer Window located at:

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

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

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

Liana Walsh
Petitions Examiner
Office of Petitions

[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.

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

April 1, 2003

Stephen C. Durant
Morrison & Foerster
425 Market St.
San Francisco, CA 94105-2482

In re application of:
Yet Mui et al DECISION ON PETITION
Serial No.: 09/792,624
Filed: February 23, 2001
For: METHOD FOR ENTERPRISE
WORKFORCE PLANNING

This is a decision on the petition received on February 26, 2003, to withdraw the holding of abandonment in the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 C.F.R. 1.113 in timely manner to the Notice to File Missing Parts of Application mailed June 6, 2001. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned August 7, 200l.

On February 26, 2003, the office received a communication from the attorney of record. Enclosed was an acknowledgment that the attorney responded to the Notice to File Missing Parts on October 9, 2001and the Notice of Incomplete Reply on January 9, 2002 with 5 months of extensions.

The evidence submitted is sufficient to establish that the petitioners responded to the Notice to File Missing Parts on October 9, 200l and the Notice of Incomplete Reply on January 9, 2002 with a certificate of mailing dated December 6, 2001.

The petition is hereby GRANTED.

The application has been completed for release to Technology Center 2176.

The office regrets any inconvenience this may have caused the client.

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

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : May 29, 2009

TO SPE OF : ART UNIT 3625
SUBJECT : Request for Certificate of Correction for Appl. No.: 09/792646 /7076449

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: _____

JEFFREY A. SMITH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

SPE 3625 **Art Unit**

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JUN 22 2006

Director's Office
Group 3700

Amedeo F. Ferraro
MARTIN & FERRARO, L.L.P.
1557 Lake O'Pines Street, NE
Hartville, Ohio 44632

In re Application of: Gary K. Michelson
Appl. No.: 09/792,679
Filed: February 22, 2001
For: INTERBODY SPINAL FUSION IMPLANT HAVING AN ANATOMICALLY CONFROMED TRAILING END

DECISION ON PETITION

This is a decision on the petition filed on Oct. 17, 2005 by which petitioners request supervisory review and withdrawal of the finality of the office action dated April 18, 2005. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is dismissed.

A review of the relevant prosecution history shows that the applicant filed a RCE on Feb. 4, 2005 with amendment to claims 1, 76, 116 and non-elected independent claim 95. The RCE was properly filed in accordance with the 35USC 132(b) and MPEP 706.07(h). On April 18, 2005, the examiner issued a first Office action final rejection to the RCE. The examiner finally rejected claims 1, 7, 10-15, 17-18, 67-94 and 114-124 under applicable sections of 35 USC 102 and 103 based on the references to GLSA, FR 2761879A1 and Rehberg et al USP 6,034,295 and Brantigan US Pat 5.192,327. This final rejection is the first office action based on different references from the previous final rejection of August 5, 2004 and was necessitated by the altered scope of the claimed invention and not by a shift to a different invention (the last sentence of page 3 of the advisory action of September 13, 2005). In response to the first Office action final rejection, the applicant filed a 37 CFR 1.116 amendment on August 19, 2005. The applicant amended claims 1, 7, 76, 84, 116, 117, 123, added new claims 125-132 and cancel non-elected claims 95-113. The applicant also requested the examiner to withdraw the finality of the last office action. Subsequently, the examiner issued an advisory action and refused the entry of the amendment after final.

On October 17, 2005, the petitioner filed the current petition requesting supervisory review of the propriety of the final rejection and withdrawal of the finality of the office action dated April 18, 2005 pursuant to MPEP 706.07(d) and issuance of a non-final office action. The petitioner is of the opinion that first Office action final rejection of 4/18/05 was improper under MPEP 706.07(b), claims filed in the amendment of 2/4/05 changed the scope of the claims from the previously filed claims so that they are not drawn to same invention and the claims presented on 2/4/05 could not have been finally rejected on the grounds and art of record in the next office

action if they had been entered in the application earlier under 37 CFR 1.114. The Petitioner also noted that the claims in the amendment of 2/4/05 raised new issue that required further consideration by the examiner.

Analysis of Application Record

In the earlier final rejection of August 5, 2004, three separate prior art references, namely Grosse et al. WO 97/23174, Rehberg et al. US 6,034,295 and GLSA, FR 2 761 879 Al, were applied against the claims. In response to the final rejection, on Feb. 4, 2005 the applicant filed the current RCE with an amendment to amend, among other dependent claims, the independent claims 1 and 76. It should be noted that under MPEP 706.07(h), applicant cannot file an RCE to obtain continued examination on the basis of claims that are independent and distinct from the previously claimed and examined as a matter of right (i.e. applicant cannot switch inventions).

In order to determine whether or not the claims filed earlier on 4/24/04 and the claims filed with the RCE on 2/4/05 are directed to the same invention. A comparison of at least the independent claims 1 and 76 must be made. The finally rejected independent claims 1 and 76 in the earlier final rejection of August 5, 2004 are reproduced below.

Claims 1. (previously presented) A manufactured preformed interbody spinal fusion implant for insertion at least in part across a surgically corrected height of a disc space between two adjacent vertebral bodies of a human spine, the vertebral bodies having an anterior aspect, a posterior aspect, and to each side a lateral aspect, said implant comprising: a leading end for insertion into the disc space, an opposite trailing end, a mid-longitudinal axis passing through said leading and trailing ends, and a cross section of said implant transverse to the mid-longitudinal axis adjacent to said trailing end being generally circular, said trailing end having an outer perimeter configured to be rotationally asymmetrical about the mid-longitudinal axis; and opposed arcuate convex portions adapted for placement toward and into the adjacent vertebral bodies, said implant having a height between said opposed arcuate convex portions defining an implant height greater than the surgically corrected height of the disc space into which said implant is to be implanted, each of said opposed arcuate convex portions having at least one opening, said openings being in communication with one another to permit for the growth of bone from adjacent vertebral body to adjacent vertebral body through said implant.

76. (currently amended) A manufactured preformed interbody spinal fusion implant for insertion at least in part across a surgically corrected height of a disc space between two adjacent vertebral bodies of a human spine, the vertebral bodies having an anterior aspect, a posterior aspect, and to each side a lateral aspect, said implant comprising: a leading end for insertion into the disc space, an opposite trailing end having an exterior surface, and a mid-longitudinal axis passing through said leading and trailing ends; opposed arcuate convex portions adapted for placement toward and into the adjacent vertebral bodies, said implant having a height between said opposed arcuate convex portions defining an implant height greater than the surgically corrected height of the disc space into which said implant is to be implanted, each of said opposed arcuate convex portions having at least one opening, said openings being in communication with one another to permit for the growth of bone from adjacent vertebral body to adjacent vertebral body through said implant, and opposed first and second side walls connecting said opposed arcuate convex portions, said trailing end being asymmetrical in a cross sectional plane transverse to the mid-longitudinal axis, said trailing end having an outer perimeter that curves at least in part along a plane transverse to the mid-longitudinal axis and along a plane parallel to the mid-longitudinal axis ~~being generally non-planar along a cross sectional plane transverse to the mid-longitudinal axis of said implant~~.

The claims filed with the RCE Feb. 4, 2005 are also reproduced below.

1. (currently amended) A manufactured preformed interbody spinal fusion implant for insertion at least in part across a surgically corrected height of a disc space between two adjacent vertebral bodies of a human spine, the vertebral bodies having an anterior aspect, a posterior aspect, and to each side a lateral aspect, said implant comprising: a leading end for insertion into the disc space, an opposite trailing end, and a mid-longitudinal axis passing through said leading and trailing ends, ~~and a cross section of said implant transverse to the mid-longitudinal axis adjacent to said trailing end being generally circular~~, said trailing end having an outer perimeter configured to be rotationally asymmetrical about the mid-longitudinal axis; and opposed arcuate convex portions adapted for placement toward and into the adjacent vertebral bodies, said implant having a height between said opposed arcuate convex portions defining an implant height greater than the surgically corrected height of the disc space into which said implant is to be implanted, said trailing end of said implant having a maximum width as measured across the mid-longitudinal axis and being transverse to the height of said implant, each of said opposed arcuate convex portions having at least one opening, said openings being in communication with one another to permit for the growth of bone from adjacent vertebral body to adjacent vertebral body through said implant, said trailing end having an exterior surface that is curved across a substantial portion of the maximum width of said implant.

76. (currently amended) A manufactured preformed interbody spinal fusion implant for insertion at least in part across a surgically corrected height of a disc space between two adjacent vertebral bodies of a human spine, the vertebral bodies having an anterior aspect, a posterior aspect, and to each side a lateral aspect, said implant comprising: a leading end for insertion into the disc space, an opposite trailing end ~~having an exterior surface~~, and a mid-longitudinal axis passing through said leading and trailing ends, opposed arcuate convex portions adapted for

placement toward and into the adjacent vertebral bodies, said implant having a height between said opposed arcuate convex portions defining an implant height greater than the surgically corrected height of the disc space into which said implant is to be implanted, said trailing end of said implant having a maximum width as measured across the mid-longitudinal axis and being transverse to the height of said implant, each of said opposed arcuate convex portions having at least one opening, said openings being in communication with one another to permit for the growth of bone from adjacent vertebral body to adjacent vertebral body through said implant; and opposed first and second side walls connecting said opposed arcuate convex portions, said trailing end being asymmetrical in a cross sectional plane transverse to the mid-longitudinal axis, said trailing end having an outer perimeter that curves at least in part along a plane transverse to the mid-longitudinal axis and along a plane parallel to the mid-longitudinal axis, said trailing end having an exterior surface that is curved across a substantial portion of the maximum width of said implant.

In comparison of claim 1 of the amendment filed 4/24/04 and 2/4/05, the claims basically remain directed to an interbody spinal fusion implant for insertion at least in part across a surgically corrected height of a disc space between two adjacent vertebral bodies of a human spine. Claim 1 of 4/24/04 contains a feature that the cross section of the implant transverse to the mid-longitudinal axis adjacent to the trailing end being generally circular. Claim 1 of 2/4/05 was broadened. Such limitation was deleted but other limitations regarding the width, height and curved surface were added. Both claim ones required same search fields and belong to same classification. Therefore, it is concluded that both claim ones are not independent and distinct from each other and are directed to the same invention with different scopes.

In comparison of claim 76 of the amendment filed 4/24/04 and 2/4/05, the claims basically remain directed to an interbody spinal fusion implant for insertion at least in part across a surgically corrected height of a disc space between two adjacent vertebral bodies of a human spine. The implant has a leading end for insertion, an opposite trailing end and a mid-longitudinal axis passing through the leading and trailing ends. Claim 76 of 4/24/04 requires the opposite trailing end having exterior surface. Whereas claim 76 of 2/4/05 further define that exterior surface being curved across a substantial portion of the maximum width of the implant. Claim 76 of 2/4/05 was broader than the claim 76 of 2/4/05. Both claim seventy-sixes require the same search fields and belong to same classification. Therefore, it is concluded that both claim seventy-sixes are not independent and distinct from each other and are directed to the same invention with different scopes.

In order to determiner whether or not the final rejection given on 4/18/05 was necessitated by the applicant's amendment of 2/4/5, a comparison with the previous final rejection of 8/5/04 must be made. It is noted that the examiner withdrew two rejections of claims 1, 7, 10, 11, 14, 15, 17, 18, 67-70, 72-79, 81-89, 91-94, 115, 117-119, 121, 123, 124 based on Grosse et al WO 97/23174 patent due to the applicant's amendment of 2/4/05 filed with the RCE. It appears to be the applicant's amendment has overcome the rejections of those claims based on this reference. However, the amended independent claim 1was broadened by deleting a previously claimed feature regarding the cross section of the implant transverse to the mid-longitudinal axis adjacent to the trailing end being generally circular. Amended claim 1 also added a few other limitations regarding the width, height and curved surface. The amended independent claim 76 added limitations regarding the exterior surface being curved across a substantial portion of the maximum width of the implant. In both rejections of 8/5/04 and 4/18/05, the rejection of claims 1, 7, 11-15, 17, 18, 67-75, 114-117 and 119 based on Rehberg et al patent US Pat. 6034295 remained unchanged and repeated. The rejection of claims 1, 7, 11-15, 17, 18, 67-77, 79-94 and 120-124 based on GLSA French pat. 2761879A1 also remained unchanged and repeated. This resulted in dependent claims 10, 78, and 118 with no art rejection. Subsequently, the examiner found dependent claims 10, 78, and 118 along with their independent claims to be unpatentable. The examiner applied another reference of record, Brantigan US Pat. 5192327 for two additional

rejections of the entire chains of claims 1, 7, 10, 11, 14, 15, 17, 18, 67-70, 72-79, 81-89, 91-94, 115, 117-119, 121, 123, 124 under 35 USC 102 (b) and 103(a).

In view of the applicant's amendment of 2/4/05 which changed the scope of the claims, the examiner withdrew the rejections of claims1, 7, 10, 11, 14, 15, 17, 18, 67-70, 72-79, 81-89, 91-94, 115, 117-119, 121, 123, 124 based on Grosse patent due to the applicant's amendment of 2/4/05, then, the examiner substituted for two new rejections under 35 USC 102(b) and 103(a) based on another reference of record, Brantigan US Pat. 5192327. This is a clear indication that the new grounds of rejections of claims were necessitated by the applicant's amendment of 2/4/05.

Based on the analysis of record, when the examiner promulgated the first office action final rejection of April 18, 2005, the conditions set forth in MPEP 706.07(b)[1] were met. In particular, the claims in the amendment of 2/4/05 in fact are directed to the same invention of the claims in the earlier amendment as indicated by the contents of the claims, supra. The claims in the amendment of 2/4/05 would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered earlier. Therefore, under MPEP 706.07(b) the first action final rejection appears to be proper.

For the foregoing reasons it appears that the examiner did not abuse his discretion, or act in an arbitrary or capricious manner, in making the April 18, 2005 Office action final. Therefore, there is no basis for granting any of the relief requested.

The application is being forwarded to the Supervisory Patent Examiner of Art Unit 3738 pending the filing of a proper reply to the final rejection. See relevant provisions of 37 CFR 41.31, 1.113, 1.114 and 1.116. Petitioner is reminded that the period for filing such reply remains as set forth in the final rejection notwithstanding the filing of the instant petition. Petitioner may file a request for reconsideration of this decision, without fee. However, such request must be filed within two months of the date of this decision. See 37 CFR 1.181(f). Should petitioner have any further questions, he is invited to contact TC 3700 SPRE Henry Yuen at 571-272-4856.

PETITION DISMISSED

Frederick R. Schmidt, Director
Technology Center 3700

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[1] **706.07(b) Final Rejection, When Proper on First Action [R-1]**
The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. A first Office action in a continuing or substitute application may not be made final if it contains a new ground of rejection necessitated by the amendments to 35 U.S.C. 102 (e) by the Intellectual Property and High Technology Technical Amendments of 2002 (Pub. L. 107-273, 116 Stat. 1758 (2002)). However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised. Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application. A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

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66 SOUTH SIXTH ST
MINNEAPOLIS MN 55402

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OFFICE OF PETITIONS

In re Application
Goronzy, et al.
Application No. 09/792,686
Filed: February 23, 2001
Atty Docket No. 07039-250001

: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT

This is a decision on the "PETITION TO CORRECT PATENT TERM ADJUSTMENT UNDER 37 CFR §1.705(b)," filed July 14, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred twenty-nine (129) days to four hundred ninety (490) 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 **four hundred ninety (490) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 5, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is one hundred twenty-nine (129) days. On July 14, 2004, applicants timely[1] submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is four hundred ninety (490) days.

[1] The application for patent term adjustment was submitted prior to payment of the issue fee.

Applicants assert entitlement to a patent term adjustment of four hundred ninety (490) days on the basis that the PTO improperly assessed applicants a delay of three hundred sixty-five (365) days for responding to a Notice to File Missing Parts mailed on April 11, 2001. Applicants assert that they filed a response on July 11, 2001, not July 11, 2002.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of one hundred twenty-nine (129) days based on an adjustment for PTO delay of five hundred twenty-six (526) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by applicants' delays of three hundred sixty-five (365) days and thirty-two (32) days, both pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. § 1.704(b). The PTO delay of thirty-two (32) days has been reviewed and found to be correct. The adjustment of three hundred sixty-five (365) days is at issue.

The adjustment of three hundred sixty-five (365) days has been found to be incorrect. Applicants have submitted a copy of a postcard receipt for the instant application, itemizing a declaration and the proper fees, and bearing a USPTO date stamp of June 11, 2001. A postcard receipt which itemizes and properly identifies the items which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.[2] Accordingly, it is concluded that Applicants filed a complete reply in response to the April 11, 2001 "Notice to File Missing Parts" on June 11, 2001. No applicant delay should have been assessed for this response.

Next, on July 25, 2001, the Office mailed a "Cover Letter for Correction of Previous Notice" and a "Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures" (hereinafter "Sequence Listing Notice"). Applicants did not file a response to this notice until January 30, 2002, a delay of ninety-seven (97) days. However, applicants' response contained a Certificate of Mailing dated October 24, 2001. In this situation the Office has stated that when:

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[2] MPEP 503.

> a reply to an Office action or notice was mailed on or after October 13, 2001 and no later than December 1, 2001 (as shown on a certificate of mailing under 37 CFR 1.8), ... the Office will...reinstate a period equal to the period beginning on the date that is four business days after the date indicated on the certificate of mailing on the reply and the date of receipt (37 CFR 1.6) of the reply in the Office up to a maximum of three months.[3]

In view of the above, applicants should only have been assessed a delay of four (4) days for their January 30, 2002 response (97 days of applicant delay (October 25, 2001 to January 30, 2002) with a reinstatement of 93 days (October 30, 2001 to January 30, 2002).

Lastly, the Office mailed an additional "Sequence Listing Notice" on April 22, 2002. Applicants filed a reply on June 5, 2002. Accordingly, no applicant delay should have been assessed.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **four hundred ninety (490) days** (526 days of PTO delay and 36 (32 + 4) days of applicant delay).

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e).

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (703) 305-0272.

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

Enclosure: Copy of Revised PAIR Screen

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[3] Processing of, and Requirements for, the Filing of Duplilcate Applications and Papers in Patent Applications in view of USPS Mail Delays, 1254 OG 92 (January 15, 2002).

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Paper No. 25

Patent Legal Department/A-42-C
Beckman Coulter, Inc.
4300 N. Harbor Blvd., Suite 3100
Fullerton, CA 92834-3100

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OFFICE OF PETITIONS

In re Application of :
Stephen D. Mikolajczyk :
Application No. 09/792,692 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. 1582D-451 (81841.0182) :

This is a decision on the petition under 37 CFR 1.137(b), filed October 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 Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures (Notice) mailed January 15, 2003. The Notice set a period for reply of one (1) month 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 February 16, 2003.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. However, in accordance with 37 CFR 1.34(a), the signature of Wei-Ning Yang appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts. However, if Wei-Ning Yang desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. A courtesy copy of this decision is being mailed to petitioner. Nevertheless, all future correspondence regarding this application file will be directed solely to the address of record until otherwise instructed.

The application file is being forwarded to Technology Center AU 1642.

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

cc: Biltmore Tower
Hogan & Hartson
500 South Grand Avenue, Suite 1900
Los Angeles, CA 90071

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LAW OFFICE OF SCOTT C HARRIS INC
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RANCHO SANTA FE, CA 92067

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OFFICE OF PETITIONS

In re Application of
William E. Hewlett
Application No. 09/792,729
Filed: February 22, 2001
Attorney Docket No. 07319-085002

ON PETITION

This is a decision in response to the petition, filed July 29, 2008, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 12, 2007, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the application became abandoned on January 13, 2008. A Notice of Abandonment was mailed on May 7, 2008. On July 29, 2008, 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 amendment; (2) the petition fee of $1,540; and (3) an adequate statement of unintentional delay[1].

The application is being referred to Technology Center AU 2628 for appropriate action by the Examiner in the normal course of business on the amendment received July 29, 2008.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

[1] 37 CFR 1.137(b)(3) requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. 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.

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Paper No. 11

In re application of
Charles Redlin
Serial No. 09/792,739
Filed: February 23, 2001
For: ARTWORK AND METHOD OF MAKING THE SAME

DECISION ON
PETITION

This is a decision on the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed September 15, 2003, for failure to timely reply to the Final Rejection dated December 30, 2002. Petitioner contends that the said Rejection was never received.

DECISION

Since petitioner asserts that the Office Action was never received, the request is accepted as a petition under 37 C.F.R. 1.181 (no fee). A review of the file and petitioner's evidence provided with the instant petition indicates that the request has merit.

Submitted as evidence is 1) a statement that no such Office Action was ever received, 2) a statement that a review of the file record was made, but the Action not found, and 3) submission of a copy of the docket records, showing that the Office Action was not received.

Therefore, the Notice of Abandonment dated August 12, 2003 is hereby withdrawn.

The Petition is **GRANTED.**

The case will be delivered to the LIE and returned to pending status. After such is completed, the Final Rejection of December 30, 2002 will be remailed and time period for response will be restarted.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

DORSEY & WHITNEY LLP
Intellectual Property Department
50 South Sixth Street
Minneapolis, MN 55402-1498

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Paper No. 6

Kent A. Herink, Esq.
Davis, Brown, Koehn, Shors & Roberts, P.C.
2500 Financial Center
666 Walnut Street
Des Moines, IA 50309

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JUL 12 2002
OFFICE OF PETITIONS

In re Application of :
Robert G. McCracken :
Application No. 09/792,745 : ON PETITION
Filed: February 23, 2001 :
Attorney Docket No. 8594560/27150 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 14, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice To File Missing Parts Of Non-Provisional Application mailed April 10, 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 June 11, 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

for Sherry Brinkley
Petitions Examiner

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 03/04/10

TO SPE OF : ART UNIT 2465

SUBJECT : Request for Certificate of Correction for Appl. No.: 09792765 Patent No.: 7079508

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

FOR IFW FILES:

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

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

FOR PAPER FILES:

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

Certificates of Correction Branch (C of C)
Randolph Square 9D40-D
Palm Location 7580

[redacted]

Lamonte Newsome
Certificates of Correction Branch
703-756-1574

Thank You For Your Assistance

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

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

Comments: _____

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_____

_____

_____ 2465
SPE **Art Unit**

PAGE 2/4 * RCVD AT 3/9/2010 8:21:55 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-5/0 * DNIS:2709990 * CSID: * DURATION (mm-ss):01-40

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OFFICE OF PETITIONS

DAY PITNER LLP
7 TIMES SQUARE
NEW YORK, NY 10036-7311

In re Application of :
Naganori MASUBUCHI, et al :
Application No. 09/792,776 : DECISION ON PETITION
Filed: February 23 2001 : TO WITHDRAW
Attorney Docket No. 3094-31 : 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 March 26, 2007.

The request is **APPROVED**.

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

The request was signed by Lindsay S. Adams on behalf of all attorneys of record who are associated with customer No. 29540.

All attorneys/agents associated with the Customer Number 29540 have been withdrawn.

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

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

There are no pending Office actions at the present time.

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

April Wise
Petitions Examiner
Office of Petitions

cc: NAGANORI MASUBUCHI
1-34-1-1007, ASAGAYAMINAMI,
SUGINAMI-KU,
TOKYO, JAPAN

cc: MR. MITSUO MATSUI
MATSUI AND ASSOCIATES
NISHISHIBASHI YS BUILDING, 3F
19-2, NISHISHINBASHI 2-CHOME
MINATO-KU
TOKYO, JAPAN

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MAIL Paper No. 6

MAR 16 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Fish & Richardson P.C.
12390 El Camino Real
San Diego, CA 92130

In re Application of
Scot Fairchild :

Application No. 09/792,792 : DECISION ON REQUEST TO
Filed: February 22, 2001 : WITHDRAW FROM RECORD
For: **MULTI-INPUT WAVELOCKER FOR CONTROLLING LASER WAVELENGTHS OF MULTIPLE LASERS** :

This is a decision on the Request for Withdrawal as agent of record received on February 10, 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**.

Attorneys/agents associated with the firm of Fish & Richardson P.C., listed in the Request for withdraw 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.

The file is being returned to TC 2600 Central Files to await a response to the Outstanding Office Action, mailed on December 03, 2003 (Paper No. 4).

Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4778

Cc: Thomas F. Cooney, Patent Adminstration
Avanex Corporation
40919 Encyclopedia Circle
Fremont, CA 94538

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DIW Mar-06

PATTERSON & SHERIDAN, LLP
3040 POST OAK BLVD
SUITE 1500
HOUSTON TX 77095

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MAR 1 5 2006

OFFICE OF PETITIONS

In re Application of :
Scot Fairchild :
Application No. 09/792,792 : ON PETITION
Filed: 22 February, 2001 :
Atty Dckt No. 11971-009001 :

This is a decision on the petition filed on 17 May, 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 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 application became abandoned on 3 January, 2005, for failure to timely submit a proper reply to the final Office action mailed on 2 July, 2004, which set a three (3) month shortened statutory period for reply. On 24 August, 2004, an amendment after final rejection was filed. The examiner determined that the amendment did not place the case in *prima facie* condition for allowance, however, and an Advisory Action stating that the period for reply expired six (6) months from the mailing date of the final rejection was mailed on 3 November, 2004. Notice of Abandonment was mailed on 23 February, 2005.

Petitioner has filed a new amendment after final rejection. As the examiner has determined that the amendment places the application in *prima facie* condition for allowance, the reply may be favorably considered.

The application is being referred to Technology Center Art Unit 2633 for further processing.

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

D Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

AUG 26 2005

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~~AUG 25 2005~~ VOID

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

In re Application of	:
John R. McDonald et al	:
Serial No.: 09/792,793	: PETITION DECISION
Filed: February 22, 2001	:
Attorney Docket No.: 17080-002004	:

This is in response to the petition under 37 CFR 1.181, filed June 9, 2005, requesting withdrawal of the Final rejection, mailed April 7, 2005.

BACKGROUND

A review of the file history shows that the examiner mailed a non-Final Office action to applicants on November 21, 2003, setting a three month shortened statutory period for reply. Claims 1-26 were rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. All other rejections were withdrawn.

Applicants replied on May 21, 2004, by filing a response and a request and fee for a three month extension of time. A supplemental response was received June 10, 2004, which included an executed affidavit. Applicants did not amend the claims and replied to the lone rejection with 39 pages of argument and affidavit.

The examiner mailed a Final Office action to applicants on April 7, 2005, setting a three month shortened statutory period for reply. The examiner again rejected claims 1-26 under 35 U.S.C. 112, first paragraph, for lack of enablement as the sole rejection and made the action Final.

Applicants then filed this petition on June 9, 2005.

DISCUSSION

Applicants request withdrawal of the finality of the Office action of April 7, 2005, even though the rejection set forth is on the same basis as the previous non-Final Office action on the basis that the rejection now includes a new argument or ground of rejection within the rejection basis. In view of this the examiner's mailing of a new Office action, the Office action of April 7, 2005, has been withdrawn.

DECISION

The petition is **DISMISSED** as moot.

It is noted that the examiner in view of the petition has withdrawn the last Office action and mailed a new Final Office action to applicants on August 10, 2005, setting a new three month shortened statutory period for reply which may be extended under 37 CFR 1.136(a)

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

George C. Elliott
Director, Technology Center 1600

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FISH & RICHARDSON, PC
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

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OCT 0 2 2006

OFFICE OF PETITIONS

In re Application of :
McDonald et al. :
Application No. 09/792,793 : LETTER REGARDING
Filed: February 22, 2001 : PATENT TERM ADJUSTMENT
Attorney Docket No. 25020-601D:

This is in response to the LETTER REGARDING PATENT TERM ADJUSTMENT (PTA) PURSUANT TO COMMENT 43 OF THE FINAL RULE (09/18/00) AT ALLOWANCE OF APPLICATION filed July 7, 2006. Applicants indicate that there may be errors resulting in a number of total PTA days that have not been earned by the Applicant.

On April 17, 2006, 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 282 days. On July 7, 2006, applicants filed the instant comment.

However, on July 17, 2006, applicants filed a request for continued examination (RCE). Pursuant to this filing, prosecution may be reopened. It is noted that petitioner has not paid the issue fee.

In view thereof, a decision is being **held in abeyance** until after the mailing of any new Notice of Allowance and the filing of any application for patent term adjustment under 37 CFR 1.705(b) or resubmission of letter pursuant to comment 43. A new determination of patent term adjustment will accompany any new Notice of Allowance and will include any further adjustments or reductions accrued to date. Applicants must submit a timely application for patent term adjustment in response to any new

Notice of Allowance. Further, applicants continue to be under a duty of candor to the Office. An application for patent term adjustment under 37 CFR 1.705(b) is properly filed after the mailing of the Notice of Allowance on which the application issues and prior to payment of the issue fee (or a request for reapplication of the issue fee) in response to that Notice. A candor letter properly accompanies any issue fee payment in response to any new Notice of Allowance.

Technology Center AU 1647 has been advised of this decision. The application is, thereby, forwarded to the Technology Center for consideration of the RCE by the examiner.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.

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

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FEB 0 8 2007

OFFICE OF PETITIONS

In re Application of :
McDonald et al. :
Application No. 09/792,793 : LETTER REGARDING
Filed: February 22, 2001 : PATENT TERM ADJUSTMENT
Attorney Docket No. 25020-601D:

This is in response to the PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(b) filed October 11, 2006 and the LETTER REGARDING PATENT TERM ADJUSTMENT (PTA) PURSUANT TO COMMENT 43 OF THE FINAL RULE (09/18/00) AT ALLOWANCE OF APPLICATION filed July 7, 2006. Applicants indicate that there may be errors resulting in a number of total PTA days that have not been earned by the Applicant. Applicants disclose that the total initial determination of patent term adjustment should be twenty-seven (27) days, not one hundred fifty-one (151) days.

The request for review of the 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 twenty **(20)** days. A copy of the updated PALM screen, showing the correct determination, is enclosed.

On July 7, 2006, applicants filed the first comment. However, on July 17, 2006 (without having paid the issue fee), applicants filed a request for continued examination (RCE). By decision mailed October 2, 2006, a decision on the comment was held **in abeyance** until after the mailing of any new Notice of Allowance and the filing of any application for patent term adjustment

under 37 CFR 1.705(b) or resubmission of letter pursuant to comment 43.

On October 3, 2006, the Office mailed the new 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 151 days. In response, applicants renewed with specificity their comments on the initial determination of patent term adjustment.

Applicants' comments have been considered and found persuasive. Generally, the Office agrees with the amounts and bases of patent term adjustment set forth in enumerated paragraphs (1) through (7) of the renewed petition filed October 11, 2006. This agreement is reflected in the adjustments entered and shown on the enclosed PALM INTRANET PTA calculation. Except, the Office also entered a period of reduction of 8 days, pursuant to 37 CFR 1.704(c)(8), for applicant delay in filing a paper (a request for correcting filing receipt) on March 21, 2006 after having filed a second preliminary amendment on March 13, 2006. Entering this 8-day reduction along with the other agreed adjustments, the computer calculated the corrected initial determination of patent term adjustment as twenty (20) days (28 not 27 days further reduced by 8 days).

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is twenty (20) days.

As both letters were submitted as an advisement to the Office of an error in Applicants' favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office. The specificity with which applicants disclosed the errors in the PTA calculation is especially appreciated.

The application is being forwarded to the Office of Patent Publication for issuance of the application. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years

to issue the patent (to the extent that the three-year period does not overlap with periods already accorded).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

PTA Calculations for Application: 09/792793			
Application Filing Date:	02/22/2001	PTO Delay (PTO):	484
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	333
Post-Issue Petitions:	0	Total PTA (days):	20
PTO Delay Adjustment:	-131		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
104	02/03/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		8	
103	02/03/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		31	
102	02/03/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	4		
101	02/03/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		125	
100	02/03/2007	ADJUSTMENT OF PTA CALCULATION BY PTO	131		
99	02/03/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		11	
98	02/03/2007	ADJUSTMENT OF PTA CALCULATION BY PTO		91	
89	10/03/2006	MAIL NOTICE OF ALLOWANCE			
88	10/03/2006	MAIL EXAMINER'S AMENDMENT			
87	10/02/2006	ISSUE REVISION COMPLETED			
86	10/02/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
85	10/02/2006	EXAMINER'S AMENDMENT COMMUNICATION			
84	10/02/2006	NOTICE OF ALLOWABILITY			
83	10/02/2006	PETITION DECISION - DISMISSED			
82	07/07/2006	PETITION ENTERED			
81	07/17/2006	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
80	07/17/2006	REFERENCE CAPTURE ON IDS			
79	07/17/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
78	08/02/2006	DATE FORWARDED TO EXAMINER			
77	07/17/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)			
76	08/02/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
75	07/17/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
74	05/10/2006	RECEIPT INTO PUBS			

73	05/10/2006	RECEIPT INTO PUBS			
72	05/04/2006	RECEIPT INTO PUBS			
71	05/04/2006	RECEIPT INTO PUBS			
70	04/28/2006	SEQUENCE FORWARDED TO PUBS ON TAPE			
69	04/21/2006	EXPORT TO INITIAL DATA CAPTURE			
68	04/17/2006	MAIL NOTICE OF ALLOWANCE			
67	04/17/2006	MAIL EXAMINER'S AMENDMENT			
66	04/17/2006	ISSUE REVISION COMPLETED			
65	04/17/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
64	04/17/2006	CASE DOCKETED TO EXAMINER IN GAU			
63	04/17/2006	EXAMINER'S AMENDMENT COMMUNICATION			
62	04/17/2006	NOTICE OF ALLOWABILITY			
61	03/23/2006	DATE FORWARDED TO EXAMINER			
60	03/13/2006	SUPPLEMENTAL RESPONSE			
59	06/06/2005	MISCELLANEOUS INCOMING LETTER			
58	02/16/2006	DATE FORWARDED TO EXAMINER			
57	02/10/2006	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
56	02/16/2006	DATE FORWARDED TO EXAMINER			
55	02/10/2006	REQUEST FOR CONTINUED EXAMINATION (RCE)		92	48
54	02/16/2006	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
53	02/10/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
52	02/10/2006	WORKFLOW - REQUEST FOR RCE - BEGIN			
51	08/26/2005	PETITION DECISION - DISMISSED			
50	06/09/2005	PETITION ENTERED			
48	08/10/2005	MAIL SUPPLEMENTAL FINAL REJECTION			
47	08/10/2005	SUPPLEMENTAL FINAL REJECTION			
46	04/07/2005	MAIL FINAL REJECTION (PTOL - 326)	198		34
45	04/05/2005	FINAL REJECTION			
44	05/28/2004	REFERENCE CAPTURE ON IDS			
43	05/28/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
42	07/02/2004	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
40	06/24/2004	CORRESPONDENCE ADDRESS CHANGE			

39	06/23/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
38	06/10/2004	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
37	06/23/2004	DATE FORWARDED TO EXAMINER			
36	06/10/2004	SUPPLEMENTAL RESPONSE		20	34
35	06/23/2004	DATE FORWARDED TO EXAMINER			
34	05/21/2004	RESPONSE AFTER NON-FINAL ACTION		90	29
33	05/21/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
32	06/10/2004	WORKFLOW INCOMING AMENDMENT IFW			
31	06/04/2004	CORRESPONDENCE ADDRESS CHANGE			
30	05/21/2004	WORKFLOW INCOMING AMENDMENT IFW			
29	11/21/2003	MAIL NON-FINAL REJECTION	125		25
28	11/20/2003	NON-FINAL REJECTION			
27	07/28/2003	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
26.8	08/18/2003	DATE FORWARDED TO EXAMINER			
26.6	07/28/2003	SUPPLEMENTAL RESPONSE		131	25
26.4	08/18/2003	DATE FORWARDED TO EXAMINER			
26.2	07/17/2003	SUPPLEMENTAL RESPONSE			
26	08/18/2003	DATE FORWARDED TO EXAMINER			
25	03/19/2003	RESPONSE AFTER NON-FINAL ACTION			
24	03/19/2003	REQUEST FOR EXTENSION OF TIME - GRANTED			
23	03/19/2003	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
22	03/19/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
21	01/17/2003	MAIL NON-FINAL REJECTION			
20	01/17/2003	NON-FINAL REJECTION			
19	11/19/2002	DATE FORWARDED TO EXAMINER			
18	11/04/2002	RESPONSE TO ELECTION / RESTRICTION FILED			
17	11/04/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
16	09/30/2002	MAIL RESTRICTION REQUIREMENT	161		-1
15	09/30/2002	REQUIREMENT FOR RESTRICTION / ELECTION			
14	09/10/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
		INFORMATION DISCLOSURE STATEMENT (IDS)			

13	01/17/2002	FILED			
12	10/09/2001	PRELIMINARY AMENDMENT			
11	07/23/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	02/05/2002	CASE DOCKETED TO EXAMINER IN GAU			
9	01/11/2002	APPLICATION DISPATCHED FROM OIPE			
8	01/10/2002	APPLICATION IS NOW COMPLETE			
7	10/05/2001	RECEIPT OF ALL ACKNOWLEDGEMENT LETTERS			
6	09/12/2001	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
5	06/01/2001	CORRESPONDENCE ADDRESS CHANGE			
4	06/01/2001	CORRESPONDENCE ADDRESS CHANGE			
3	03/27/2001	CRF IS FLAWED TECHNICALLY / NOT ENTERED INTO DATABASE			
2	03/20/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	02/22/2001	INITIAL EXAM TEAM NN			

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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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IFW→

SPE: B. Brumback

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6/7/07

TO SPE OF : ART UNIT 1647

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/792,293 Patent No.: 7192736

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

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

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

Lamonte M. Newsome
Certificates of Correction Branch
703-308-9390 ext. 112

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: Please disregard pages 10-67 of the response filed 5-25-07. These are copies of an earlier amendment and are not related to the certificate of corrections.

Gary B. Nickol
SPE

1647
Art Unit

UNITED STATES PATENT AND TRADEMARK OFFICE

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HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 272400
FORT COLLINS, CO 80527-2400

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AUG 3 2001

OFFICE OF PETITIONS
A/C PATENTS

In re Application of
Struble, et al.
Application No. 09/792,853
Filed: May 7, 2001
Attorney Docket No. 10003165-1

DECISION ON PETITION

This is a decision on the petition under §1.182, filed May 7, 2001, in essence, to accord a filing date as of the date of filing of the omitted drawings.

Application papers in the above-identified application were filed on February 23, 2001. However, on March 30, 2001, the Initial Patent Examination Division mailed applicant a "Notice of Omitted Items in a Nonprovisional Application." Petitioner was notified that the application papers had been accorded a filing date; however, Figures 5a and 5b described in the specification appeared to have been omitted.

In response, on May 7, 2001, petitioner timely filed the instant petition (and fee); submitted two (2) sheets of drawings containing the omitted figures; with a supplemental declaration amended to reference figures 5a and 5b, and in compliance with §§1.63 and 1.64; and a copy of the "Notice of Omitted Items."

In view thereof, the petition under §1.182 is **GRANTED**.

The application is being forwarded to the Office of Initial Patent Examination (OIPE) for further processing with a filing date of May 7, 2001, using the application papers received in the Office on February 23, 2001 and the two (2) sheets of drawings containing figures 5a and 5b filed on petition, May 7, 2001. Applicant will receive appropriate notifications regarding the fees owed, if any, and other information in due course from OIPE.

Telephone inquiries related to this decision may 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6

PILLSBURY WINTHROP LLP
725 SOUTH FIGUEROA STREET, SUITE 2800
LOS ANGELES , CA 90017-5406

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NOV 1 5 2001

OFFICE OF PETITIONS

In re Application of :
David Muang and Randy Salo :
Application No. 09/792,882 :
Filed: February 23,2001 :
Attorney Docket No. **78002-250052** :
Title: **WIRELESS BANKING SYSTEM** :

DECISION AFFORDING STATUS
UNDER 37 C.F.R. §1.47(a)

This is in response to the petition under 37 C.F.R. 1.47(a)[1], filed September 17, 2001.

The petition under 37 C.F.R. §1.47(a) is **GRANTED**.

The above-identified application was filed on February 23, 2001. On March 22, 2001, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted" (Notice), requiring an executed oath or declaration in compliance with §1.63, a surcharge for its late filing, the basic filing fee, and the fee for additional claims. This Notice set a two-month period for reply.

In reply, applicant filed the instant petition (and fee). To make timely this reply, a three-month extension of time was charged to counsel's Deposit Account, as authorized[2]. Accompanying the

[1]A grantable petition under 37 C.F.R. §1.47(a) requires:
(1) the petition fee of $130;
(2) a surcharge of either $65 or $130 if the petition is not filed at the time of filing the application;
(3) a statement of the last known address of the non-signing inventors;
(4) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review;
(5) proof that the non-signing inventor refuses to sign the oath or declaration after having been presented with the application papers if the inventor refuses to sign, or proof that diligent efforts have been made to locate the non-signing inventor if he or she cannot be found, and;
(6) a declaration which complies with 37 CFR §1.63.

2 Petitioner requested a two-month extension of time. However, as the certificate of mailing is dated July 23, 2001, a three-month extension of time is required.

petition was a statement from the attorney of record, Steven Smyrski, and a copy of the letter sent to the non-signing inventor.

The statement of Mr. Smyrski sets forth that a copy of the application was sent to the last known address of the non-signing inventor, and that he has failed to respond.

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

As provided in Rule 1.47(a), this Office will forward notice of this application's filing to the non-signing inventor at the address given in the petition, not the Declaration. Notice of the filing of this application will also be published in the Official Gazette.

After this decision is mailed, the application will be forwarded to Technology Center 2100 for further processing.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

BURT MAGEN ESQ
FLIESLER DUBB MEYER & LOVEJOY LLP
FOUR EMBARCADERO CENTER SUITE 400
SAN FRANCISCO CA 94111-4156

COPY MAILED

MAR 28 2002

OFFICE OF PETITIONS
ON PETITION

In re Application of
Knouse, et al.
Application No. 09/792,911
Filed: February 26, 2001
Attorney Docket No. OBLX-01012US0

This is a decision on the petition under 37 CFR 1.137(f), filed October 3, 2001, 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.

Telephone inquiries regarding 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

cc: Vierra Magen Marcus Harmon & Deniro Llp
685 Market Street
Suite 540
San Francisco CA 94105

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

VIERRA MAGEN MARCUS HARMON &
DENIRO LLP
685 MARKET STREET, SUITE 540
SAN FRANCISCO, CA 94105

COPY MAILED

MAR 1 2 2002

OFFICE OF PETITIONS

In re Application of :
Joshi et al. :
Application No. 09/792,915 : DECISION ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. :
OBLX-01017US0

This is a decision on the petition filed October 3, 2001, to revive the instant nonprovisional application under 37 CFR 1.137(b), which is treated as a petition under the unintentional provisions of 37 CFR 1.137(f).

This Petition is **granted**.

Background

This 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 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 that requires 18 Month publication;[1] (2) the petition fee as set forth in 37 CFR 1.17(m); and (3) a statement that the entire delay in filing the notice from the date that the notice was due under 35 USC 122(b)(2)(B)(iii) until the date the notice was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was intentional.

The instant petition has been found 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 as provided by 35 USC 1.22(b)(2)(B)(iii) is accepted as having been unintentionally delayed.

---

[1] The filing of a petition under this section will not relieve applicant of the obligation to reply to any outstanding Office action.

A corrected Filing Receipt which sets forth the projected publication date accompanies this decision on petition.

This application is being forwarded to Publishing Division for the mailing of a Notice of Publication Fee Due.

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

Derek L. Woods
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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
DW 02-02

Paper No. 6

VIERRA MAGEN MARCUS
HARMON & DENIRO LLP
685 MARKET STREET, SUITE 540
SAN FRANCISCO, CA 94105

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APR 16 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of
Chan
Application No. 09/792,918
Filed: February 26, 2001
Attorney Docket No. OBLX-01011US0

This is a decision on the petition under the provisions of 37 CFR 1.137(f), filed on October 1, 2001, to revive the above-identified application.

The petition is **GRANTED.**

The application as filed on February 26, 2001 was accompanied by a "Non-Publication Request and Certification Under 35 U.S.C. 122(b)(2)(B)(i)" ("2/26/01 Request").[1] Applicant subsequently filed a PCT application on July 9, 2001,[2] but failed to notify the USPTO within 45 days of that PCT filing, i.e., on or before August 23, 2001.[3] Consequently, the application became abandoned on August 24, 2001.[4]

Under 37 CFR 1.137(f), an application so abandoned is revivable pursuant to 37 CFR 1.137(b), i.e., if the delay in notifying the USPTO of the subsequent filing was unintentional. In the instant case, the requirements for a grantable petition under 37 CFR 1.137(b) would include:[5]

---

1 This Request certifies that the invention disclosed in the application has not and will not be the subject of an application filed in another country, or under a multi-lateral international agreement, that requires 18-month pre-grant publication of the application.

2 Information provided by counsel for Applicant, Burt Magen, by telephone on 4/4/02. USPTO was the receiving office for the PCT application.

3 35 U.S.C. 122(b)(2)(B)(ii), (iii); 37 CFR 1.213(b), (c). The 45th day after 7/9/01 is 8/23/01.

4 35 U.S.C. 122(b)(2)(B)(iii); 37 CFR 1.213(c).

5 37 CFR 1.137(f) only applies to utility/plant applications filed on or after 11/29/00; see MPEP section 711.03(c)(III)(A)(3) (Aug. 2001). A terminal disclaimer required under 37 CFR 1.137(d) applies to a design application, or an application filed on or before June 8, 1995. By definition, an application revivable under 37 CFR 1.137(f) is not subject to the terminal disclaimer required by 37 CFR 1.137(d).

(1) the required notification;[6]
(2) a $640 petition fee (small entity) under 37 CFR 1.17(m);[7] and
(3) a statement that the entire delay in filing the required notification from the due date for the required notification, i.e., August 23, 2001, until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.[8]

The instant petition meets the above requirements[9]. The petition is thus granted.[10] The 2/26/01 Request is hereby rescinded.

This application is being forwarded to the Office of Initial Patent Examination for further processing, including issuance of a corrected filing receipt indicating a projected publication date. Thereafter, the application will be forwarded to Technology Center 2100 for examination in due course.

In addition, the Office acknowledges receipt of the Information Disclosure Statement filed on February 28, 2002.

Telephone inquiries concerning this matter may be directed to Petitions Attorney RC Tang at (703) 308-0763.

Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

6 Generally, the required reply under 37 CFR 1.137(b)(1) is the reply sufficient to have avoided abandonment, had it been timely filed; see MPEP section 711.03(c)(III)(A) (Aug. 2001). In the instant case, the "required reply" would be a notification to the USPTO of the PCT filing. This notification requirement is considered to have been met by the Request to Rescind Previous Nonpublication Request [Form PTO/SB/36 (4-01)] submitted with the instant petition, in conjunction with the information provided by counsel by phone on 4/4/02.

7 The petition encloses a payment of $620 for the petition fee, which increased to $640 (small entity) effective 10/1/01, the date the petition was filed. The $20 deficiency has been charged to Deposit Account No. 50-1826 as authorized in the instant petition.

8 The petition includes such a statement. The Commissioner may require additional information should there ever be a question regarding whether the delay was unintentional.

9 See *supra* notes 6-8.

10 The filing of the instant petition does not operate to stay any period for reply that may be running against the application. See MPEP section 711.03(c)(III)(A)(3) (Aug. 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. 5

Reese Taylor, Esq.
Renner, Kenner, Greive, Bobak, Taylor & Weber
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First National Tower
Akron, OH 44308-1456

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MAY 23 2002

OFFICE OF PETITIONS

In re Application of :
John M. Questel, et al. :
Application No. 09/792,933 :
Filed: February 27, 2001 :
Attorney Docket No. 20132 :

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(f)

This is a decision on the petition filed April 25, 2002, to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f).

The petition is **GRANTED**.

This application became abandoned pursuant to 35 USC 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 August 29, 2002 accompanies this decision on petition.

Telephone inquiries concerning this decision should be directed to Marianne Morgan at (703) 306-3475.

This application is being forwarded to Technology Center Art Unit 2878 for examination in due course.

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

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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Paper No. 9

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 MARKET STREET
SUITE 540
SAN FRANCISCO CA 94105

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JAN 10 2002

OFFICE OF PETITIONS

In re Application of :
Joshi, et al. :
Application No. 09/792,934 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. OBLX1018US0 :

This is a decision on the petition under 37 CFR 1.137(f), filed October 2, 2001, 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.

The application is being returned to the Office of Initial Patent Examination Division for issuance of a corrected filing receipt indicating a projected publication date.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.

K. McFlanagan

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 PATENT
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WASHINGTON, D.C. 20231
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JJGJr: 04-03

Paper No: 4

SCOTT WARREN
PENNIE & EDMONDS LLP
1155 AVENUE OF THE AMERICAS
NEW YORK NY 10036-2711

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APR 17 2003

OFFICE OF PETITIONS

In re Application of:
Murphy, et al.
Filed: 26 February, 2001
Application No. 09/792,957
Docket No. 8449-173-999

ON PETITION

This is a decision on the petition filed herein on 17 December, 2002, under 37 C.F.R.§1.137(b)[1] to revive the above-identified application.

The petition is **GRANTED**.[2]

BACKGROUND

The record indicates that:

- applicant failed to file a timely and proper reply to the Notice to File Corrected Application Papers (Filing Date Granted) (the Notice) mailed on 29 May, 2001, with a reply due (absent extension of time) on or before 29 August, 2001;

- the Application went abandoned after midnight 29 August, 2001;

---

[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] Pursuant to Petitioner's authorization, the petition fee ($1,300.00) is charged to Deposit Account 16-1150.

- no Notice of Abandonment was mailed before the instant petition was filed;
- contemporaneously with the petition (and fee), Petitioner filed a reply to the Notice; and
- Petitioner made the statement of unintentional delay.

The record (including the petition filed on 17 December, 2002) does not necessitate a finding that the delay between midnight 29 August, 2001, and 17 December, 2002, was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on Petitioners' (Adriane M. Antler (Reg. No. 32,605) and Scott A. Warren (Reg. No. 47,167)) duty of candor and good faith when accepting Petitioner's representation that the delay in filing the response was unintentional.[3]

CONCLUSION

Accordingly, in view of Petitioner's satisfaction of the fee, reply and statement requirements of the regulation, the petition under 37 C.F.R. §1.137(b) is **granted**.

This application is being forwarded to OIPE for further processing 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] See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the 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

JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

MAILED

MAY 10 2010

OFFICE OF PETITIONS

In re Application of
Cheryl Murphy et al
Application No. 09/792,957
Filed: February 26, 2001
Attorney Docket No. 8449-173-999

ON PETITION

This is a decision on the petition, filed May 6, 2010 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 5, 2010 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 1645 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/
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

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

ALBERT TALKER
APT : 14R
375 SOUTH END AVE
NEW YORK, NY 10280

COPY MAILED
FEB 26 2010

In re Patent No. 6,954,740 :
Issue Date: October 11, 2005 :
Application No. 09/793,040 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. A.I. TALKER :

This is a decision on the petition under 37 CFR 1.378(c), filed December 2, 2009, to accept the unintentionally delayed payment of a maintenance fee for the above-identified patent.

The petition is **DISMISSED.**

A petition to accept the unintentionally delayed payment of a maintenance fee under 35 U.S.C. 41(c) and 37 CFR 1.378(c) must be accompanied by: (1) a statement that the delay was unintentional; (2) payment of the appropriate maintenance fee, unless previously submitted; (3) payment of the surcharge set forth in 37 CFR 1.20(i)(2). This petition lacks item 3 above.

Petitioner should note that the fees required for consideration of the present petition total $2,130, for the $490 maintenance fee and the $1,640 surcharge. Petitioner submitted fees of $555, resulting in a fee deficiency of $1,575 in the payment of the surcharge. The petition does not include an authorization to charge any fee deficiencies to a deposit account. Accordingly, this petition cannot be granted at this time.

If reconsideration of this decision is desired, a petition for reconsideration under 37 CFR 1.378(e) must be filed within TWO (2) MONTHS from the mail date of this decision. No extension of this two-month time limit can be granted under 37 CFR 1.136(a) or (b). This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

Any petition for reconsideration of this decision must be accompanied by the petition fee of $400 as set forth in 37 CFR 1.17(f), as well as the $1,575 balance of the requisite surcharge, since, after a decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Director.

If petitioner does not wish to pursue reinstatement of this expired patent, petitioner may request a refund of the $555 fees submitted with the petition. The request should be made in writing and addressed to: Mail Stop 16, Director of the U.S. Patent and Trademark Office, P. O. Box 1450, Alexandria, VA 22313-1450. A copy of this decision should accompany petitioner's request.

Further correspondence with respect to this matter should be delivered through one of the following mediums:

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
By Internet:	EFS-Web1

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

1 www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (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

ALBERT TALKER
APT : 14R
375 SOUTH END AVE
NEW YORK, NY 10280

MAILED

JUN 10 2010

OFFICE OF PETITIONS

In re Patent No. 6,954,740	:	
Issue Date: October 11, 2005	:	
Application No. 09/793,040	:	ON PETITION
Filed: February 26, 2001	:	
Attorney Docket No. A.I.TALKER	:	

This is a decision on the renewed petition under 37 CFR 1.378(e), filed April 6, 2010, requesting reconsideration of a prior decision which refused to accept the delayed payment of a maintenance fee under 37 CFR 1.378(c) for the above identified patent.

The petition is **DENIED**.

The petition was not accompanied by the $400 petition fee required in accordance with 37 CFR 1.17(f) and the $1,575 balance of the requisite surcharge required under 37 CFR 1.20(i)(2). Consequently, the petition cannot be granted under the provisions of 37 CFR 1.378.

In view of the above, no further reconsideration or review of a request to accept the delayed payment of a maintenance fee will be undertaken.

As per petitioner's request, the fees paid with the original petition on December 2, 2009 are being refunded in the form of a Treasury Check in due course.

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

Sherry D. Brinkley
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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WHITHAM, CURTIS & CHRISTOFFERSON, P.C.
11491 SUNSET HILLS ROAD, SUITE 340
RESTON, VA 20190

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JUL 0 7 2005

OFFICE OF PETITIONS

In re Application of :
Schiefer et al :
Application No. 09/793,048 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. CA9-2000-0002 :

This is a decision on the petition under 37 CFR 1.137(b), filed February 3, 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 Notice To File Missing Parts Of Nonprovisional Application mailed March 26, 2001, which set a period for reply of two (2) months. Accordingly, the above-identified application became abandoned on May 27, 2001.

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

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

This matter is being referred to the Office of Initial Patent Examination.

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JUL 19 2004

Paper No. 23

In re Application of
Thomas A. Solosko *et al*
Application No. 09/793,091
Filed: February 27, 2001
Attorney Docket No. PHUS010374

: DECISION ON PETITION

This is a decision on the petition filed on May 17, 2004 by which petitioners request withdrawal of the examiner's holding that this application stands abandoned for failure to file a timely and proper reply to the Office letter dated September 29, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioners allege that the application is not abandoned because a reply to the Office letter in question was actually filed on January 2, 2004. Petitioners have supported this allegation by furnishing a copy of the reply and a copy of a post card filing receipt for the reply that shows that the reply was in fact received in the Office on January 2, 2004. In addition, the reply has affixed thereto a 37 CFR 1.8(a) certificate of mailing dated December 29, 2003, a date within the period for filing a reply to the Office letter in question. Based upon this evidence, it is clear that this application is not abandoned. In particular, see 37 CFR 1.8(b).

Accordingly, the Notice of Abandonment is hereby vacated, the holding of abandonment is withdrawn, and the application is restored to pending status. The application is being forwarded to the Head Supervisory Applications Examiner for entry of the reply filed on January 2, 2004, certificate of mailing date December 29, 2003. Thereafter, the application will be forwarded to the examiner for action on the reply.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Philips Intellectual Property and Standards
P.O. Box 3001
Briarcliff Manor, NY 10510

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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ROSS J OEHLER
AVENTIS PHARMACEUTICALS INC
ROUTE 202-206
MAIL CODE D303A
BRIDGEWATER NJ 08807

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DEC 15 2005

OFFICE OF PETITIONS

In re Patent No. 6,919,441	:	DECISION ON
Uhlmann, et al.	:	PATENT TERM ADJUSTMENT
Issue Date: July 19, 2005	:	AND NOTICE OF INTENT
Application No. 09/793,146	:	TO ISSUE
Filed: February 27, 2001	:	CERTIFICATE OF
Attorney Docket No. 2481.1437-02000	:	CORRECTION

This is a decision on the "Combined Request for Reconsideration of Patent Term Adjustment Indicated in the Notice of Allowance (37 C.F.R. Under §1.705) and Statement of the Correct Patent Term Adjustment: Basis(es) Under §1.702 For the Adjustment (37 C.F.R. §1.704(b)(2)(i) and (ii)", filed September 19, 2005. Patentee requests that the patent term adjustment indicated on the patent be corrected from three hundred four (304) days to three hundred forty-two (342) days.

The petition 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 **three hundred forty-two (342)** days.

On July 19, 2005, the above-identified application matured into U.S. Patent No. 6,919,441. The instant request for

reconsideration filed September 19, 2005 was timely filed within two months of the date the patent issued. See §1.705(d). The Patent issued with a Patent Term Adjustment of three hundred four (304) days.

Patentees state that the patent is not subject to a terminal disclaimer.

Patentees assert that he should not have been assessed applicant delay of one hundred twenty (120) days for the submission of a "Miscellaneous Incoming Letter", under 37 C.F.R. §1.704(c)(10), on December 10, 2004. According to patentees, no paper was filed on that date. In addition, patentees point the Offices's attention to the fact that they should have been assessed ninety-nine (99) days for a Rule 312 Amendment filed on November 23, 2004, not seventeen (17) days.

A review of the record fails to indicate that any paper was filed on December 10, 2004. Accordingly, applicant delay of one hundred twenty (120) days should not have been assessed.

In addition, applicants filed a Rule 312 Amendment on November 23, 2004. The Office did not mail a response to the amendment until March 1, 2005. Accordingly, pursuant to 37 C.F.R. §1.704(c)(10), ninety-nine (99) days

In view thereof, the correct determination of PTA at the time of issuance is three hundred forty-two (342) (491 (198+293) days of PTO delay and 149 (99+23+27) days of applicant delay).

The $200.00 fee set forth in 37 C.F.R. §1.18(e) has been charged to Deposit Account No. 18-1982, as authorized.

The application file 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 **three hundred forty-two (342)** days, subject to any disclaimers.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

/Karin A Ferriter/

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

Enc: draft certificate of correction

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6391 Sprint Parkway
KSOPHT0101-Z2100
Overland Park, Kansas 66251-2100

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FEB 15 2006

TECHNOLOGY CENTER 2100

In re Application of: Warren B. Copé et al.)
Application No.: 09/793,176) **DECISION ON PETITION**
Filed: February 26, 2001) **REQUESTING CONSIDERATION OF**
For: METHOD AND SYSTEM FOR) **AN INFORMATION DISCLOSURE**
WIRETAPPING OF PACKET-BASED) **STATEMENT**
COMMUNICATIONS)

This is a decision on the petition filed January 30, 2006 and resubmitted on February 8, 2006 requesting that the Examiner provide an initialled copy of an IDS first filed on February 26, 2001.

In support of the petition, Petitioner provides a copy of (1) a utility patent application transmittal form dated February 26, 2001 which itemizes the items submitted including a PTO-1449 and copies of the IDS Citations, (2) copies of the PTO-1449 and the 4 references cited thereon, (3) Express Mail receipt No. EL625519610US, (4) the attorney's mail log, and (5) a post card with a PTO stamp indicating receipt at the USPTO on February 26, 2001 of the aforementioned items, specifically reciting Form PTO-1449 and copies of four cited references.

M.P.E.P. § 503 states:

> A post card receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

Petitioner has established that an IDS and copies of the art cited thereon were filed on February 26, 2001 with the initial submission of the application. Therefore, applicant is entitled to have the references submitted in a timely fashion considered by the Examiner of record in the determination of the patentability of the claims in the application. Apparently, the IDS was not been previously considered as the result of Office error which separated the IDS from the application file.

The petition is **GRANTED**.

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

Pinchus M. Laufer
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(571) 272-3599

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 MARKET STREET
SUITE 540
SAN FRANCISCO CA 94105

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MAR 2 8 2002

OFFICE OF PETITIONS
ON PETITION

In re Application of :
Knouse, et al. :
Application No. 09/793,196 :
Filed: February 26, 2001 :
Attorney Docket No. OBLX01013US0 :

This is a decision on the petition under 37 CFR 1.137(f), filed October 2, 2001, 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.

Telephone inquiries regarding 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

#7
DW

UNITED STATES PATENT AND TRADEMARK OFFICE

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TC 3600

SALIWANCHIK LLOYD & SALIWANCHIK
2421 N.W. 41ST STREET
SUITE A-1
GAINESVILLE FL 32606-6669

In re application of
Christopher T. Fey et al.
Application No. 09/793,238
Filed: February 26, 2001
For: METHOD FOR CENTRALIZED HEALTH DATA MANAGEMENT

DECISION ON REQUEST FOR WITHDRAWAL OF ATTORNEY

This is a decision on the request filed on May 22, 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 D) above.

In summary, the request is **NOT APPROVED**.

Steven N. Meyers, Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868
Facsimile No.: (703) 605-0586

SM/dw: 7/9/02

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Commissioner for Patents
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Paper No. 7

Sand & Sebolt
Aegis Tower
4940 Munson Street, NW
Suite 1100
Canton, OH 44718-3615

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FEB 0 5 2004

OFFICE OF PETITIONS

In re Application of :
Paul W. Wilson et al. :
Application No. 09/793,253 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. 1110-OT-CIP; P98045US2A :

This is a decision on the petition under 37 CFR 1.137(b), filed January 26, 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 Notice to File Missing Parts of Application (Notice) mailed March 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 May 22, 2001.

The application file is being forwarded to the Office of Initial Patent Examination Division 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. 15

RANJANA KADLE
HODGSON RUSS LLP
ONE M&T PLAZA, SUITE 2000
BUFFALO, NY 14203-2391

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APR 2 3 2004

OFFICE OF PETITIONS

In re Application of :
Aridam Sen et al :
Application No. 09/793,256 : DECISION GRANTING PETITION
Filed: February 26, 2001 : UNDER 37 CFR 313(c)(2)
Attorney Docket No. 03551.0056 :

This is a decision on the petition, filed June 24, 2003,[1] under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 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.[2]

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

The file is being forwarded to Technology Center AU 1615 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 instant petition was only recently brought to the attention of the deciding official's office. The Office sincerely apologizes for the delay in replying to the instant petition and inconvenience caused petitioner by this delay.

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

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DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

CHARLES G. CALL
68 HORSE POND ROAD
WEST YARMOUTH MA 02673-2516

In re Application of:
Charles G. Call
Application No. 09/793,267
Filed: February 26, 2001
For: **METHODS AND APPARATUS FOR STORING AND PROCESSING NATURAL LANGUAGE TEXT DATA AS A SEQUENCE OF FIXED LENGTH INTEGERS**

DECISION
ON PETITION

This is a response to the Petition to Withdrawal the Holding of Abandonment, filed November 6, 2005, pursuant to 37 C.F.R. §1.181.

This application became abandoned for failure to timely file a response to the Office action mailed November 30, 2004, which set a shortened statutory period of three (3) months to reply. A Notice of Abandonment was mailed on November 3, 2005.

Petitioner alleges to have timely filed a response to the Office action on May 31, 2005. To support this position, Petitioner has included with the instant petition a copy of the response including a petition for three month extension of time, and a copy of the facsimile transmittal. Also included with the petition was a copy of an Auto-Reply Facsimile Transmission indicating that 13 pages from Petitioner was received in the U.S. Patent and Trademark Office on May 31, 2005. Petitioner also states that the Amendment was inadvertently filed with an improper serial number.

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. Moreover, a review of the file record reveals that the original amendment has been associated with the application. Accordingly, the Notice of Abandonment is vacated and the holding of abandonment withdrawn.

The petition is **GRANTED**.

Applicant is reminded to insure the accuracy of the header information in all future communications with the Office in order to avoid potential delays in prosecution.

The application will be forwarded to the Technology Center's technical support staff for processing of applicant's response. From there, the file will be forwarded to the examiner for consideration in due course.

Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications

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CHARLES G. CALL
68 HORSE POND ROAD
WEST YARMOUTH MA 02673-2516

In re Application of:
Charles G. Call
Application No. 09/793,267
Filed: February 26, 2001
For: **METHODS AND APPARATUS FOR STORING AND PROCESSING NATURAL LANGUAGE TEXT DATA AS A SEQUENCE OF FIXED LENGTH INTEGERS**

DECISION
ON PETITION

This is a response to the Petition to Withdrawal the Holding of Abandonment, filed November 6, 2005, pursuant to 37 C.F.R. §1.181.

This application became abandoned for failure to timely file a response to the Office action mailed November 30, 2004, which set a shortened statutory period of three (3) months to reply. A Notice of Abandonment was mailed on November 3, 2005.

Petitioner alleges to have timely filed a response to the Office action on May 31, 2005. To support this position, Petitioner has included with the instant petition a copy of the response including a petition for three month extension of time, and a copy of the facsimile transmittal. Also included with the petition was a copy of an Auto-Reply Facsimile Transmission indicating that 13 pages from Petitioner was received in the U.S. Patent and Trademark Office on May 31, 2005. Petitioner also states that the Amendment was inadvertently filed with an improper serial number.

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. Moreover, a review of the file record reveals that the original amendment has been associated with the application. Accordingly, the Notice of Abandonment is vacated and the holding of abandonment withdrawn.

The petition is **GRANTED**.

Applicant is reminded to insure the accuracy of the header information in all future communications with the Office in order to avoid potential delays in prosecution.

The application will be forwarded to the Technology Center's technical support staff for processing of applicant's response. From there, the file will be forwarded to the examiner for consideration in due course.

Dwayne Bost
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
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WASHINGTON, DC 20231
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MAY 20 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Wood, Phillips, Katz, Clark & Mortimer
Citicorp Center, Suite 3800
500 West Madison Street
Chicago, IL 60661-2511

In re application of
Christopher Richardson
Application No. 09/793,305
Filed: February 26, 2001
For: FASCIAS

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

This is in response to applicant's petition to withdraw the holding of abandonment filed in the United States Patent and Trademark Office (USPTO) on January 31, 2003.

The petition is **DISMISSED as moot**.

A review of the application file reveals that an Office action was mailed July 2, 2002 wherein a three-month shorten statutory period for reply was set. Since no response had been matched with the file and the six-month statutory period for response had expired, the application was technically abandoned, although a Notice of Abandonment had yet been mailed.

A further review reveals that the original amendment of December 11, 2002 has since been matched with the file. That original amendment is timely. Since a timely response to the Office action of July 2, 2002 has been filed, the abandonment will be withdrawn. Since the original of the amendment in question is now in the file, there is no need to treat the petition on the merits and it is therefore dismissed as moot.

This application will be forwarded to the Supervisory Legal Instruments Examiner to withdraw the abandonment, return the application to pending status and enter the original amendment filed December 11, 2002 before forwarding to the examiner for treatment on the merits.

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

KJD/tpl: 5/8/03

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

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JUL 2 1 2008

In re Patent No. 7,087,713	: DECISION GRANTING PETITION
Issue Date: 08/08/2006	: UNDER 37 CFR 1.78(a)(3) AND
Application No. 09/793306	: REQUEST FOR CERTIFICATE OF
Filed: 02/26/2001	: CORRECTION
Attorney Docket No. 014058-008740US	:

This is a decision on the petition, filed on April 14, 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 nonprovisional Applications No. 09/073,010, filed on May 5, 1998, and No. 08/859,381, filed on May 20, 1997, by way of a 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 applications 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 applications as required by 37 CFR 1.78(a)(2)(i) and 1.78(a)(2)(iii).

The instant application was filed February 26, 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 the prior-filed nonprovisional applications 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 applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

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 applications. A determination that applicant is entitled to claim benefit of the prior-filed applications will be made by the Examiner prior to the mailing of a certificate of correction.

As authorized, the $1,410.00 surcharge fee, as well as the $100.00 certificate of correction fee, have been received.

Any inquiries concerning this decision may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

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).

Anthony Knight
Supervisor
Office of Petitions

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VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 MARKET STREET
SUITE 540
SAN FRANCISCO CA 94105

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OFFICE OF PETITIONS

ON PETITION

In re Application of :
Jeffrey D. Hodges :
Application No. 09/793,320 :
Filed: February 26, 2001 :
Attorney Docket No. OBLX-01020US0 :

This is a decision on the petition under 37 CFR 1.137(f), filed October 2, 2001, 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.

Telephone inquiries regarding 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

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Paper No. 10

STEPHEN LESAVICH
MCDONNELL BOEHNEN HULBERT & BERGHOFF
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

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JAN 1 4 2005

OFFICE OF PETITIONS

In re Application of :
Bowler et al. :
Application No. 09/793,334 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. 343328002US :

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed December 20, 2004, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply to the non-final Office action mailed March 30, 2004. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on July 1, 2004. A Notice of Abandonment was mailed December 10, 2004.

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

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 solely to the address currently of record until such time as appropriate instructions are received to the contrary.

It is not apparent whether the statement of unintentional delay was signed by a person who would have been in a position of knowing that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. Nevertheless, in accordance with 37 CFR 10.18, the statement is accepted as constituting a certification of unintentional delay. However, in the event that petitioner has no knowledge that the delay was unintentional, petitioner must make such an inquiry to ascertain that, in fact, the delay was unintentional. If petitioner discovers that the delay was intentional, petitioner must notify the Office.

The file is now being forwarded to Technology Center 2100 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

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

cc: MAURICE J. PIRIO
PERKINS COIE LLP
P.O. BOX 1247
SEATTLE, WA 9811-1247

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OFFICE OF PETITIONS

In re Application of
Ramamurthy, et al.
Application No. 09/793,354
Filed: February 26, 2001
Attorney Docket No. OBLX-01015US0

ON PETITION

This is a decision on the petition under 37 CFR 1.137(f), filed October 2, 2001, 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.

The application is being returned to the Office of Initial Patent Examination Division for issuance of a corrected filing receipt indicating a projected publication date.

Telephone inquiries regarding 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

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OFFICE OF PETITIONS

TOWNSEND AND TOWNSEND AND CREW LLP/ORACLE
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO CA 94111-3834

In re Patent No. 7,080,077 :
Issued: July 18, 2006 :
Application No. 09/793,354 : ON PETITION
Filed: February 2, 2001 :
Attorney Docket No: 021756-011000US :

This is a decision regarding your requests for acceptance of fee deficiency submissions and loss of small entity status filed February 2, 2010 and March 4, 2010 under 37 CFR 1.28.

On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. See DH Technology v. Synergystex International, Inc.. 154 F.33d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. 1098 Off. Gaz. Pat. Office 502 (January 3, 1989). Therefore nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby accepted and the petition is **GRANTED**. Status as a small entity has also been removed.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (571) 272-3282.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 5

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 MARKET STREET
SUITE 540
SAN FRANCISCO CA 9410

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JAN 10 2002

OFFICE OF PETITIONS

In re Application of
Crosbie, et al.
Application No. 09/793,355
Filed: February 26, 2001
Attorney Docket No. OBLX-01016US0

DECISION ON PETITION
UNDER 37 CFR 1.137(f)

This is a decision on the petition under 37 CFR 1.137(f), filed October 3, 2001, 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.

The application is being returned to the Office of Initial Patent Examination Division for issuance of a corrected filing receipt indicating a projected publication date.

Telephone inquiries regarding this decision should be directed to Petitions Attorney Cliff Congo at (703) 305-0272.

T. McGaughlin/fm

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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SAN FRANCISCO CA 94111-3834

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MAR 17 2008

OFFICE OF PETITIONS

In re Application of :
Mastin et al. :
Application No. 09/793,355 : DECISION ON PETITION
Filed: February 26, 2001 :
Attorney Docket Number: 21756-011100 :

This is a decision on the petition, filed February 6, 2008 which is being treated as a petition under 37 CFR 1.181, requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely respond to the Office action of February 9, 2006, which set a three (3) month shortened statutory period for reply. Accordingly, a reply was due on or before May 9, 2006.

Petitioner states that a timely reply was mailed via certificate of mailing on May 9, 2006 which included the following papers: Notice of Appeal, Pre-Appeal Brief Request for Review and Statement of Reasons in Support of Pre-Appeal Brief Request for Review.

Review of the file record shows the originally submitted reply sent on May 9, 2006 has been located. Further review of the reply shows that the reply also contained a certificate of submission via EFS dated May 9, 2006.

Accordingly, the holding of abandonment for failure to timely file a reply to the Office action of February 9, 2006 is hereby withdrawn and the application restored to pending status.

The time period for filing an appeal brief will be the later of the two month period set in 37 CFR 41.37(a) or one month from mailing of the decision on the Pre-Appeal Brief Request For Review, whichever is greater. Further, the time period for filing of the appeal brief is extendable under 37 CFR 1.136 based upon the mail date of the decision on the request or the receipt date of the notice of appeal, as applicable.

This application is being referred to art unit 2157 for appropriate action in the normal course of business.

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

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

#14

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Paper No. 14

Duane C. Basch
Basch & Nickerson LLP
1777 Penfield Road
Penfield, NY 14526

MAILED

MAR 12 2004

Technology Center 2100

In re Application of: Baker
Application No. 09/793,364
Attorney Docket No. BDB-1
Filed: February 26, 2001
For: INTELLIGENCE DRIVEN PAGING PROCESS FOR A CHAT ROOM

DECISION ON PETITION TO WITHDRAW FINAL REJECTION UNDER 37 CFR §1.181

This is a decision on the petition filed February 19, 2004 under 37 CFR § 1.181 requesting the withdrawal of the final rejection in the above-identified application as premature. A final rejection was mailed on November 19, 2003 (Paper No. 9) and applicant filed a request for reconsideration from the examiner's action in the final rejection on December 22, 2003 (Paper No. 10). The examiner mailed an Advisory Action dismissing applicant's request on January 5, 2004 (Paper No. 11). Under 37 CFR § 1.181(c) it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. As that has occurred, this matter is ripe for consideration as a petition under 37 CFR § 1.181.

Background

The current application claims priority under 35 USC § 119(e) to provisional application 60/185,858 which was filed February 29, 2000. Petitioner's nonprovisional application has a filing date of February 26, 2001. The examiner has relied throughout the prosecution on US Patent 6,480,885, Olivier (hereafter referred to as "Olivier") in making a rejection under 35 USC § 102(e) on applicant's pending claims. Applicant contested the examiner's position in the first response filed April 22, 2003 (see page 16 of Paper No. 8); and again in the response to the final office action (pp. 2-3 of Paper No. 10) and argued the examiner had not made a *prima facie* showing that the Olivier reference is prior art under 35 USC § 102(e) due to the relative dates of applicant's priority dates and the prior art's priority dates. In earlier papers, the applicant noted several telephonic interviews were held with the examiner during prosecution, but the examiner has failed to provide an interview summary and has not annotated agreement or the substance of any discussions held with applicant's representative. Therefore, the content of the conversations and any clarifications the examiner may have provided to applicant's representative in those conversations have not been confirmed.

The petition sets forth the reasons why the use of the Olivier reference was improper due to the relative filing dates of applicant's provisional application and the fact that Olivier has certain priority information that the petitioner maintains eliminates the use of the reference as prior art

under 35 USC § 102(e). The petition argues the examiner has been in error in applying the reference. The petition further states that on July 22, 2003, applicant's representative requested at page 16 of the response that "if the rejection was based upon an earlier-filed Olivier provisional patent application that such a document be made part of the record and that the Examiner's arguments refer to specific portions of the disclosure of such provisional application(s)."[1] Applicant does not appear to have repeated this request in any subsequent filings. The petitioner does state a request was verbally made to the supervisory patent examiner on January 30, 2004 that applicant "must be provided with a copy of the Olivier provisional upon which the rejection is based, and that the rejection must address what is disclosed in the relied upon Olivier provisional application(s), not the teachings of the Olivier Patent." However, this request occurred after the date of the final rejection and after the mailing of the advisory action.

Therefore, the petitioner argues the final rejection was premature because the examiner repeatedly maintained a rejection without providing applicant with a copy of the provisional, and that on its face, the use of the Olivier patent is an improper art reference under 35 USC § 102(e) but for the reliance on the filing dates of the provisional application.

Decision

There are two distinct issues raised by the petitioner: first, did the examiner improperly apply the rules and procedures set forth at MPEP 706.02(f)(1); and second, was the final rejection premature because the examiner failed to provide requested evidence to meet his burden of proof?

A. Decision on examiner's application of rules and procedures

The petitioner has argued why the examiner has not met his burden of proof of setting forth a *prima facie* case for rejecting the claim limitations over the applied prior art because the date of the Olivier reference does not antedate the petitioner's own priority document. In regards to this matter, this is deemed to be an appealable matter and therefore is not petitionable to the Commissioner of Patents and Trademarks.

The guidelines for petition practice are set forth in 37 CFR §1.181 "Petitions to the Commissioner." While MPEP § 1201 outlines the differences in appealable and petitionable matters. MPEP § 1201 states in part:

> The United States Patent and Trademark Office (Office) in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him or her the patent protection to which he or she is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to the merits, and appeal procedure within the Office and to the courts has long been provided by statute.
>
> The line of demarcation between appealable matters for the Board of Patent Appeals and Interferences (Board) and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes

[1] Applicant's actual language found on page 16, lines 27-30 of Paper No. 8 is "In the event that the rejection is based upon an earlier-filed Olivier application, Applicant respectfully requests that such a document be made part of the record and that the rejection refer to the specific portions of the disclosure of such an application."

> should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since 37 CFR 1.181(f) states that any petition not filed within 2 months from the action complained of may be dismissed as untimely and since 37 CFR 1.144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. *In re Watkinson*, 900 F.2d 230, 14 USPQ2d 1407 (Fed. Cir. 1990).

Whether the examiner has met his burden of proof is an appealable matter. The petitioner's attempt to wrap the argument about dates in the mantle of rules and procedures does not eliminate the underlying issue: namely, did the examiner make a *prima facie* case? Whether the examiner properly applied the Olivier reference under 35 USC § 102(e) is ultimately a question for appeal.

B. Decision on whether the examiner was required to provide a copy of priority documents

A review of the examiner's response to applicant's arguments relating to the propriety of applying the Olivier reference due to 102(e) date shows the examiner provided a limited explanation as to why the date of the reference was considered to be valid for purposes of making an art rejection. Also, it appears the examiner did not explain which date upon which the examiner was relying. Olivier's non-provisional filing date was April 25, 2000.

Olivier also contains the following information on the face of the patent:

Related U.S. Application Data

(63) Continuation-in-part of application No. PCT/US99/21589, filed on Sep. 15, 1999.
(60) Provisional application No. 60/100,387, filed on Sep. 15, 1998, provisional application No. 60/115,566, filed on Jan. 12, 1999, and provisional application No. 60/143,947, filed on Jul. 15, 1999.

and the following information in the first section of the specification:

REFERENCE TO RELATED APPLICATIONS

This application is a Continuation-in Part of PCT/US99/21589 filed Sep. 15, 1999 which claims priority to provisional patent application Ser. No. 60/100,387, filing date Sep. 15, 1998, entitled "Electronic Match-Making Within A Group Using Criteria." This application also claims priority to provisional patent application Ser. No. 60/115,566, filing-date Jan. 12, 1999, entitled "Dynamic Matching™ of Users For Group Communication" and provisional patent application Ser. No. 60/143,947, filing date Jul. 15, 1999, entitled "Dynamic Matching™ of Users For Group Communication."

Applicant's date for filing the non-provisional application is February 26, 2001 and for filing the provisional application is February 29, 2000.

The examiner set forth a rejection under 35 USC § 102(e) in both the first action on the merits and in the final rejection. MPEP 706.02(b) sets forth guidance on how the applicant can overcome a 35 USC § 102 rejection that states in pertinent part:

> (F) Perfecting priority under 35 U.S.C. 119(e) or 120, within the time periods set in 37 CFR 1.78(a) or filing a grantable petition under 37 CFR 1.78(a), by amending the specification of the

> application to contain a specific reference to a prior application or by filing an application data sheet under 37 CFR 1.76 which contains a specific reference to a prior application in accordance with 37 CFR 1.78(a), ***and by establishing that the prior application satisfies the enablement and written description requirements of 35 U.S.C. 112, first paragraph.*** See MPEP § 201.11 and § 706.02. [Emphasis added.]

It appears that throughout the applicant's prosecution of the application, the applicant presumed a perfected priority claim under 35 USC § 119(e) which would have entitled him to his provisional application filing date, February 29, 2000. However, applicant, in fact, failed to meet his burden of establishing that the prior provisional application satisfies the enablement and written description requirements of 35 USC § 112, first paragraph. There is no record that the petitioner ever addressed this matter.

Since applicant is not entitled to the benefit of his provisional application's filing date until perfected, the examiner was entitled to rely on Olivier's nonprovisional filing date of April 25, 2000. Therefore, the examiner did not need to provide applicant with a copy of any of Olivier's priority documents and the final rejection was proper.

It also should be noted that even if the applicant had perfected his priority claim by establishing support under 35 USC § 112, first paragraph, there was no requirement at the time of these two Office actions that the examiner was required to provide a copy of any relied upon provisional applications to applicant. A request for copies of Olivier's provisional applications could have been made to the USPTO's Office of Public Records at any time the applicant required copies. (See MPEP § 103.)

The petition is **DENIED**. The period for reply continues to run from the date of the final rejection.

The applicant is advised that future arguments and remarks to the examiner should clearly delineate between paraphrasing and quoting of MPEP sections and other rules and guidelines. For example, the remarks found in the after final request for reconsideration filed in December 2003 cites MPEP § 706.02(f), but the exact language that applicant says is "unequivocally" presented therein could not be exactly found. In addition, applicant bolded sections relating to "application publications" which did not pertain to the circumstances of the Olivier reference and are not on point.

Future amendments to this application should clarify applicant's intended title for the invention. The amendment filed July 22, 2003 requested a title change, but applicant's papers filed thereafter fail to reflect the new title. The requested title change would not normally be considered descriptive and may be subject to an objection by the examiner.

Telephone inquiries regarding this decision should be directed to Special Program Examiner Josie Ballato at (703) 308-0269.

Margaret A. Focarino, Director
Technology Center 2100
Computer Architecture, Software, and Information Security

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JUN 0 5 2005

Technology Center 2100

BASCH & NICKERSON LLP
1777 PENFIELD ROAD
PENFIELD, NY 14526

In re Application of: BAKER, Benjamin
Application No. 09/793,364
Filed: February 26, 2001
For: SYSTEM AND METHOD FOR THE AUTOMATED NOTIFICATION OF COMPATIBILITY BETWEEN REAL-TIME NETWORK PARTICIPANTS

DECISION ON PETITION TO INVOKE THE SUPERVISORY AUTHORITY OF THE COMMISIONER UNDER 37 CFR §1.181

This is a decision on the Petition, filed January 26, 2005, to invoke the supervisory authority of the commissioner under 37 CFR §1.181 to require the Examiner to recognize the Applicant's perfected claim for priority under 35 U.S.C. 119(e) to the US provisional application number 60/185,858 filed on February 29, 2000.

The Petition is **GRANTED**.

The Petition filed January 26, 2005 requests a relief from the rejection under 35 U.S.C. 102(e) made in the Final Office Action dated November 19, 2003. The rejection, based solely upon the Olivier reference (US 6,480,885), is contended by Applicant to be improper according to the rules and procedures set forth at MPEP 706.02(f)(1). Petitioner further asserted that MPEP 706.02(b)(F) is not applicable to the instant application, since the application has met all requirements of MPEP 706.02(b)(F).

In support of the petition, Petitioner stated that in accordance with 35 U.S.C. 119(e)(1), the instant application was filed within twelve months of the filing date of the provisional application and properly perfected the claim for priority under 35 U.S.C. 119(e)(1) by providing notice of the claim of priority to an invention disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in a provisional application filed under 35 U.S.C 111(b), by an inventor named in the provisional application in the original filed specification of the instant application. Therefore, in accordance with 35 U.S.C. 119(e)(1), the instant application's claim for priority under 35 U.S.C. 119(e) has been perfected, and MPEP 706.02(b)(F) is not applicable to the instant application, since MPEP 706.02(b)(F) is only directed to situations where the priority is not claimed at the time of filing.

M.P.E.P. §706.02(f)(1) Section I, which sets out the Examination Guidelines for Applying References Under 35 U.S.C. 102(e), states in relevant part:

> (A) **The potential reference must be a U.S. patent**, a U.S. application publication (35 U.S.C. 122(b)) or a WIPO publication of an international application under PCT Article 21(2) in order to apply the reference under 35 U.S.C. 102(e) [*emphasis added*].
>
> (B) **Determine if the potential reference resulted from, or claimed the benefit of, an international application. If the reference does, go to step (C) below.** The 35 U.S.C. 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper benefit claims to prior U.S. applications under 35 U.S.C. 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection in compliance with 35 U.S.C. 112, first paragraph. See MPEP § 2136.02 [*emphasis added*].
>
> (C) If the potential reference resulted from, or claimed the benefit of, an international application, the following must be determined:
>
> (1) **If the international application meets the following three conditions:**
> **(a) an international filing date on or after November 29, 2000.**
> **(b) designated the United States; and**
> **(c) published under PCT Article 21(2) in English,**
>
> **then the international filing date is a U.S. filing date for prior art purposes under 35 U.S.C. 102(e)** [*emphasis added*].

Upon careful reviews of the issue at hand, it is deemed that Applicant has met all requirements for establishing that the prior provisional application satisfies the enablement and written description requirements of 35 USC 112, first paragraph. Thus, Applicant has a valid claim to a perfected priority claim under 35 USC 119(e), which would have entitled the Applicant to the provisional application filing date of February 29, 2000. Furthermore, according to MPEP 706.02(f)(1) as stated above, the Olivier reference can not be used for rejection under 102(e) because the filing date of the International Application PCT/US99/21589, from which the Olivier reference claims priority to, was prior to November 29, 2000.

Accordingly, the Petition is **GRANTED**.

It is noted that, in the Chronological Statement of Facts Section of the Petition, Petitioner indicated that since the Examiner was relying on the disclosure of an earlier Oliver provisional application, a copy of the Olivier provisional upon which the rejection is based, ***must be*** provided to Applicant. However, note 37 CFR § 1.14 (a)(1)(iv) states the following:

> Unpublished abandoned applications (including **provisional applications**) that are identified or relied upon. The file contents of an unpublished, abandoned application may be made available to the public if the application is identified in a U.S. patent, a statutory invention registration, a U.S. patent application publication, or an international patent application publication of an international application that was published in accordance with PCT Article 21(2). An application is considered to have been identified in a document, such as a patent, when the application number or serial number and filing date, first named inventor, title and filing date or other application specific information

> are provided in the text of the patent, but not when the same identification is made in a paper in the file contents of the patent and is not included in the printed patent. Also, the file contents may be made available to the public, upon a written request, if benefit of the abandoned application is claimed under 35 U.S.C. 119(e), 120, 121, or 365 in an application that has issued as a U.S. patent, or has published as a statutory invention registration, a U.S. patent application publication, or an international patent application that was published in accordance with PCT Article 21(2). A copy of the application-as-filed, the file contents of the application, or a specific document in the file of the application **may be provided to any person upon written request, and payment of the appropriate fee (§ 1.19(b))** [*emphasis added*].
>
> Note, should applicant desire a copy of such a provisional application, applicant should Promptly request the copy from the Office of Public Records (OPR) in accordance with 37 CFR 1.14(a)(1)(iv), paying the required fee under 37 CFR 1.19(b)(1).

Therefore, it is neither required nor mandatory for the Office to provide Applicant a copy of a provisional application, unless a written request accompanied by payment of the appropriate fee is provided as stated above.

The application is being forwarded to the Examiner for prompt action on the merits.

Brian L. Johnson
Special Program Examiner
Technology Center 2100
Computer Architecture, Software and Information Security
571-272-3595

6/3/05

SDL: 06/02/05

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JUN 21 2006

OFFICE OF PETITIONS

In re Application of : DECISION ON APPLICATION
Baker : FOR PATENT TERM ADJUSTMENT
Application No. 09/793,364
Filed: February 26, 2001
Atty. Dkt. No: BDB-01

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR §1.705)" filed November 16, 2005.

In view of the withdrawal of allowance dated April 28, 2006, a decision on the application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is being held in abeyance.

Should a new Notice of Allowance issue and applicant is in disagreement with the period of adjustment set forth therein, applicant should, at or prior to payment of the issue fee, renew the instant request for reconsideration of patent term adjustment.

No additional application fee will be due in connection with a renewed request for reconsideration of patent term adjustment as the Office here acknowledges receipt of the required $200.00 application fee submitted herewith. A copy of this letter should accompany any subsequently filed request for reconsideration.

The application is being forwarded to Technology Center 2100.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

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

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OFFICE OF PETITIONS

BASCH & NICKERSON LLP
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In re Application of :
Baker : DECISION ON APPLICATION
Application No. 09/793,364 : FOR PATENT TERM ADJUSTMENT
Filed: February 26, 2001 :
Atty. Dkt. No.: BDB-1 :

This is a decision on the "RENEWED REQUEST FOR PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR 1.705)", filed January 15, 2008. This matter is being properly treated under 37 CFR 1.705(b) as an application for patent term adjustment.

The application for patent term adjustment (PTA) under 37 CFR 1.705(b) is **GRANTED to the extent herein indicated.**

The Determination of Patent Term Adjustment under 35 U.S.C. 154(b), mailed December 12, 2007, indicated a patent term adjustment (PTA) to date of 284 days. The instant application for PTA was timely filed January 15, 2008, prior to submission of the issue fee payment. The instant application for PTA renews the application for PTA filed November 16, 2005 and sets forth additional grounds for adjustment of PTA. The application for PTA filed November 16, 2005 was held in abeyance in view of the withdrawal from issuance mailed April 28, 2006.

The correct PTA at the time of the allowance is 281 days, as set forth herein.

The application is entitled to an adjustment of 361 days under 37 CFR 1.702(a)(1), as uncontested applicant.

As further uncontested by applicant, the adjustment is properly reduced 29 days under 37 CFR 1.704(b) in connection with the Notice of Appeal filed March 19, 2004.

The adjustment is further reduced 432 days in connection with the Information Disclosure Statement (IDS) filed July 25, 2005. The reduction began May 20, 2004, the day after the date that the request for continued examination (RCE) was filed, and ended July 25, 2005, the date that the IDS was filed. *See*, 37 CFR

1.704(c)(8). Applicant argues that the reduction in this regard is 285 days. However, in accordance with 37 CFR 1.704(d), "[a] paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable."

The IDS submitted July 25, 2005 lacked the requisite statement set forth at 37 CFR 1.704(d). Accordingly, the submission of the IDS is a failure to engage in reasonable efforts to conclude prosecution in accordance with 37 CFR 1.704(c)(8), as indicated herein.

The application was previously accorded an adjustment of 132 days in connection with the mailing of the Notice of Allowance on October 5, 2005. The correct adjustment is 381 days in accordance with 37 CFR 1.702(a)(2). The adjustment began September 20,2 004, the day after the date that is four months after the date that the RCE was filed on May 19, 2004, and ended October 5, 2005, the date that the Notice of Allowance was mailed. *See*, 37 CFR 1.703(a)(2).

Applicant requests additional adjustment on the grounds that the issue fee for the first Notice of Allowance mailed October 5, 2005 was timely paid November 18, 2005 and that applicant was not informed of the basis for withdrawal of the Notice of Allowance until a non-final Office action was mailed September 26, 2006.

Applicant's request has been carefully reviewed. However, the provisions of 37 CFR 1.702 do not provide a ground for adjustment in the event of the withdrawal of a Notice of Allowance.

Applicant also requests additional adjustment on the grounds that the Office did not respond to applicant's response filed December 26, 2006 until May 31, 2007.

Applicant's arguments have been carefully considered, but are not found convincing. The Office timely responded to applicant's December 26, 2006 response on January 8, 2007, the date that a requirement for information was mailed. In accordance with MEP 2731, a request for information under 37 CFR 1.105 is an action issued as a result of the examination conducted pursuant to 35 U.S.C. 131. As such, each of these Office actions is a notification under 35 U.S.C. 132. Accordingly, the Office timely responded within the meaning of 37 CFR 1.702(a)(2).

Applicant further requests additional adjustment as a result of "error and delay caused by erroneous rejections, albeit not expressly falling under 37 C.F.R. § 1.705." The Office is without authority to provide adjustment for grounds not specifically set forth under the provisions of 37 CFR 1.702.

In view thereof, at the time of allowance, the application was entitled to a patent term adjustment of 281 days (adjustments totaling 742 less reductions totaling 451 days).

Applicants are further advised that the patent term adjustment indicated in the patent will include any additional patent term accrued pursuant to §§ 1.702(a)(4) and 1.702(b).

Receipt is acknowledged of the required patent term adjustment application fee of $200.00.

This application is being forwarded to the Office of Patent Publications for further processing.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery A Fries

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

Enclosure: Adjusted PAIR Calculation

Day : Tuesday
Date: 5/13/2008

PALM INTRANET

Time: 11:54:13

PTA Calculations for Application: 09/793364			
Application Filing Date:	02/26/2001	PTO Delay (PTO):	493
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	209
Post-Issue Petitions:	0	Total PTA (days):	281
PTO Delay Adjustment:	-3		

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25	01/05/2004	MAIL ADVISORY ACTION (PTOL - 303)			
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15.7	02/27/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
15	02/27/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
14	02/21/2003	CASE DOCKETED TO EXAMINER IN GAU			

13	01/22/2003	POWER TO MAKE COPIES AND/OR INSPECT			
12.7	01/03/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	01/03/2003	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	12/18/2002	CASE DOCKETED TO EXAMINER IN GAU			
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8	09/21/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
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3	06/29/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	02/26/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	02/26/2001	INITIAL EXAM TEAM NN			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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Paper No. 3

Fred G. Pruner
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024

MAILED

JUL 3 0 2002

Technology Center 2100

In re Application of:
Chris M. D'aquin
Application No. 09/793,365
Filed: February 26, 2001
For: TECHNIQUE TO VALIDATE ELECTRONIC BOOKS

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed July 11, 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 Fred G. Pruner alone and does not contain a clear indication that Mr. Pruner 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
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 5

Fred G. Pruner, Jr.
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024

MAILED

AUG 19 2002

Technology Center 2100

In re Application of: Chris M. D'aquin)
Application No. 09/793,365)
Filed: February 26, 2001) **DECISION ON REQUEST FOR**
For: TECHNIQUE TO VALIDATE) **WITHDRAWAL AS ATTORNEY**
ELECTRONIC BOOKS)

This is a decision on the Supplemental Request To Withdraw from Representation filed August 6, 2002.

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

The request is **GRANTED**.

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

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

cc: Mr. Tony Williams
Questia Media America, Inc.
Three Greenway Plaza, Suite 1700
Houston, Texas 77046

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Paper No. 8

JOHN S. PRATT
KILPATRICK STOCKTON LLP
1100 PEACHTREE
SUITE 2800
ATLANTA GA 30309

COPY MAILED

JUN 0 1 2004

OFFICE OF PETITIONS

In re Application of :
Adrianov, et al. :
Application No. 09/793,375 : ON PETITION
Filed: February 26, 2001 :
Docket No.: R0023.249664 :

This decision is in response to the petition under 37 C.F.R. § 1.137(b) filed May 20, 2004.

The petition is GRANTED.

This application became abandoned May 23, 2001 for failure to timely reply to the Notice to File Missing Parts of Nonprovisional Application mailed March 22, 2001. The Notice set a two month shortened statutory period of time for reply. No petition for an extension so time in accordance with 37 C.F.R. § 1.136 was timely submitted. Notice of Abandonment was mailed June 25, 2003.

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by: (1) the required reply to the outstanding Office action or notice, unless previously filed; (2) the petition fee as set forth in 37 C.F.R. § 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(b) was unintentional; and (4)any terminal disclaimer (and fee set forth in 37 C.F.R. § 1.20(d)) required pursuant to 37 C.F.R. § 1.137(c).

The instant petition has been reviewed and found in compliance with the provisions of 37 CFR 1.137(b). Accordingly, the failure to timely reply to the Notice is accepted as having been unintentionally delayed.

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

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

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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KEVIN M. FARRELL, PIERCE ATWOOD
ONE NEW HAMPSHIRE AVENUE
SUITE 350
PORTSMOUTH NH 03801

MAILED

MAR 13 2009

OFFICE OF PETITIONS

In re Application of :
Thomas Veach Long, II :
Application No. 09/793,382 : DECISION ON PETITION
Filed: February 26, 2001 : TO WITHDRAW
Attorney Docket No. 0183-2001 : 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 November 3, 2008 and resubmitted February 26, 2009.

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.

The request was signed by Kevin M. Farrell on behalf of all attorneys of record who are associated with this application. All attorneys/agents associated with this application have been withdrawn. 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.

There are no pending Office actions at the present time.

Telephone inquiries concerning this decision should be directed to undersigned at 1642.

/AMW/
April M. Wise
Petitions Examiner
Office of Petitions

cc: THOMAS VEACH LONG, II
MARICULTURA, INC.
PO BOX 1490
WRIGHTSVILLE BEACH, NC 28480

UNITED STATES PATENT AND TRADEMARK OFFICE

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United States Patent and Trademark Office
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DNW 03-02

Paper No. 9

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, N.W.
WASHINGTON DC 20001

COPY MAILED

MAR 1 8 2002

OFFICE OF PETITIONS

In re Application of :
Yehuda et al. :
Application No. 09/793,385 : ON PETITION
Filed: 27 February, 2001 :
Attorney's Docket No. YEHUDA=1 :

This is a decision on the petition filed on 11 February, 2002, requesting that the above-identified application be accorded a filing date of 27 February, 2002, with Page 4 of the specification (description and claims) as a part of the original disclosure.

The petition is granted.

The application was filed on 27 February, 2001. However, on 10 December, 2001, Initial Patent Examination Division mailed a Notice of Omitted Items in a Nonprovisional Application stating that the application had been accorded a filing date but that Page 4 of the specification (description and claims) appeared to have been omitted. A two (2)-month period for reply was set.

In response, on 11 February, 2002,[1] petitioners filed Page 4 of the specification and the present petition. Petitioners argue that Page 4 of the specification was filed with the other application papers on 27 February, 2001, but was subsequently misplaced in the U.S. Patent and Trademark Office (Office). In support, a copy of petitioners' postcard receipt was supplied with the present petition. The postcard receipt shows a stamp from the USPTO dated 27 February, 2001, which contains the above-identified application number. The postcard also identifies the application by first-named inventor's name and docket number and itemizes the filing of, inter alia, 25 pages of specification and claims. Petitioners request that the application, including Page

[1]Since 10 February, 2002, fell on a Sunday, the response filed on 11 February, 2002, was timely filed. 37 CFR 1.7(a).

4 of the specification, be accorded a filing date of 27 February, 2001.

A review of the record reveals that Page 4 of the specification is not located among the application papers deposited on 27 February, 2001. However, the evidence is convincing that the application papers deposited on 27 February, 2001, included Page 4 of the specification which was subsequently misplaced in the Office. Therefore, the application, including Page 4 of the specification, is entitled to a filing date of 27 February, 2001.

The "Notice" mailed on 10 December, 2001, is vacated.

In view of the above, the petition is granted.

It is noted that the one (1) page of specification containing the abstract is not numbered. In future filings, the specification including claims and abstract must be numbered consecutively.[2]

The application will be processed using the application papers filed on 27 February, 2001, and the copy of Page 4 of the specification supplied on 11 February, 2002.

The application is being returned to Initial Patent Examination Division for further processing with a filing date of 27 February, 2001, using the application papers filed on 27 February, 2001, and the copy of Page 4 of the specification (description and claims) supplied on 11 February, 2002.

Telephone inquires should be directed to Petitions Attorney Douglas I. Wood at 703 308-6918.

Beverly M. Flanagan
Supervisory Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

[2] 37 CFR 1.52(b)(5).

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4/28/09

Patent No. :6965173
Ser. No. :09/793424
Inventor(s) : Yoshinori Fukasaku et al.
Issued : 11/15/05
Title : ELECTRIC GENERATING SYSTEM FOR AUTOMOBILES AND ITS CONTROL METHOD
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
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) 308-9390 Ext. 108

CROWELL & MORING LLP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

HR

UNITED STATES PATENT AND TRADEMARK OFFICE

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CROWELL & MORING LLP
INTELLECTUAL PROPERTY GROUP
P.O. BOX 14300
WASHINGTON, DC 20044-4300

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OCT 26 2009

OFFICE OF PETITIONS

In re Patent No. 6,965,173 :
Issue Date: November 15, 2005 :
Application No. 09/793,424 : ON PETITION
Filed: February 27, 2001 :
Attorney Docket No. 381NP/49713 :

This is a decision on the petition, filed June 24, 2009, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee's name on the Fee(s) Transmittal form PTOL-85(b) so that the Letters Patent will issue to the assignee.

The request is **DISMISSED**.

Petitioner states that the assignee Nissan Motor Co. Ltd., was omitted from Part B - Fee(s) Transmittal form at the time of payment of the issue fee.

The request under 37 CFR 3.81(b) was not accompanied by a statement that the failure to include additional assignee Nissan Motor Co. Ltd., was inadvertent. Accordingly, the request under 37 CFR 3.81(b) cannot be granted at this time.

Inquiries concerning this decision should be directed to Diane Goodwyn at (571) 272-6735. Any questions concerning issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

Thurman K. Page
Petitions Examiner
Office of Petitions

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

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INTELLECTUAL PROPERTY GROUP
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WASHINGTON, DC 20044-4300

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OFFICE OF PETITIONS

In re Patent No. 6,965,173 :
Issue Date: November 15, 2005 :
Application No. 09/793,424 : DECISION ON PETITION
Filed: February 27, 2001 :
Attorney Docket No. **381NP/49713** :

This is a decision on the petition, filed, December 23, 2009, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee's name on the Fee(s) Transmittal form PTOL-85(b) by way of a certificate of correction in the patent to be issued from the above-identified application.

The request is **GRANTED**.

Petitioner states that the correct assignee's name should additionally include Nissan Motor Co., Ltd., an owner of an undivided 50% interest of rights. Accordingly, petitioner requests that a certificate of correction be issued to reflect the correct assignees on the front page of the Letters Patent in the patent to be issued from the application.

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

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

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

The request was accompanied by a certificate of correction (and fee, previously paid) as required by 3.81(b). Further, Office assignment records reflect that Nissan Motor Co., Ltd." is an assignee of record. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to be processed after issuance of this application into a patent.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-0602. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (571) 272-4200.

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

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
Alexandria, VA 22313-1450
www.uspto.gov

KENNETH H. TARBET
SUITE 100
11201 N. TATUM BLVD
PHOENIX, AZ 85028

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MAR 13 2008

OFFICE OF PETITIONS

In re Application of :
Anton A. Ewing et al :
Application No. 09/793,450 : ON PETITION
Filed: February 27, 2001 :
Attorney Docket No. :

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

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 11, 2005, which set a shortened statutory period for reply of three (3) months. No extension of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on June 12, 2005.

The Power of Attorney received with the petition on October 22, 2007 is not accepted.
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 Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 3624 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Gary L. Eastman
Eastman & Associates
707 Broadway Street, Suite 1800
San Diego, CA 92101

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 25

AGENSYS C/O MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE, SUITE 500
SAN DIEGO, CA 92130

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APR 12 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of
Raitano et al.
Application No. 09/793,451
Filed: February 26, 2001
Attorney Docket No. 511582000200

This is a decision on the petition under 37 CFR 1.137(a), filed March 22, 2004, to revive the above-identified application. The petition is also being treated under 37 CFR 1.181 (no fee) as a petition to withdraw the holding of abandonment.

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

The petition under 37 CFR 1.137(a) is **dismissed as moot**.

The above-identified application was deemed abandoned for failure to reply in a timely manner to the Office action mailed July 15, 2003, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application was deemed abandoned on August 16, 2003. A Notice of Abandonment was mailed on March 12, 2004.

Petitioner contends the Office action was vacated by the examiner. A review of the record indicates that the examiner sent out an interview summary prior to the expiration of the time period which stated, "The Notice of Unresponsive Amendment sent July 15, 2003, is vacated." Therefore, the application is not abandoned.

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(a) is dismissed as moot. No petition fee is required for a petition to withdraw holding of abandonment under 37 CFR 1.181. Therefore, the petition fee of $55 will be credited to petitioner's deposit account.

The file is being forwarded to Technology Center 1600 for consideration of the amendment filed March 25, 2003.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

ICHM

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UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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APR 1 3 2004

Paper No. 25

AGENSYS C/O MORRISON & FOERSTER LLP
3811 VALLEY CENTRE DRIVE, SUITE 500
SAN DIEGO, CA 92130

* No Docketing
Reviewing by Docketing
Initials CTS

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APR 1 2 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of
Raitano et al.
Application No. 09/793,451
Filed: February 26, 2001
Attorney Docket No. 511582000200

This is a decision on the petition under 37 CFR 1.137(a), filed March 22, 2004, to revive the above-identified application. The petition is also being treated under 37 CFR 1.181 (no fee) as a petition to withdraw the holding of abandonment.

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

The petition under 37 CFR 1.137(a) is **dismissed as moot.**

The above-identified application was deemed abandoned for failure to reply in a timely manner to the Office action mailed July 15, 2003, which set a shortened statutory period for reply of one (1) month or thirty (30) days (whichever is later). No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application was deemed abandoned on August 16, 2003. A Notice of Abandonment was mailed on March 12, 2004.

Petitioner contends the Office action was vacated by the examiner. A review of the record indicates that the examiner sent out an interview summary prior to the expiration of the time period which stated, "The Notice of Unresponsive Amendment sent July 15, 2003, is vacated." Therefore, the application is not abandoned.

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(a) is dismissed as moot. No petition fee is required for a petition to withdraw holding of abandonment under 37 CFR 1.181. Therefore. the petition fee of $55 will be credited to petitioner's deposit account.

The file is being forwarded to Technology Center 1600 for consideration of the amendment filed March 25, 2003.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

RBM 4/12/04

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RYAN MASON & LEWIS, LLP
90 FOREST AVENUE
LOCUST VALLEY, NY 11560

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OFFICE OF PETITIONS

In re Application of :
Lior Shabtay et al :
Application No. 09/793,455 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. 500005-A-01-US :

This is a decision on the petition under 37 CFR 1.137(b), filed February 3, 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 19, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 20, 2004.

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

This matter is being forwarded to Technology Center AU 2152 for further processing.

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

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COMMISSIONER FOR PATENTS
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KENYON & KENYON
Suite 700
1500 K Street, N.W.
Washington, DC 20005

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FEB 0 2 2006

OFFICE OF PETITIONS

In re Application of :
Fukui, et al. : DECISION ON PETITION
Application No. 09/793,518 :
Filed: February 27, 2001 :
Docket No.: 29273/545 :

This decision is in response to the petition to withdraw the holding of abandonment under 37 CFR 1.181 filed December 13, 2005.

The petition is hereby **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is not a final agency decision.

This application became abandoned August 27, 2005 for failure to timely submit a proper reply to the Notice of Allowance ("Notice") mailed May 26, 2005. Notice of Abandonment was mailed November 28, 2005.

Petitioners allege non-receipt of the Notice, but have provided no supporting evidence to establish non-receipt.

In the absence of any irregularity in the mailing of the Notice, there is a strong presumption that the Office communication was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. *See*, MPEP 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost

after receipt rather than a conclusion that the Office communication was lost in the mail.

Office records indicate the Office communication was properly mailed to the correspondence address of record at the time of mailing. Accordingly, there was no irregularity in mailing the Office communication on the part of the United States Patent and Trademark Office.

ALTERNATE VENUE

Petitioners may wish to consider filing a petition stating that the delay in timely submitting a properly reply to the Notice was unintentional or unavoidable pursuant to 37 CFR 1.137(b) and (a) respectively. *See* MPEP 711.03(c).

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

By mail:	**Mail Stop Petition** Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(571) 273-8300
By hand delivery:	U.S. Patent and Trademark Office Customer Window, **Mail Stop Petition** Randolph Building 401 Dulany Street Alexandria, VA 22314

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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OFFICE OF PETITIONS

KENYON & KENYON
Suite 700
1500 K Street, N.W.
Washington, DC 20005

In re Application of :
Fukui, et al. : DECISION ON PETITION
Application No. 09/793,518 :
Filed: February 27, 2001 :
Docket No.: 29273/545 :

This decision is in response to the renewed petition to withdraw the holding of abandonment under 37 CFR 1.181 filed February 16, 2006.

The petition is hereby **GRANTED**.

This application was held abandoned August 27, 2005 for failure to timely submit a proper reply to the Notice of Allowance ("Notice") mailed May 26, 2005. Notice of Abandonment was mailed November 28, 2005.

Petitioners allege non-receipt of the Notice.

In the absence of any irregularity in the mailing of the Notice, there is a strong presumption that the Office communication was properly mailed to practitioner at the address of record. This presumption may be overcome by a showing that the Notice was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. *See*, MPEP 711.03(c). The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail.

Office records indicate the Office communication was properly mailed to the correspondence address of record at the time of mailing. Accordingly, there was no irregularity in mailing the

Office communication on the part of the United States Patent and Trademark Office.

Nevertheless, in view of the evidence presented, the petition to withdraw the holding of abandonment is hereby **GRANTED**.

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

This application is being forwarded to Group Art Unit 3639 for re-mailing of the Notice of Allowance and Notice of Allowability. The time period for reply will be set therein.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON DC 20005

In re Application of :
Nakano :
Application No. 09/793,539 :
Filing Date: 27 February, 2001 :
Attorney Docket No.: 1566.1002/JDH :

DECISION

This is a revised decision on the petition filed on 14 February, 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181, and, in light of Petitioner's alternative characterization of the petition, considered as to allege unavoidable delay under 37 C.F.R. §1.137(a).

For the reasons set forth below:

- the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**;
- the petition under 37 C.F.R. §1.137(a) is **GRANTED** and the petition fee ($500.00) is charged as authorized to Deposit Account 19-3935.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to a non-final Office action mailed on 3 June, 2005, with reply due absent extension of time on or before Tuesday, 6 September, 2005 (following the holiday);

- the application went abandoned after midnight 3 September, 2005;
- the Office mailed the Notice of Abandonment on 14 December, 2005;
- on 14 February, 2006, Petitioner filed the instant request to withdraw the holding of abandonment, and alternatively indicated that if a petition fee was required, such was authorized, and further filed a reply in the form of an amendment (over a 3 October, 2005, certificate of transmission) averred to have been submitted (with a request and fee for a one- (1-) month extension of time) timely, however, Petitioner provides neither a date-stamped receipt card evidencing receipt by the Office nor a Auto-Reply Facsimile Transmission;
- **although Petitioner fails to make the regulatory statement as to unavoidable delay, in light of the documentary support that is presented the petition is read to so state, however, Petitioner Allison Oleginski (Reg. No. 55,509) must notify the Office if this reading is in error, consistent with her duty of candor to the Office.**[1]

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

---

[1] See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137 to the Patent and Trademark Office).

[2] 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[3] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5] And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[8]

Petitioner has not satisfied the Delgar requirements.

As to Allegations
of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and–where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

Petitioner appears to have satisfied the regulatory requirements under 37 C.F.R. §1.137(a).

---

[4] See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[5] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[6] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[7] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

[8] See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

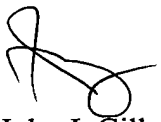
CONCLUSION

Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, and so the petition as considered under 37 C.F.R. §1.181 hereby is **dismissed**.

The petition under 37 C.F.R. §1.137(a) is **granted**.

The instant application is forwarded to Technology Center 2100 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.
Senior Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 12

HENRY SHOOFLAR
2520 DELORIMIER
LONGUEUIL QC J4K3P-6 CA CANADA

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APR 1 6 2003

OFFICE OF PETITIONS

In re Application of
Shooflar
Application No. 09/793,551
Filed: February 27, 2001
Attorney Docket No. N/A
For: COMPUTER CONTROLLED AIRCRAFT FIRE SPRINKLER SYSTEM AND SMOKE EXPULSION MECHANISM

On PETITION

This is a decision on the correspondence filed February 27, 2003. This correspondence is being treated as a petition under 37 CFR 1.137(a) 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 a reply to the non-final Office action mailed July 8, 2002, which set a shortened statutory period for reply of three (3) months. Extensions of time were available under 37 CFR 1.136(a). A reply was received on November 13, 2002, but no extension of time fee was included. Thus, the reply was untimely. This application became abandoned on October 9, 2002. A Notice of Abandonment was mailed on February 11, 2003.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).

Regarding (3) above, petitioners have not shown to the satisfaction of the Commissioner that the entire delay from the due date of the reply to the filing of a grantable petition was unavoidable.

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:

> 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.

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).

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).

Petitioners filed a reply on November 13, 2002, but the deadline for replying without an extension time and required fee was October 8, 2002. Petitioner should have purchased a two month extension of time.

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an "unavoidable" delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

ALTERNATE VENUE

Petitioner is 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 required $650.00 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 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). For petitioners' convenience, a blank PTO/SB/64 -- Petition for Revival of an Application for Patent Abandoned Unintentionally under 37 CFR 1.137(b).

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

By mail until 05/01/03:
Commissioner for Patents
Box DAC
Washington, D.C. 20231

By mail on or after 05/01/03:
Mail Stop PETITION
Commissioner for Patents
P.O. 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 the undersigned at (703) 308-6712.

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

enclosures: blank PTO/SB/64 -- Petition for Revival of an Application Abandoned Unintentionally under 37 CFR 1.137(b)

Privacy Act Statement

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 14

HENRY SHOOFLAR
2520 DELORIMIER
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OFFICE OF PETITIONS

In re Application of
Shooflar
Application No. 09/793,551
Filed: February 27, 2001
Attorney Docket No. N/A
For: COMPUTER CONTROLLED AIRCRAFT FIRE SPRINKLER SYSTEM AND SMOKE EXPULSION MECHANISM

On PETITION

This is a decision on the reconsideration petition, filed May 29, 2003, to revive the above-identified application.

The reconsideration petition under 37 CFR 1.137(a) 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 a reply to the non-final Office action mailed July 8, 2002, which set a shortened statutory period for reply of three (3) months. Extensions of time were available under 37 CFR 1.136(a). A reply was received on November 13, 2002, but no extension of time fee was included. Thus, the reply was untimely. This application became abandoned on October 9, 2002. A Notice of Abandonment was mailed on February 11, 2003. Applicant's petition to revive under 37 CFR 1.137(a), filed February 27, 2003, was dismissed on April 16, 2003 for failure to show the entire delay in filing a reply to the July 8, 2002 non-final Office action was unavoidable.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition still lacks item (3).

Regarding (3) above, petitioners have not shown to the satisfaction of the Commissioner that the entire delay from the due date of the reply to the filing of a grantable petition was unavoidable.

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:

> 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.

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).

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).

With the instant reconsideration petition, applicant claims, "...I could have met the October 8th, 2003 deadline if I didn't fall sick with an arthritic problem that affects my arms as well as my legs for three weeks starting October, 2nd 2003." It is presumed that petitioner intended to type 2002 instead of 2003 in this sentence.

Petitioner now asserts incapacitation as a cause of the delay. A showing of "unavoidable" delay based upon incapacitation must establish that the incapacitation was of such a nature and degree as to render the incapacitated person unable to conduct business (e.g., correspond with the Office) during the three week period of the arthritic problem -- between October 2, 2002 and October 23, 2002. Such a showing must be supported by a statement from the incapacitated person's treating physician, and such statement must provide the nature and degree of

incapacitation during the above-mentioned period. Petitioner must provide documentary evidence that shows that but for the arthritic problem, petitioner would have timely submitted a reply to the July 8, 2002 non-final Office action. In other words, petitioner must prove that he was so incapacitated that he was unable to file a timely response.

However, petitioner states that the arthritic problem lasted only three weeks, starting October 2, 2003. Thus, after October 23, 2002 -- which is the expiration of the three week period of the arthritic problem-- petitioner's incapacitation rationale for the unavoidable delay in replying to the July 8, 2002 non-final Office action seems not to apply.

In short: Petitioner must prove the arthritic problem was so severe that petitioner could not reply to the July 8, 2002 non-final Office action from October 2, 2002 until October 23, 2002. In addition, petitioner must explain why he did not reply to the July 8, 2002 non-final Office action from October 24, 2002 until January 12, 2003.

Petitioner must provide **documentary evidence** that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

If petitioner cannot do so, petitioner is urged to file a petition under 37 CFR 1.137(b), which is a petition to revive under an unintentional standard. The appropriate form 137(b) revival form was enclosed with the April 15, 2003 dismissal of applicant's first petition to revive under 37 CFR 1.137(a), filed February 27, 2003.

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 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 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
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Paper No. 17

HENRY SHOOFLAR
2520 DELORIMIER
LONGUEUIL QC J4K3P-6 CA CANADA

COPY MAILED

JUL 2 8 2003

OFFICE OF PETITIONS

On PETITION

In re Application of
Shooflar
Application No. 09/793,551
Filed: February 27, 2001
Attorney Docket No. N/A
For: COMPUTER CONTROLLED AIRCRAFT FIRE SPRINKLER SYSTEM AND SMOKE EXPULSION MECHANISM

This is a decision on the reconsideration petition, filed July 11, 2003, to revive the above-identified application.

The reconsideration petition under 37 CFR 1.137(a) 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 a reply to the non-final Office action mailed July 8, 2002, which set a shortened statutory period for reply of three (3) months. Extensions of time were available under 37 CFR 1.136(a). A reply was received on November 13, 2002, but no extension of time fee was included. Thus, the reply was untimely. This application became abandoned on October 9, 2002. A Notice of Abandonment was mailed on February 11, 2003. Applicant's petition to revive under 37 CFR 1.137(a), filed February 27, 2003, was dismissed on April 16, 2003 for failure to show the entire delay in filing a reply to the July 8, 2002 non-final Office action was unavoidable. Applicant's second petition to revive under 37 CFR 1.137(a), filed May 29, 2003, was dismissed on June 9, 2003 for failure to show the entire delay in filing a reply to the July 8, 2002 non-final Office action was unavoidable.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition still lacks item (3).

Regarding (3) above, petitioners have not shown to the satisfaction of the Commissioner that the entire delay from the due date of the reply to the filing of a grantable petition was unavoidable.

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:

> 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.

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).

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a).

Petitioner proffers two explanations for the allegedly unavoidable delay: (1) incapacitation due to an arthritic condition and (2) the fact that petitioner is involved in correspondence/investigation with several governmental agencies.

Regarding (1), petitioner has not provided documentary evidence that the arthritic problem was so severe that petitioner could not reply to the July 8, 2002 non-final Office action from October 2, 2002 until October 23, 2002. In previous petitions, applicant claims, "...I could have met the October, 8th 2002 deadline if I didn't fall sick with an arthritic problem that affects my arms as well as my legs for three weeks starting October, 2nd 2002."

As stated in the June 9, 2003 dismissal, "A showing of "unavoidable" delay based upon incapacitation must establish that the incapacitation was of such a nature and degree as to render

the incapacitated person unable to conduct business (e.g., correspond with the Office) during the three week period of the arthritic problem -- between October 2, 2002 and October 23, 2002. Such a showing must be supported by a statement from the incapacitated person's treating physician, and such statement must provide the nature and degree of incapacitation during the above-mentioned period. Petitioner must provide documentary evidence that shows that but for the arthritic problem, petitioner would have timely submitted a reply to the July 8, 2002 non-final Office action. In other words, petitioner must prove that he was so incapacitated that he was unable to file a timely response."

In the instant reconsideration petition, applicant states that a physician was not seen during the delay period. Therefore, petitioner has not offered to submit documentary evidence contemporaneous with the October 2, 2002 - October 23, 2002 period of incapacitation.

Instead, petitioner offers to submit a medical file from Quebec City that is over 200 pages long. Petitioner's June 16, 2003 (dated June 6, 2003) letter from Louis-Denis Laberge suggests that the medical file concerns Mr. Shooflar's accident that occurred on June 22, 1984. The accident occurred several years before the alleged unavoidable delay occurred. If the Quebec City medical file cannot prove that petitioner was physically incapacitated to such a degree that replying timely to the July 8, 2002 non-final Office action would have been extremely difficult, then there is no need to submit the medical file.

Regarding (2), petitioner appears to be alleging that the delay was unavoidable due to the fact that ongoing investigations between the FAA, the TSA, the PTO, and various Canadian agencies/entities were/are occurring and that Mr. Shooflar created special reports that could be used by all agencies/entities, rather than tailoring a report to each agency. The special reports were made to "save all the various Examiners much time in there [sic] investigations." See Letter from Louis-Denis Laberge, dated June 6, 2003. However, the special reports took a long period of time to create and petitioner was late in responding to the July 8, 2002 non-final Office action.

Petitioner is informed that petitioner is expected to treat his patent business as his most important business. 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). While petitioner created the special reports intending to aid all investigating agencies' examiners in their review of his invention, petitioner allowed the PTO deadline for replying to the July 8, 2002 non-final Office action to pass. Petitioner knew that the office did not require a special report. See reconsideration petition dated June 27, 2003. Petitioner could have submitted a reply timely, but instead petitioner chose to spend time on creating special reports that could be used for all agencies/entities reviewing this invention. Petitioner did not treat PTO business as his most important business.

Petitioner's preoccupation with other matters which took precedence over the above-identified application does not constitute unavoidable delay. See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Petitioner did not take care to ensure a timely reply

to the July 8, 2002 non- final Office action was filed.

Petitioner is urged to file a petition under 37 CFR 1.137(b), which is a petition to revive under an unintentional standard. The appropriate form 137(b) revival form was enclosed with the April 15, 2003 dismissal of applicant's first petition to revive under 37 CFR 1.137(a), filed February 27, 2003.

In the instant reconsideration, petitioner states that he "...will send ...the difference in fees between an unintentional and unavoidable delay with signed documents" if the reconsideration petition under 37 CFR 1.137(a) is not granted.

Petitioner submitted the $55 petition fee for his petition under 37 CFR 1.137(a) and received several decisions under 37 CFR 1.137(a). Now petitioner states that he will file a petition under 37 CFR 1.137(b), without paying the full petition fee.

Petitioner is informed that the payment of the petition fee in full is a prerequisite to the filing of a petition to revive under 37 CFR 1.137(b). The phrase "[o]n filing" in 35 U.S.C. 41(a)(7) means that the petition fee is required for the filing (and not merely the grant) of a petition under 37 CFR 1.137. See H.R.Rep. No. 542, 97th Cong., 2d Sess. 6 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770 ("[the fees set forth in this section are due on filing the petition"). Accordingly, the Commissioner is statutorily precluded from reviewing a petition under 1.137(b) until the 137(b) petition fee is paid in full. The 137(b) petition fee for a small entity is currently $650.

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 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 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
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Paper No. 19

HENRY SHOOFLAR
2520 DELORIMIER
LONGUEUIL QC J4K3P-6 CA CANADA

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SEP 1 5 2003

OFFICE OF PETITIONS
ON PETITION

In re Application of
Shooflar
Application No. 09/793,551
Filed: February 27, 2001
Attorney Docket No. N/A
For: COMPUTER CONTROLLED AIRCRAFT FIRE SPRINKLER SYSTEM AND SMOKE EXPULSION MECHANISM

This is a decision on the petition under 37 CFR 1.137(b), filed September 9, 2003, to revive the above-identified application.

The above-identified application became abandoned for failure to timely submit a reply to the non-final Office action mailed July 8, 2002, which set a shortened statutory period for reply of three (3) months. Extensions of time were available under 37 CFR 1.136(a). Replies were received on November 13, 2002 and January 17, 2003, but no extension of time fee was included with either submission. Thus, the replies were untimely. This application became abandoned on October 9, 2002. A Notice of Abandonment was mailed on February 11, 2003.

Applicant has submitted a proper reply in the form of amendments, filed November 13, 2002 and January 17, 2003, an acceptable statement of the unintentional nature of the delay in responding to the July 8, 2002 non-final Office action, and the $650 petition fee.

The petition is **GRANTED**.

After the mailing of this decision the application will be forwarded to Technology Center 3700 for further examination.

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
P.O. Box 1450
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JUN 29 2006

OFFICE OF PETITIONS

ARENT FOX KINTNER PLOTKIN & KAHN
1050 CONNECTICUT AVENUE, N.W., SUITE 600
WASHINGTON DC 20036-5339

In re Application of :
Nobuo Ogasawara :
Application No. 09/793,604 : ON PETITION
Filed: February 27, 2001 :
Attorney Docket No. 101229-00001 :

This is a decision on the petition, filed June 27, 2006, and resubmitted on June 28, 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 June 8, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 3625 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

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

VIERRA MAGEN MARCUS HARMON & DENIRO LLP
685 MARKET STREET
SUITE 540
SAN FRANCISCO CA 94105

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MAR 2 8 2002

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Martherus, et al. :
Application No. 09/793,658 :
Filed: February 26, 2001 :
Attorney Docket No. OBLX-01014US0 :

This is a decision on the petition under 37 CFR 1.137(f), filed October 3, 2001, 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.

Telephone inquiries regarding 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

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

Mail Date: 05/21/2010

Applicant	: Kwang-youn Park	: DECISION ON REQUEST FOR
Patent Number	: 7646964	: RECALCULATION of PATENT
Issue Date	: 01/12/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 09/793,717	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 02/27/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2182** 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
Address: COMMISSIONER FOR PATENTS
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Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/793,720	02/27/2001	Masaaki Ozaki	01-111	2796

23400 7590 08/14/2003

POSZ & BETHARDS, PLC
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RESTON, VA 20190

EXAMINER
MENDIRATTA, VISHU K

ART UNIT	PAPER NUMBER
3711	17

DATE MAILED: 08/14/2003

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.gov

Paper No. 14

In re Patent No. OZAKI ET AL.
Appl No.: 09/793,720
Filed: February 27, 2001
For: PATTERN DISPLAY DEVICE AND GAME MACHINE INCLUDING THE SAME

DECISION GRANTING PETITION
37 CFR 1.48(b)

This is a decision on the petition filed 07/28/2003 to correct inventorship under 37 CFR 1.48(b). The petition includes a statement signed by the applicant's attorney and identifying each named inventor being deleted and acknowledging that the inventor's invention is no longer being claimed in the application. The petition is accompanied by the fee set forth in 37 CFR 1.17(i).

37 CFR 1.48(b) requires that the amendment be accompanied by: (1) a request including a statement identifying each named inventor who is being deleted and acknowledging that the inventor's invention is no longer being claimed in the application; and (2) a fee under 37 CFR 1.17(i). The statement may be signed by applicant's registered attorney or agent who then takes full responsibility for ensuring that the inventor is not being improperly deleted from the application. Written consent of any assignee is not required for requests filed under 37 CFR 1.48(b).

The petition is **granted**.

S. Passaniti

Sebastiano Passaniti, Acting SPE
for Paul Sewell
Supervisory Patent Examiner
Art Unit 3711
Technology Center 3700

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SUITE 10
RESTON, VA 20190

UNITED STATES PATENT AND TRADEMARK OFFICE

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

POSZ LAW GROUP, PLC
12040 SOUTH LAKES DRIVE
SUITE 101
RESTON VA 20191

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AUG 25 2006

OFFICE OF PETITIONS

In re Application of :
Masaaki Ozaki et al :
Application No. 09/793,720 : ON PETITION
Filed: February 27, 2001 :
Attorney Docket No. 01-111 :

This is a decision on the petition, filed August 24, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 4, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 3711 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Petitions Examiner
Office of Petitions

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

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AUG 25 2006

OFFICE OF PETITIONS

Paper No. _____

Date : August 25, 2006

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) :Masaaki Ozaki et al
Application No. :09/793,720
Filed :February 27, 2001

The above-identified application has been assigned Patent No. 7,101,281 and an issue date of September 5, 2006.

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

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of September 5, 2006:

"All reference to Patent No. 7,101,281 to Masaaki Ozaki et al of Japan for PATTERN DISPLAY DEVICE AND GAME MACHINE INCLUDING THE SAME appearing in the Official Gazette of September 5, 2006 should be deleted since no patent was granted."

Karen Creasy

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

cc: Paul Harrison, MDW-4B03,(FAX-273-5468)
Deneise Boyd, MDE-3D39 (FAX-273-5124)
Mary Louise McAskill, ST-8C15 (FAX 305-4372)
Niomi Farmer, ST-8C14 (FAX-305-4372)
Mary E. Johnson (Cookie), MDE-7C71 (FAX 273-0038
Duane Davis P/OPC MDE-7D89

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

May 31, 2007

David G. Posz
POSZ LAW GROUP. PLC
12040 South Lakes Drive,
Suite 101
Reston, VA 20191

Patent No.: 7204753 B2
Application No.: 09/793720
Inventor(s): **Masaaki Ozaki, et al.**
Issued: **April 17, 2007**
Title: **PATTERN DISPLAY DEVICE AND GAME MACHINE INCLUDING THE 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(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:	(571) 273-0025 ATTN: Office of Petitions

If a fee (currently $100) was previously submitted for consideration of a Request for Certificate of Correction, under CFR 1.323, to correct assignment data, no additional fee is required.

Virginia Tolbert
For Cecelia Newman
Decisions & Certificate of Correction Branch
(703) 305-8309 or (703) **308-9390 ext 113**

vt

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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POSZ LAW GROUP, PLC
12040 SOUTH LAKES DRIVE
SUITE 101
RESTON VA 20191

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JUL 2 9 2008

In re Patent No. 7,204,753	:	
Issue Date: April 17, 2007	:	
Application No. 09/793,720	:	ON PETITION
Filed: February 27, 2001	:	
Attorney Docket No. 01-111	:	

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

The request is **GRANTED**.

Telephone inquiries concerning this decision may be directed to Carl Friedman at (571) 272-6842. 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.

Carl Friedman
Petitions Examiner
Office of Petitions

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

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Paper No. 13

Jenkins & Gilchrist
1445 Ross Avenue
Suite 3200
Dallas, TX 75202

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OFFICE OF PETITIONS

In re Application of :
Andrew M. Taylor :
Application No. 09/793,723 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. AMT0003 :

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 in reply to the non-final office action mailed August 22, 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 November 23, 2002.

The application file is being forwarded to Technology Center AU 3723 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

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JAN 13 2004

Technology Center 2100

Paper No. 11

Edward A Pennington, Esq.
SWIDLER BERLIN SHEREFF FRIEDMAN LLP
3000 K Street
Suite 300
Washington DC 20007

In re Application of: DAVID SPENCER TYREE
Application No.: 09/793,733
Filed: February 27, 2001
For: **SCRIPTED DISTRIBUTED DENIAL-OF-SERVICE (DDOS) ATTACK DISCRIMINATION USING TURING TESTS**

DECISION ON PETITION FOR ACCELERATED EXAMINATION UNDER M.P.E.P. §708.02(VIII)

This is a decision on the petition, filed June 06, 2003 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(VIII), requesting the Accelerated Examination of the above-identified application.

The petition is **DISMISSED**.

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.
>
> 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.

Although Petitioner's submission has complied with the above-mentioned items (A), (B), (C), and (D), the petition is deficient with respect to item (E) above.

Petitioner's submission does not provide a **detailed** discussion of the references, which points out, with the **particularity** required by 37 CFR 1.111(b) and (c), how the claimed subject matter is patentable over the references. Petitioner's submission provides short summaries (6 to 12 lines) of cited references, and concludes that each reference does not appear to disclose presenting an entity with a test and determining from said test whether or not said entity is an intelligent being. The use of the terms "appears to disclose" and "does not appear to disclose" in the Petitioner's discussion implies some doubt about the existence of the claim elements. Short summaries of cited references and the use of the terms "appears to disclose" and "does not appear to disclose," without more, does not comply with the above-mentioned item (E).

Accordingly, the Petition is **DISMISSED**. The application file will be forwarded to the Central Files of Technology Center 2100 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.

Bot LeDynh, J.D., Ph.D.
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
(703) 305-0651

UNITED STATES PATENT AND TRADEMARK OFFICE

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MOTOROLA, INC.
INTELLECTUAL PROPERTY SECTION
LAW DEPT.
8000 WEST SUNRISE BLVD
FT LAUDERDALE, FL 33322

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AUG 14 2005

OFFICE OF PETITIONS

In re Application of :
David H. Minasi, et al. :
Application No. 09/793,798 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. CM03225J :

This is a decision on the petition under 37 CFR 1.137(b), filed March 10, 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 10, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 11, 2004.

The petition satisfies the requirement 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 $1500; and (3) the required statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 2600, Art Unit 2634 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

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Wyatt, Tarrant & Combs, LLP
1715 Aaron Brenner Drive
Suite 800
Memphis, TN 38120-4367

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OFFICE OF PETITIONS

In re Application of :
Oppenheimer : DECISION ON PETITION
Application No. 09/793,819 :
Filed: February 23, 2001 :
Atty. Dkt. No.: A02171US :

This is a decision on the petition under 37 CFR 1.137(a), filed March 8, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." This is not a final agency decision.

This application became abandoned October 17, 2003 for failure to timely file a proper response to the final Office action mailed July 16, 2003. The final Office action set a three (3) month shortened statutory period of time for reply. No extensions of time in accordance with 37 CFR 1.136 were timely requested. Notice of Abandonment was mailed February 27, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

The present petition lacks requirement (3) set forth above. Petitioner has failed to present a showing to the satisfaction of the Commissioner that the entire delay in filing the required

reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The Office may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable." See, 37 CFR 1.137(a)(3). Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition to revive an application as unavoidably abandoned cannot be granted where petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay. Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

Petitioner attributes the delay in timely submitting a proper response to the final Office action to the fact that petitioner did not receive an Advisory Action until December 11, 2003. Petitioner further attributes the delay to a docketing error.

Petitioner's arguments have been considered but found unconvincing. The final Office action was mailed July 16, 2003. Petitioner contends a response was timely submitted August 12, 2003[1], however, petitioner indicates that the Office alleged it had not received the response. Hence, a copy of the response was submitted via facsimile on November 12, 2003. An Advisory Action was mailed December 11, 2003. The Advisory Action indicated that the period of time for response remained as set forth in the final Office action, making a proper response due on or before October 16, 2003. Petitioner argues that at the time the Advisory Action was mailed, the date for reply to the final Office action had passed by almost two months. However, the

[1] The original response submitted August 12, 2003 has been located in the Office.

period of time for response to the final Office action was extendible under 37 CFR 1.136(a). Hence, a proper reply to the final Office action could have been submitted up to and including January 16, 2004. Petitioner has provided no evidence that he was unable of timely respond despite the availability of extensions of time.

Petitioner further contends that a docketing error contributed to the delay in timely filing a proper response to the final Office action. A docketing error may constitute an unavoidable delay within the meaning of 37 CFR 1.137(a) provided the delay resulted from the action or inaction on the part of an employee in the performance of a clerical function. *See*, MPEP 700.03(c). However, an act or omission on the part of an attorney cannot constitute unavoidable delay. Such action, while perhaps unintentional in nature, does preclude a finding of unavoidable delay, even if such action performed by an attorney was the result of a good faith error. *See*, In re Maldague, 10 USPQ2d 1477, 1478 Comm'r Pat. 1988).

Petitioner has provided no information regarding who was responsible for inputting information into the docketing system. If petitioner performed this function, then a finding of unavoidable delay would be precluded. If, however, petitioner maintains an employee was responsible for docketing, this fact should be set forth in a renewed petition. Petitioner should also provide details regarding the business method in place for monitoring the response due dates for patent matters; the type of the docketing system in place; and information regarding the person(s) responsible for docketing, including the degree of training, experience, and supervision such person(s) received.

Petitioner should further detail how petitioner became aware that a problem with the docketing system existed and whether this type of problem has previously occurred. Petitioner should provide copies of any docketing records for the instant application where available. Petitioner should further indicate what steps, if any, have been taken to prevent the reoccurrence of similar docketing errors.

Any renewed petition must be accompanied by evidence to sufficiently establish that the entire period of delay in responding to the Office communication was unavoidable.

ALTERNATE VENUE

Application No. 09/793,819

Petitioner is urged to consider filing a petition stating that the delay was unintentional. Petitioner's attention is directed to 37 CFR 1.137(b) which provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable". An "unintentional" petition under 37 CFR 1.137(b) must be accompanied by the required petition fee and reply.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

By mail:	**Mail Stop Petition** Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450
By facsimile:	(703) 872-9306
By hand delivery or: courier service(FedEx, UPS, DHL, etc.)	U.S. Patent and Trademark Office 220 20th Street S. Customer Window, **Mail Stop Petition** Crystal Plaza Two, Lobby, Room 1B03 Arlington, VA 22202

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

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Park, Vaughan & Fleming LLP
702 Marshall Street, Suite 310
Redwood City, CA 94063

In re Application of:
Max Levchin
Application No. 09/793,843
Filed: February 26, 2001
For: SYSTEM AND METHOD FOR DEPICTING ON-LINE TRANSACTIONS

: DECISION ON PETITION TO MAKE SPECIAL (Pre-First Action Interview)

This is a decision on applicant's petition filed August 19, 2004, to have this application made Special under MPEP 708.02 VIII and the request for a Pre-First Office interview.

The petition and request meet the requirements of 37 CFR 1.102 and the Pilot Program announced March 31, 2004, and consequently, they are both granted.

This application is being forwarded to the examiner assigned to the case, who will call applicant within sixty days of the mailing of this decision to arrange for an interview which may be in person or by telephone. If you have not heard from the examiner within that time period, please contact the undersigned at 703 308-1020.

The examiner will prepare and have a First Office Action ready for mailing within thirty days of the date of the Interview.

John J. Love, Director
Technology Center 3600
703 308-1020

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MOTOROLA INC
600 NORTH US HIGHWAY 45
ROOM AS437
LIBERTYVILLE IL 60048-5343

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CANCELLED
OFFICE OF PETITIONS

In re Application of :
Eric J. Overtoom :
Application No. 09/793,864 : ON PETITION
Filed: 27 February, 2001 :
Att'y Docket No. CS1153 :

This is a decision on the petition under 1.137(b),[1] filed on 20 January, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on 20 August, 2004, for failure to file a timely response to the non-final Office action mailed on 19 May, 2004, which set a three (3) month shortened statutory period for reply. No extensions of the time for reply in

---

[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)).

accordance with 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 24 January, 2005.

Petitioner has submitted an amendment as the required reply.

The application is being referred to Technology Center Art Unit 2157 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

#5
7-1403

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TECHNOLOGY CENTER 2100

Paper No. 5

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street
Suite 1800
Arlington, VA 22209

In re Application of: Joseph A. Bennett, et al.)
Application No. 09/793,965)
Filed: February 28, 2001) **DECISION ON REQUEST FOR**
For: TECHNIQUE FOR CAPTURING) **WITHDRAWAL AS ATTORNEY**
INFORMATION)

This is a decision on the Request To Withdraw from Representation filed June 26, 2003.

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

The request is **GRANTED**.

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

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

cc: BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
Attn: Richard Pagaduan
1279 Oakmead Parkway
Sunnyvale, CA 94085-4040

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

MAIL

JUN 19 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, VA 22209

In re Application of: Joseph C. BACO, et al.)
Application No. 09/793,969)
Filed: February 28, 2001) **DECISION ON REQUEST FOR**
For: METHOD FOR MODELING A) **WITHDRAWAL AS ATTORNEY**
REFLECTED ELECTRICAL WAVE)
IN A DIGITAL SIMULATION)

This is a decision on the Request To Withdraw from Representation filed June 6, 2003.

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

The request is **GRANTED**.

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

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

cc: Schwegman, Lundberg, Woessner & Kluth P.A.
c/o Anne Richards
1600 TCF Tower
121 S. 8th Street
Minneapolis, MN 55402

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PILLSBURY WINTHROP
1600 TYSONS BOULEVARD
MCLEAN VA 22102

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OFFICE OF PETITIONS

In re Application of :
Shuji Abe et al :
Application No. 09/793,982 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No.: 008312-0277946 :

This is a decision on the petition, filed June 19, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 12, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

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

The application is being referred to Technology Center AU 2623 for further processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 5

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OFFICE OF PETITIONS

LONG ALDRIDGE & NORMAN LLP
701 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004

In re Application of
KIM
Application No. 09/793,983
Filed: February 28, 2001
Atty. Dkt. No. 8733.413.00
Title: METHOD FOR FABRICATING TRANSFLECTIVE COLOR LCD DEVICE AND THE TRANSFLECTIVE COLOR LCD DEVICE

: DECISION REFUSING
: STATUS UNDER 37 CFR
: 1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed August 27, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," 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 CFR 1.136(a).

The above-identified application was filed February 28, 2001 without an executed oath or declaration and naming YONG-BEOM KIM as sole inventor. Accordingly, on April 25, 2001, a Notice to File Missing Parts of Nonprovisional Application ("Notice") was mailed, requiring an executed oath or declaration, and a surcharge for its late filing.

The instant petition along with a request for extension of time was filed in response.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) a showing that such action is required to preserve the rights of the parties or to prevent irreparable damages.

Petitioner lacks items (2), (5), and (6) set forth above.

As to item (2), no oath or declaration for the patent application in compliance with 37 CFR 1.63 or 1.64 has been presented. The declaration presented with the original application papers has not been executed. Please note that in a petition under 37 CFR 1.47(b) where no inventor is

available to execute the declaration, the declaration should be executed by a corporate officer, such as the president, vice president, secretary, or treasurer of the assignee on behalf of and as agent for the non-signing inventor. The corporate officer's title or position must be identified in the declaration. If an officer is unavailable to execute the declaration, the declaration may be signed on behalf of the corporation by one whose proof of signing authority has been submitted to the Office, such as the corporation's attorney. Petitioner's attention is directed to MPEP 409.03(b) for further guidance.

As to item (5), petitioner has presented no evidence of proprietary interest in the above-referenced application. Petitioner must establish that the invention has been assigned to applicant, that the inventor has agreed in writing to assign the invention to applicant, or that applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. Petitioner must submit a copy of an employment agreement between the inventor and applicant or a legal memorandum signed by an attorney familiar with the law of the relevant jurisdiction stating that a court of competent jurisdiction would by weight of authority in that jurisdiction award title of the invention to Rule 47 applicant.

As to item (6), the petition does not give any indication that status under Rule 47 is necessary to preserve the rights of any particular party or to prevent irreparable damages to any particular party.

As per the authorization contained in the instant petition, deposit account 50-0911 has been charged $130.00, the required petition fee.

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

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

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

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries regarding this decision should be directed to Petitions Attorney Alesia M. Brown at (703) 305-0310.

for D Wood
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
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Paper No. 10

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AUG 1 3 2002

OFFICE OF PETITIONS

LONG ALDRIDGE & NORMAN LLP
701 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004

In re Application of :
KIM :
Application No. 09/793,983 : DECISION REFUSING
Filed: February 28, 2001 : STATUS UNDER 37 CFR
Atty. Dkt. No. 8733.413.00 : 1.47(b)
Title: METHOD FOR FABRICATING :
TRANSFLECTIVE COLOR LCD DEVICE :
AND THE TRANSFLECTIVE COLOR :
LCD DEVICE :

This is in response to the renewed petition under 37 CFR 1.47(b), filed June 6, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(b)," 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 CFR 1.136(a).

The above-identified application was filed February 28, 2001 without an executed oath or declaration and naming YONG-BEOM KIM as sole inventor. Accordingly, on April 25, 2001, a Notice to File Missing Parts of Nonprovisional Application ("Notice") was mailed, requiring an executed oath or declaration, and a surcharge for its late filing. A petition under 37 CFR 1.47(b) was filed August 27, 2001 and dismissed November 7, 2001.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor; (5) proof of proprietary interest; and (6) a showing that such action is required to preserve the rights of the parties or to prevent irreparable damages.

Petitioner lacks item (2) set forth above. The declaration submitted with the instant petition is unacceptable as it fails to comply with the provisions of 37 CFR 1.63 and 37 CFR 1.64. Jeong-Hwan Lee is listed as the second inventor on the declaration, however, the petition alleges said person is an officer of the assignee company. Please note that in a petition under 37 CFR 1.47(b) where no inventor is available to execute the declaration, the declaration must include the

last known address of the non-signing inventor and should be executed by a corporate officer, such as the president, vice president, secretary, or treasurer of the assignee on behalf of and as agent for the non-signing inventor. The corporate officer's title or position must be identified in the declaration. If an officer is unavailable to execute the declaration, the declaration may be signed on behalf of the corporation by one whose proof of signing authority has been submitted to the Office, such as the corporation's attorney. The signature block of the non-signing inventor should remain unexecuted. Petitioner's attention is directed to MPEP 409.03(b) for further guidance.

Any renewed petition must be accompanied by a oath or declaration in full compliance with 37 CFR 1.63 and 37 CFR 1.64.

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

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

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

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

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

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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Paper No. 13

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OCT 2 2 2002

OFFICE OF PETITIONS

LONG ALDRIDGE & NORMAN LLP
701 PENNSYLVANIA AVENUE, N.W.
WASHINGTON, DC 20004

In re Application of
KIM
Application No. 09/793,983
Filed: February 28, 2001
Atty. Dkt. No. 8733.413.00
Title: METHOD FOR FABRICATING TRANSFLECTIVE COLOR LCD DEVICE AND THE TRANSFLECTIVE COLOR LCD DEVICE

: DECISION GRANTING
: STATUS UNDER 37 CFR
: 1.47(b)

This is in response to the renewed petition under 37 CFR 1.47(b), filed October 9, 2002.

The petition is **GRANTED**.

Petitioner has shown that inventor Yong-Beom Kim cannot be reached to execute the application papers.

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

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

Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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HEWLETT PACKARD COMPANY
P.O. BOX 272400, 3404 E. HARMONY ROAD
PORT COLLINS, CO 80527-2400

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OFFICE OF PETITIONS

In re Application of :
HUNTER, Andrew Arthur :
Application No. 09/794,021 :
Filed: February 28, 2001 :
Attorney Docket No. 30990046-3 US (1509-141) :

DECISION
ON PETITION
37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed June 23, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely pay the issue fee and publication fee in reply to the Notice of Allowance (Notice) mailed January 25, 2005, which set a statutory period for reply of three (3) months. Accordingly the application became abandoned on April 26, 2005.

In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. See MPEP 711.03(c)(III)(A)(1). In view of the authorization contained in the petition to charge any additional fees due, the $1400 issue fee and $300 publication fee will be charged to Deposit Account No.08-2025.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR §1.137(b) in that (1) the issue fee and the publication fee; (2) the petition fee of $1500.00 (for a large entity); and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Notice mailed January 25, 2005 is accepted as having been unintentionally delayed.

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 Angela Ortiz at (571) 272-6051 or, in his absence, to the undersigned at (571) 272-3217.

This matter is being referred to the Office of Publications.

Karen Creasy for

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

cc: LOWE HAUGMAN & BERNER, LLP
Customer No.22429
1700 Diagonal Road
Suite 300
Alexandria, VA 22314

#4
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TECHNOLOGY CENTER 2100

Paper No. 4

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 North Seventeenth Street, Suite 1800
Arlington, Virginia 22209

In re Application of: Mark A. Beiley, et al.	)	
Application No. 09/794,036	)	
Filed: February 28, 2001	)	**DECISION ON REQUEST FOR**
For: DYNAMIC BUS INVERSION METHOD	)	**WITHDRAWAL AS ATTORNEY**
	)	

This is a decision on the Request To Withdraw from Representation filed June 2, 2003.

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

The request is **GRANTED**.

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

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

cc: Kenyon & Kenyon
1500 K Street, N.W.
Suite 700
Washington, DC 20005-1257

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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Paper No. 6

HALE & DORR LLP
THE WILLARD OFFICE BUILDING
1455 PENNSYLVANIA AVE, NW
WASHINGTON, DC 20004

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OFFICE OF PETITIONS

In re Application of :
Singer et al. :
Application No. 09/794,083 : DECISION
Filed: 28 February, 2001 : UNDER 37 CFR 1.28(c)
Attorney's Docket No. 110293.2909U :

This is in response to the deficiency fee payment filed pursuant to 37 CFR 1.28(c) on 10 July, 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 deficiency fee payment of $632.00 is accepted. However, petitioner is ultimately responsible for ensuring that the correct fee is paid.

Small entity status will no longer apply.

The file is being forwarded to Technology Center 3700 for examination in due course.

Telephone inquiries should be directed to Petitions Attorney Douglas I. Wood at (703)308-6918.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, D.C. 20231
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Paper No. 8

DYKEMA GOSSETT PLLC
THIRD FLOOR WEST, FRANKLIN SQUARE
1300 I STREET NW
WASHINGTON DC 20005-3353

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NOV 0 5 2001

OFFICE OF PETITIONS

In re Application of :
Lieven Callewaert et al :
Application No. 09/794,254 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. 66345-027-7 :

This is a decision on the petition under 37 CFR 1.55(c), filed October 23, 2001, requesting acceptance of an unintentionally delayed claim under 35 USC 119 (a) through (d) for benefit of the filing date of foreign European Application No. 00870030.4, filed March 1, 2000.

A petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority requires:

(1) the nonprovisional application claiming the benefit of an earlier filing date must be filed on or after November 29, 2000;

(2) the claim submitted with the petition must identify the prior foreign application for which priority is claimed, as well as any foreign application for the same subject matter and having a filing date before that of the application for which priority is claimed, by the application number, country, and the filing date;

(3) the surcharge of $1,280.00, as set forth in 37 CFR 1.17(t);

(4) a statement that the entire delay between the date the claim was due under 37 CFR 1.55(a)(1)(i) 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); and

(5) the above-identified nonprovisional application must be filed within 12 months of the filing date of the foreign application.

The instant pending nonprovisional application was filed after November 29, 2000, and did not include a reference to the foreign application, for which benefit is now sought, within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior foreign application. Therefore, since the claim for priority is submitted after the period specified in 37 CFR 1.55(a)(1)(i), this is an appropriate petition under the provisions of 37 CFR 1.55(c).

The above-identified pending nonprovisional application was filed on February 28, 2001, which is after November 29, 2000 and within 12 months of March 1, 2000 (the filing date of the foreign application to which benefit is now being claimed). The petition was accompanied by a certified copy of Application No. 00870030.4, filed March 1, 2000. Additionally, on October 11, 2001, an executed oath/declaration was received which identifies the foreign application for which priority is claimed by application number, country and filing date. The required petition fee of $1,280 was received with the petition. Lastly, petitioner has provided an adequate statement of unintentional delay.

All requirements being met, the petition under 37 CFR 1.55(c) to accept an unintentionally delayed claim for priority under 35 USC 119(a) through (d) is **granted.**

This application is being returned to the Office of Initial Patent Examination Division for preexamination processing and for issuance of a corrected filing receipt that will include the foreign priority claim and the projected publication date for the above-identified application. Afterwards, the application will be forwarded to the appropriate Technology Center for consideration by the examiner of record of the foreign priority claim under 35 USC 119 and 37 CFR 1.55(c).

Any inquiries directly pertaining to this matter may be directed to the undersigned at (703) 305-8680.

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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AUG - 4 2004

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

In re Application of	:
Erwin W. Gelfand et al.	:
Serial No.: 09/794,258	: PETITION DECISION
Filed: February 27, 2001	:
Attorney Docket No.: 2879-37-1-1	:

This is in response to the petition under 37 CFR 1.181 for withdrawal of abandonment and a petition under 37 CFR1.183 for a waiver of the provisions of 37 CFR 1.18(f) accompanied by a terminal disclaimer, filed May 6, 2004. Applicant states that the application was abandoned for failure to respond timely to the Office action mailed on March 20, 2003.

A review of the file history shows that the examiner mailed an Office action to applicants on March 20, 2003 setting a three month shortened statutory period for reply. Upon failure to receive a reply the Office mailed a Notice of Abandonment to applicants on November 4, 2003. Applicants state that they filed a timely response on Monday September 22, 2003 (September 20 fell on a Saturday). Applicants have supplied a copy of the Amendment, a copy of the check dated September 22, 2003, for the three months extension of time, and a post card receipt from OIPE.

The submission of the withdrawal from abandonment petition was filed after the two month period from the mailing of the Notice of Abandonment and as such applicant has sent in a second petition under 37CFR 1.183, a statement that the delay was unintentional and without deceptive intent, fees required under 37 CFR 1.17(h) and a terminal disclaimer which dedicates to the public the terminal part of the term of any patent granted that would extend beyond 20 years from the filing date of the application.

The petition for waiver of the requirements under 37CFR 1.181(f) and the petition for the withdrawal of holding of abandonment are **GRANTED**.

The application has been returned to pending status and will be forwarded to the examiner, after the mailing of this letter, for consideration of the Amendment.

Should there be any questions about this decision please contact Jean F. Vollano, by letter addressed to Director, TC 1600, P.O. Box 1450, Alexandria, VA 22313-1450, or by telephone at 571-272-0648 or by facsimile sent to the general Office facsimile number.

Jasemine C. Chambers

Jasemine Chambers
Director, Technology Center 1600

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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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MILA KASAN, PATENT DEPT.
APPLIED BIOSYSTEMS
850 LINCOLN CENTRE DRIVE
FOSTER CITY, CA 94404

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APR 2 1 2004

OFFICE OF PETITIONS

In re Application of :
John Brandis, et al. :
Application No. 09/794,262 :
Filed: February 27, 2001 :
Attorney Docket No. 4325D1 :

ON PETITION

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 final Office action mailed May 20, 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) was obtained. An Advisory action was mailed September 30, 2003 indicating that the reply filed on August 25, 2003 failed to place the application in condition for allowance. Accordingly, the application became abandoned on August 21, 2003.

The application file is being forwarded to Technology Center 1600, Art Unit 1637 for further processing.

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

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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FREESCALE SEMICONDUCTOR, INC.
LAW DEPARTMENT
7700 WEST PARMER LANE MD:TX32/PL02
AUSTIN, TX 78729

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AUG 29 2006

OFFICE OF PETITIONS

In re Application of Weizhong :
Application No. 09/794,285 : Decision on Petition
Filing Date: February 27, 2001 :
Attorney Docket No. PF02058NA P01 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 14, 2005, to revive the above-identified application.

The petition is **DISMISSED**.

Facts:

The application was filed with 18 claims. A copy of the original claims is enclosed.

A non-final Office action was mailed May 25, 2004.

A reply was filed August 25, 2004. The reply stated, "Claims 1-24 are pending." The reply included 24 claims. Each claim is designated as an "original" claim. A copy of the reply is attached.

A Notice of Non-Compliant Amendment was mailed November 8, 2004. Petitioner failed to file a timely reply. Therefore, the application became abandoned as of midnight on December 8, 2004.

A Notice of Abandonment was mailed October 4, 2005.

Discussion:

Petitioner has not filed a new amendment. Instead, petitioner asserts the August 25, 2004, amendment is proper and should be entered. However, even though only 18 claims were present at filing, the amendment identifies each of the 24 claims as "original." The amendment filed August 25, 2004, was not proper and cannot be entered. A proper amendment should be filed.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are NOT permitted. The 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 Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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

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AUG 29 2006

OFFICE OF PETITIONS

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

Attached: Copy of original claims
Copy of claims filed August 25, 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FREESCALE SEMICONDUCTOR, INC.
LAW DEPARTMENT
7700 WEST PARMER LANE MD:TX32/PL02
AUSTIN, TX 78729

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JAN 1 1 2007

OFFICE OF PETITIONS

In re Application of Weizhong :
Application No. 09/794,285 : Decision on Petition
Filing Date: February 27, 2001 :
Attorney Docket No. PF02058NA P01 :

This is a decision on the petition under 37 CFR 1.137(b), filed October 27, 2006, to revive the above-identified application.

The petition is **granted**.

Facts:

The application was filed with 18 claims.

A non-final Office action was mailed May 25, 2004.

Petitioner filed a reply on August 25, 2004.

The reply to the non-final Office action consisted of:
(1) a terminal disclaimer to obviate the double patenting rejection, and
(2) an amendment.

The amendment included 24 claims. Due to problems with the amendment, the amendment was not entered and the Office mailed a Notice of Non-Compliant Amendment on November 8, 2004.

Petitioner failed to file a timely reply to the Notice of Non-Compliant Amendment. Therefore, the application became abandoned as of midnight on December 8, 2004.

A Notice of Abandonment was mailed October 4, 2005.

Discussion:

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 amendment filed August 25, 2004, will not be entered. The currently pending claims are the 18 claims filed with the original application.

Technology Center Art Unit 2634 will be informed of the instant decision. The terminal disclaimer filed August 25, 2004, has been entered and will be considered by the examiner in due course.

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 7

William S. Frommer, Esq.
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York NY 10151

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JAN 2 8 2002

OFFICE OF PETITIONS

In re Application of
Derek Slone
Application No. 09/794,290
Filed: February 27, 2001
Attorney Docket No. 450110-03107
For: MEDIA EDITING

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(b)

This is a decision on the petition under 37 CFR 1.47(b), filed December 11, 2001.

The petition under 37 CFR 1.47(b) is **dismissed.**

Any request for reconsideration under 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. Failure to respond will result in the abandonment of this application. Any response should be titled "Request for Reconsideration of Petition Under 37 CFR 1.47(b).

The above-identified application was filed on February 27, 2001, without an executed oath or declaration. Accordingly, a "Notice to File Missing Parts of Nonprovisional Application" (the "Notice") was mailed on May 22, 2001, requiring an executed oath or declaration, filing fee, a surcharge for the late filing of the oath or declaration. The Notice set forth a two month extendable period for reply.

On December 11, 2001(certificate of mailing dated October 22, 2001), petitioner filed the instant "Petition Under 37 CFR 1.47(b)" and obtained a three (3) month extension of time to file a reply.

A grantable petition under 37 CFR 1.47(b) requires:

(1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims, and drawings).

(2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116.

(3) the petition fee.

(4) a statement of the last known address of the non-signing inventor.

(5) the establishment of a prima facie case that (1) the invention has been assigned to him or her or (2) that the inventor has agreed in writing to assign the invention to him or her or (3) otherwise demonstrate a proprietary interest in the subject matter of the application.

(6) and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner has failed to satisfy items (2) and (5) above.

As to item (2), the declaration filed is not executed by an authorized party. Section 409.03(b) of the *Manual of Patent Examining Procedure* ("MPEP") states, in pertinent part, that:

> [t]he 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 US Patent and Trademark Office, to sign the application oath or declaration on its behalf. Where an oath 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.

The declaration filed is not executed by anyone. A signature of an authorized corporate official, attorney or agent, is necessary in order for the declaration to be considered valid. Petitioner is also cautioned to adhere to the guidance provided in Section 409.03(b) relative to establishing that person signing the declaration is, in fact, authorized to make the representations on behalf of the company.

As to item (5) above, petitioner has not satisfactorily established that either the invention has been properly assigned or another sufficient proprietary interest exist. It is noted that petitioner provided a statement relative to the 37 CFR 1.47(b) applicant's proprietary interest, however; the statement only indicates that the inventor was an employee of the applicant at the time the invention was created and was under an obligation to assign said invention. The statement does not indicate that the invention was, in fact, assigned or that a written assignment was executed. Further, there is no record in the Patent and Trademark Office of any assignment being recorded relative to the above-cited invention. Petitioner has neither provided the necessary memorandum that is required when the applicant must, as in this case, establish sufficient proprietary interest by means other than an executed assignment document. See MPEP 409.03(f). Petitioner must satisfactorily establish sufficient proprietary interest before status can be granted under 37 CFR 1.47(b). Prior to filing any petition for reconsideration, petitioner is cautioned to refer to MPEP 409.03(f) and follow it accordingly.

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) 308-6919
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 South Clark Place
Arlington, Virginia

Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

William S. Frommer, Esq.
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, NY 10151

COPY MAILED

MAY 10 2002

OFFICE OF PETITIONS

In re Application of	:	
Derek Sloane	:	
Application No.: 09/794,290	:	
Filed: February 27, 2001	:	DECISION ACCORDING
Attorney Docket No: 450110-03107	:	STATUS UNDER
For: MEDIA EDITING	:	RULE 47(b)

This is in response to the renewed petition under 37 CFR 1.47(b), filed April 4, 2002 (certificate of mailing dated March 26, 2002.)

The petition is **GRANTED**.

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.

The above-identified application was filed on February 27, 2001, without an executed oath or declaration. Accordingly, a "Notice to File Missing Parts of Nonprovisional Application" (the "Notice") was mailed on May 22, 2001, requiring an executed oath or declaration, filing fee, a surcharge for the late filing of the oath or declaration. The Notice set forth a two month extendable period for reply. On December 11, 2001(certificate of mailing dated October 22, 2001), petitioner filed the instant "Petition Under 37 CFR 1.47(b)" and obtained a three (3) month extension of time to file a reply. The petition was dismissed by a decision mailed January 28, 2002, because petitioner failed to have authorized party execute the declaration and failed to establish sufficient proprietary interest for the 37 CFR 1.47(b) applicant.

On April 4, 2002, petitioner filed a renewed petition along with a declaration pursuant to 37 CFR 1.63 executed by a properly authorized party. Further, through the declarations of Miles Flint and Morgan David and a redacted employment agreement executed by the nonsigning inventor, petitioner has established sufficient proprietary interest exists to warrant according status under 37 CFR 1.47(b).

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.

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

Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Derek Sloane
2 Highcrown Mews
Southhampton SO17 1PT

AIRMAIL

In re Application of
Derek Sloane
Application No. 09/794,290
Filed: February 27, 2001
Attorney Docket Number: 450110-03107
For: MEDIA EDITING

LETTER

COPY MAILED

MAY 10 2002

OFFICE OF PETITIONS

Dear Mr. Sloane:

You are named as the sole 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(b), Rules of Practice in Patent Cases. Should a patent be granted on the application you will be designated therein as the sole inventor.

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney Kenya A. McLaughlin at (703) 305-0010. 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).

K. A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Beverly M. Flanagan

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

cc:
William S. Frommer, Esq.
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, NY 10151

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : August 28, 2006

TO SPE OF : ART UNIT 2193 Mai Tan

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/794,303 Patent No.: 7024447 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**.

Antonio J. Mason

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.

Mai

TAN V. MAI
PRIMARY EXAMINER

Comments: _____

KAKALI CHAKI
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

9.5.06

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

Heller Ehrman LLP
275 Middlefield Road
Menlo Park, California 94025

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DEC 13 2005

OFFICE OF PETITIONS

In re :
Tsien et al. :
Application No. 09/794,308 : RECONSIDERATION OF
Filing Date: February 26, 2001 : PATENT TERM ADJUSTMENT
Atty. Docket:39754-0831 A :

This decision is in response to Applicants' request titled REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b) timely filed on May 24, 2005 requesting that the Office adjust the PTA calculation at the time of the mailing of the notice of allowance from a determination of one hundred and ninety-two (192) days to a determination of two hundred and twenty-two (222) days.

Applicants request for reconsideration is **GRANTED.** The Office will adjust the PTA determination to reflect 222 days as requested by applicants. A copy of the Adjusted PTA calculation is being mailed with this decision.

Applicants assert that the Office erred in assessing a fifty (50) day reduction for the submission of an IDS (supplemental paper) after the initial November 6, 2002 response. Applicants do not dispute the IDS submission after the initial response. Applicants assert that the proper date of receipt in the Office of the IDS submission was November 26, 2002 not December 26, 2002 as noted in PALM. Accordingly, applicant asserts that the proper amount of reduction pursuant to 37 CFR 1.704(c)(8) is 20 days not 50 days. Applicants do not dispute the administrative delays of two hundred and eighty days (115 + 159+ 6) pursuant to 37 CFR 1.702(a)(1) or 37 CFR 1.702(a)(2). Nor do applicants contest the thirty-six day reduction pursuant to 37 CFR 1.704(c)(8).

Applicants' arguments are persuasive. The Office did errantly enter the date of submission of the IDS as 12/26/2002 rather than

the actual date of 11/26/02. Accordingly, the Office improperly reduced applicants' PTA by thirty days more than was accurate. Applicants should have been assessed a delay of twenty (20) days for the submission of an IDS on 11/26/2002. Accordingly, the proper amount of applicant delay is 56 days (36 +20). Overall, the proper amount of PTA is two hundred and twenty-two (280-56=222) days of PTA at the time of the mailing of the notice of allowance.

After the mailing of the notice of allowance, the Office will forward this application to the Office of Patent Publications for a prompt issuance of the patent. Any delays by the Office under 37 CFR 1.702(a)(4) or 1.702(b) will be reflected in the issue notification letter that is mailed to applicants approximately three weeks prior to issuance of the patent.

The Office has assessed the required $200.00 fee to Deposit Account 08-1641. No additional fees are required by the Office in determining this request for reconsideration of the PTA determination.

Any questions relating to this decision should be directed to Kery A. Fries, Senior Legal Advisor, 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

cc: Adjusted Pair Calculation

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov
DNW 10-01

Paper No. 5

HALE AND DORR LLP
1455 PENNSYLVANIA AVENUE, NW
WASHINGTON, DC 20004

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OCT 2 2 2001

OFFICE OF PETITIONS

In re Application of :
Tracy et al. : DECISION GRANTING PETITION
Application No. 09/794,386 :
Filed: 28 February, 2001 :
Attorney Docket No. 102632.120 U :

This is a decision on the petition filed on 9 August, 2001, requesting that the application, including 34 sheets of drawings, be accorded a filing date of 28 February, 2001.

The petition is granted.

On 28 February, 2001, the application was filed.

On 14 May, 2001, Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application stating the application had not been accorded a filing date because the application was deposited without drawings.

In response, on 9 August, 2001, *inter alia*, 34 sheets of informal drawings were filed. Petitioners argue that 34 sheets of drawings were filed with the other application papers on 28 February, 2001, that the drawings were later misplaced in the U.S. Patent and Trademark Office ("Office"). In support, a copy of petitioners' postcard receipt was supplied on 9 August, 2001. The postcard receipt shows an Office date stamp of 28 February, 2001, and acknowledges receipt of 34 sheets of drawings.

A review of the record reveals that no sheets of drawings deposited on 28 February, 2001, have been located in the application file. Based on the evidence present in the file, it is concluded that 34 sheets of drawings were filed on 28 February, 2001, and that the drawings were subsequently misplaced

in the Office. Therefore, the application, including 34 sheets of informal drawings, is entitled to a filing date of 28 February, 2001.

The "Notice" mailed on 14 May, 2001, is hereby withdrawn to the extent that it stated that the application was deposited without drawings. The petition fee of $130.00 will be refunded to counsel's deposit account, No. 08-0219.

The application will be processed and examined using the 34 sheets of informal drawings supplied on 9 August, 2001.

This application file is being forwarded to Initial Patent Examination Division for further processing with a filing date of 28 February, 2001, using the 34 sheets of informal drawings supplied on 9 August, 2001, and for an indication on the file data sheet that 34 sheets of drawings were present on filing.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Douglas I. Wood at (703) 308-6918.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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COOLEY GODWARD LLP
ATTN: PATENT GROUP
11951 FREEDOM DR SUITE 1700
ONE FREEDOM SQUARE - RESTON TOWN CENTER
RESTON VA 20190-5061

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APR 0 7 2005

OFFICE OF PETITIONS

In re Application	:	
Tracy, et al.	:	
Application No. 09/794,386	:	DECISION ON APPLICATION
Filed: February 28, 2001	:	FOR PATENT TERM ADJUSTMENT
Atty Docket No. TELO-001/01US	:	

This is a decision on the "REQUEST FOR CORRECTION OF PATENT TERM ADJUSTMENT", filed August 10, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from seventy-six (76) days to four hundred (400) days.

The application for patent term adjustment is **GRANTED**. However, applicants' request that an additional PTO delay of one hundred eighty-five (185) days be assessed is being **HELD IN ABEYANCE** until after the actual patent date.

Applicants are given two months from the issue date of the patent to request reconsideration of the patent term adjustment indicated on the patent application. Applicants may seek such reconsideration without payment of the fee. A copy of this decision should accompany applicant's written request for reconsideration.

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 fifteen (215) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 19, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is seventy-six days. On August 10, 2004, Applicants timely[1] submitted the instant application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is four hundred (400) days.

Applicants assert entitlement to a patent term adjustment of four hundred (400) days on the basis that the PTO improperly assessed Applicants a delay of one hundred thirty-nine (139) days for responding to a Notice of Incomplete Nonprovisional Application mailed on May 14, 2001. Applicants assert that they timely filed a response on August 9, 2001, within the three month period pursuant to 37 C.F.R. §1.704(b). In addition, applicants assert that the PTO should be assessed delay for its failure to issue the patent within three years of filing.

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of zero seventy-six (76) days based on an adjustment for PTO delay of two hundred sixty-four (264) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1) and twelve (12) days pursuant to 35 U.S.C. 154(b)(1)(A)(ii) and 37 C.F.R. §1.703(a)(2), reduced by Applicants' delay of one hundred thirty-nine (139) and sixty-one (61) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. §1.704(b). The adjustment of 139 days is at issue.

The adjustment of 139 days has been found to be incorrect. A review of the application file reveals that a Notice to File Missing Parts of Nonprovisional Application was mailed on May 14, 2001. Applicants timely filed a complete response to this notice on August 9, 2001. As this was timely pursuant to 37 C.F.R. § 1.704(b), no applicant delay should have been assessed.

---

[1] Applicants filed the application for patent term adjustment on the same day as the issue fee.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **two hundred fifteen (215) days** (276 (264 + 12) days of PTO delay, reduced by 61 days of applicant delay).

The $200.00 fee set forth in 37 C.F.R. §1.18(e) has been charged to Deposit Account No. 50-1283, as authorized.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

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

Enclosure: Copy of Revised PAIR Screen

UNITED STATES PATENT AND TRADEMARK OFFICE

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P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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1725 K STREET, NW
SUITE 1000
WASHINGTON, DC 20006

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APR 16 2004

OFFICE OF PETITIONS

In re Application of
Takeuchi, Kyohei
Application No. 09/794,398
Filed: February 28, 2001
Attorney Docket No. 010221

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed January 28, 2004, to revive the above-identified application.

The petition is **granted.**

This application became abandoned for failure to timely reply within three months to the final Office action mailed June 11, 2003. A one-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, this application became abandoned on October 12, 2003.

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

The file is now being forwarded to Technology Center 2800 for processing of the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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

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

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)
6,589,981	2003-07-08	09/794,417	2001-02-27	ILEX:055US (P-1000-US)

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

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☒ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

NOT Small Entity

	Fee	Code
◉	3 ½ year	(1551)
○	7 ½ year	(1552)
○	11 ½ year	(1553)

Small Entity

	Fee	Code
○	3 ½ year	(2551)
○	7 ½ year	(2552)
○	11 ½ year	(2553)

SURCHARGE

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

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Monica A. De La Paz/	Date (YYYY-MM-DD)	2007-07-18
Name	Monica A. De La Paz	Registration Number	54662

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. 6589981
Issue Date: July 8,2003
Application No. 09794417
Filed: February 27,2001
Attorney Docket No. P-1000-US

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

This is a decision on the electronic petition, filed July 18,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 18,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

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. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROGER M. LORIA

MAILED
APR 26 2004
U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Appeal No. 2004-0761
Application No. 09/794,531

ON BRIEF

Before WINTERS, ADAMS, and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-18 and 27-80. Claims 19-26 are also pending but have been withdrawn from consideration. Claim 1 is representative and is reproduced in the attached appendix.

The examiner relies on the following references:

Loria WO 97/37662 Oct. 16, 1997

Berkow, Merck Manual of Diagnosis and Therapy, 16th ed., pp. 1750-1751 (1992)

Claims 1-18 and 27-80 stand rejected under 35 U.S.C. § 103.

We reverse.

Background

"Δ5-Androstenediol (AED) is a naturally-occurring metabolite of dehydroepiandrosterone (DHEA), the most abundant product of the adrenal glands. . . . AED exists in two epimeric forms: Δ5-androstene-3-β,17α-diol (αAED) and Δ5-androstene-3-β,17β-diol (βAED). . . . βAED has immuno-stimulating properties and immune upregulating properties. αAED has been shown to induce apoptosis in transformed cells in vitro." Specification, page 2.

Discussion

Claim 1, the broadest claim on appeal, is directed to a two-step method of treating cancer. In a first step, αAED or an ether or ester derivative thereof is administered to the patient, and in a second, subsequent step, βAED or an ether or ester derivative is administered.

The examiner rejected all of the claims as obvious in view of Loria and Berkow. The examiner cited Berkow, however, only for its teaching that "aminoglutethimide and orchiectomy are useful in treating prostate cancer." Examiner's Answer, page 5. This teaching seems to be relevant only to certain dependent claims, and therefore we need not discuss Berkow further.

The examiner cited Loria's teachings that αAED inhibits tumor growth and that the combination of αAED and βAED inhibited proliferation of breast cancer cells in vitro. See the Examiner's Answer, page 4. The examiner also noted that Loria "teaches that βAED can enhance immune response, and [is] also useful in counteracting the untoward effects of irradiation and chemotherapy." Id.

The examiner conceded that "Loria does not expressly teach the compounds are administered in a subsequent manner," id., but asserted that "the optimization of therapeutic effect parameters (e.g., dosing regimens) is obvious as being within the skill of the artisan." Id., page 5. See also page 7: "[A]djusting and optimizing the timing and administration order of the compounds would be obvious as being within the purview of the skilled artisan."

Appellant argues that the cited references would not have suggested the claimed method of administering αAED and βAED sequentially. See the Appeal Brief, pages 8-9: "[T]he activity of the combination of αAED alone or the activity of αAED and βAED does not suggest using αAED and βAED sequentially. If anything, it suggests that αAED and βAED should be used in combination and not sequentially. Therefore, Loria does not suggest treating cancer using sequential administration of αAED and βAED. . . . Berkow does not provide any teaching or suggestion related to the administration of αAED and βAED."

"In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant." In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993).

In considering whether a claimed invention would have been obvious at the time it was made, examiners must be careful to avoid interpreting the references in light of the later-filed patent application. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999): "Measuring a claimed

invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field." As Judge Learned Hand put it, obviousness is "the creature of an imagination projected upon the future out of materials from the past." Schaefer, Inc. v. Mohawk Cabinet Co., Inc., 276 F.2d 204, 207, 125 USPQ 318, 320 (2d Cir. 1960).

Thus, showing that a claimed invention would have been prima facie obvious requires evidence that the prior art would have suggested the invention as a whole to those of ordinary skill in the art. "Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant." In re Kotzab, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

In this case, we agree with Appellant that the examiner has not adequately explained how the cited references would have suggested the method of claim 1 to a person of ordinary skill in the art reading them without the benefit of the instant specification. In particular, the examiner has pointed to nothing in the

prior art that would have led those of skill in the art to administer first αAED and then, subsequently, βAED.

The examiner pointed out that Loria teaches that the combination of αAED and βAED was effective in vitro for inhibiting the growth of breast cancer cells (Example 2). Loria also teaches, however, that the two epimers have different activities when used separately. See page 7, lines 4-13: "At concentration[s] of 25 nM or greater, the αAED significantly inhibited the growth of ZR-75-1 [breast cancer] cells. . . . As opposed to αAED, the βAED alone at 100 nM concentrations did not have any antiproliferative effect on the growth of the ZR-75-1 cells." This disclosure would not seem to suggest following administration of αAED with administration of βAED.

The examiner's statement that "optimization of therapeutic effect parameters (e.g., dosing regimens) is obvious as being within the skill of the artisan" does not make up for the deficiencies of the prior art. It is true that "discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." In re Boesch, 617 F.2d 272, 276, 205 USPQ 215, 219 (CCPA 1980). That rule, however, applies only where the variable being optimized is one that is known to affect the results of the particular process; i.e., the knowledge that the variable is result-affecting provides the motivation to optimize it. The examiner has pointed to no evidence of record showing that those of skill in the art would have been motivated to add a subsequent step of administering βAED in order to "optimize" the known process of inhibiting tumor cell growth by administering αAED.

Summary

The references cited by the examiner do not support a prima facie case of obviousness. The rejection under 35 U.S.C. § 103 is reversed.

REVERSED

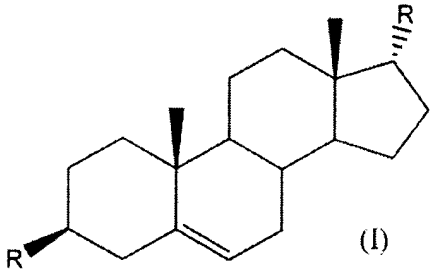
Sherman D. Winters)
Administrative Patent Judge)
)
)
)
Donald E. Adams) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
)
) INTERFERENCES
)
Eric Grimes)
Administrative Patent Judge)

EG/jlb

Parker and Destefano
300 Preston Avenue
Suite 300
Charlottesville, VA 22902

APPENDIX

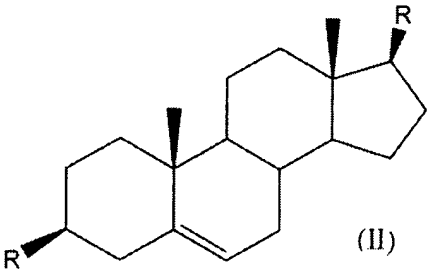
1. A method of treating precancer, cancer, or metastatic cancer in a patient in need of such treatment comprising delivering to the tissues of said patient or administering to said patient a therapeutically effective amount of one or more compounds of formula (I):



(I)

wherein each R is independently selected from the group consisting of a hydroxyl, a C_1-C_{30} ether and a C_1-C_{30} ester; and

subsequently delivering to the tissues of said patient or administering to said patient a therapeutically effective amount of one or more compounds of formula (II):



(II)

wherein each R is independently selected from the group consisting of a hydroxyl, a C_1-C_{30} ether and a C_1-C_{30} ester.

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)
6908401	2005-06-21	09794657	2001-02-28	380112-142

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

SMALL ENTITY

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

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

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

SURCHARGE

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

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Craig A. Slavin/	Date (YYYY-MM-DD)	2009-08-12
Name	Craig A. Slavin	Registration Number	35362

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
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In re Patent No. 6908401
Issue Date: June 21,2005
Application No. 09794657
Filed: February 28,2001
Attorney Docket No. 380112-142

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

This is a decision on the electronic petition, filed August 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 August 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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE
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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

LERNER AND GREENBERG, P.A.
Post Office Box 2480
Hollywood, FL 33022-2480

Paper No. 9

In re Application of :
Christine Born :
Application No. 09/794,661 :
Filed: February 27, 2001 :
For: METHOD FOR ACQUIRING ELECTRONIC DATA USING A DATA MEDIUM, AND CORRESPONDING DATA MEDIUM

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on applicant's petition to withdrawal the holding of abandonment filed on December 3, 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 July 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/1/28/04

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

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JUL 18 2001

OFFICE OF PETITIONS
A/C PATENTS

LAWSON, PHILPOT & PERSSON, P.C.
67 WATER STREET, SUITE 110
LACONIA, NH 03246

In re Application of
Sinclair, Durkee & Floyd
Application No.: 09/794,767
Filed: February 26, 2001
Attorney Docket No.: 1421-006
For: HIGH DENSITY DIGITAL SUBSCRIBER LINE SPLITTER

DECISION REFUSING STATUS
UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed June 14, 2001(certificate of mailing date June 11, 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 instant petition listed incorrect identifiers on the first page -- i.e. wrong first named inventor, serial number, filing date, and title of invention. The undersigned assumes that it is an error because the contents of petition pertain to the inventors in the above-identified application. The incorrect identifiers are those of another case that Attorney Persson is handling. Appropriate modifications to the identifiers have been made.

The above-identified application was filed on February 26, 2001 without an executed oath or declaration. Accordingly, on April 11, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a filing fee, and a surcharge for their late filing.

In response, on June 14, 2001 (certificate of mailing June 11, 2001),, a declaration executed by joint inventors Sinclair and Durkee, the surcharge, the application filing fee, the petition fee, and the instant petition were filed. Declaration of facts of Inventor Sinclair, Inventor Durkee, Mr. Lloyd Martin, a vice president of the company that employed non-signing inventor Floyd, and Michael Persson, an attorney handling this matter, accompanied the petition. The petition sets forth the last known address of each inventor. Attorney Persson's declaration explains that joint inventor Floyd received two copies of the application papers, but did not respond to the requests 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(s) refuses to join, or cannot be found or reached after diligent effort,
(2) a proper oath or Declaration executed by the available joint inventor(s),
(3) the fee of $130 as specified in 37 CFR § 1.17(h), and
(4) the last known address of the omitted inventor(s).

This petition lacks items (1) and (2) above.

As to item (1), Applicant has failed to establish that the inventor has refused to join in the filing of this application. The Office requires that a non-signing inventor be presented with the complete application as filed in the Office. The declaration presented along with the application papers to Mr. Floyd was not the declaration filed in Office. The declaration presented to Mr. Floyd only listed him as an inventor. While the declaration referred to Mr. Floyd as the Third Inventor, the other two inventors were not listed. There could be ambiguity with respect to who the other inventors are. The Declaration should set forth all of the joint inventors on the same page or number each page of the declaration, i.e. 1 of 2, 2 of 2, to ensure that each named inventor is aware of the other named inventors of the subject matter. See 37 CFR 1.63.. Mr. Floyd must be presented again with the application papers, including an acceptable declaration.

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 filed with the instant petition does not set forth any of Mr. Floyd's information. The declaration must contain Mr. Floyd's citizenship, residence, and post office address. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of the non-signing inventor or left blank in his signature line 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

JUL 23 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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JUL 18 2001

OFFICE OF PETITIONS
A/C PATENTS

LAWSON, PHILPOT & PERSSON, P.C.
67 WATER STREET, SUITE 110
LACONIA, NH 03246

In re Application of
Sinclair, Durkee & Floyd
Application No.: 09/794,767
Filed: February 26, 2001
Attorney Docket No.: 1421-006
For: HIGH DENSITY DIGITAL SUBSCRIBER LINE SPLITTER

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed June 14, 2001(certificate of mailing date June 11, 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 instant petition listed incorrect identifiers on the first page -- i.e. wrong first named inventor, serial number, filing date, and title of invention. The undersigned assumes that it is an error because the contents of petition pertain to the inventors in the above-identified application. The incorrect identifiers are those of another case that Attorney Persson is handling. Appropriate modifications to the identifiers have been made.

The above-identified application was filed on February 26, 2001 without an executed oath or declaration. Accordingly, on April 11, 2001, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration and a filing fee, and a surcharge for their late filing.

In response, on June 14, 2001 (certificate of mailing June 11, 2001),, a declaration executed by joint inventors Sinclair and Durkee, the surcharge, the application filing fee, the petition fee, and the instant petition were filed. Declaration of facts of Inventor Sinclair, Inventor Durkee, Mr. Lloyd Martin, a vice president of the company that employed non-signing inventor Floyd, and Michael Persson, an attorney handling this matter, accompanied the petition. The petition sets forth the last known address of each inventor. Attorney Persson's declaration explains that joint inventor Floyd received two copies of the application papers, but did not respond to the requests 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(s) refuses to join, or cannot be found or reached after diligent effort,
(2) a proper oath or Declaration executed by the available joint inventor(s),
(3) the fee of $130 as specified in 37 CFR § 1.17(h), and
(4) the last known address of the omitted inventor(s).

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JAN 23 2002

OFFICE OF PETITIONS

This petition lacks items (1) and (2) above.

As to item (1), Applicant has failed to establish that the inventor has refused to join in the filing of this application. The Office requires that a non-signing inventor be presented with the complete application as filed in the Office. The declaration presented along with the application papers to Mr. Floyd was not the declaration filed in Office. The declaration presented to Mr. Floyd only listed him as an inventor. While the declaration referred to Mr. Floyd as the Third Inventor, the other two inventors were not listed. There could be ambiguity with respect to who the other inventors are. The Declaration should set forth all of the joint inventors on the same page or number each page of the declaration, i.e. 1 of 2, 2 of 2, to ensure that each named inventor is aware of the other named inventors of the subject matter. See 37 CFR 1.63.. Mr. Floyd must be presented again with the application papers, including an acceptable declaration.

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 filed with the instant petition does not set forth any of Mr. Floyd's information. The declaration must contain Mr. Floyd's citizenship, residence, and post office address. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 signed by the Rule 1.47 applicants on behalf of the non-signing inventor or left blank in his signature line 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

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WASHINGTON, D.C. 20231
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Paper No. 11

LAWSON, PHILPOT & PERSSON, P.C.
67 WATER STREET, SUITE 110
LACONIA, NH 03246

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OFFICE OF PETITIONS

In re Application of
Sinclair, Durkee & Floyd
Application No.: 09/794,767
Filed: February 26, 2001
Attorney Docket No.: 1421-006
For: HIGH DENSITY DIGITAL SUBSCRIBER LINE SPLITTER

DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the reconsideration petition under 37 CFR 1.47(a), filed January 18, 2002 (certificate of mailing date November 19, 2001).

The petition is granted.

Petitioner has shown that the non-signing inventor has refused to join in the filing of the above-identified application after having been presented with the application papers Specifically, the declaration/statement of facts of Michael J. Perssons, an attorney of record for this application, establishes that the inventor was mailed the application papers, including the specification, claims and drawings, but 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 forwarded to the Office of Initial Patent Examination for issuance of a corrected filing receipt. Thereafter the application will be returned 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
WASHINGTON, D.C. 20231
www.uspto.gov

BENJAMIN FLOYD
223 CROSS MILL ROAD
NORTHFIELD, NH 03276

COPY MAILED

FEB 1 1 2002

OFFICE OF PETITIONS

In re Application of :
Sinclair, Durkee & Floyd :
Application No.: 09/794,767 : LETTER
Filed: February 26, 2001 :
Attorney Docket No.: 1421-006 :
For: HIGH DENSITY DIGITAL SUBSCRIBER LINE SPLITTER

Dear Mr. Floyd:

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.

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).

Telephone inquiries regarding this communication 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

ATTORNEY OF RECORD: LAWSON, PHILPOT & PERSSON, P.C.
67 WATER STREET, SUITE 110
LACONIA, NH 03246

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/794,778	02/27/2001	3629	710	22397.242	2	17	2

CONFIRMATION NO. 2975

27683
HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

CORRECTED FILING RECEIPT

OC000000014201492

Date Mailed: 10/27/2004

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 write to the Office of Initial Patent Examination's Filing Receipt Corrections, facsimile number 703-746-9195. 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)

Akira Ishikawa, Royse City, TX;
Takashi Kanatake, Dallas, TX;

Power of Attorney: The patent practitioners associated with Customer Number **27683**.

Domestic Priority data as claimed by applicant

Foreign Applications

If Required, Foreign Filing License Granted: 04/03/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/794,778

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Business method for a digital photolithography system

Preliminary Class

705

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 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).

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AUG 1 8 2006

OFFICE OF PETITIONS

HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

In re Application of :

ISHILAWA, et al. :
Application No. 09/794,778 : DECISION ON PETITION
Filed: February 27, 2001 : TO WITHDRAW
Attorney Docket No. 22397.242 : 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 19, 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 David M. O'Dell on behalf of all attorneys of record. All attorneys/agents associated have been withdrawn. Applicant is reminded that there is no attorney of record at this time.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

The application became abandoned for failure to timely respond to office action mailed December 20, 2006. Telephone inquiries concerning this decision should be directed to Monica A. Graves at 571-272-7253.

Amelia Au
Petitions Examiner
Office of Petitions

cc: Akira Ishikawa
846 FM 2453
Rose City, TX 75189

cc: Mr. Hisazumi Ono
Ono & Associates
Nippon Shuzo Building
1-21, Nishi-Shimbashi 1-chome
Minato-Ku-Tokyo, Japan 105-0003

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APPLICATION NUMBER	FILING OR 371 (c) DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
09/794,778	02/27/2001	Akira Ishikawa	22397.242

CONFIRMATION NO. 2975

OC000000020087347

27683
HAYNES AND BOONE, LLP
901 MAIN STREET, SUITE 3100
DALLAS, TX 75202

Date Mailed: 08/18/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 04/19/2006.

- The withdrawal as attorney in this application has been accepted. Future correspondence will be mailed to the new address of record. 37 CFR 1.33.

MONICA A GRAVES
OP (571) 272-7253

FORMER ATTORNEY/AGENT COPY

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FROM DIRECTOR'S OFFICE

FEB 20 2007

TECHNOLOGY CENTER 3600

SHELDON & MAK
225 South Lake Avenue,
9th Floor
Pasadena CA 91101

In re Application of: Tony Lai	:	PETITION TO
Application Number: 09/794,815	:	WITHDRAW HOLDING
Filed: February 26, 2001	:	OF ABANDONMENT
For: METHOD AND SYSTEM FOR SECURED	:	UNDER 37 C.F.R.
WEB-BASED ESCROWED TRANSACTIONS	:	1.181(a)

This is a decision on Applicant's Petition under 37 C.F.R. 1.181(a) received on July 18, 2005 to withdraw the holding of abandonment.

The Petition is **GRANTED.**

The record reflects that:

- On August 13, 2002 the Examiner mailed a first non-final Office action.
- On November 19, 2002 Applicant filed a response.
- On January 28, 2003 the Examiner issued a second non-final Office action.
- On July 28, 2003 the Applicant filed an Amendment and Response to Second Office Action.
- On October 6, 2004 the Examiner mailed an Advisory Action.
- On May 20, 2005 the Examiner mailed a Notice of Abandonment. The Notice of Abandonment set forth the reasons for abandonment as "Applicant's failure to timely file a proper reply to the Office letter mailed on 06 October 2004. No reply has been received."

Petitioner argues that the Advisory Action mailed October 6, 2004 is not a proper Office Action in response to the Amendment and Response to Second Office Action filed July 28, 2003.

A review of the file history indicates that the Examiner never made the case final. As a result, the Advisory Action mailed October 6, 2004 was an improper action in

response to Applicant's Amendment and Response to Second Office Action filed July 28, 2003.

Accordingly, Examiner's Notice of Abandonment is also improper and thus Applicant's petition to withdraw the holding of abandonment is granted.

The file is being returned to the Examiner for prompt action on the amendment filed July 28, 2003.

SUMMARY: The Petition is **GRANTED.**

Wynn Coggins, Director
Patent Technology Center 3600
(571) 272 5350

WWC/JAK: 1/4/07

Pet. Dec.

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700

3/14/05
Mailed: _____

MEB
Paper Number: ✓

In re application of :
K.Y. Hwang, et al. : DECISION ON
Serial No. 09/794,835 : PETITION
Filed: February 27, 2001 :
For: Flame Retardant Resin and Flame Retardant
Composition Containing the Same :

This is a response to the PETITION TO WITHDRAW ABANDONMENT, filed December 3, 2003. The petition requests that the abandonment, as set forth in the Notice of Abandonment of November 17, 2003, for failure to timely reply to the office action of March 25, 2003 be withdrawn. The petitioner asserts that the response was timely filed by facsimile on June 23, 2003, with the appropriate Certificate of Transmission.

DECISION

The instant request is accepted as a timely petition under 37 C.F.R. 1.181 (no fee), and is evaluated under the procedures regarding a Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed.

As set forth in MPEP 711.03(c), 37 CFR 1.10(c) through 1.10(e) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 CFR 1.10(c), (d), or (e) (see MPEP § 513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.

Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides prima facie evidence that the reply was timely filed. See MPEP § 503. For example, if the application has been held

abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt. Where a certificate of mailing or transmission under 37 CFR 1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 CFR 1.8(b) and MPEP § 512. As stated in 37 CFR 1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 CFR 1.8).

The petitioner's showing with the response having the appropriate Certificate of Transmission is sufficient. The application will be forwarded to the examiner for processing and consideration of the papers filed June 23, 2003, by facsimile transmission and a copy of which is provided as an attachment to the instant petition.

The Petition is **Granted**.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

John B. Alexander, Ph.D.
EDWARDS & ANGELL, LLP
101 Federal Street
Boston, MA 02110-1800

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 4

TOWNSEND & TOWNSEND & CREW
TWO EMBARCADERO CENTER
8TH FLOOR
SAN FRANCISCO, CA 94111-3834

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NOV 2 0 2001

OFFICE OF PETITIONS

In re Application of :
Brad Hollander : DECISION GRANTING
Application No. 09/794,838 : PETITION
Filed: February 26, 2001 :
Attorney Docket No. 18357-000410US :

This is a decision on the paper styled "Petition For Corrected Filing Receipt" filed on April 2, 2001, which is being treated as a petition under 1.10(c), requesting that the above-identified application be accorded a filing date of February 26, 2001, rather than the presently accorded filing date of February 27, 2001.

Petitioner alleges that the application was deposited in "Express Mail" service with the U.S. Postal Service, on February 26, 2001. In support, petitioners provided a copy of the Express Mail label, receipt no. ET054315630US, showing a Date-In of February 26, 2001. The same Express Mail receipt number was referred to in the original transmittal letter found in the present application. Petitioner requests that the application be accorded a filing date of February 26, 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 February 26, 2001.

The petition is granted.

Office records have been corrected to show the sole inventor as Brad C. Hollander. A copy of the corrected Filing Receipt is enclosed.

The application is being returned to Technology Center AU 1724 for examination in due course.

Telephone inquires 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

Enclosure: Corrected Filing Receipt

UNITED STATES
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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

MAY - 8 2001

#3

FROMMER LAWRENCE & HAUG LLP
745 FIFTH AVENUE
NEW YORK , NY 10151

In re Application of	:	
Michael John Reed et al	:	
Serial No.: 09/794,853	:	PETITION TO MAKE SPECIAL
Filed: February 27, 2001	:	
Attorney Docket No.: CIP-7	:	

This is in response to applicants' petition filed February 27, 2001, to make the above-identified application special under the provisions of 37 CFR 1.102(d).

Applicants are reminded that all petitions must be presented as a separate paper (not as part of the transmittal letter) in order to ensure proper and timely consideration.

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, X. 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, Washington, DC 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230

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

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Alexandria, VA 22313-1450
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BRANDON N. SKLAR
KAYE SCHOLER LLP
425 PARK AVENUE
NEW YORK, NY 10022

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OFFICE OF PETITIONS

In re Application of :
Raymond V. Damadian et al :
Application No. 09/794,858 : ON PETITION
Filed: February 27, 2001 :
Attorney Docket No. 261/002

This is a decision on the petition, filed November 15, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on October 20, 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 Irvin Dingle at (571) 272-3210.

This matter will be forwarded to Technology Center AU 2859 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
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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NXP INTELLECTUAL PROPERTY
DEPARTMENT M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE CA 95131

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SEP 1 8 2008

OFFICE OF PETITIONS

In re Application of :
Jan HOOGERBRUGGE :
Application No. 09/794,943 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. NL 000075 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 9, 2008, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned as a result of petitioner's failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within the time period provided in 37 CFR 41.37(a)(1). As an appeal brief (and appeal brief fee) was not filed within two (2) months of the Notice of Appeal filed February 16, 2007, 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 April 17, 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 an appeal brief, (2) the petition fee of 1540; and (3) the required statement of unintentional delay.

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.

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

This application is being referred to Technology Center 2183 for further processing by the Examiner in the normal course of business.

Thurman Page
Petitions Examiner
Office of Petitions

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First-Named Inventor: HAROLD-BARRY	Docket No.: GB02 0078 US
Application No.: 10/515,943 Conf.: 8128	Art Unit: 2627
Date Filed: 11/23/2004	Examiner: HALEY, JOSEPH R

Title: METHOD AND APPARATUS FOR PROCESSING A DIGITAL DATA STREAM

PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

The above-identified application became abandoned for failure to file a timely and proper reply to a USPTO notice or action dated 02/02/2007.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION.

NOTE: A grantable petition requires: (1) Petition fee; (2) Reply and/or issue fee; (3) Terminal disclaimer w/disclaimer fee (IF filed before 6/8/1995); and (4) Statement that the entire delay was unintentional.

1. PETITION FEE UNDER 37 CFR §1.17(m):

☐ Please charge the petition fee to Deposit Account 50-4019.

2. REPLY AND/OR FEE:

☒ The reply and/or fee to the above-noted Office Action in the form of a Response
- ☐ has been filed previously on _____.
- ☒ is enclosed herewith.

☐ The issue fee
- ☐ has been paid previously on _____.
- ☐ is enclosed herewith.

3. TERMINAL DISCLAIMER WITH DISCLAIMER FEE:

☐ Since this application was filed after June 8, 1995, no terminal disclaimer is required.

☐ A terminal disclaimer and the required disclaimer fee disclaiming the required period of time is enclosed herewith.

[illegible] JC388210 394319 09794943

01 FC:1451 1540.00 DA
02 FC:1492 510.00 DA

4. STATEMENT:

☒ 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.

Date: 12/08/07

Respectfully submitted,

By _____
Michael J. Ure, Reg. No. 33,089

Enclosures:
- ☐ Fee Payment
- ☒ Reply
- ☐ Terminal Disclaimer Form
- ☐ Additional sheets containing statements establishing unintentional delay
- ☐ Other: _____

CERTIFICATE OF MAILING or TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450," or being facsimile transmitted to the USPTO at (571) 273-8300, on the date indicated below.

(Date) _____ (Signature) _____
(Name) Michael J. Ure

Application Number:	09/794,943
Filing or 371 (c) Date:	02-28-2001
Application Type:	Utility
Examiner Name:	LI, AIMEE J
Group Art Unit:	2183
Confirmation Number:	2863
Attorney Docket Number:	NL 000075
Class / Subclass:	712/024
First Named Inventor:	Jan Hoogerbrugge , Eindhoven, (NL)

Title of Invention: Data processor with multi-command instruction words

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

Charge Authorization and Extension of Time Statement

The Commissioner is hereby requested and authorized pursuant to 37 CFR §1.136(a)(3), to treat any concurrent or future reply in this application requiring a petition for extension of time for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. Please charge any additional fees which may now or in the future be required in this application, including extension of time fees, but excluding the issue fee unless explicitly requested to do so, and credit any overpayment, to Deposit Account No. 50-4019.

Respectfully submitted,

/John Rehberg/
John Rehberg, Reg. 29,207

Dated: 1/4/08

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P.O. Box 1450
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KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

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OFFICE OF PETITIONS

In re Application of Keezer et al. :
Application No. 09/794,952 : Decision on Application
Filing Date: February 27, 2001 : For Patent Term Adjustment
Attorney Docket No. ALEXAI.007A :

This is a decision in response to the "Application for Patent Term Adjustment," filed April 11, 2006. The paper requests correction of the patent term adjustment from five hundred seventeen days (517) days to seven hundred thirteen (713) days.

The application for patent term adjustment is **granted to the extent indicated herein.**

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance was **seven hundred twelve (712)** days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 8, 2006, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicants were advised of a patent term adjustment to date of 517 days. In response, applicants timely[1] filed the instant request for reconsideration of the patent term adjustment. Applicants request that the patent term adjustment be corrected to 713 days.

Applicants assert applicants' delay in filing a reply to the June 16, 2004 Office action should not have resulted in a 96 day reduction pursuant to 37 C.F.R. § 1.704(b). Applicants assert the term adjustment should be increased 113 days pursuant to 37 C.F.R. § 1.703(a)(2). Applicants assert applicants' delay in filing a reply to the Notice to File Missing Parts should result in a 13 day reduction pursuant to 37 C.F.R. § 1.704(b).

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The application history has been reviewed and it has been determined that the initial patent term adjustment of 517 days is incorrect.

[1] PALM Records indicate that the petition was filed at the same time as the Issue Fee.

Applicants assert that applicants' delay in filing a reply to the June 16, 2004 Office action should not have resulted in a 96 day reduction pursuant to 37 C.F.R. § 1.704(b). In support, applicants have provided evidence in the form of a stamped postcard receipt[2] demonstrating a reply to the June 16, 2004 Office action was filed on July 19, 2004. An adjustment pursuant to 37 C.F.R. § 1.704(b) is only proper when an applicant takes more than three months to file a reply to an Office action. Since a reply was filed within three months, a reduction of 0 days, rather than 96 days, was proper.

Applicants assert the patent term adjustment should be increased 113 days pursuant to 37 C.F.R. § 1.703(a)(2). 37 C.F.R. § 1.703(a)(2) provides for an adjustment when the Office takes more than four months to respond to a reply under § 1.111, either by mailing an action under 35 USC 132 or a notice of allowance. The Office did not respond to the July 19, 2004 reply until March 11, 2005, when the Office mailed a non-final Office action. Therefore, an adjustment pursuant to 37 C.F.R. § 1.703(a)(2) is proper.

37 C.F.R. § 1.703 states,

> The period of adjustment under § 1.702(a) is the sum of the following periods: ...
> (2) The number of days, if any, in the period beginning on the day after the date that is four months after the date a reply under § 1.111 was filed and ending on the date of mailing of either an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

The time period for an adjustment pursuant to 37 C.F.R. § 1.703(a)(2) starts the day *after* the date four months after the date a reply was filed. In other words, the time period began on November 20, 2004. The time period ended on March 11, 2005, when the non-final Office action was mailed. Therefore, the time period for adjustment pursuant to 37 C.F.R. § 1.703(a)(2) is 112 days rather than the 113 days asserted in the instant request.

Applicants assert applicants' delay in filing a reply to the Notice to File Missing Parts should have resulted in a 13 day reduction pursuant to 37 C.F.R. § 1.704(b). A Notice to File Missing Parts was mailed on October 3, 2001. A reply was filed on January 16, 2002. An adjustment pursuant to 37 C.F.R. § 1.704(b) is proper when an applicant takes more than three months to file a reply to an Office action. Since the reply was not filed on or before January 3, 2002, a term adjustment of 13 days is proper pursuant to 37 C.F.R. § 1.704(b).

Applicants do not disagree with the Office's prior determination that the proper term adjustment pursuant to 37 C.F.R. § 1.703(a)(1) is 678 days. Applicants do not disagree with the Office's prior determination that the paper filed August 15, 2005, in response to the March 11, 2005 Office action, requires a 65 day reduction in patent term pursuant to 37 C.F.R. § 1.704(b).

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[2] Evidence of receipt of any correspondence filed in the Patent and Trademark Office can be obtained by submitting a self addressed post card properly itemizing and identifying the paper or papers being filed. Upon receipt of the correspondence, the Patent and Trademark Office will check the listing on the post card against the papers submitted, making sure that all items listed are present and will then stamp the postcard with an Official date stamp and place the post card in the outgoing mail. "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 items listed thereon by the PTO." M.P.E.P. § 503.

The correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance was 712 (112 - 13 + 678 -65) days .

Submission of the $200.00 fee set forth in 37 CFR 1.18(e) is acknowledged. No additional fee is required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. The patent term adjustment shown on the patent (and in the Issue Notification mailed approximately three weeks prior to issuance) will include any additional patent term accrued pursuant to sections 1.702(a)(4) and 1.703(b).

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised Pair Screen

Day : Friday
Date: 5/26/2006

PALM INTRANET

Time: 17:41:32

PTA Calculations for Application: 09/794952			
Application Filing Date:	02/27/2001	PTO Delay (PTO):	678
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	161
Post-Issue Petitions:	0	Total PTA (days):	712
PTO Delay Adjustment:	195		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
55	05/26/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		13	
54	05/26/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		13	
53	05/26/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	13		
52	05/26/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	96		
51	05/26/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	112		
43	03/08/2006	MAIL NOTICE OF ALLOWANCE			
42	03/06/2006	ISSUE REVISION COMPLETED			
41	03/06/2006	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
40	02/21/2006	NOTICE OF ALLOWABILITY			
39	11/21/2005	INFORMATION DISCLOSURE STATEMENT CONSIDERED			
38	12/07/2005	CORRESPONDENCE ADDRESS CHANGE			
37	12/02/2005	REFERENCE CAPTURE ON IDS			
36	11/21/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED		0	34
35	12/02/2005	DATE FORWARDED TO EXAMINER			
34	11/21/2005	RESPONSE TO ELECTION / RESTRICTION FILED			
33	11/17/2005	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
32	11/10/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
31	10/25/2005	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
30	10/21/2005	MAIL RESTRICTION REQUIREMENT			
29	10/19/2005	REQUIREMENT FOR RESTRICTION / ELECTION			
28	08/19/2005	DATE FORWARDED TO EXAMINER			
27	08/15/2005	RESPONSE AFTER NON-FINAL ACTION		65	23

26	08/15/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
25	08/08/2005	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
24	08/04/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
23	03/11/2005	MAIL NON-FINAL REJECTION			
22	03/07/2005	NON-FINAL REJECTION			
21	01/16/2004	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
20	12/28/2004	DATE FORWARDED TO EXAMINER			
19	12/21/2004	RESPONSE TO ELECTION / RESTRICTION FILED		96	17
18	07/19/2004	WORKFLOW INCOMING AMENDMENT IFW			
17	06/16/2004	MAIL RESTRICTION REQUIREMENT			
16	06/10/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
15	04/05/2004	DATE FORWARDED TO EXAMINER			
14	03/25/2004	RESPONSE TO ELECTION / RESTRICTION FILED			
13	03/05/2004	MAIL RESTRICTION REQUIREMENT	678		-1
12	03/04/2004	REQUIREMENT FOR RESTRICTION / ELECTION			
11	10/07/2003	CASE DOCKETED TO EXAMINER IN GAU			
10	04/23/2002	CASE DOCKETED TO EXAMINER IN GAU			
9	03/22/2002	CHANGE IN POWER OF ATTORNEY (MAY INCLUDE ASSOCIATE POA)			
8	12/06/2001	CASE DOCKETED TO EXAMINER IN GAU			
7	11/07/2001	APPLICATION DISPATCHED FROM OIPE			
6	11/05/2001	APPLICATION IS NOW COMPLETE			
5	10/03/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
4	10/02/2001	CORRESPONDENCE ADDRESS CHANGE			
3	06/27/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	02/27/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	02/27/2001	INITIAL EXAM TEAM NN			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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P.O. Box 1450
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MAY 16 2008

OFFICE OF PETITIONS

WINSTEAD SECHREST & MINICK P.C.
PO BOX 50784
DALLAS TX 75201

In re Application of :
HUBBARD, Edward A. :
Application No. 09/794,969 : DECISION ON PETITION
Filed: February 27, 2001 : TO WITHDRAW
Attorney Docket No. **UNTD:017** : 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 March 31, 2008.

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 reason set forth in the request, termination of client representation, 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 Tredelle Jackson at 571-272- 2783.

Tredelle D. Jackson
Petitions Examiner
Office of Petitions

cc: **UNIVA UD**
9737 GREAT HILLS TRAIL
SUITE 300
AUSTIN, TX 78759

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OFFICE OF PETITIONS

FISH & RICHARDSON P.C.
P.O BOX 1022
MINNEAPOLIS, MN 55440-1022

In re Application of :
HUBBARD, Edward A. :
Application No. 09/794,969 : DECISION ON PETITION
Filed: February 27, 2001 : TO WITHDRAW
Attorney Docket No. **NING0009** : 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 06, 2009.

The request is not approved because it is **moot**.

A review of the file record indicates that the power of attorney to FISH & RICHARDSON P.C. has been revoked by the assignee of the patent application on February 27, 2009. 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 Tredelle Jackson at 571-272-2783.

Tredelle D. Jackson
Paralegal Specialist
Office of Petitions

cc: **SADLER, BREEN, MORASCH & COLBY, PS**
422 W. RIVERSIDE AVE, SUITE 424
SPOKANE WA 99201

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

THOMAS C THOMPSON
92-543 KOKOLE PL
MAKAKILO HI 96707

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DEC 17 2001

OFFICE OF PETITIONS

In re Application of :
Thomas C. Thompson :
Application No. 09/794,998 : DECISION ON PETITION
Filed: February 28, 2001 :
Title: RETROFIT HURRICANE AND :
EARTHQUAKE PROTECTION

This is a decision on the "Amendment on Notice of Omitted Items in Nonprovisional Application", filed June 15, 2001, which is being treated as a Petition Under 37 CFR 1.53, to accord the above-identified application a filing date of February 28, 2001, with page 17 of the specification as a part of the original disclosure.

Application papers in the above-identified application were filed on February 28, 2001. However, on April 12, 2001, the Initial Patent Examination Division mailed applicant a "Notice of Omitted Items in a Nonprovisional Application." Applicant was notified that the application papers had been accorded a filing date; however, page 17 of the specification appeared to have been omitted.

In response, applicant timely filed the instant petition. Petitioner maintains that the application as originally filed included a specification containing page 17. As evidence of receipt in the Office of page 17 of the specification, petitioner submitted a true and correct copy of the returned postcard receipt.

A postcard receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the Office of all items listed thereon on the date stamped thereon by the Office. See MPEP 503. A review of petitioner's postcard receipt reveals that it identifies the items that were filed, including "57 sheets text."

A review of the record reveals that applicant did file 57 sheets of text. However, the application file indicates the presence of two pages denoted as "page 34". The 57 sheets are comprised of pages 1-16, and 18 - 57, with 2 copies of page 34. Accordingly, the application cannot be accorded the filing date of February 28, 2001, with page 17 of the specification as a part of the original disclosure.

Accordingly, the petition is **DISMISSED**.

Page 17, submitted with the instant petition on June 15, 2001, will not be entered or used during the prosecution of this application. However, applicant may resubmit the matter included in Page 17 as an amendment for consideration by the examiner under Section 608.04 of the Manual of Patent Examining Procedure.

Any request for reconsideration of this decision should be filed within **TWO (2) MONTHS** of the date of this decision in order to be considered timely. 37 CFR 1.181(f). This time period may not be extended pursuant to 37 CFR 1.136.

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

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

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

By hand: Office of Petitions
2201 South Clark Place
Crystal Plaza 4, Suite 3C23
Arlington, VA 22202

The application file will be forwarded to the Office of Initial Patent Examination for further processing with a filing date of February 28, 2001, using the pages of specification filed on that date.

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

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DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Thomas C. Thompson
92-543 Kokole Pl.
Makakilo HI 96707

In re Application of :
Thomas C. Thompson :
Application No. 09/794,998 :
Filed: February 28, 2001 :
For: RETROFIT HURRICANE
AND EARTHQUAKE PROTECTION

DECISION ON PETITION
TO WITHDRAW THE
HOLDING OF ABANDONMENT

This is in response to applicant's communication filed in the United States Patent and Trademark Office on June 29, 2003, which will be treated as a petition to withdraw the holding of abandonment.

The petition is **DENIED**.

A review of the file record indicates that an Office Action was mailed to applicant on October 7, 2002 wherein a three-month shortened statutory period for response was set. Since no timely response to the October 7, 2002 Office Action was received and the six-month statutory time period for reply has expired, the application was abandoned and a notice to that effect was mailed on May 1, 2003

Petitioner states that a response was filed on January 7, 2003 via facsimile. The copy of the response submitted with the petition includes a Certificate of Transmission dated January 7, 2003.

MPEP 512 states:

> "(C) When the certification is presented on a separate sheet, that sheet must (1) be signed and (2) fully identify and be securely attached to the paper it accompanies. The required identification should include the application number and filing date of the application as well as the type of paper being filed, e.g., reply to rejection or refusal, Notice of Appeal, etc...
>
> Moreover, without the proper identifying data, a certification presented on a separate sheet will not be considered acceptable if there is any question or doubt concerning the connection between the sheet and the paper filed."

The Certificate of Transmission is contained on a separate sheet and fails to fully identify the paper to which it accompanied. Therefore, the certification is not acceptable since there is no connection between the certification and the paper filed. Further, the Certificate of Transmission is unsigned and is not acceptable for that reason also.

Applicant has also submitted a copy of the Auto-Reply Facsimile Transmission of the paper submitted. However, the Auto-Reply Facsimile Transmission indicates that the paper was submitted to the Patent Office on January 8, 2003 which is one day late. Since the paper did not come with an extension of time nor did it indicate authorization to charge a deposit account the Auto-Reply Facsimile Transmission also is not acceptable as a showing of timely filing.

Applicant's remarks in the petition appear to further confuse the issue since applicant states that applicant's brother is the person who faxed the response. This is in direct contradiction with the Certificate of Transmission with shows applicants named typed, yet as noted above, unsigned.

Since applicant's petition to withdraw the Holding of Abandonment will not be granted applicant may wish to consider filing a petition to revive under 37 CFR 1.137(a) (unavoidable delay) or 37 CFR 1.137(b) (unintentional delay) as discussed below.

I. Unavoidable Delay.

> 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), which may be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; **(2)** the petition fee required by 37 CFR 1.17(l); and **(3)** an adequate showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable.

The showing requirement can be met by submission of statements of fact establishing that the delay in filing the reply was unavoidable. This includes a satisfactory showing that the cause of the delay resulting in failure to reply in a timely fashion to the Office action was unavoidable. Diligence during the time period between abandonment and filing of the petition to revive must also be shown.

As an alternative to filing a petition for unavoidable abandonment, a petition for revival of an application abandoned unintentionally under 37 CFR 1.137(b) might be appropriate.

II. Unintentional Delay.

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 be met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; (**2**) the petition fee required by 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 37 CFR 1.137(b) was unintentional.

The petition fee required by law for filing a petition under unavoidable standard is $110. The fee for a petition under the unintentional standard is $1,300. If applicant has, or can qualify as a "small entity" and does so prior to or together with the payment of the fee, the fee will be one-half of the amount indicated.

If not previously filed, the reply to the outstanding Office action must accompany the petition to revive.

The required items should be promptly submitted under a cover letter entitled "Petition to Revive".

Further correspondence with respect to a petition to revive should be addressed as follows:

By mail: Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By Hand: Crystal Plaza 4, Suite 3C23
2201 South Clark Place
Arlington, VA 22202

Telephone inquiries regarding petitions to revive should be directed to the Office of Petitions Staff at (703) 305-9282.

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."

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868

SNM/ekn: 10/29/03

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 11

THOMAS C. THOMPSON
92-543 KOKOLE PL.
MAKAKILO, HI 96707

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MAY 2 7 2004

OFFICE OF PETITIONS

In re Application of :
Thomas C. Thompson :
Application No. 09/794,998 : ON PETITION
Filed: February 28, 2001 :
For: RETROFIT HURRICANE AND :
EARTHQUAKE PROTECTION :

This is a decision on the petition under 37 CFR 1.137(b), filed December 15, 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 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 January 8, 2003.

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

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

The application file is being forwarded to Technology Center AU 3635.

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
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SEP 19 2005

TECHNOLOGY CENTER 3600

Thomas C. Thompson
92-543 Kokole Pl.
Makakilo, HI 96707

In re Application of Thomas C. Thompson Application No. 09/794,998 Filed: February 28, 2001	: : : :	DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

For: HURRICANE-EARTHQUAKE FRIEZE PLATE

This is a decision on Applicant's renewed petition to withdraw the holding of abandonment, filed in the United States Patent and Trademark Office (USPTO) on July 11, 2005.

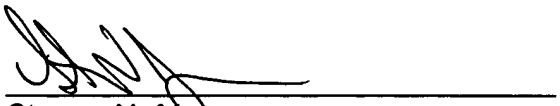
The petition is **GRANTED**.

A review of the file record reveals that a response was filed by applicant on December 9, 2003. The response that the examiner reviewed did not include any amendments to the claims. On September 9, 2004, the examiner mailed a final rejection based on claims previously entered in the file, since no claims were received on December 9, 2003. Applicant responded to the final rejection by sending in another amendment with a complete copy of the claims on November 4, 2004. The examiner responded to this submission by sending an Advisory Action stating the proposed amendment of November 4, 2004 raised new issues after final and would not be entered. As of March 9, 2005, the application was held as abandoned.

Applicant's petition indicates that the response of December 9, 2003 did in fact include amendments to the claims. Petitioner has submitted evidence (stamped post card receipt, exhibit A) that 13 pages were filed in the response of December 9, 2003. The response acted on by the examiner was only 8 pages. Evidently, through a mix-up within the Office, some pages of applicant's response were not made available to be considered by the examiner.

Given that the amended claims were never considered, the final rejection of September 9, 2004 is hereby **VACATED**.

The application is being forwarded to the Supervisory Legal Instruments Examiner with instructions to enter the correct amendment of December 9, 2003, withdraw the holding of abandonment, and return the application to pending status so that it may be forwarded to the examiner of record for an action on the merits.



Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(571) 272-6611

SNM/js: 9/8/05

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20100712

DATE : July 12, 2010

TO SPE OF : ART UNIT 1625

SUBJECT : Request for Certificate of Correction on Patent No.: 6965010

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:

Patentee is attempting to correct the sequence listing. However, the new listing filed contains the following error: there are duplicate opening brackets "<" in the numerical identifier <213> for sequences 968 and 1078. This information is available to applicant in PAIR. In addition, there is no statement as required under 37 CRF 1.821(g) that the COCIN contains no new matter as per 37 CFR 1.825(c).

/Janet L Andres/
Supervisory Patent Examiner.Art Unit 1625

7-13-2010

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

Patent No. : 6,965,010
Applicant : Kari Alitalo, et. al.
Issued : November 15, 2005
Application Number: 09/795,006

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 Rules 1.322 and 1.323.

Patentee is attempting to correct the sequence listing. However, the new listing filed contains the following error: there are duplicate opening brackets "<" in the numerical identifier <213> for sequences 968 and 1078. This information is available to applicant in PAIR. In addition, there is no statement as required under 37 CRF 1.821(g) that the COCIN contains no new matter as per 37 CFR 1.825(c).

Therefore, your request is hereby denied.

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

Eva James
For Mary Diggs
Decisions & Certificates
of Correction Branch
(703) 756-1583 or 1580

Jeanne M. Brashear
Marshall, Gerstein & Borun LLP
233 S. Wasker Drive
6300 Willis tower
Chicago, Illinois 60606-6357

ej

NL 000 111

HALA

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WASHINGTON, D.C. 20231
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Paper No. 11

CORPORATE PATENT COUNSEL
U.S. PHILIPS CORPORATION
580 WHITE PLAINS ROAD
TARRYTOWN, NY 10591-5190

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APR 07 2003

OFFICE OF PETITIONS
ON PETITION

In re Application of
Hack et al.
Application No. 09/795,018
Filed: February 27, 2001
Attorney Docket No. NL000111

This decision concerns the April 1, 2003 petition under 37 CFR 1.10(c), requesting that the above-referenced application be accorded a filing date of February 27, 2001 rather than the presently accorded filing date of February 28, 2001.

The petition is **GRANTED**.

Petitioners request a filing date of February 27, 2001, on the basis that the application was deposited on that day in the U.S. Postal Service (USPS) "Express Mail Post Office to Addressee" service pursuant to the requirements of 37 CFR 1.10.[1] The petition is accompanied by a copy of the "Express Mail" mailing label indicating a February 27, 2001 "date-in" and bearing the number "EL666160888US." The same number also appears on the application transmittal which itemizes the application papers being mailed on that date.[2] Moreover, the Office has verified that the papers mailed under this mailing label number had been deposited in the USPS "Express Mail" on February 27, 2001 at 4:29pm. The petition is thus granted.

No fee is owed. The $130 charge to Deposit Account No. 14-1270 has been reversed.

The application file is being forwarded to the Office of Initial Patent Examination for correction of the filing date to February 27, 2001. Thereafter, the file will be returned to the Office of Patent Publication to await submission of the issue fee.

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

RC Tang
Petitions Attorney
Office of Petitions

---

[1] 37 CFR 1.6(a) (Correspondence received in the USPTO is stamped with the date of receipt except . . . (2) Correspondence filed in accordance with §1.10 will be stamped with the date of deposit as "Express Mail" with the USPS).

[2] MPEP section 513 (Aug. 2001) (When a correspondence mailed by USPS "Express Mail" service includes several papers directed to the same application, it may be submitted with a transmittal which itemizes the papers. Merely placing the "Express Mail" mailing label number in one prominent location on such a transmittal is sufficient.).

RU

Received from < 914 332 0615 > at 4/25/03 9:05:01 AM [Eastern Daylight Time]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	Atty. Docket
MARTINUS JACOBUS JOHANNES HACK ET AL.	NL 000111
Serial No. 09/795,018	Group Art Unit: 1745
Filed: FEBRUARY 28, 2001	Examiner: S.N. TSANG FOSTER

Title: METHOD OF MANUFACTURING A LITHIUM BATTERY

Commissioner for Patents
Washington, D.C. 20231

APR 2 5 2003

OFFICIAL

Petition To Accord Filing Date Under 37 CFR §1.181

Sir:

This Petition is being filed in response to noting, upon review in preparation for payment of the issue fee due by May 13, 2003, (in response to the Notice of Allowance, Exhibit A), that the Patent office incorrectly accorded February 28, 2001, as the filing date of the present application. The correct filing date should be February 27, 2001.

It is respectfully submitted that the present application was filed on February 27, 2001, with a completed Certificate of Mailing with Express Mail Mailing Label No. EL666160888US, as indicated in the filing transmittal form (Exhibit B). Express Mail address label (Exhibit C) also shows a mailing date of February 27, 2001, and lists the attorney docket number, NL 000111, of the present application. Further, the post card receipt (Exhibit D) shows a mailing date of February 27, 2001. It is not clear why the post card receipt is stamped by the Patent Office on February 26, 2001,

Received from < 914 332 0615 > at 4/25/03 9:05:01 AM [Eastern Daylight Time]

one day prior to the mailing, and why the serial number stamp was dated February 28, 2001.

OFFICIAL

Accordingly, since the present application was mailed by Express Mail in compliance with 37 CFR 1.10, Applicants hereby petition to accord a filing date of February 27, 2001, to the above-identified patent application.

Please charge Deposit Account 14-1270 in the amount of $130.00 under §1.17(h), for filing this petition. Further, since the present application is entitled to the filing date of February 27, 2001, Applicants respectfully request a refund of the $130.00 petition fee. Accordingly, please credit charge Deposit Account 14-1270 in the amount of $130.00.

Apr 25 2003

Respectfully submitted,

By _____
Dicran Halajian, Reg. 39,703
Senior Patent Counsel
(914) 333-9607

Enc. Exhibits A-D

CERTIFICATE OF MAILING

It is hereby certified that this correspondence is being deposited with the United States Postal Service as first-class mail in an envelope addressed to:

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

On March 24, 2003
(Date of Mailing)

By Natali A'Mary
(Signature)

Received from < 914 332 0615 > at 4/25/03 9:05:01 AM [Eastern Daylight Time]

EXHIBIT A

Received from < 914 332 0615 > at 4/25/03 9:05:01 AM [Eastern Daylight Time]

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

AUG 2 5 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510

In re Application of:
Sandra Del Corso
Serial No.: 09/795,020
Filed: February 28, 2001
For: **ENCODING METHOD AND DEVICE INCLUDING THRESHOLDING PIXEL-TO-PIXEL DIFFERENCES**

DECISION *SUA SPONTE* WITHDRAWING HOLDING OF ABANDONMENT

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

A Notice of Allowance and Issue Fee(s) Due communication was mailed on July 19, 2004 setting a shortened statutory period of three months for filing the issue fee. No response to the Notice of Allowance and Issue Fee(s) Due was received. A Notice of Abandonment has not been mailed.

A review of the file record indicates that the Notice of Allowance and Issue Fee(s) Due communication was returned to the Office as undeliverable. Thus, there was obviously an irregularity in mailing of the Office action. Seven months later, applicants file a change of address request

Although no petition or request to withdraw the holding of abandonment has been filed, the holding of abandonment is hereby withdrawn. The Notice of Allowance and Issue Fee(s) Due is also hereby vacated.

Since it has been established that applicant had not received the Notice of Allowance, it is also presumed that applicant also did not receive the Notice of Allowability. The application is being forwarded to the Technology Center's technical support staff for preparing and mailing a new Notice of Allowance and Issue Fee(s) Due, including a copy of the Notice of Allowability and restarting the time period for payment of the issue fee.

Applicant is reminded to timely notify the Office of any correspondence change in order to avoid any future prosecution delays.

Dwayne Bost
Special Programs Examiner
Technology Center 2600
Communications

#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
09/795,037	02/26/2001	Markus Kurz	50036/044002

CONFIRMATION NO. 4339

21559
CLARK & ELBING LLP
176 FEDERAL STREET
BOSTON, MA 02110-2214

OIPE
MAY 29 2001
PATENT & TRADEMARK OFFICE

FORMALITIES LETTER

OC000000005984536

Date Mailed: 04/19/2001

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given **TWO MONTHS** from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The oath or declaration is unsigned.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of $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 $ 65.**

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

05/31/2001 ETULU1 00000014 09795037
01 FC:205 65.00 OP

H-A- Sectors #3

OIPE JC62
MAY 2 9 2001
PATENT & TRADEMARK OFFICE

PATENT
ATTORNEY DOCKET NUMBER: 50036/044002

Certificate of Mailing: Date of Deposit: May 24, 2001

I hereby certify under 37 C.F.R. § 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 above and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Colleen Coyne
Printed name of person mailing correspondence

Colleen Coyne
Signature of person mailing correspondence

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Markus Kurz et al.	Art Unit:	1651
Serial No.:	09/795,037	Examiner:	
Filed:	February 26, 2001	Customer No.:	21559

Title: IMPROVED METHODS FOR GENERATING CATALYTIC PROTEINS

Assistant Commissioner for Patents
Washington, D.C. 20231

REPLY TO NOTICE TO FILE MISSING PARTS

In reply to the Notice to File Missing Parts of Application mailed April 19, 2001 (a copy of which is enclosed), Applicants as a small entity submit herewith the following:

- A Combined Declaration and Power of Attorney in compliance with 37 C.F.R. § 1.63.

- Payment of the surcharge of $65.00 for late filing of the basic filing fee/declaration.

If there are any charges, or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 24 May 2001

Karen L. Elbing, Ph.D.
Reg. No. 35,238

Clark & Elbing LLP
176 Federal Street
Boston, MA 02110
Telephone: 617-428-0200
Facsimile: 617-428-7045

21559
PATENT TRADEMARK OFFICE

\\Clark-w2k1\documents\50036\50036.044002 Reply to Notice to File Missing Parts.wpd

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

SUTHERLAND ASBILL & BRENNAN LLP
999 PEACHTREE STREET, N.E.
ATLANTA, GA 30309

Mail Date: 04/21/2010

Applicant	: Timothy L. O'Mara	: DECISION ON REQUEST FOR
Patent Number	: 7620592	: RECALCULATION of PATENT
Issue Date	: 11/17/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/795,050	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 02/26/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2503** 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.

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)
6,725,080	2004-04-20	09/795,126	2001-03-01	5074A-000010/US

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

SMALL ENTITY

☐ Patentee claims, or has previously claimed, small entity status. See 37 CFR 1.27.

LOSS OF ENTITLEMENT TO SMALL ENTITY STATUS

☐ Patentee is no longer entitled to small entity status. See 37 CFR 1.27(g)

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

SURCHARGE

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

MAINTENANCE FEE (37 CFR 1.20(e)-(g))

The appropriate maintenance fee must be submitted with this petition.

STATEMENT

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

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	/Richard W. Warner/	Date (YYYY-MM-DD)	2008-07-08
Name	Richard W. Warner	Registration Number	38043

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. 6725080
Issue Date: April 20,2004
Application No. 09795126
Filed: March 1,2001
Attorney Docket No. 5074A-000010

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

This is a decision on the electronic petition, filed July 8,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 8,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

20 MAY 2002

C. Scott Talbot
Cooley Godward LLP
Attention: Patent Group
One Freedom Square, Reston Town Center
11951 Freedom Drive
Reston, VA 20190-5601

In re Application of:
Sherry NEUMAN
Application No. 09/795,135
Filed: March 1, 2001
For: SYSTEM AND METHOD FOR CONDUCTING DRUG USE EVALUATION

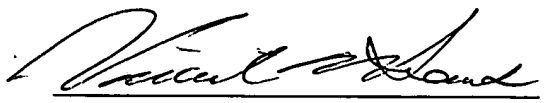
DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed January 11, 2002.

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

The request filed January 11, 2002 meets all the requirements. Accordingly the request is **GRANTED**.

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



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

cc: Marc Sockol, Esq.
SQUIRE, SANDERS & DEMPSEY L.L.P.
600 Hansen Way
Palo Alto, California 94304-1043

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. 100703

NAIPO (NORTH AMERICA INTERNATIONAL PATENT OFFICE)
P.O. Box 506
Merrifield, VA 22116

OCT - 9

In re Application of:	:	
Bing-Chang Wu	:	
Serial No.: 09/795,143	:	DECISION ON REQUEST TO WITHDRAW
Filed: March 01, 2001	:	FROM RECORD
Attorney Docket No.: **NAUP0321USA0**	:	

This is a decision on the request to withdraw as attorney of record under 37 C.F.R. § 1.36, filed August 18, 2003.

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 Mord Michael Lewis on behalf of himself.

The request is **APPROVED**.

Winston Hsu remains as attorney of record at this time. It is noted that the application is now abandoned.

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

Inquiries related to this decision should be directed to Clayton E. LaBalle at (703) 308-0519.

Clayton E. LaBalle, Special Programs Examiner
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

CHARLES J. COOK
6710 SOUTH LACIENEGA BOULEVARD #3
INGLEWOOD, CA 90302

COPY MAILED

APR 2 2 2004

OFFICE OF PETITIONS

In re Application of
Cook, Charles J.
Application No. 09/795,183
Filed: March 1, 2001
Title: Thermal Smoother And Comb

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 13, 2004, to revive the above-identified application.

The petition is **DISMISSED**.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. No further petition fee is required for the request. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

This application became abandoned for failure to timely reply to the non-final Office action mailed August 15, 2001. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on November 16, 2001. A Notice of Abandonment was mailed March 26, 2002.

A grantable petition under 37 CFR 1.137(b) must be accompanied by:
(1) the required reply,[1]
(2) the petition fee,
(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional, and
(4) a terminal disclaimer and fee if the application was filed on or before June 8, 1995 or if the application is a design application.

Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information.[2]

---

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

[2] See MPEP 711.03(c)(III)(C) and (D).

The instant petition lacks item (2). Petitioner failed to include payment of the small entity petition fee of $665.00. To revive the above-identified application, petitioner must submit the appropriate funds.

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

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

Effective December 1, 2003, the Office of Petitions can no longer receive hand-carried correspondence, or facsimile transmissions of correspondence. The centralized location for hand-carried correspondence is the existing Customer Window located at:

2011 South Clark Place
Crystal Plaza 1 Lobby
Room 1B03
Arlington, VA 22202

The centralized facsimile number is **(703) 872-9306.**

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

Charles J. Cook
6710 South LaCienega Boulevard #3
Inglewood, CA 90302

COPY MAILED

MAY 2 1 2004

OFFICE OF PETITIONS

In re Application of :
Charles J. Cook :
Application No. 09/795,183 :
Filed: March 1, 2001 :
Title of Invention: THERMAL :
SMOOTHER AND COMB :

CORRECTED
DECISION
ON PETITION

This is a corrected decision in response to the petition under 37 CFR 1.137(b), filed April 13, 2004, to revive the above-identified application.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed August 15, 2001. The Office action set a three (3) month period for reply, and provided for extensions of time under 37 CFR 1.136(a). No reply having been received, the application became abandoned on November 16, 2001. A Notice of Abandonment was mailed on March 26, 2002.

A Decision on Petition, mailed April 22, 2004, dismissed the petition alleging Applicant failed to include the petition fee with the petition. However, Applicant notified this Office via telephone that the fee had been included and a search of the correspondence envelope revealed that applicant was correct, the petition fee in the form of a check was found among the papers filed on April 13, 2004.

The Decision, mailed April 22, 2004, is hereby VACATED.

With the instant petition, Petitioner has satisfied the requirements of a grantable petition under 37 CFR 1.137(b). An Amendment in response to the August 15, 2001 Office action was filed with the instant petition on April 13, 2004.

Accordingly, the petition is **granted**.

This application is being forwarded to Technology Center Art Unit 3732 for processing of the Amendment, filed April 13, 2004, in due course.

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

Derek L. Woods
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

Mailed: MAY 10 2004

wak
Paper Number _____

In re application of	:	
Kasturi et al.	:	DECISION ON
Serial No. 09/795,211	:	PETITION
Filed: February 28, 2001	:	
For: LIQUID DETERGENT COMPOSITION EXHIBITING ENHANCED AMYLASE ENZYME STABILITY	:	

This is a decision on the petition filed on December 18, 2003. The petition requests that the period for reply to the Examiner's Answer dated October 3, 2003 be restarted.

DECISION

The instant PETITION is accepted as a petition under 37 CFR 1.181(no fee).

A review of the application record and the petitioner's evidence indicates that the request has merit and is sufficient to establish that the Examiner's Answer of October 3, 2003 was not received timely. The evidence provided includes a copy of the facsimile cover sheet and a declaration by a docket clerk.

The petition is **GRANTED**.

The period for responding to the Examiner's Answer will be restarted from the date of the new mailing.

JMStone

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

Kevin Waugh
The Proctor & Gamble Company
Winton Hill Business Center, Box 161
Fem Care Building
5110 Center Hill Blvd
Cincinnati, Ohio 45202

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.
09/795,211	02/28/2001	Chandrika Kasturi	8437	4679

27752 7590 05/10/2004

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

EXAMINER	
KUMAR, PREETI	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 05/10/2004

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.gov

wak
Paper Number _____

Mailed: MAY 10 2004

In re application of	:	
Kasturi et al.	:	DECISION ON
Serial No. 09/795,211	:	PETITION
Filed: February 28, 2001	:	
For: LIQUID DETERGENT COMPOSITION EXHIBITING ENHANCED AMYLASE ENZYME STABILITY	:	

This is a decision on the petition filed on December 18, 2003. The petition requests that the period for reply to the Examiner's Answer dated October 3, 2003 be restarted.

DECISION

The instant PETITION is accepted as a petition under 37 CFR 1.181(no fee).

A review of the application record and the petitioner's evidence indicates that the request has merit and is sufficient to establish that the Examiner's Answer of October 3, 2003 was not received timely. The evidence provided includes a copy of the facsimile cover sheet and a declaration by a docket clerk.

The petition is **GRANTED**.

The period for responding to the Examiner's Answer will be restarted from the date of the new mailing.

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

Kevin Waugh
The Proctor & Gamble Company
Winton Hill Business Center, Box 161
Fem Care Building
5110 Center Hill Blvd
Cincinnati, Ohio 45202

UNITED STATES PATENT AND TRADEMARK OFFICE

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WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI OH 45224

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AUG 25 2005

OFFICE OF PETITIONS

In re Application of
KATSURI et al.
Application No. 09/795,211
Filed: February 28, 2001
Attorney Docket No. 4679

DECISION
ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed August 2, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely file an appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action in accordance with 37 CFR 1.197 from a Decision on Appeal before the Board of Appeals and Interferences mailed May 20, 2005. Pursuant to 37 CFR 1.304, the period to appeal is two (2) months from the date of the decision of the Board of Patent Appeals and Interferences. Accordingly, the application became abandoned on July 21, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137 (b) in that (1) the reply in the form of the filing of a continuation application after the Decision on Appeal; (2) the petition fee of $1500; and (3) an adequate statement of unintentional delay have been received. Accordingly, the filing of the continuation application is accepted as having been unintentionally delayed.

The above-identified application is being construed as being revived solely for purposes of continuity and as a request to expressly abandon the application upon revival. As continuity has been established by this decision reviving the above-identified application, the above-identified application is again abandoned in favor of the continuation application U.S. Serial No. 11/195,538. Petitioner must notify the Office if this is **not** a correct interpretation.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the instant petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent must be submitted. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed to the address of currently of record until such time as appropriate instructions are received to the contrary.

Telephone inquiries concerning this decision should be directed to Denise Pothier at (571) 272-4787.

The application matter is being forwarded to Files Repository.

Brian Hearn, for

Frances Hicks
Petitions Examiner
Office of Petitions

cc: Clare Iery
Dinsmore & Shohl LLP
1900 Chemed Center
255 East Fifth Street
Cincinnati, OH 45202

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
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MICHAEL B. FEIN
COZEN AND O'CONNOR
1900 MARKET STREET
PHILADELPHIA, PA 19103

COPY MAILED

AUG 1 3 2001

OFFICE OF PETITIONS

In re Application of :
Edmund J. Walters, et al : DECISION DISMISSING
Application No. 09/795,219 : PETITION
Filed: February 27, 2001 :
Attorney Docket No. 103591 :

This is a decision on the petition filed April 30, 2001, requesting review of a determination that drawings containing Figures 1 and 2 were omitted on February 27, 2001, the filing date of the application.

The application was filed on February 27, 2001. However, on April 4, 2001, Initial Patent Examining Division mailed a notice advising petitioners that drawings of Figures 1 and 2 described in the specification appeared to have been omitted.

In response, on April 30, 2001, the present petition was filed. Petitioners argue that drawings of Figures 1 and 2 were filed on February 27, 2001. In support, the petition is accompanied by a copy of the application as contained in counsel's files and a copy of petitioners' postcard receipt.

The evidence presented has been carefully considered, but is not persuasive that drawings of Figures 1 and 2 were filed on February 27, 2001.

The USPTO file is the official record of the papers actually received or filed, on February 27, 2001. The official file contains nine (9) sheets of drawings containing Figures 3-13. No drawings of Figures 1 and 2 are present in the file other than the copies presented with the petition.

The Office has a well established and well publicized practice of providing a receipt for papers filed in the Office to any applicant desiring a receipt. The practice requires that any paper for which a receipt is desired be filed in the Office with a

self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the Office of all the items listed thereon on the date stamped thereon by the Office. See MPEP 503. Petitioners' return postcard does not show an "Office Date" stamp thereon. Therefore, it is not sufficient evidence to establish to the satisfaction of the Commissioner that drawing Figures 1 and 2 were filed on February 27, 2001. Even if an Office date stamp were present, petitioners' postcard would not be sufficient evidence, because the postcard fails to identify the number of sheets of drawings contained in the application which was filed.

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 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

The application is being returned to Initial Patent Examination for further processing with a filing date of February 27, 2001, using the nine (9) sheets of drawings filed on that date.

Telephone inquiries concerning this matter may be directed to Karen Creasy at (703) 305-8859.

M. A. Antonakas

Manuel A. Antonakas, Director
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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ROBERTS ABOKHAIR & MARDULA, LLC
SUITE 1000
11800 SUNRISE VALLEY DRIVE
RESTON, VA 20191

COPY MAILED

JUN 10 2005

OFFICE OF PETITIONS

In re application of :
Paul A. Kline, et al. :
Application No. 09/795,225 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. 2171-011 :

This is a decision on the petition, filed October 18, 2004, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the assignee's name on Issue Fee Transmittal Form PTOL-85(b) so that the Letters Patent will issue to the assignee.

The request is **dismissed**.

Petitioner states that the correct assignee's name is PCTel Maryland, Inc. and that an incorrect assignee's name was unintentionally included on Fee Transmittal Form PTOL-85(b) at the time of payment of the issue fee. Accordingly, petitioner herein requests that the patent issue to PCTel Maryland, Inc.

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

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

[1] *See* Official Gazette of June 22, 2004

The instant request under 37 CFR 3.81(b) was not accompanied by a request for a certificate of correction (and fee) as required by 3.81(b). As petitioner has failed to comply with the provisions of 37 CFR 3.81(a), the request cannot be granted.

A review of Office database assignment records reflects that an assignment to PCTel Maryland, Inc. has been recorded. Therefore, upon submission of the required certificate of correction and fee, it would be appropriate for the Office to issue a certificate of correction to correct the front page of the Letters Patent to reflect that PCTel Maryland, Inc. was the assignee of record at the time of issuance of the instant application into a patent. *Note also* 35 U.S.C. § 152.

In view of the above and **after issuance of the instant application into a patent, the Certificates of Correction Branch is instructed to issue a certificate of correction upon submission by petitioner of a request for a certificate of correction (and fee) which sets forth PCTel Maryland, Inc., as the assignee**. *No certificate of correction will be issued which sets forth an assignee other than the assignee set forth in the instant request. A copy of this decision **must** accompany the request for a Certificate of Correction.*

No further renewed request under 37 CFR 3.81(b) is necessary for consideration by the Office of Petitions for issuance of a certificate of correction in the name of the assignee set forth in the instant request, as this decision operates as an instruction to the Certificates of Correction Branch to issue the requested certificate of correction.

Alternatively, if petitioner desires to have the correct assignee data appear on the front page of the Letters Patent, petitioner may wish to consider filing a petition to withdraw the subject application from issue under 37 CFR 1.313(c)(2). The petition to withdraw from issue under 37 CFR 1.313(c)(2) must be accompanied by a request for continued examination (RCE) and submission (which may be a request under 37 CFR 3.81(b)).

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3204. After the submission by petitioner of the request for a certificate of correction to correct the assignee data on the front page of the Letters Patent, any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

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
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Alexandria, VA 22313-1450
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Paper No. 7

BEYER WEAVER & THOMAS
P.O. BOX 778
BERKELEY, CA 94704-0778

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SEP 26 2003

OFFICE OF PETITIONS

In re Application of :
Ali M. Saffari et al :
Application No. 09/795,337 : DECISION ON PETITION
Filed: February 27, 2001 : UNDER 37 CFR 1.137(b)
Attorney Docket No. IGT1P044/P-401 :

This is a decision on the petition, filed August 22, 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 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 filed within TWO MONTHS from the mail date of this decision. Extensions of time are available pursuant to the provisions of 37 CFR 1.136(a).

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 petition fails to comply with item (1) above. More specifically, while notification has been given of the foreign filing, the petition fails to state the date of such foreign filing. Accordingly, the date of foreign filing must be supplied before the Office can make a decision on the appropriateness of the instant petition to revive.

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

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

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

By Fax: (703) 308-6916
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Wan Laymon at (703) 306-5685.

for
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
WWW.USPTO.GOV

Paper No. 10

BEYER WEAVER & THOMAS
P O BOX 778
BERKELEY,CA 94704-0778

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NOV 12 2003

OFFICE OF PETITIONS

In re Application of :
Ali M. Saffari et al :
Application No. 09/795,337 : DECISION ON PETITION
Filed: February 27, 2001 : UNDER 37 CFR 1.137(b)
Atty Dkt No. IGT1P044/P-401 :

This is in response to the communication filed October 14, 2003, which is being treated as a renewed petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark Office (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is dismissed as **MOOT**.

Petitioner states that the instant nonprovisional application became the subject of a counterpart application filed in an eighteen-month country on February 25, 2002. A review of the file record discloses that a notice to rescind and notification of foreign filing was received in the USPTO on March 22, 2002 (certificate of mailing date of February 25, 2002), which mail room date is within forty-five (45) days of filing of the counterpart application.

In the instant application, although the notice to rescind was received in the USPTO after the filing date of the counterpart application, the request to rescind also contained notification of foreign filing. Where a nonpublication request was not rescinded before or on the date of the filing of a counterpart application in an eighteen-month publication country, a notice of foreign filing is required to be filed in the USPTO not later than forty-five days after the date the counterpart application was filed to avoid abandonment of the application. Therefore, as a request to rescind and notification of foreign filing was filed

not later than forty-five (45) days after the date such counterpart application was filed (35 U.S.C. § 122(b)(2)(B)(iii), the application is not be regarded as abandoned. *See* Clarification of the United States Patent and Trademark Office's Interpretation of the Provisions of 35 U.S.C. 122(b)(2))(B)(ii)-(iv), 1272 OG 1 (July 1, 2003), available at http://www.uspto.gov/web/patents/patog/week26/. 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 $1,300 is being credited to Deposit Account No. 50-0388 in due course. as authorized.

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 February 19, 2004 has been mailed under separate cover.

This application is being forwarded to Technology Center AU 3713 for examination in due course.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/795,344	02/27/2001	Simon Dodd	10992893-1	6249

7590 01/23/2004

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER	
STEPHENS, JUANITA DIONNE	
ART UNIT	PAPER NUMBER
2853	

DATE MAILED: 01/23/2004

8

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

JAN 21 2004

In re Application of: Dodd
Application No.: 09/795,344
Filed: February 27, 2110
Attorney Docket No.: 10992893-1

NOTICE OF WITHDRAWAL
FROM ISSUE
UNDER 37 CFR § 1.313

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 above-identified application is hereby withdrawn from issue. The Notice of Allowance and Issue Fee Due and the Notice of Allowability mailed November 4, 2003, are hereby vacated.

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

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.

Telephone inquires should be directed to John Barlow at (703) 308-3126.

The above-identified application is being forwarded to the examiner for prompt appropriate action.

Howard Goldberg, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : March 1, 2010

TO SPE OF : ART UNIT 2853

SUBJECT : Request for Certificate of Correction for Appl. No.: 09795344 Patent No.: 6974205

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 – 9D40-C
Palm Location 7580

_____
Certificates of Correction Branch

703-756-1573

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

STEPHEN MEIER
SUPERVISORY PATENT EXAMINER

SPE 2853 **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS TX 75265

COPY MAILED
MAY 19 2006
OFFICE OF PETITIONS

In re Application :
Morgan, et al. :
Application No. 09/795,402 : ON PETITION
Filed: February 26, 2001 :
Attorney Docket No. TI-30658 :
For: SPATIAL-TEMPORAL MULTIPLEXING

This is a decision on the petition under 37 CFR 1.182, filed May 9, 2006, to correct the name of the second listed joint inventor.

The petition is **GRANTED**.

The second named inventor will be changed from "JEFFREY KEMPF" to "JEFFREY M. KEMPF". A replacement filing receipt reflecting this change is enclosed.

The file is being returned to Publications Division for processing into a patent.

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

enclosure: replacement 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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APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/795,402	02/26/2001	2629	1300	TI-30658	5	5	5

CONFIRMATION NO. 4854

023494
TEXAS INSTRUMENTS INCORPORATED
P O BOX 655474, M/S 3999
DALLAS, TX 75265

REPLACEMENT FILING RECEIPT

OC000000018842057

Date Mailed: 05/18/2006

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)

Daniel J. Morgan, Denton, TX;
Jeffrey M. Kempf, Plano, TX;

Power of Attorney: The patent practitioners associated with Customer Number **023494**.

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/184,949 02/25/2000

Foreign Applications **Acceptable Request to Retrieve Priority Application Received?**

If Required, Foreign Filing License Granted: 03/22/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/795,402

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

SPATIAL - TEMPORAL MULTIPLEXING

Preliminary Class

345

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).

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WEISS & WEISS
SUITE 251
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MINEOLA, NY 11501

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FEB 0 3 2006

OFFICE OF PETITIONS

In re Application of :
Roger P. Hoffman :
Application No. 09/795,427 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. P/2-91 :

This is a decision on the petition, filed October 27, 2005, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed January 18, 2005, which set a shortened statutory period for reply of three (3) months. A Notice of Abandonment was mailed on August 11, 2005. In response, on October 27, 2005, the present petition was filed.

The petition is found to comply with the requirements of 37 CFR 1.137(b).

The file is being referred to Technology Center Art Unit 3623 for consideration of the amendment filed October 27, 2005.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3204. All other inquiries regarding this application should be directed to the Technology Center.

Sherry D. Brinkley

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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CHADBOURNE & PARKE LLP
30 ROCKEFELER PLAZA
NEW YORK, NY 10112

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FEB 07 2007

OFFICE OF PETITIONS

In re Application of :
Mark Higgins :
Application No. 09/795,428 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. 17209-004 :

This is a decision on the petition, filed July 10, 2006, under 37 CFR 1.137(b) to revive the above-identified application.

The petition is **DISMISSED**.

A grantable petition under 37 CFR 1.137(b)[1] must be accompanied by: (1) the required reply,[2] unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lacks item 1.

It is noted that an amendment was included with the petition filed on July 10, 2006. However, the amendment is considered non-responsive, since it did not place the application in condition for allowance. See the attached Advisory Action. The proposed reply required for consideration of a petition to revive this application must be a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)), an amendment that *prima facie* places the application in condition for allowance, or the filing of a submission under 37 CFR 114 (RCE) or a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2).

This decision is made without prejudice to reconsideration. However, 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)" and the required reply as noted above.

---

[1] As amended effective December 1, 1997. See Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53194-95 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 119-20 (October 21, 1997).

[2] In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

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

Attachment: Advisory Action

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/795,428	**Applicant(s)** HIGGINS, MARK	
	Examiner Daniel Felten	**Art Unit** 3693	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 July 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
    Applicant arguments have been considered and are not persuasive. Applicant asserts that the Examiner's interpretation of basket option as a portfolio is incorrect. Applicant argue that Anderson teaches portfolios as providing diversification and whereas "some embodiments of basket options may have baskets containing only securities that are high correlated." Examiner respectfully disagrees with Applicant. The Examiner is charged with giving claim terms their broadest reasonable interpretation. Further, Applicant's own admission that basket options "may" be correlated suggests that they may not be. At the same time, just because some portfolios provide diversification doesn't mean, under the broadest reasonable interpretation, that all portfolios are diverse. Barron's Dictionary of Finance and Investment Terms defines portfolio as "combined holding of more than one stock, bond, commodity, real estate investment, cash equivalent, or other asset by an individual or institutional investor. Based on the broadest reasonable interpretation, a basket option is a portfolio .
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-303 (Rev. 08-06) Advisory Action Before the Filing of an Appeal Brief Part of Paper No. 20070206

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NEW YORK, NY 10112

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OFFICE OF PETITIONS

In re Application of :
Mark Higgins :
Application No. 09/795,428 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. 17209-004 :

This is a decision on the communication filed March 6, 2007, which is being treated as a renewed petition to revive the above-identified application under 37 CFR 1.137(b).

The petition is **GRANTED**.

The two-month period for filing an appeal brief under 37 CFR 41.37 (accompanied by the fee required by 37 CFR 41.20(b)(2)), runs from the date of this decision.

This application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of September 26, 2005. A Notice of Abandonment was mailed on April 4, 2006. In response, on July 10, 2006 a petition to revive was filed. The petition was dismissed in a decision mailed February 7, 2007, since the amendment did not place the application in condition for allowance. On March 6, 2007, the present petition was filed.

The petition now complies with the requirements of 37 CFR 1.137(b) in that petitioner has submitted (1) the required reply in the form of a Notice of Appeal and appeal fee; (2) the requisite petition fee; and (3) an adequate statement of unintentional delay.

This application is being referred to Technology Center AU 3624 to await the filing of an appeal brief or for such other appropriate reply as may be submitted to continue prosecution of the application.

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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James J. Kulbaski
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
1940 Duke Street
Alexandria, VA 22314

MAIL

JUL 1 3 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:
Shogo HYAKUTAKE, et al
Appl. No.: 09/795,438
Filed: March 1, 2001
For: SYSTEM, COMPUTER PROGRAM PRODUCT AND METHOD FOR MANAGING DOCUMENTS

DECISION ON PETITION
UNDER 37 CFR § 1.59

This is a decision on the petition under 37 CFR § 1.59(b), filed May 10, 2005 to expunge the Information Disclosure Statement submitted on March 25, 2005.

The petition is **GRANTED**.

Petitioner requests that any information contained in the Information Disclosure Statement (IDS) filed on March 25, 2005 be expunged from the record. Petitioner states that applicants are uncertain about the certification status of the references listed therein and that failure to obtain the IDS of March 25, 2005 would cause irreparable harm to applicants. The petition fee set forth in 37 CFR § 1.17(h) has been paid.

Applicant is required to retain the expunged material(s) for the life of any patent which issues on the above-identified application.

The expunged material has been closed from public view and will not be returned to applicant.

It is noted that the instant application has been published on October 28, 2004. Thus, the IDS filed March 25, 2005 has already been made available to the public and subject to copying by the public. According, the Office cannot guarantee that the information being closed as a result of this decision were not previously accessed by the public.

Any inquiry concerning this decision should be directed to the undersigned whose telephone number is (571) 272-3613.

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

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Commissioner for Patents
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WASHINGTON DC 20006

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OFFICE OF PETITIONS

In re Application of	:	
Masaki Nose et al	:	
Application No. 09/795,449	:	ON PETITION
Filed: March 1, 2001	:	
Attorney Docket No. 010150	:	

This is a decision on the petition, filed July 11, 2006, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on June 6, 2006, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2625 will consider the request for continued examination under 37 CFR 1.114.

Karen Creasy
Petitions Examiner
Office of Petitions

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No. _____

Date : July 12, 2006

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

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JUL 11 2006
OFFICE OF PETITIONS

SUBJECT : Withdrawal from Issue of

Applicant(s) :Masaki Nose et al
Application No. :09/795,449
Filed :March 1, 2001

The above-identified application has been assigned Patent No. 7,079,288 and an issue date of July 18, 2006.

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

Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of July 18, 2006:

> "All reference to Patent No. 7,079,288 to Masaki Nose et al of Japan for IMAGE PROCESSING METHOD, AND IMAGE PROCESSOR AND STORAGE MEDIUM THEREOF appearing in the Official Gazette of July 18, 2006 should be deleted since no patent was granted."

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

cc: Paul Harrison, MDW-4B03,(FAX-273-5468)
Deneise Boyd, MDE-3D39 (FAX-273-5124)
Mary Louise McAskill, ST-8C15 (FAX 305-4372)
Niomi Farmer, ST-8C14 (FAX-305-4372)
Mary E. Johnson (Cookie), MDE-7C71 (FAX 273-0038
Duane Davis P/OPC MDE-7D89

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Paper No. 10

Timothy R. DeWitt
ARNOLD & PORTER
555 Twelfth Street, N.W.
Washington, DC 20004

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MAY 2 8 2003

OFFICE OF PETITIONS

In re Application of :
Luc Jean Langouet, et al. :
Application No. 09/795,453 :
Filed: March 1, 2001 :
Attorney Docket No. 14737.004 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed May 12, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action August 23, 2002, which set a shortened statutory period for reply of three(3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on November 24, 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 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 1700, Art Unit 1732.

Cheryl Gibson-Baylor
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Sherry D. Brinkley
Petitions Examiner

cc: Timothy R. DeWitt
Shanks & Herbert
TransPotomac Plaza
1033 N. Fairfax Street, Suite 100
Alexandria, VA 22314

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DEWITT ROGGIN PLLC
12 E. LAKE DRIVE
ANNAPOLIS, MD 21403

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OFFICE OF PETITIONS

In re Application of :
Luc Jean Langouet et al :
Application No. 09/795,453 : ON PETITION
Filed: March 1, 2001 :
Attorney Docket No. 14737.004 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 28, 2004, to revive the above-identified application.

The petition is **DISMISSED.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is not final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(c). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Commissioner may require additional information. See MPEP 711.03(c)(III)(C) and (D). The instant petition lack(s) item(s) one (1).

The issue fee has been received. However, the corrected formal drawing as required by the Notice of Allowability mailed November 24, 2003, was objected to by the Draftsperson under 37 CFR 1.84 or 1.52. This application cannot be revived until an acceptable drawing of Figure 1 has been submitted. For applicant's convenience, a copy of the notice of draftsperson's patent drawing review dated December 13, 2004 is enclosed.

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

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

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

By hand: U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

By facsimile: (703) 872-9306
ATTN: Office of Petitions

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

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

cc:

Timothy R. DeWitt
DeWitt Roggin, PLLC
1455 Pennsylvania Ave., NW, Suite 100
Washington, DC 20004

Attachment: Notice of Draftsperson's Patent Drawing Review, December 13, 2004.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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P.O. Box 1450
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DEWITT ROGGIN PLLC
12 E. LAKE DR.
ANNAPOLIS, MD 21403

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FEB 03 2005

OFFICE OF PETITIONS

In re Application of :
Luc Jean Langouet et al :
Application No. 09/795,453 : ON PETITION
Filed: March 1, 2001 :
Attorney Docket No. 14737.004 :

This is a decision on the renewed petition under 37 CFR 1.137(b), filed January 12, 2005, to revive the above-identified application.

The petition is **GRANTED**.

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

This matter is being forwarded to the Publishing Division to be reviewed by the drawing draftperson.

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

#18

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DEC 17 2004

In re Patent No. 6,528,175 B2, GRANTHAM ET AL.
Issue Date: March 04, 2003
Appl No.: 09/795,559
Filed: February 28, 2001
For: CORRECTION OF INVENTORSHIP

DECISION GRANTING PETITION
37 CFR 1.324

This is a decision on the petition filed February 09, 2004 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.

Deborah Jones
Supervisory Patent Examiner
Art Unit 1773
Technology Center 1700

Carl M. Napolitano,
Allen, Dyer, Doppelt, Milbrath & Gilchrist, P. A.
255 South Orange Avenue, Suite 1401
Orlando, Florida 32801

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: October 6, 2004
TO: Certificates of Correction Branch
FROM: Deborah Jones
SPE, Art Unit 1773
SUBJECT: REQUEST FOR CERTIFICATE OF CORRECTION

Please issue a Certificate of Correction in U. S. Letters Patent No. 6,528,175 B2 as specified on the attached Certificate.

Deborah Jones, SPE
Art Unit 1773

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE

Patent No. 6,528,175 B2
Patented: March 04, 2003

On petition requesting issuance of a certificate for correction of inventorship pursuant to 35 U.S.C. 256, it has been found that the above identified patent, through error and without deceptive intent, improperly sets forth the inventorship. Accordingly, it is hereby certified that the correct inventorship of this patent is:

Robert Grantham, Fort Myers, Florida,

John S. Warren, Jr., Mobile, Alabama, and

James Robert Weaver, III, Pensacola, Florida.

Deborah Jones
Supervisory Patent Examiner
Art Unit 1773

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)
6530711	2003-03-11	09795572	2001-02-28	

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	/RML/	Date (YYYY-MM-DD)	2007-06-21
Name	Robert M. Leonardi	Registration Number	27815

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. 6530711
Issue Date: March 11,2003
Application No. 09795572
Filed: February 28,2001
Attorney Docket No. 60680-0316 (5804 NAK)

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

This is a decision on the electronic petition, filed June 21,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of June 21,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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PEARL COHEN ZEDEK, LLP
10 ROCKEFELLER PLAZA
SUITE 1001
NEW YORK NY 10020

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AUG 0 9 2005

OFFICE OF PETITIONS

In re Application of	:	
Feld et al.	:	
Application No. 09/795,633	:	ON PETITION
Filed: February 26, 2001	:	
Attorney Docket No. P-8037-US	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed August 2, 2005, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply to the non-final Office action mailed August 11, 2004. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on November 12, 2004. A Notice of Abandonment was mailed March 18, 2005.

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

This matter is being referred to Technology Center 2100 for further examination on the merits.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No. 19

LADAS & PARRY
Suite 2100
5670 Wilshire Boulevard
Los Angeles, CA 90036-5679

In re Application of :
Sadosky et al. :
Application No. 09/795,644 : DECISION ON PETITION
Filed: February 26, 2001 :
Atty Docket No. B-4095 618556.5 :

This is in response to the "PETITION UNDER 37 C.F.R. § 1.10," filed October 20, 2003, requesting that the above-identified application be accorded a filing date of February 26, 2001, rather than the presently accorded filing date of February 28, 2001.

The petition is again **GRANTED**.

A review of the application file reveals that a petition under § 1.10 to accord the earlier filing date of February 26, 2001, was previously submitted on June 8, 2001. Furthermore, by decision mailed July 19, 2001, the petition was granted. Unfortunately, correction of the filing date has never occurred in this application. The petition is again being granted to effectuate this correction.

Pursuant to the decision mailed July 19, 2001 (Paper No. 4) and the instant decision, the application file is being forwarded to the Office of Initial Patent Examination (OIPE) for **correction of the filing date to February 26, 2001** and **mailing of a corrected filing receipt**. (Thereafter, the application will be forwarded to Technology Center 3635 for consideration by the examiner of the amendment filed November 3, 2003).

No fee is required and none has been charged.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Best Available Copy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

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JUL 19 2001

**OFFICE OF PETITIONS
A/C PATENTS**

Ladas & Parry
Suite 2100
5670 Wilshire Boulevard
Los Angeles, California 90036-5679

In re Application of :
Sadosky, Miller, Tanner, Wilson, Baas, :
Elzink, Hayman, and Richards :
Application No.: 09/795,644 :
Filed: February 26, 2001 :
Attorney Docket No: B-4095 61855 :
For: ROOF PANEL AND A METHOD OF :
MANUFACTURING THEREOF :

DECISION ACCORDING
STATUS UNDER RULE 47(a)
AND DECISION ON
PETITION UNDER
37 CFR 1.10

This is in response to the petition under 37 CFR 1.47(a), filed June 8, 2001 (certificate of mailing dated June 4, 2001, and the petition under 37 CFR 1.10 also filed June 8, 2001.

The petition under 37 CFR 1.47(a) is **GRANTED**.

The petition under 37 CFR 1.10 is also **GRANTED**.

TREATMENT UNDER 37 CFR 1.47(a)

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.

A "Notice to File Missing Parts of Non-Provisional Application" ("Notice") was mailed to petitioner on April 5, 2001, indicating that petitioner did not file a proper oath or declaration in compliance with 37 CFR 1.63. The Notice also advised petitioner that various filing fees and a surcharge were also outstanding. The Notice set forth an extendable period of reply of two months from its mailing date. Petitioner filed a response to the Notice on June 8, 2001, certificate of mailing dated June 4, 2001. In said petition and accompanying supplementary documents, petitioner established that the non-signing inventor, Joseph O. Wilson, was presented with the complete application papers, but that the non-signing inventor expressly refused to review the documents and execute the declaration. This application is hereby accorded Rule 1.47(a) status.

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

TREATMENT UNDER 37 CFR 1.10

This is a decision on the petition under 37 CFR 1.10(c) filed June 8, 2001, requesting that the above-

identified application be accorded a filing date of February 26, 2001, rather than the presently accorded filing date of February 28, 2001.

Petitioner alleges that the application was deposited in Express Mail service on February 26, 2001. In support thereof, the petition is accompanied by a copy of Express Mail Receipt No.EL052829623US (the same Express Mail number found on the original application papers located in the official file) showing a "date in"of February 26, 2001.

In view of the foregoing, the petition is granted. A corrected filing receipt is enclosed reflecting the filing date for the above-cited application as February 26, 2001.

As per petitioner's request, corrections were made to the spelling of the names of certain inventors which are also reflected on the corrected filing receipt.

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

Telephone inquiries should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703) 305-0010.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Enclosure: 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

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JUL 19 2001

OFFICE OF PETITIONS
A/C PATENTS

Joseph O. Wilson
29633 Melitta Road
Menifee Valley, California 92355

In re Application of
Sadosky, Miller, Tanner, Wilson, Baas,
Elzink, Hayman, and Richards
Application No. 09/795,644
Filed: February 26, 2001
For: ROOF PANEL AND A METHOD OF MANUFACTURING THEREOF

LETTER

Dear Mr. Wilson:

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

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

Telephone inquiries regarding this communication should be directed to Petitions Attorney Kenya A. McLaughlin at (703) 305-0010. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1-800-972-6382 (outside the Washington D.C. area).

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Ladas & Parry
Suite 2100
5670 Wilshire Boulevard
Los, Angeles, California 90036-5679

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
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Paper No. 19

LADAS & PARRY
Suite 2100
5670 Wilshire Boulevard
Los Angeles, CA 90036-5679

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JAN 0 9 2004

OFFICE OF PETITIONS

In re Application of :
Sadosky et al. :
Application No. 09/795,644 : DECISION ON PETITION
Filed: February 26, 2001 :
Atty Docket No. B-4095 618556.5 :

This is in response to the "PETITION UNDER 37 C.F.R. § 1.10," filed October 20, 2003, requesting that the above-identified application be accorded a filing date of February 26, 2001, rather than the presently accorded filing date of February 28, 2001.

The petition is again **GRANTED**.

A review of the application file reveals that a petition under § 1.10 to accord the earlier filing date of February 26, 2001, was previously submitted on June 8, 2001. Furthermore, by decision mailed July 19, 2001, the petition was granted. Unfortunately, correction of the filing date has never occurred in this application. The petition is again being granted to effectuate this correction.

Pursuant to the decision mailed July 19, 2001 (Paper No. 4) and the instant decision, the application file is being forwarded to the Office of Initial Patent Examination (OIPE) for **correction of the filing date to February 26, 2001** and **mailing of a corrected filing receipt**. (Thereafter, the application will be forwarded to Technology Center 3635 for consideration by the examiner of the amendment filed November 3, 2003).

No fee is required and none has been charged.

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

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

AUG 1 2 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

MARK M. TAKAHASHI
GRAY CARY WARE & FREIDENRICH, LLP
4365 EXECUTIVE DRIVE, SUITE 1100
SAN DIEGO CA 92121-2133

In re Application of :
Steffens et al. :
Application No. 09/795,665 :
Filed: February 28, 2001 :
For: **METHOD AND APPARATUS FOR IMAGE ANALYSIS OF A GABOR-WAVELET TRANSFORMED IMAGE USING A NEURAL NETWORK** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request to Withdraw as Attorney/Agent of record filed on June 30, 2003.

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

Petitioner has met all of the above.

Accordingly, the request is **GRANTED**.

All attorneys associated with Customer No. 25,548 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 Wieder
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4710

cc: NARAYAN IYER
40134 LAIOLO ROAD
FREMONT, CA 94538

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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HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS MI 48303

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SEP 0 5 2006

OFFICE OF PETITIONS

In re Application of :
Geisel et al. :
Application No. 09/795,670 : ON PETITION
Filed: February 28, 2001 :
Title: Computer-Implemented Method and :
Apparatus for Item Processing

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed February 13, 2006.

The petition to withdraw the holding of abandonment is **GRANTED**.

This above-identified application became abandoned for failure to timely file an Appeal Brief. A Pre-Brief Conference Decision was mailed on September 23, 2005. An Appeal Brief was filed on October 24, 2005. A Notice of Abandonment was mailed January 30, 2006 indicating the Appeal Brief was untimely.

Pursuant to the OG Notice of July 12, 2005 "New Pre-Appeal Brief Conference Pilot Program" paragraph 7, " the time period for filling an appeal brief will be reset to be one month from the mailing of the decision on the request, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater.

Further review shows that October 23, 2005 fell on a Sunday. Accordingly, the receipt of the Appeal Brief and fee on the next business day, October 24, 2005, was timely pursuant to 37 CFR 1.7.

The Notice of Abandonment is hereby vacated and the holding of abandonment is withdrawn.

The application is being forwarded to the Art Unit 2164 for further processing of the Appeal Brief.

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

Charlema R. Grant

Petitions Attorney

Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 24

FISH & RICHARDSON PC
225 FRANKLIN STREET
BOSTON, MA 02110

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JUL 0 2 2004

OFFICE OF PETITIONS

In re Application of
Pamela Olson et al
Application No. 09/795,671
Filed: February 28, 2001
Attorney Docket No. 10287-057001/1658.1

: DECISION GRANTING PETITION
: UNDER 37 CFR 313(c)(2)

This is a decision on the petition, filed July 1, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on January 20, 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.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 1642 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed amendment, sequence listing and information disclosure statement.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 6

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

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JUL 03 2001

SPECIAL PROGRAMS OFFICE
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In re Application of
Jinxiang Dai et al.
Application No. 09/795,696
Filed: February 28, 2001
Attorney Docket No. NAO-0002

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.

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 1700.

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

If Required, Foreign Filing License Granted 03/29/2001

Projected Publication Date: 08/29/2002

Non-Publication Request: No

Early Publication Request: No

Title

Interprocess application programming interface for computer applications

Preliminary Class

345

Data entry by : KELECHA, ASEGEDECH **Team :** OIPE **Date:** 03/29/2001

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Technology Center 2600

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:

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Technology Center 2100

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Technology Center 2100

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Assistant Commissioner for Patents
Office of Initial Patent Examination
Customer Service Center
Washington, DC 20231

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Technology Center 2100

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OCT 0 1 2001
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AND CLAIMS BENEFIT OF 60/193,142 03/29/2000
AND CLAIMS BENEFIT OF 60/193,862 03/30/2000
~~WHICH~~ CLAIMS BENEFIT OF 60/193,142 03/29/2000
THIS APPLICATION 09/795,719
AND CLAIMS BENEFIT OF 60/193,141 03/29/2000
AND CLAIMS BENEFIT OF 60/193,153 03/29/2000
AND CLAIMS BENEFIT OF 60/193,862 03/30/2000
AND CLAIMS BENEFIT OF PCT/US00/26436 09/26/00

Foreign Applications WHICH APPLICATION CLAIMS BENEFIT OF 60/159,069 10/12/99
AND CLAIMS BENEFIT OF 60/193,141 03/29/00

If Required, Foreign Filing License Granted 03/29/2001 AND CLAIMS BENEFIT OF 60/193,153 03/29/00

Projected Publication Date: 12/06/2001 AND CLAIMS BENEFIT OF 60/193,142 03/29/00

Non-Publication Request: No AND CLAIMS BENEFIT OF 60/193,862 03/30/00
AND IS A CIP OF 09/629,115 07/31/00

Early Publication Request: No AND A CIP OF 09/628,851 07/31/00
AND A CIP OF 09/628,850 07/31/00
AND A CIP OF 09/629,117 07/31/00

Title

Interprocess application programming interface for computer applications

Preliminary Class

345

Data entry by : GIZAW, ASTER **Team :** OIPE **Date:** 08/29/2001

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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 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 500 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

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UNITED STATES PATENT AND TRADEMARK OFFICE

#11

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ALEXANDRIA, VA 22313-1450
www.uspto.gov

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JUL 20 2006

Technology Center 2100

Amir N. Penn
McDonnell Boehnen Hulbert & Berghoff
32nd Floor
300 S. Wacker Dr.
Chicago, IL 60606

In re Application of: Claessens, et al.	)	
Application No. 09/795,730	)	DECISION ON PETITION TO
Attorney Docket No. 99,872	)	WITHDRAW HOLDING OF
Filed: February 28, 2001	)	ABANDONMENT UNDER 37 CFR
For: SYSTEM AND METHOD FOR	)	§1.181
NETWORK PERFORMANCE TESTING	)	

This is a decision on the petition to withdraw the holding of abandonment of the instant application, filed on January 19, 2005, under 37 CFR §1.181.

The Petition is **GRANTED**.

The instant application became abandoned for failure to timely respond to the non-final Office action mailed February 9, 2004. A Notice of Abandonment was mailed on October 1, 2004. A grantable petition must include a copy of the response and proof of timely filing of the response. A stamped post card receipt with an indication of the documents filed therewith, in accordance with MPEP § 203.08 and § 508, is acceptable. No fee is required.

A review of the file record shows that a non-final Office action was mailed on February 9, 2004, setting a three month shortened statutory period for response. The response, indicated by Applicant to have been filed on May 7, 2004, is not of record in the application file and cannot be located.

Applicant has provided evidence in the petition of January 19, 2005 that includes: a complete copy of the papers as filed; as well as an OIPE stamped receipt card identifying the filing of an amendment/response in the USPTO with a receipt date of May 10, 2004, for case SN 09/785,730. The complete copy of the papers is taken to be a true and complete copy of the papers, as filed on May 10, 2004, for the correct application, case SN 09/795,730. Care should be taken in identifying papers before the USPTO.

MPEP § 203.08 states in relevant part:

> < A >stamped< postcard receipt for replies to Office actions, adequately and specifically identifying the papers filed, will be considered prima facie proof of receipt of such papers. >See MPEP § 503.< Where such proof indicates the timely filing of a reply, the submission of a copy of the postcard with a copy of the reply will ordinarily obviate the need for a petition to revive.

In addition, MPEP § 503 states in part:

> The identifying data on the postcard should be so complete as to clearly identify the item for which >a< receipt is requested. For example, the postcard should identify the applicant's name, application number (if known), confirmation number (if known), filing date, interference number, title of the invention, etc. The postcard should also identify **the type of paper being filed**, e.g., new application, affidavit, **amendment**, notice of appeal, appeal brief, drawings, fees, motions, supplemental oath or declaration, petition, etc., **and the number of pages being submitted [emphasis added]**. If a new application is being filed, all parts of the application being submitted should be separately listed on the postcard, e.g., the number of pages of specification (including written description, claims and abstract), number of claims, number of sheets of drawings, number of pages of oath/declaration, number of pages of cover sheet (provisional application).

Applicant is reminded of the requirements of MPEP § 503 to ensure future submissions of proof of filing are complete with all available information of the identifying data on the postcard or receipt card, as outlined above, to ensure a complete and proper *prima facie* showing of proof of filing of such papers.

In addition, it is noted that the Examiner followed proper Office practice and procedures by telephoning Applicant's Attorney, leaving a message regarding the impending abandonment of the instant application if no return call was received (see notice of abandonment, PTOL-1432 box 7).

Since all of the criteria set forth above have been met, the petition is **GRANTED.**

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 **ENTER THE RESPONSE** (copy, filed with the instant petition, dated January 19, 2005). The application will then be forwarded to the examiner for prompt action on the merits.

Brian L. Johnson
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
571-272-3595

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 3

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

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OCT 29 2001

OFFICE OF PETITIONS

In re Application of :
Goodrich et al. : DECISION GRANTING
Application No. 09/795,733 : PETITION
Filed: February 27, 2001 :
Attorney Docket No. 42390.P8928 :

This is a decision on the petition under 37 CFR 1.10(c), filed April 27, 2001, requesting that the above-identified application be accorded a filing date of February 27, 2001, rather than the presently accorded filing date of February 28, 2001.

Petitioner alleges that the application was deposited in Express Mail service on February 27, 2001. In support of the allegation, the petition is accompanied by a copy of Express Mail label No. EL627470959US. The "date-in" indicated on the Express Mail label is February 27, 2001. Additionally, the Express Mail label contains a United States Postal Service (USPS) stamp of February 27, 2001. The same Express Mail label number was placed on the original application papers located in the official file.

In view of the above, the petition is **granted**. No petition fee is necessary.

This application file will be forwarded to the Office of Initial Patent Examination for correction of the filing date to February 27, 2001.

Telephone inquiries should be directed to the undersigned at (703) 306-5589.

Christina T. Tartera

Christina T. Tartera
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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DIW 05-04

Paper No. 5

LSI LOGIC CORPORATION
1621 BARBER LANE
MS: D-106 LEGAL
MILPITAS CA 95035

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OFFICE OF PETITIONS

In re Application of	:
Hadley et al.	: DECISION GRANTING
Application No. 09/795,767	: PETITION
Filed: 28 February, 2001	:
Atty Dcket No. 00-593	:

This is a decision on the petition styled under 37 CFR 1.137(a) filed on 12 May, 2004, which is treated as a petition under 37 CFR 1.53 requesting that the above-identified application, including three (3) sheets of drawings, be accorded a filing date of 28 February, 2001.

The petition is **GRANTED**.

On 28 February, 2001, the application was filed.

On 17 April, 2001, Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application stating that the application had not been accorded a filing date because the application had been deposited without drawings.

On 29 August, 2003, a Notice of Termination of Proceedings Under 37 CFR 1.53(e) was filed, stating that proceedings on the application are terminated because the application did not meet the requires of 37 CFR 1.53(e).

In response, on 12 May, 2004, the present petition was filed, accompanied by a copy of the application papers, including three (3) sheets of drawings. Petitioners additionally supplied an itemized receipt postcard bearing an Office-date stamp dated 02/28/01 and bearing the above-identified application number and

itemizing the filing of, *inter alia,* three (3) sheets of drawings.

Upon review of the record, no sheets of drawings deposited on 28 February, 2001, have been located among the application papers. However, the evidence is convincing that the application papers deposited on 28 February, 2001, included three (3) sheets of drawings, which were subsequently misplaced in the USPTO. Therefore, the application, including three (3) sheets of drawings, was complete on filing and entitled to a filing date of 28 February, 2001.

In view of the above, the petition is granted.

It is noted that a petition under 37 CFR 1.137(a) is inappropriate because the present application was never accorded a filing date. As the application was not accorded a filing date, the application did not become abandoned and therefore is not subject to revival under 37 CFR 1.137(a). The $110.00 petition fee filed with the present petition will be refunded to counsel's deposit account, No. 12-2252.

The application will be processed and examined using the copy of three (3) sheets of drawings supplied with the petition filed on 12 May, 2004. The copies of the other application papers supplied with the petition will not be processed or entered, but will be retained in the application file.

The application will be forwarded to the Office of Initial Patent Examination for further processing with a filing date of 28 February, 2001, using the application papers filed on that date and the copy of three (3) sheets of drawings supplied with the present petition, and for an indication in Office records that three (3) sheets of drawings were present on filing.

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

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

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Technology Center 2100

Paper No. 8

Haynes and Boone, LLP
901 Main Street
Suite 3100
Dallas, Texas 75202-3789

In re Application of: Gregory T. Royal	)	
Application No. 09/795,790	)	
Filed: February 28, 2001	)	**DECISION ON REQUEST FOR**
For: METHOD AND APPARATUS FOR	)	**WITHDRAWAL AS ATTORNEY**
ELECTRONIC DOCUMENT	)	
EXCHANGE	)	

This is a decision on the Request To Withdraw from Representation filed April 17, 2003.

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

The request is **GRANTED**.

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

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

cc: James Miller
Xbridge Software, Inc.
17304 Preston Road, Suite 975
Dallas, Texas 75252

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United States Patent and Trademark Office
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Keith D. Nelson
Lockheed Martin Corporation
Building 220, Mail Stop A08
P.O. Box 49041
San Jose CA 95161-9041

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JUN 22 2005

OFFICE OF PETITIONS

In re Application of :
Wilson et al. : DECISION ON PETITION
Application No. 09/795,799 :
Filed: February 28, 2001 :
Attorney Docket No. 00-1015 :

This is a decision on the petition filed March 18, 2005, requesting that the above-identified application be accorded a filing date of February 26, 2001, rather than the presently accorded filing date of February 28, 2001.

It is unclear from the petition if petitioner is alleging that there is a discrepancy between the filing date accorded by the United States Patent and Trademark Office (USPTO) and the date-in entered by the United States Patent and Trademark Office (USPS) (37 CFR 1.10(c)) or that the date-in was incorrectly entered by the USPS (37 CFR 1.10(d)). Therefore, the Office will treat this petition under both 37 CFR 1.10(c) and (d).

In the present petition, petitioner asserts that the USPTO incorrectly identified the filing date for this application as February 28, 2001, instead of February 26, 2001. Petitioner avers that although the date-in on the Express Mail label, No. EF341528634US, is illegible, this application should be granted a filing date of February 26, 2001, based upon the statements made in the Certificate of Express Mailing under 37 CFR 1.10. A copy of the Certificate of Express Mailing and the Express Mail mailing label accompany the petition.

Paragraph (a) of 37 CFR 1.10 states that:

> Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date. See §1.6(a).

Consideration under 37 CFR 1.10(c)

Paragraph (c) of 37 CFR 1.10 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 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 Director 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.

The present petition lacks the showing required by item (3) above. Petitioner did not submit any other official notation by the USPS showing the date of deposit as February 26, 2001.

Consideration under 37 CFR 1.10(d)

Paragraph (d) of 37 CFR 1.10 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 the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:
>
> (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
>
> (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 showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS.

A grantable petition under 37 CFR 1.10(d) must include "a showing which establishes, to the satisfaction of the Director, that the requested filing date was the date the correspondence was deposited in 'Express Mail Post Office to Addressee' service prior to the last scheduled pickup for that day." In addition, the showing "must be corroborated by evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the 'Express Mail Post Office to Addressee' service of the USPS." Evidence from the USPS may be, for example, the Express Mail Corporate Account Mailing Statement or a statement by an appropriate official of the USPS that according to a USPS record the "date-in" on petitioner's Express Mail receipt is erroneous, accompanied by a copy of the relevant USPS record. Evidence that came into being within one day after the deposit of the correspondence as Express Mail may be, for example, a log book which contains information such as the Express Mail label number; the application number, attorney docket number or other such file identification number; the place, date and time of deposit; the time

of the last scheduled pick-up for that date and place of deposit; the depositor's initials or signature; and the date and time of the log book entry.

The Office notes that petitioner bears the burden to prove that the "date-in" was incorrectly entered on the "Express Mail" mailing label. Petitioner did not provide any evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the Express Mail Post Office to Addressee service of the USPS showing that the Express Mail package was accepted by the USPS on February 26, 2001. The statements made in the Certificate of Express Mailing are not evidence that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail Post Office to Addressee" service of the USPS. Moreover, a review of the USPS Track & Confirm indicates that the USPS does not have a record of Express Mail label No. EF341528634US. Absent evidence from the USPS or that came into being after deposit and within one business day of the deposit of the correspondence in the "Express Mail" service, which corroborates the allegation that the application was, in fact, deposited with the USPS on February 26, 2001, before the last scheduled pick-up for that day, the application will be accorded a filing date of February 28, 2001.

Petitioner's attention is directed to 37 CFR 1.10(b), which states, in part:

> Correspondence should be deposited directly with an employee of the USPS to ensure that the person depositing the correspondence receives a legible copy of the "Express Mail" mailing label with the "date-in" clearly marked. Persons dealing indirectly with the employees of the USPS (such as by deposit in an "Express Mail" drop box) do so at the risk of not receiving a copy of the "Express Mail" mailing label with the desired "date-in" clearly marked.

Therefore, petitioner has failed to submit sufficient corroborating evidence as required by the rule. Accordingly, the petition is **dismissed**. The application will retain the filing date of February 28, 2001.

The $130.00 petition fee is unnecessary and will be refunded by treasury check in due course.

Further correspondence with respect to this matter should be addressed as follows and **to the attention of Senior Petitions Attorney Christina Tartera Donnell:**

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

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

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

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

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)
6,520,169	2003-02-18	09/795,807	2001-02-28	ABT-3

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	/Arthur K. Shaffer/	Date (YYYY-MM-DD)	2007-04-23
Name	Arthur K. Shaffer	Registration Number	50257

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

In re Patent No. 6520169
Issue Date: February 18,2003
Application No. 09795807
Filed: February 28,2001
Attorney Docket No. ABT-3

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

This is a decision on the electronic petition, filed April 23,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of April 23,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

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P.O. Box 1450
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EDWARDS & ANGELL, LLP
P.O. BOX 55874
BOSTON MA 02205

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OFFICE OF PETITIONS

In re Application of :
Izumi et al. :
Patent No. 6,770,978 : ON PETITION
Application No. 09/795,832 :
Filed: February 28, 2001 :
Issued: August 3, 2004
Attorney Docket No. 55653 (70820)

This is a decision on the petition under 37 C.F.R. § 1.183, filed August 31, 2004, to waive the rules and accept the correction of the assignee data on the front page of the above-identified patent. The petition is also being treated as a request under 37 CFR 3.81 to accept the correction of the assignee data.

The petition under 37 CFR 1.183 is **DISMISSED AS MOOT.**

The request under 37 CFR 3.81 is **GRANTED**.

Effective June 25, 2004, 37 CFR 3.81(b) has been revised to no longer require the correction of the assignee data prior to issuance of the patent. Therefore, a petition to waive the rule is unnecessary. 37 CFR 3.81(b) currently states:

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

In other words, the request under 37 CFR 3.81(b) will be granted when:
(1) a request under 37 CFR 3.81 and the fee set forth in 37 CFR 1.17(i) are filed,
(2) the assignment was submitted for recordation prior to issuance of the patent, and
(3) a request for a certificate of correction and the fee set forth in 37 CFR 1.20(a) are submitted.

Petitioner has met the requirements set forth above. Therefore, the request is granted.

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

Telephone inquiries should be directed to Paralegal Liana Chase at (571) 272-3282.

Charles Steven Brantley
Petitions Attorney
Office of Petitions

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OLSON & HIERL, LTD.
36th Floor
20 North Wacker Drive
Chicago, IL 60606

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OFFICE OF PETITIONS

In re Application of

Hoashi, et al. :

Application No. 09/795,841

: DECISION ON PETITION

Filed: February 28, 2001

:

Attorney Docket No. MM-21009

This is a decision on the petition under 37 CFR 1.137(b), filed January 9, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 15, 2005, which set a shortened statutory period for reply of three (3) months from its mailing date. No extension of time pursuant to 37 CFR 1.136(a) was obtained within the allowable period. Accordingly, the application became abandoned on September 16, 2005. A Notice of Abandonment was mailed on January 12, 2006

The amendment, filed January 9, 2006, is noted and made of record.

The request for an extension of time within the third month is noted, but cannot be granted as the request was made outside the maximum statutory period for reply. An extension of time is not necessary as the application was already in an abandoned status. The amount of $1020.00 will be refunded, in due course.

The application is being forwarded to Technology Center 2100, GAU 2164 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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VIERRA MAGEN MARCUS & DENIRO LLP
575 MARKET STREET SUITE 2500
SAN FRANCISCO CA 94105

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OFFICE OF PETITIONS

In re Application of
Jeffrey R. Cobb
Application No. 09/795,901
Filed: February 28, 2001
Attorney Docket No: **WILY-01009US0**

ON PETITION

This is a decision on the petition to withdraw the holding of abandonment, filed January 18, 2007, under 37 CFR 1.181, in accordance with the reasoning of the decision in Delgar Inc. v. Schuyler, 172 USPQ 513.

The petition is **GRANTED**.

This application became abandoned on July 19, 2006, for failure to file a timely response to an office communication mailed May 18, 2006, which set a two (2) month statutory period for reply. Accordingly, a Notice of Abandonment was mailed November 28, 2006. Petitioner asserts that the office communication was never received.

The file record discloses that the office communication was mailed to the address of record which is the same address used on all correspondences from the USPTO including the Notice of Abandonment. Petitioner has provided a copy of the docket report, wherein receipt of the office communication mailed May 18, 2006 would have been filed, had it been received. To further show that the office communication mailed May 18, 2006 was not received, petitioner explains that after searching the file jacket it was concluded that no correspondence was received for this matter from the USPTO,

In that the statement from the petitioner and the exhibit from the docket record for the instant matter show no entry indicating receipt of the office communication mailed May 18, 2006, it is apparent that it was not received. The evidence submitted corroborates non-receipt of the office communication.

In view of the facts set forth in the petition, it is concluded that the office communication was never received at the address of record. Accordingly, the holding of abandonment is withdrawn and no petition fee is due.

This matter is being referred to Technology Center 2193 for a re-mailing of the office communication originally mailed May 18, 2006 and for a restarting of the period for response.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

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FISH & NEAVE LLP
1251 AVENUE OF THE AMERICAS
NEW YORK NY 10020

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OFFICE OF PETITIONS

In re Application of :
Mukherjee, et al. :
Application No. 09/795,915 : ON PETITION
Filed: February 27, 2001 :
Attorney Docket No. SPC-002 :
For: NOVEL COMPOSITE CATHODES, ELECTROCHEMICAL CELLS COMPRISING NOVEL COMPOSITE CATHODES, AND PROCESSES FOR FABRICATING SAME

This is a decision on the petition under 37 CFR 1.181, filed July 31, 2006 (certificate of mailing date July 27, 2006), requesting that the Office withdraw the holding of abandonment of the above-identified application.

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

This application was held abandoned for failure to seek court review of the Board of Patent Appeals and Interferences Decision on Appeal within two months of the April 7, 2006 decision. The Office contended this application became abandoned on June 8, 2006. A Notice of Abandonment was mailed on July 5, 2006.

Petitioners argue that the application did not become abandoned because a notice of appeal from the April 7, 2006 Board decision was purportedly filed on April 28, 2006, which was within the two month period for action.

Petitioners have provided evidence that a notice of appeal from the April 7, 2006 Board decision was timely filed on April 28, 2006. The Office acknowledged the April 28, 2006 filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit in correspondence dated June 8, 2006. The appeal has been docketed by the Court of Appeals as Appeal No. 2006-1450.

Therefore, the petition under 37 CFR 1.181 is **granted** and the Notice of Abandonment is **vacated**. No petition fee has been or will be charged in connection with this matter.

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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JJGJR.: 06-04

Paper No: 25

MICHAEL BERNADICOU
BLAKELY, SOKOLOFF, TAYOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES CA 90025

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JUN 23 2004
OFFICE OF PETITIONS

In re Application of
Gurer, et al. :
Application No. 09/795,924 :
Filing Date: 28 February, 2001
Attorney Docket No. 6601P019 :

This is a decision on the petition filed on 15 May, 2004, under 37 C.F.R. §1.137(b), and alleging abandonment due to unintentional delay.

For the reasons set forth below, the petition as considered under 37 C.F.R.§1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the Notice of Allowance and Fees Due mailed on 30 June, 2003, with reply due under a non-extendable deadline on or before 30 September, 2003;
- the application went abandoned by operation of law after midnight 30 September, 2003;
- the Office mailed the Notice of Abandonment on 6 November, 2003;
- with the instant petition, fee and statement of unintentional delay, Petitioner filed an RCE with fee and submission in the form of an Information Disclosure Statement (IDS).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[1]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[2]

Delays in responding properly raise the question whether delays are unavoidable.[3] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[4] And the Petitioner must be diligent in attending to the matter.[5] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6] And petitions calling upon the authority of the Commissioner to act, such as that under 37 C.F.R. §1.181,[7] require diligence as to their filing–i.e., the petition must be filed within two months of

---

[1] 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[2] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

[3] 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).

[4] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[5] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[6] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

[7] The regulations at 37 C.F.R. §1.181 provide:
§ 1.181 Petition to the Commissioner.
(a) Petition may be taken to the Commissioner:
(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

the action complained of.

Allegations as to Unintentional Delay

The requirements of a petition under 37 C.F.R. §1.137(b) are: petition, fee, reply, statement and–if applicable–terminal disclaimer.

Applicable here are only the petition, fee, reply and statement requirements, which Petitioner has satisfied.

CONCLUSION

Petitioner has satisfied the requirements under 37 C.F.R. §1.137(b), the petition hereby is **granted**.

The instant application is forwarded to Technology Center 1700 for further processing 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

---

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by orreviewed by the Commissioner; and
(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. For petitions in interferences, see § 1.644.
(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.
(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, or in the *ex parte* or *inter partes* prosecution of a reexamination proceeding, it may be required that there have been a proper request for reconsideration (§ 1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his or her decision upon the matters averred in the petition, supplying a copy to the petitioner.
(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed.
(e) Oral hearing will not be granted except when considered necessary by the Commissioner.
(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.
(g) The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions.
[24 Fed. Reg. 10332, Dec. 22, 1959; 34 Fed. Reg. 18857, Nov. 26, 1969; paras. (d) and (g), 47 Fed. Reg. 41278, Sept. 17, 1982, effective Oct. 1, 1982; para. (a), 49 Fed. Reg. 48416, Dec. 12, 1984, effective Feb. 11, 1985; para. (f) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Nov. 7, 2000; paras. (a) and (c) revised, 65 Fed. Reg. 76756, Dec. 7, 2000, effective Feb. 5, 2001]

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JUN - 7 2006

FOLEY HOAG, LLP
PATENT GROUP, WORLD TRADE CENTER WEST
155 SEAPORT BLVD
BOSTON MA 02110

In re Application of	:
Elizabeth Keep et al	:
Serial No.: 09/795,946	: PETITION DECISION
Filed: February 27, 2001	:
Attorney Docket No.: P313087	:

This is in response to the petition under 37 CFR 1.182, filed July 2, 2002, which is being treated as a petition requesting suspension of action under 37 CFR 1.103.

A review of the file history shows that the examiner mailed a first Office action to applicants on January 2, 2002, setting forth a number of requirements to complete the description criteria for the claimed plant. Applicants replied on July 2, 2002, to the extent possible to the Office action, including a request and fee for a three month extension of time, and concurrently filed this petition to suspend prosecution for a period of six months in order to complete the response to the examiner's description requirements which required the plant to complete its annual growth cycle. For unknown reasons the petition was not forwarded for consideration until recently. It is noted that the petition was filed almost four years ago and requested a suspension of only six months (the maximum permissible) in order to complete the response to the examiner's requirement regarding description. Since a significant amount of time has passed (more than the six months requested) it would not be appropriate to now grant a six month suspension of action as applicants have had ample time to satisfy the examiner's requirements without the requested suspension of action. (It is noted that applicants have not filed any further reply which would complete the description requirement of the examiner.)

The petition is **DENIED**.

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

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

Bruce M. Kisliuk
Director, Technology Center 1600

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HUGHES LAW FIRM, PLLC
PACIFIC MERIDIAN PLAZA, SUITE 302
4164 MERIDIAN STREET
BELLINGHAM WA 98226-5583

In re Application of	:
Elizabeth Keep et al	:
Serial No.: 09/795,946	: PETITION DECISION
Filed: February 27, 2001	:
Attorney Docket No.: P313087	:

This is in response to the petition under 37 CFR 1.182, filed July 2, 2002, which is being treated as a petition requesting suspension of action under 37 CFR 1.103.

A review of the file history shows that the examiner mailed a first Office action to applicants on January 2, 2002, setting forth a number of requirements to complete the description criteria for the claimed plant. Applicants replied on July 2, 2002, to the extent possible to the Office action, including a request and fee for a three month extension of time, and concurrently filed this petition to suspend prosecution for a period of six months in order to complete the response to the examiner's description requirements which required the plant to complete its annual growth cycle. For unknown reasons the petition was not forwarded for consideration until recently. It is noted that the petition was filed almost four years ago and requested a suspension of only six months (the maximum permissible) in order to complete the response to the examiner's requirement regarding description. Since a significant amount of time has passed (more than the six months requested) it would not be appropriate to now grant a six month suspension of action as applicants have had ample time to satisfy the examiner's requirements without the requested suspension of action. (It is noted that applicants have not filed any further reply which would complete the description requirement of the examiner.)

The petition is **DENIED**.

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

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

Bruce M. Kisliuk
Director, Technology Center 1600

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1230 PEACHTREE STREET, N.E.
SUITE 3100, PROMENADE II
ATLANTA GA 30309-3592

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AUG 15 2005

OFFICE OF PETITIONS

In re Application of
Anastasios Tzathas, et al.
Application No. 09/795,950
Filed: February 28, 2001
Attorney Docket No.: 4659-10

ON PETITION

This is a decision on the petition, filed August 8, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on July 12, 2005, using a Certificate of Mailing or Transmission under 37 CFR 1.8 dated 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 relating to this decision should be directed to the undersigned at (571) 272-3204.

The application is being referred to Technology Center AU 2873 for further processing of the request for continued examination under 37 CFR 1.114.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

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

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MERCHANT & GOULD P.C.
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

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APR 21 2004

OFFICE OF PETITIONS

In re Application of :
Kenji Orita et al :
Application No. 09/795,959 :
Filed: February 28, 2001 :
Attorney Docket No. 10873.669US01 :

ON PETITION

This is a decision on the petition under 37 CFR 1.313, filed April 12, 2004, which is being treated under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on March 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 Wan Laymon at (703) 306-5685.

This application file is being forwarded to Technology Center AU 2881 for processing of the request for continued examination under 37 CFR 1.114.

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

[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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JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

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JAN 27 2005

OFFICE OF PETITIONS

In re Application of :
Enrique Nollas Amoros et al :
Application No. 09/795,964 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. 618-908 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 28, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed May 18, 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 August 19, 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)).

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

This matter is being referred to Technology Center 3743 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Amendment.

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

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KILYK & BOWERSOX, P.L.L.C.
53 A EAST LEE STREET
WARRENTON VA 20186

In re Application of :
Abbot F. Clark et al :
Serial No.: 09/796,008 : PETITION DECISION TO RESTART
Filed: February 28, 2001 : PERIOD FOR REPLY
Attorney Docket No.: 3010-018-01 :
:

This is in response to applicants' petition under 37 CFR § 1.181, filed September 30, 2003, by facsimile, requesting restarting of the period for reply.

A review of the file history shows the examiner mailed a Final Office action to applicants on May 7, 2003, setting a three month shortened statutory period for reply. Applicants state that they did not receive the Office action. In addition, the Office action was returned to the Office on or about May 16, 2003, for unknown reasons and was not remailed. Applicants discovered the existence of the Office action in September, 2003, and contacted the examiner who provided a copy of the Office action by facsimile transmission on September 15, 2003. Applicants request that the period for reply be reset to that date.

Applicants' petition is **GRANTED**.

The period for reply to the Final Office action originally mailed May 7, 2003, is reset to the date of receipt of the facsimile transmitted copy, September 15, 2003.

Should there be any questions regarding 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

DECISION ON PETITION
ROUTING SLIP
TC 2100

Application No.: 09/796,008 Art Unit: 1635

For Director's Secretary:

X **Granted** ___**Denied** ___**Dismissed**

___**Decision to be reviewed and signed by Directo**

X **Mail Decisioin & enter decision in Petition Database**

___**Enter Change of Address in PALM**

___**Enter Paper Nos._____and the decision in PALM**

___**Other**

For Tech Support Staff and/or LIE:

___**Process and enter Paper Nos._____**

___**Charge_____fee to D.A. No._____**

X **Other** Change Mail date of FR to 9/15/03

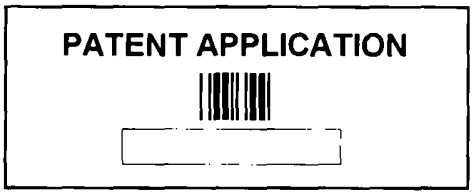
___**Forward file to_____**

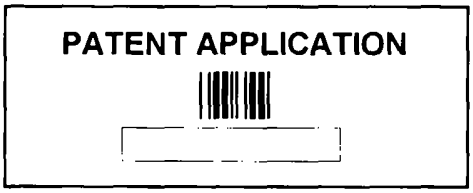
Questions should be directed to:

SPRE No. 1	SPRE No. 2	SPRE No. 3	SPRE No. 4
Cecilia Tsang SPRE, TC-1600 CM1-11D19 (703) 308-0254	Julie Burke SPRE, TC-1600 CM1-11D17 (703) 308-7553	Bill Dixon SPRE, TC-1600 CM1-11E17 (703) 308-3824	Vacant

PATENT APPLICATION
09796008

PATENT APPLICATION


PATENT APPLICATION


PATENT 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

JJGJR.: 08-07

Paper No:__

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SEP 0 4 2007

OFFICE OF PETITIONS

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON MA 02210

In re Application of :
Muntz :
Application No. 09/796,046 :
Filing Date: 28 February, 2001 :
Attorney Docket No.: 112025-0446 :

DECISION

This is a decision on the petition filed on 8 November, 2006, and properly considered as a request under 37 C.F.R. §1.181 for the withdrawal of the holding of abandonment.

The Office regrets the delay in addressing this matter, however, the instant petition was presented to the attorneys in the Office of Petitions only at this writing.[1]

For the reasons set forth below, the petitions as considered under 37 C.F.R. §1.181 are **DISMISSED**; and Petitioner must clarify the record.

NOTES:

(1) Any petition (and fee) for reconsideration of this decision must be submitted within two (2) months from the mail date of this decision. Extensions of time

[1] NOTE: Monitoring of the status of applications on PAIR can inform one's management of application responses and provide an indication when mailings of Office actions should be expected. Status Inquiries filed at three (3) or four (4) month intervals provide a demonstration of diligence and attention in supporting a petition seeking relief under 37 C.F.R. §1.181.

under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181."

(2) Thereafter, there will be no further reconsideration of this matter.

BACKGROUND

The record indicates that:

- Petitioner failed to reply timely and properly to the Notice of Allowance/Allowability and Fees Due mailed on 29 June, 2006, with reply due under a non-extendable deadline on or before Monday 29 September, 2006;
- the application went abandoned by operation of law after midnight 29 September, 2006;
- the Office mailed the Notice of Abandonment on 2 November, 2006;
- on 8 November, 2006, Petitioner filed the instant petition, with payment of the Fees Due and a copy of his docket sheet for the instant application and the averment that the Fees Due deadline would be reflected on that document if the Notice thereof had been received, however, Petitioner failed to complete the requisite showing.

Specifically, and as noted below in greater detail, the Commentary at MPEP §711.03(c)states:

> ... if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. (Emphasis supplied.)

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)); and those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

---

[2] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[3]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding

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Specifically, the regulations at 37 C.F.R. §10.18 provide:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;
(2) Returning papers;
(3) Precluding a party from filing a paper, or presenting or contesting an issue;
(4) Imposing a monetary sanction;
(5) Requiring a terminal disclaimer for the period of the delay; or
(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).
[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[3] 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[4]

Delays in responding properly raise the question whether delays are unavoidable.[5] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[6] And the Petitioner must be diligent in attending to the matter.[7] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[8]))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[9]

The commentary at MPEP §711.03(c) provides:

* * *

A. Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the

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[4] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

[5] See: *Changes to Patent Practice and Procedure*; *Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

[6] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[7] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[8] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

[9] See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

> original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.
>
> * **
>
> The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).
>
> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). (Emphasis supplied.)
>
> * * *

And the regulation requires that relief be sought within two (2) months of the act complained of.

Thus, as of this writing Petitioner appears not to have satisfied the showing requirement described above–and, thus, not satisfied his burden herein.

CONCLUSION

Because it appears that Petitioner has not carried his burden in the instant matter, the instant petition under 37 C.F.R. §1.181 is **dismissed**.

ALTERNATIVE VENUE

Petitioner's only alternative to irretrievable abandonment may well be a petition alleging unintentional delay under 37 C.F.R. §1.137(b).

Petitioner may wish to file such a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay. (See: http://www.uspto.gov/web/offices/pac/mpep/documents/0700_711_03_c.htm#sect711.03c)

A petition to revive on the grounds of unintentional delay must be filed promptly and such petition must be accompanied by the reply (the amendment), the petition fee, and a statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional." (The statement is in the form available online.) Further correspondence with respect to this matter should be addressed as follows:[10]

By mail: Commissioner for Patents[11]
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: IFW Formal Filings
(571) 273-8300
ATTN.: Office of Petitions

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

While telephone inquiries regarding this decision may be directed to the undersigned at (571)

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[10] On July 15, 2005, the Central Facsimile (FAX) Number changed to (571) 273-8300. Faxes sent to the old number no longer are routed to the new number. The number (571) 273-8300 is the only facsimile number recognized for centralized delivery. (For further information. see: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/cfax062005.pdf .)

[11] To determine the appropriate addresses for other subject-specific correspondence, refer to the USPTO Web site at www.uspto.gov.

272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[12]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[12] The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing.The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation,or understanding in relation to which there is disagreement or doubt.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JJGJR.: 12-07

Paper No:__

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DEC 1 0 2007

OFFICE OF PETITIONS

CESARI AND MCKENNA, LLP
88 BLACK FALCON AVENUE
BOSTON MA 02210

In re Application of	:	
Muntz	:	DECISION
Application No. 09/796,046	:	
Filing Date: 28 February, 2001	:	
Attorney Docket No.: 112025-0446	:	

This is a decision on the petition filed on 4 October, 2007, and properly considered as a request under 37 C.F.R. §1.181 for the withdrawal of the holding of abandonment, alternatively.under 37 C.F.R. §1.137(b) as abandoned due to unintentional delay.

For the reasons set forth below, the petition as considered under 37 C.F.R. §1.181 is **GRANTED**; the petition under 37 C.F.R. §1.137(b) is **DISMISSED**.

BACKGROUND

The record indicates that:

- Petitioner failed to reply timely and properly to the Notice of Allowance/Allowability and Fees Due mailed on 29 June, 2006, with reply due under a non-extendable deadline on or before Monday 29 September, 2006;

- the application went abandoned by operation of law after midnight 29 September, 2006;

- the Office mailed the Notice of Abandonment on 2 November, 2006;

- on 8 November, 2006, Petitioner filed the original petition, with payment of the Fees Due and a copy of his docket sheet for the instant application and the averment that the Fees Due deadline would be reflected on that document if the Notice thereof had been received, however, Petitioner failed to complete the requisite showing (see: the guidance at the Commentary at MPEP §711.03(c)–and the petition was dismissed on 4 September, 2007;

- the instant petition seeks to over come those deficiencies, and Petitioner has, *inter alia*, made such showings in statements and documents as are set forth in the guidance at the Commentary at MPEP §711.03(c), and has alternatively filed the petition and fee under 37 C.F.R. §1.137(b), made the statement of unintentional delay and filed the reply in the form of the Fees Due.

The availability of applications and application papers online to applicants/practitioners who diligently associate their Customer Number with the respective application(s) now provides an applicant/practitioner on-demand information as to events/transactions in an application. Thus, now if one wishes to know the progress in and/or status of an application or the accuracy of the data therein, one need only look at the file online.

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)); and those registered to practice *and* all others who make representations before the Office must inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

---

[1] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.
(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.
(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—
(1) All statements made therein of the party's own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[2]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[3]

Delays in responding properly raise the question whether delays are unavoidable.[4] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing

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paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

(2) To the best of the party's knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —

(i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;

(ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.

(c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner's designee, which may include, but are not limited to, any combination of —

(1) Holding certain facts to have been established;

(2) Returning papers;

(3) Precluding a party from filing a paper, or presenting or contesting an issue;

(4) Imposing a monetary sanction;

(5) Requiring a terminal disclaimer for the period of the delay; or

(6) Terminating the proceedings in the Patent and Trademark Office.

(d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15).

[Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

[2] 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[3] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

[4] See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 *Fed. Reg.* at 53158-59 (October 10, 1997), 1203 *Off. Gaz. Pat. Office* at 86-87 (October 21, 1997).

that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[5] And the Petitioner must be diligent in attending to the matter.[6] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[7]))

Allegations as to the Request to
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.[8]

The commentary at MPEP §711.03(c) provides:

* * *

A. Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the

---

[5] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[6] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[7] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

[8] See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

> practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.
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> * **
>
> The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).
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> Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). (Emphasis supplied.)
>
> * * *

And the regulation requires that relief be sought within two (2) months of the act complained of.

Petitioner appears to have satisfied the showing requirement described above.

As to the Allegation
of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and–where appropriate--a terminal disclaimer and fee.

It appears that the instant petition is moot.

CONCLUSION

The instant petition under 37 C.F.R. §1.181 is **granted** and the 2 November, 2006, Notice of Abandonment is **vacated**; the petition under 37 C.F.R. §1.137(b) is **dismissed as moot**.

The instant application is released to Publications Branch to be processed into a patent in due course.

While telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214, it is noted that all practice before the Office is in writing (see: 37 C.F.R. §1.2[9]) and the proper authority for action on any matter in this regard are the statutes (35 U.S.C.), regulations (37 C.F.R.) and the commentary on policy (MPEP). Therefore, no telephone discussion may be controlling or considered authority for Petitioner's action(s).

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

---

[9] The regulations at 37 C.F.R. §1.2 provide:

§1.2 Business to be transacted in writing.

All business with the Patent and Trademark Office should be transacted in writing.The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation,or understanding in relation to which there is disagreement or doubt.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Aug. 17, 2005

TO SPE OF : ART UNIT 2182

SUBJECT : Request for Certificate of Correction on Patent No.: 6,886,050

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

Please complete this form and return with file, within 7 days to:

Palm location 7580, Certificates of Correction Branch – South Tower – 9A22

If response is for an IFW, **return to employee (named below) via PUBSCofC Team in MADRAS.**

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

Please see the References Cited!

Thank You For Your Assistance

sp

Certificates of Correction Branch

Tel. No. 703-308-9390 x120

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

Note your decision on the appropriate box.

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

Comments:

_____

_____

_____

_____

_____

SPE

2182

Art Unit

OIPE JC183 JUL 22 2005 PATENT AND TRADEMARK OFFICE

COPC

P5287.I

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Number:	6,886,050
Issued:	April 26, 2005
Name of Patentee:	Yuji Takamizawa, et al.
Serial No.:	09/796,065
Filing Date:	February 27, 2001
Title of Invention:	Method For Controlling A Communication Terminal Device And Rewritable Storage Medium Having Initialization Setting Data (As Amended)

Certificate
JUL 26 2005
of Correction

CERTIFICATE OF MAILING

I hereby certify that this correspondence, and the documents attached hereto, are being deposited with the United States Postal Service as "First Class" mail with sufficient postage in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this date.

Date: July 19, 2005

Mary Bastida

REQUEST FOR CERTIFICATE OF CORRECTION OF PATENT FOR PTO MISTAKE (37 CFR §1.322(a))

Attention Certificate of Corrections Branch
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

It is noted that errors appear in this patent of a clerical, typographical or minor nature or character, as more fully described below, due to a mistake by the Patent and Trademark Office.

Attached hereto in duplicate is Form PTO-1050 with at least one copy being suitable for printing.

The exact page and line number where the error occurs in the patent are:

Title Page,

Item [56] References Cited,
U.S. Patent Documents, insert
-- 6,081,663 06/2000 Takahashi et al.
5,537,626 07/1996 Kraslavsky et al.
5,216,754 06/1993 Sathi et al.--

JUL 28 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO.: 6,886,050
DATED: April 26, 2005
INVENTOR(S): Yuji Takamizawa, et al.

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

Title Page,

Item [56] References Cited,
U.S. Patent Documents, insert
-- 6,081,663 06/2000 Takahashi et al.
5,537,626 07/1996 Kraslavsky et al.
5,216,754 06/1993 Sathi et al.—

Item [56] References Cited,
Foreign Patent Documents, insert
--JP 2000-076030 04/2004--

MAILING ADDRESS OF SENDER:

Epson Research and Development, Inc.
Intellectual Property Department
150 River Oaks Parkway, Suite 225
San Jose, CA 95134
Customer No. 20178

PATENT NO. 6,886,050

FORM PTO 1050

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO.: 6,886,050
DATED: April 26, 2005
INVENTOR(S): Yuji Takamizawa, et al.

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

Title Page,

Item [56] References Cited,
U.S. Patent Documents, insert
-- 6,081,663 06/2000 Takahashi et al.
5,537,626 07/1996 Kraslavsky et al.
5,216,754 06/1993 Sathi et al.—

Item [56] References Cited,
Foreign Patent Documents, insert
--JP 2000-076030 04/2004--

MAILING ADDRESS OF SENDER:

Epson Research and Development, Inc.
Intellectual Property Department
150 River Oaks Parkway, Suite 225
San Jose, CA 95134
Customer No. 20178

PATENT NO. 6,886,050

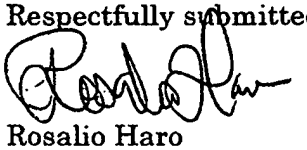
FORM PTO 1050

JUL 28 2005

Item [56] References Cited,
Foreign Patent Documents, insert
--JP 2000-076030 04/2004--

Patentee's undersigned attorney may be reached at the telephone number listed below. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,



Rosalio Haro
Registration No. 42,633

Please address all correspondence to:
Epson Research and Development, Inc.
150 River Oaks Parkway, Suite 225
San Jose, CA 95134
Customer No. 20178
Phone: (408) 952-6000
Facsimile: (408) 954-9058

Date: July 19, 2005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ARTHROCARE CORPORATION
680 VAQUEROS AVENUE
SUNNYVALE CA 94085-3523

COPY MAILED

JUN 07 2007

OFFICE OF PETITIONS

In re Application of :
Jean Woloszko et al. :
Application No. 09/796,094 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. U-04 :

This is a decision on the petition under 37 CFR 1.137(b), filed December 4, 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 April 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) was obtained. Accordingly, the application became abandoned on July 28, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment; (2) the petition fee of $1500; and (3) an adequate statement of unintentional delay.

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 3739 for appropriate action on the concurrently filed amendment.

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

ALEX FREEMAN
3733 LOWREY WAY
PLANO TX 75025

COPY MAILED

OCT 2 6 2006

OFFICE OF PETITIONS

In re Application of :
Freeman :
Application No. 09/796,095 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. 123501-1001 :
For: INTEGRALLY MANUFACTURED
MICRO-ELECTROFLUIDIC CABLES

This is a decision on the petition under 37 CFR 1.137(b), filed April 17, 2006 (certificate of mailing date April 12, 2006), to revive the above-identified application.

The petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." Petitioner is advised that this is not a final agency decision.

This application became abandoned for failure to timely reply to the Notice of Allowance and Fee(s) Due and the Notice of Allowability, both mailed on June 22, 2005, which set a three month period for reply. No reply being timely filed, the application became abandoned on September 23, 2005. A Notice of Abandonment was mailed on March 1, 2006.

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. The Director may require additional information where there is a question whether the delay was unintentional; and

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

The instant petition does not satisfy requirement (1) above.

Petitioner has not submitted acceptable drawings. Please find enclosed a Notice of Draftsperson's Patent Drawing Review, dated October 20, 2006 for more details.

Applicant submitted a terminal disclaimer and terminal disclaimer fee. Since the above-identified application is a utility application filed **after** June 8, 1995, a terminal disclaimer is not required as a component of a petition to revive. The $65.00 fee submitted with the terminal disclaimer will be refunded via a treasury check that will be scheduled shortly.

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.

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

Enclosure: Notice of Draftsperson's Patent Drawing Review, dated October 20, 2006

Form PTO-948 (Rev. 06/03)
Application No. 09/796,095

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark Office

NOTICE OF DRAFTSPERSON'S PATENT DRAWING REVIEW

The drawing(s) filed (insert date) 10/7/05 are:

A. ___ approved by the Draftsperson under 37 CFR 1.84 or 1.152.

B. ✓ objected to by the Draftsperson under 37 CFR 1.84 or 1.152 for the reasons indicated below. Corrected drawings are required.

1. DRAWINGS. 37 CFR 1.84(a): Acceptable categories of drawings: Black ink or Color (3 sets required).

___ Color drawings are not acceptable until petition is granted. Fig(s)_____

___ Pencil and non black ink not permitted. Fig(s)_____

2. PHOTOGRAPHS. 37 CFR 1.84(b)

___ One (1) full-tone set is required. Fig(s)_____

___ Photographs may not be mounted. 37 CFR 1.84(e)

___ Photographs must meet paper size requirements of 37 CFR 1.84(f). Fig(s)_____

___ Poor quality (half-tone). Fig(s)_____

3. TYPE OF PAPER. 37 CFR 1.84(e)

___ Paper not flexible, strong, white, and durable. Fig(s)_____

___ Erasures, alterations, overwritings, interlineations, folds, copy machine marks not accepted. Fig(s)_____

4. SIZE OF PAPER. 37 CFR 1.84(f): Acceptable sizes:

21.0 cm by 29.7 cm (DIN size A4) or
21.6 cm by 27.9 cm (8 1/2x 11 inches)

___ All drawing sheets not the same size. Sheet(s)_____

___ Drawings sheets not an acceptable size. Fig(s)_____

5. MARGINS. 37 CFR 1.84(g): Acceptable margins:

Top 2.5 cm Left 2.5 cm Right 1.5 cm Bottom 1.0 cm

___ Margins not acceptable. Fig(s) 6A, 7C 8D, 8C 9D 9E 10A 10C

✓ Top (T) ___ Left (L)

___ Right (R) ___ Bottom (B)

6. VIEWS. 37 CFR 1.84(h)

REMINDER: Specification may require revision to correspond to drawing changes, e.g., if Fig. 1 is changed to Fig. 1A, Fig 1B and Fig. 1C, etc., the specification, at the Brief Description of the Drawings, must likewise be changed.

___ Views not labeled separately or properly. Fig(s)_____

7. SECTIONAL VIEWS. 37 CFR 1.84(h)(3)

___ Sectional designation should be noted with Arabic or Roman numbers. Fig(s)_____

8. ARRANGEMENT OF VIEWS. 37 CFR 1.84(i)

___ Words do not appear on a horizontal, left-to-right fashion when page is either upright or turned so that the top becomes the right side, except for graphs. Fig(s)_____

9. SCALE. 37 CFR 1.84(k)

___ Scale not large enough to show mechanism without crowding when drawing is reduced in size to two-thirds in reproduction. Fig(s)_____

10. CHARACTER OF LINES, NUMBERS, & LETTERS. 37 CFR 1.84(l)

___ Lines, numbers & letters not uniformly thick and well defined, clean, durable, and black (poor line quality). Fig(s)_____

11. SHADING. 37 CFR 1.84(m)

___ Solid black areas pale. Fig(s)_____

___ Solid black shading not permitted. Fig(s)_____

12. NUMBERS, LETTERS, & REFERENCE CHARACTERS. 37 CFR 1.84(p)

___ Numbers and reference characters not plain and legible. Fig(s)_____

___ Figure legends are poor. Fig(s)_____

___ Numbers and reference characters not oriented in the same direction as the view. 37 CFR 1.84(p)(1) Fig(s)_____

___ English alphabet not used. 37 CFR 1.84(p)(2) Fig(s)_____

___ Numbers, letters and reference characters must be at least 32 cm (1/8 inch) in height. 37 CFR 1.84(p)(3). Fig(s)_____

13. LEAD LINES. 37 CFR 1.84(q)

___ Lead lines missing. Fig(s)_____

14. NUMBERING OF SHEETS OF DRAWINGS. 37 CFR 1.84(t)

___ Sheets not numbered consecutively, and in Arabic numbers beginning with number 1. Sheet(s)_____

15. NUMBERING OF VIEWS. 37 CFR 1.84(u)

___ Views not numbered consecutively, and in Arabic numerals, beginning with number 1. Fig(s)_____

16. DESIGN DRAWINGS. 37 CFR 1.152

___ Surface shading shown not appropriate. Fig(s)_____

___ Solid black surface shading is not permitted except when used to represent the color black as well as color contrast. Fig(s)_____

COMMENTS:

Reviewer CBR

Date 10/20/06

If you have questions, call (703) 305-8404.

Attachment to Paper No. _____

☆ U.S. GOVERNMENT PRINTING OFFICE: 2003-300-153

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

ALEX FREEMAN
3733 LOWREY WAY
PLANO, TX 75025

COPY MAILED

JUN 19 2007

OFFICE OF PETITIONS

In re Application of :
Alex Freeman :
Application No. 09/796,095 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. 123501-1001 :

This is a decision on the renewed petition, filed January 23, 2007, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is **GRANTED.**

A review of the record discloses that the above-identified application became abandoned for failure to respond in a timely manner to the Notice of Allowance/Allowability on or before September 22, 2005. Drawings and the requisite issue fee was filed on October 6, 2005. Consequently, on March 1, 2006, a Notice of Abandonment was mailed. In response, on April 13, 2006, a petition under 37 CFR 1.137(b) was filed; however, the petition was dismissed in a decision mailed October 26, 2006 since the drawings were not acceptable. On January 23, 2007, the present petition was filed.

The petition satisfies the requirements of 37 CFR 1.137(b).

The application is being referred to the Office of Publications to oversee the review of the drawing filed January 23, 2007.

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

Sherry D. Brinkley
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

MAILED

DEC 3 1 2001

Paper No. 7

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2100

Silicon Valley Intellectual Property Group
P.O. Box 721120
San Jose, California 95112

In re Application of: Michel Bowman-Amuah.)
Application No. 09/796,106)
Filed: February 27, 2001)
For: SYSTEM, METHOD AND COMPUTER PROGRAM PRODUCT FOR A B2B PROCUREMENT PORTAL)

DECISION ON PETITION UNDER M.P.E.P. §708.02(II): INFRINGEMENT

This is a decision on the petition, filed 10 December 2001, 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(d), 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 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

Zilka-Kotab, PC
P.O. BOX 721120
SAN JOSE CA 95172-1120

COPY MAILED

APR 27 2006

OFFICE OF PETITIONS

In re Application of :
Michael K. Bowman-Amuah :
Application No. 09/796,106 : DECISION ON PETITION
Filed: February 27, 2001 : TO WITHDRAW
Attorney Docket No. MKBAP001 : FROM RECORD
:

This is a decision in response to a Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed January 12, 2006.

The request is **dismissed as moot**.

A review of the file record indicates that while a request to withdraw the power of attorney to Kevin J. Zilka and Dominic M. Kotab was filed on January 12, 2006, a Revocation and Power of Attorney appointing Kevin J. Zilka and Dominic M. Kotab was filed on March 20, 2006.

Accordingly, 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 Sherry D. Brinkley at 571-272- 3204.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Conferee: Amelia Au

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

INTELLECTUAL PROPERTY GROUP
FREDRIKSON & BYRON, P.A.
200 SOUTH SIXTH STREET, SUITE 4000
MINNEAPOLIS, MN 55402

Mail Date: 07/06/2010

Applicant	: David B. Masters	: DECISION ON REQUEST FOR
Patent Number	: 7662409	: RECALCULATION of PATENT
Issue Date	: 02/16/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 09/796,170	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 02/28/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **551** 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.

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 10/31/08

TO SPE OF : ART UNIT 2176

SUBJECT : Request for Certificate of Correction for Appl. No.: 09796179 Patent No.: 7272788 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
You can fax the Directors/SPE response to 571-270-9990

_____
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: The amendments correct grammatical errors and do not affect the scope of the claims.

Doug Hutton
Supervisory Patent Examiner
Technology Center 2100

_____ **SPE**

2176 **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

COPY MAILED

MAR 2 2 2005

OFFICE OF PETITIONS

KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

In re Application of :
Bagdi, et al. : DECISION ON PETITION
Application No. 09/796,203 :
Filed: February 28, 2001 :
Atty. Dkt. No.: 2870/451 :

This decision is in response to the petition under 37 CFR 1.137(b), filed March 7, 2005.

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

This application became abandoned May 24, 2004 for failure to timely submit an appeal brief in compliance with 37 CFR 1.192 in response to the Notice of Appeal filed March 23, 2004. No petition for extension of time in accordance with 37 CFR 1.136(a) was timely submitted. This decision precedes Notice of Abandonment.

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

The instant petition has been reviewed and found in compliance with the provisions of 37 CFR 1.137(b). Accordingly, the failure to timely submit an appeal brief in compliance with 37 CFR 1.192 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 $2,160.00 extension of time fee submitted March 7, 2005 was subsequent to the maximum period obtainable for reply, this fee is unnecessary. The undersigned has directed that a refund be credited to deposit account No. 05-1320 on petitioner's behalf.

There is no indication that petitioner herein was ever empowered to prosecute the instant application. If petitioner desires to receive future correspondence regarding this application, the appropriate power of attorney documentation must be submitted. A

courtesy copy of this decision will be mailed to petitioner. However, all future correspondence will be directed to the address of record until such time as appropriate instructions are received to the contrary. In addition, the change of correspondence address submitted October 23, 2000 is not accepted because it was submitted by an attorney not of record in the application.

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.

This application file is being forwarded to Technology Center 1600 for further processing.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

CC: MEKALARADHA MASILAMANI
155 PINELAWN RD., SUITE 350 SOUTH
MELVILLE, NY 11747

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 6

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS MI 48303

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NOV 1 3 2003

OFFICE OF PETITIONS

In re Application of :
Voight, et al. :
Application No. 09/796,205 :
Filed: February 28, 2001 :
Attorney Docket No. 9539.000040 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed November 3, 2003, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply to the "Notice to File Missing Parts of Nonprovisional Application" ("Notice") mailed April 4, 2001. The Notice set an extendable period for reply of two months from its mailing date. No response was believed to have been received within the allowable period and the application became abandoned on June 5, 2001. A Notice of Abandonment was mailed on October 6, 2003.

The oath or declaration filed November 3, 2003, is noted and made of record.

The file is now 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) 305-0010.

Kenya A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

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Paper No. 11

Moser Patterson & Sheridan
595 Shrewsbury Avenue, Suite 100
Shrewsbury, NJ 07702

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OCT 0 6 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Michael D. Kennedy et al. :
Application No. 09/796,224 :
Filed: February 28, 2001 :
Attorney Docket No. STL 2923 :

This is a decision on the petition under 37 CFR 1.137(b) filed September 12, 2003, to revive the above-identified application under the provisions of 37 CFR 1.137(b).

The petition is granted.

The above-identified application became abandoned for failure to reply in a timely manner in reply to the non-final Office action mailed May 15, 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 August 16, 2002.

The application file is being forwarded to Technology Center AU 2859 for further processing.

Telephone inquiries concerning this decision may be directed to Technology Center AU 2859 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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RYAN KROMHOLZ & MANION, S.C.
POST OFFICE BOX 26618
MILWAUKEE WI 53226

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AUG 2 5 2005

OFFICE OF PETITIONS

In re Application of :
Cruise et al. :
Application No. 09/796,238 : DECISION GRANTING PETITION
Filed: February 28, 2001 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 1849.16102-B CON :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 21, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/140,017, filed August 26, 1998, as 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;
(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 nonprovisional application is submitted after expiration of the period specified by 37 CFR 1.78(a)(2)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(3).

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 nonprovisional 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 a proper 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 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 Paralegal Liana Chase at (571) 272-3282.

This matter is being referred to Technology Center Art Unit 3763 for appropriate action on the amendment filed June 21, 2005, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application.

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

ATTACHMENT: Corrected Filing Receipt

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SCULLY SCOTT MURPHY & PRESSER, PC
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SUITE 300
GARDEN CITY NY 11530

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OFFICE OF PETITIONS

In re Application of:
Kuniyuki OKUYAMA
Application No. 09/796,249
Filed: February 28, 2001
Attorney Docket No. 14365

DECISION ON PETITION

This is a decision on the petition, filed March 24, 2010, which is being treated as a petition under 37 CFR 1.181 (no fee), requesting withdrawal of the holding of abandonment in the above-identified application.

The petition is **GRANTED**.

This application was held abandoned for failure to timely respond to the non-final Office action of April 10, 2003, which set a three (3) month shortened statutory period for reply. A reply was due on or before July 10, 2003.

Petitioner states that a reply was in fact timely filed. To support this assertion, petitioner has submitted a copy of a return postcard which acknowledges receipt by the U.S. Patent and Trademark Office (USPTO) on July 14, 2003 (certificate of mailing date is July 10, 2003) of, *inter alia,* Amendment and Response, Figure 1, Substitute Specification and the fee. A copy of the previously submitted reply accompanies the petition.

The response acknowledged as having been received in the USPTO on July 14, 2003 is not of record in the application file and has not to date been located. However, MPEP 503 states that "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." Accordingly, it is concluded that the response was timely received in the USPTO but lost after receipt thereof.

In view of the above, the holding of abandonment is hereby withdrawn and the application restored to pending status.

The copy of the reply supplied with the petition will be accepted in place of the reply shown to have been received by the USPTO on July 14, 2003.

Telephone inquiries concerning this decision should be directed to Shahid Alam at (571) 272-6052 or in his absence to the undersigned at (571) 272-7099.

This application is being referred to Technology Center AU 2814 for appropriate action in the normal course of business on the reply received with petition.

David A. Bucci
Petitions Examiner
Office of Petitions

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Paper No: 8

EDWARD ETKIN, ESQ.
SUITE 3C
4804 BEDFORD AVENUE
BROOKLYN NY 11235

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OCT 17 2003
OFFICE OF PETITIONS

In re Application of:
Zakoshansky
Filed: 10 February, 2001
Application No. 09/796,276
Docket No.: 1007-7

ON PETITION

This is a decision on the petition filed herein via FAX on 25 September, 2003, under 37 C.F.R. §1.137(b) to revive the above-identified application.

The petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record indicates that:

- Petitioner failed to reply timely and properly to the final Office action on 26 April, 2002, with reply due (absent extension of time) 26 July, 2002;
- the application was deemed abandoned after midnight 26 July, 2002;
- Notice of Abandonment was mailed on 3 February, 2003;
- as indicated above, the instant petition (with fee) was filed via FAX on 25 September, 2003, and therewith the Petitioner made the statement of unintentional delay and submitted a reply in the form of a request for continued examination (with submission and fee).

The record (including the petition filed on 25 September, 2003) does not necessitate a finding that the delay between midnight 26 July, 2002, and 25 September, 2003, was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on Petitioner's (through Counsel Edward Etkin (Reg. No. 37,824)) duty of candor and good faith when accepting Petitioner's representation that the delay in filing the response was unintentional.[1]

CONCLUSION

Accordingly, in view of the showing and reply of Petitioner, the petition to revive under 37 C.F.R. §1.137(b) hereby is **granted**.

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

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

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[1] See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

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ROBERT W. BERGSTROM
OLYMPIC PATENT WORKS LLC
PO BOX 4277
SEATTLE, WA 98194

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OFFICE OF PETITIONS

In re Application of :
Dean A. Sleeper :
Application No. 09/796,323 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. 35003.001D1 :

This is a decision on the petition under 37 CFR 1.137(b) filed October 17, 2005, to revive the above-identified application.

The petition is GRANTED.

The Office acknowledges receipt of the Notice of Appeal filed October 17, 2005.

The 2-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.

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

This application is being referred to Technology Center AU 2173.

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

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OFFICE OF PETITIONS

FISH & RICHARDSON
P.O. BOX 1022
MINNEAPOLIS MN 55440-1022

In re Application of :
Adam T. Lake et al :
Application No. 09/796,331 : ON PETITION
Filed: February 28, 2001 :
Attorney Docket No. 10559-459001/P10870 :

This is a decision on the petition, filed December 20, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED.**

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

Petitioner is advised that the issue fee paid on October 31, 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 2676 will consider the request for continued examination under 37 CFR 1.114.

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

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

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

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OCT 3 1 2005

OFFICE OF PETITIONS

In re Patent No. 6,793,753 :
Issue Date: September 21, 2004 :
Application No. 09/796,378 : NOTICE
Filed: February 28, 2001 :
Attorney Docket No. 20174000260 :

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) 272-3223.

Marianne E. Jenkins
Petitions Examiner
Office of Petitions

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Paper No. 20

MARIA LUISA PALMESE
KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

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MAR 23 2004

OFFICE OF PETITIONS

In re Application of
Vesely (deceased) and DeSimone
Application No. 09/796,432
Filed: March 2, 2001
For: STRAINS OF BACTERIA AND PHARMACEUTICAL COMPOSITION etc.

: ON PETITION

This application has been referred to this office to treat the following communications: (1) filed or dated on or about July 10, 2003, by or on behalf of DeSimone sole: a revocation of the power of counsel of record (Oblon et al.) and appointment of power to Terzian and Dietze (Terzian et al.), and a letter of express abandonment signed by Terzian ; (2) filed or dated on or about July 17, 2003, by or on behalf of Simone sole, a petition under 37 CFR 1.313(a) to withdraw the application from issue; (3) filed or dated on or about July 17, 2003 (USPTO date stamped July 31, 2003), a petition filed by Oblon et al. under 37 CFR §§ 1.36, 10.70, 1.183 for withdrawal as counsel, (4) filed or dated on or about July 31, 2003 by or on behalf of Vesely a petition for the USPTO to refuse to recognize the Notice of Express Abandonment filed by or on behalf of Simone on July 10, 2003, (4) filed or dated on or about August 8, 2003, as supplemented or augmented by papers filed on or about August 12, 2003, or petitions under 37 CFR 1.182 filed on behalf of DeSimone seeking (a) withdrawal of the aforementioned letter of express abandonment, (b) that the USPTO force the withdrawal of representation by Oblon et al,(c) USPTO processing of the revocation (of Oblon et al.) and power (to Terzian et al. filed by or on behalf of DeSimone on July 10, 2003, (5) filed or dated on or about August 3, 2003, a petition under 37 CFR 1.182 filed on behalf of Vesely, requesting the USPTO refuse recognition of a revocation of power and Notice of Express Abandonment filed July 10, 2003, on behalf of DeSimone

After consideration of all papers filed by or on behalf of all parties, all petitions and requests are **dismissed** with exception of the following, and only the following, which are **granted**::

For Oblon *et al*:

While the death of Vesely operated to then revoke Vesely's power to Oblon *et al.*, see MPEP 409.01, to the extent that Oblon *et al.* require approval to withdraw as counsel(s) for either Vesely or DeSimone or both, such approval is **granted**. **See infra for the new correspondence address and coordinating counsel information**

For DeSimone:

In accordance with MPEP 402.10 and 37 CFR 1.182, the requested appointment of Terzian *et al* to represent DeSimone (but not Vesely or his heirs) is **granted** as of the mail date of this

decision. **See infra for the new correspondence address and coordinating counsel information.**

For Vesely:

(1) The intervention of the heirs of Vesely, while not compulsory, see MPEP 409.01(f), is under the facts of this allowed application, recognized on the record.
(2) In accordance with MPEP 402.10 and 37 CFR 1.182, the requested appointment of Palmese et al. (customer No. 23838) and the associated address to represent only the heirs of Vesely, who collectively represent the interest of Vesely constitute the interest of less than all the named inventors, is **granted** as of the mail date of this decision.

Manifestly, the USPTO cannot follow its usual practice of continuing to conduct correspondence with the attorney first named in the application, *i.e.*, Oblon et al. at the correspondence address of record. Accordingly, pursuant to 37 CFR 1.182, which authorizes the imposition of one or more conditions as a consequence of favorable treatment, the correspondence address of record will be that of Pamerey, et al. who will also be responsible for coordinating replies or submissions to the USPTO. See MPEP 402.10. It should be noted that as maintenance fees may be paid by anyone during the lifetime of the patent, both parties need not jointly agree to payment nor need both sign the maintenance fee transmittal.

Unfortunately, USPTO records currently cannot support more than one customer number per application, or additional counsel not associated with a given customer number (i.e., Terzian et al. The customer number for Palmese (and registration numbers of counsel associated with that customer number) has been accepted as the correspondence address (and counsel) of record. The appointment of all counsel having registration numbers specified in DeSimone's revocation and power (collectively) is accepted on the record as representing DeSimone only; however DeSimone's representatives are reminded that (1) they represent the interests only of DeSimone, who does not control the entire ownership[interest herein, (2) and that neither DeSimone nor his representatives may act unilaterally in this case, with the exception of payment of the maintenance fees.

Under separate cover, the withdrawal of Oblon et al., in their entirety will be acknowledged.

The new correspondence address is:

MARIA LUISA PALMESE
KENYON & KENYON
ONE BROADWAY
NEW YORK, NY 10004

Of course, if a court of competent jurisdiction makes a final determination of ownership and/or inventorship that differs from the current circumstance, such should be made of record at the same time that any conforming request(s) for changes in representation and/or correspondence address are made. Under the circumstances of this case, such a court order will have to be submitted for recordation at the USPTO.

In order to assure that all interests are properly and effectively represented, all further correspondence to the United States Patent and Trademark Office (USPTO) in this application--or resultant patent-- must be signed both by Palmese et al. who represent

Vesely's heirs, and by Terzian et al. who represent DeSimone, with the sole exception noted above: payment of maintenance fees and surcharge(s) during the life of the patent as such may be performed by any party without the permission of the [joint] patentee. See 37 CFR 1.366(a). Any registered practitioner signing any subsequent papers with the exception of maintenance fee and surcharge payments must indicate whom he or she represents.

All parties are reminded that dual correspondence is not permitted, and will not be undertaken by the USPTO. See 37 CFR 1.33(a).

DISCUSSION

While the USPTO does not wish to become involved in ownership disputes, it does attempt to preserve the rights of all parties to the extent it is able. See Rainer v. McPhail, 1899 C.D. 196, 197 (Comm'r Pat. 1899). Inspection of the declaration present on filing reveals that Vesely and DeSimone are named as joint inventors and jointly they appointed Oblon *et al.* as their counsel.

Inventorship is the starting point for determining ownership, see University Patents, Inc. v. Kligman, 762 F.Supp. 1212, 1218-19, 20 USPQ2d 1401, 1405 (E.D. Pa. 1991), and unless there is an assignment, the PTO will presume each of the named inventors to be the owner, see 37 CFR 3.73(a). As such, Since Vesely and DeSimone are jointly named as inventors, and as there is no USPTO record of any assignment of either inventor's rights title or interest to any other party(s), the USPTO will presume the named inventors are the joint owners of this application. See 37 CFR 3.73(a). As such neither owns the entire interest. See 37 CFR 3.71. However, only the owner of the *entire* interest in an application has the sole right to control prosecution of an application. See In re Goldstein, 16 USPQ2d 1963, 1964 (Comm'r Pat. 1988; see also In re Scold, 195 USPQ 335, 335 (Comm'r Pat. 1976); Ex parte Harrison, 1925 Dec. Comm'r Pat. 122, 123 (Comm'r Pat. 1924). The procedures set forth in the regulations (e.g., 37 CFR §§ 1.36, 3.71 and 3.73(b)) serve to assure that papers filed with the USPTO in an application or patent are submitted on behalf of the owner(s) of the *entire* interest in the application or patent. See Goldstein, 16 USPQ2d at 1964.

DeSimone's assertion of sole inventorship in this application does not overcome the presumption of joint inventorship, and it follows, joint ownership of this application, especially in view of the lack of agreement on the record by either Vesely or Vesely's heirs. Furthermore, while 37 CFR 1.34(b) authorizes the USPTO to accept and act on communications filed in an application or patent by a registered practitioner who is not of record, that regulation does not compel the USPTO to accept or act on such communication where there is a question as to whether that communication actually represents the interests of all the named inventors. See 37 CFR 1.34(b)("[f]urther proof of authority to act in a representative capacity may be required.").

In light of the unrefuted allegation of litigation between the parties, the petitions and all other requests filed by or on behalf of DeSimone sole, with the single exception of the request for separate representation by Terzian et al which has been granted as noted above are dismissed or otherwise will not be further acted upon as not having been filed in the interests of all named inventors.

To clarify the record, the rules of practice before the USPTO permit all applicants to appoint their choice of representative(s), but all applicants must appoint the same representative(s). See 37 CFR 1.31. Where, as here, the applicants (or their successor(s) in title) each seek to

appoint their own, but different, representative(s), such requires the filing of a petition under 37 CFR 1.182, which rule, by its terms, only applies where no other rule speaks to the question. See MPEP 410.02. Since it is discretionary with the Director to grant such a request(s) (or indeed any request) filed under 37 CFR 1.182, it follows that a revocation and/or appointment of power of attorney filed under the provisions of MPEP 410.02 is only effective upon the grant of the petition, and is not effective upon the mere filing of the petition.

Nevertheless, the timely payment of the issue fee by counsel who had not, at that time, been recognized as being of record by the USPTO is accepted under the provisions of 37 CFR 1.34(b), as such clearly tended to preserve the rights of all parties. Such a conclusion is reinforced by *e.g.*, noting DeSimone's subsequent petition for rescission of his earlier request for express abandonment.[1]

All parties are reminded that the USPTO will not undertake dual correspondence. See 37 CFR 1.33(a). On a one time basis only, all parties are being sent copies of this decision.

This allowed application is being forwarded to the Office of Publications.

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

cc:
Norman F. Oblon
Oblon, Spivak, McClelland, Maier, & Neustadt
1940 Duke Street
Alexandria VA 22314

cc:
Berj Terzian
Pennie & Edmonds
1667 K Street NW
Washington DC 20006

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[1]It should be noted that any express abandonment lacks force and effect unless it has been: (1) signed by counsel *of record*, and (2) timely acknowledged by an appropriate USPTO official. See 37 CFR 1.138(a); MPEP 711.01. Here, the express abandonment was signed by an attorney who was not *of record* within the meaning of 37 CFR 1.138 and, as it is now clear, did not represent the interests of all named inventors, and further, the express abandonment was never acknowledged by an appropriate USPTO official. See MPEP 711.01.

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FOLEY AND LARDNER LLP
SUITE 500
3000 K STREET NW
WASHINGTON DC 20007

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MAY 23 2006

OFFICE OF PETITIONS

In re Patent No. 6,996,489 :
Sakaguchi :
Issue Date: February 7, 2006 : LETTER REGARDING PTA
Application No. 09/796,451 :
Filed: March 2, 2001 :
Atty Docket No. 048369-0120 :

This letter is in response to the "COMMUNICATION REGARDING PATENT TERM ADJUSTMENT," filed January 25, 2006. Patentee requests that the determination of patent term adjustment under 35 U.S.C. § 154(b) be reviewed for accuracy.

The request for review of the determination of patent term adjustment (PTA) is **dismissed**.

On January 25, 2006, patentee submitted the instant comment. On February 7, 2006, the above-identified application matured into U.S. Patent No. 6,996,489, with a revised patent term adjustment of 908 days. Patentee states no basis for the request for review of the patent term adjustment.

A review of the application history supports a conclusion that the number of days adjusted for Office delay and the number of days reduced for Patentee's delay was correct. Patentee does not state a basis for their disagreement with the according of 908 days of PTA. A copy of the PAIR calculations for this application is enclosed. Patentee continues to be under a duty to advise the Office of any error in according too much PTA.

In view thereof, the revised Patent Term Adjustment remains nine hundred eight (908) days.

As this letter was submitted as an advisement to the Office of an error in Patentee's favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks patentee

for their good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to Files Repository.

Telephone inquiries specific to this matter should be directed to Denise Pothier, Petitions Examiner, at (571) 272-4787.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

enc: PAIR screen for U.S. Application No. 09/796,451

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : March 1, 2007

TO SPE OF : ART UNIT 2625

SUBJECT : Request for Certificate of Correction on Patent No.: 7075664 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
Certificates of Correction Branch
Tel. No. 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:

_____

_____

_____

_____

_____

_____ 2625
SPE **Art Unit**

OIPE IAP04
FEB 0 2 2007
PATENT & TRADEMARK OFFICE

00862.022137.

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Examiner: D. Tran
KOJI ARAI	Group Art Unit: 2624
Appl. No.: 09/796,547	
Filed: March 2, 2001	
For: IMAGE FORMING APPARATUS AND CONTROL METHOD THEREFOR CAPABLE OF DENSITY ADJUSTMENT	
U.S. Patent No.: 7,075,664 B2	
Issued: July 11, 2006	February 1, 2007

Yes, please enter
DT (05/03/07)

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

Certificate
FEB 0 6 2007
of Correction

REQUEST FOR
CERTIFICATE OF CORRECTION
UNDER RULES 322 AND 323

Sir:

It is respectfully requested that a Certificate of Correction be issued by the Patent and Trademark Office due to errors which appear in the printed patent as a result of Patent and Trademark Office mistakes, and mistakes of a clerical, typographical, or minor character, which were not the fault of the Patent and Trademark Office. A Certificate of Correction form, in duplicate, is enclosed.

Accompanying this letter is a check for $100.00 to cover the statutory fee for such Certificate of Correction.

02/02/2007 SZEWDIE1 00000113 7075664
01 FC:1811 100.00 OP

FEB 6 2007

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

DIKE BRONSTEIN ROBERTS & CUSHMAN
INTELLECTUAL PROPERTY PRACTICE GROUP OF
EDWARDS & ANGELL LLP
130 WATER STREET
BOSTON MA 02109

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DEC 18 2002

OFFICE OF PETITIONS

In re Application of :
Fried, et al. :
Application No. 09/796,571 : DECISION REFUSING STATUS
Filed: February 28, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 55680(71699) :

This is in response to the petition under 37 CFR 1.47(a), filed January 2, 2002. The Office apologizes for the delay.

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on February 28, 2001, without the filing fees or an executed oath or declaration. Accordingly, on April 13, 2001, the Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application. This Notice set a two month period for reply.

In reply, applicant filed the instant petition (and fee) and paid the filing fees together with the surcharge for late filing of the declaration. To make timely this petition, applicant purchased a five month extension of time and included a Certificate of Mailing dated November 13, 2001. Accompanying the petition were: 1) a declaration signed by inventors Nathaniel Fried, Ronald Berger, and Arkadiy Tsitlik, but lacking a signature from inventors Henry Halpern and Albert Lardo; 2) a declaration of facts from attorney Lisa Swiszcz Hazzard, and 3) copies of cover letters and e-mails to the nonsigning inventors (including Connie Bartosh - representative of assignee Johns Hopkins University), transmitting the 37 CFR 1.63 declaration, along with copies of assignment documents and small entity statements.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached after diligent effort 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. Rule 47 applicant has not met requirement (1) above.

As to requirement (1), applicant has not demonstrated that a copy of the **entire application papers (specification, including claims and drawings)** were sent for the nonsigning inventors' review. The record only establishes that a copy of the declaration, assignment papers, and small entity statements were forwarded for signature. Requiring that an inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted "ensures that the inventor is apprised of the application to which the oath or declaration is directed."[1]

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

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

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

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

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries regarding 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

cc: Dike, Bronstein, Roberts & Cushman, LLP
Intellectual Property Practice Group of
Edwards & Angell, LLP
P.O. Box 9169
Boston, MA 02209

[1] MPEP 409.03(d).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

DIKE BRONSTEIN ROBERTS & CUSHMAN
INTELLECTUAL PROPERTY PRACTICE GROUP OF
EDWARDS & ANGELL LLP
PO BOX 9169
BOSTON MA 02209

COPY MAILED

MAR 0 5 2003

OFFICE OF PETITIONS

In re Application of :
Fried, et al. :
Application No. 09/796,571 : DECISION REFUSING STATUS
Filed: February 28, 2001 : UNDER 37 CFR 1.47(a)
Attorney Docket No. 55680(71699) :

This is in response to the "Response to Decision Refusing Status Under 37 CFR 1.47(a)", filed January 21, 2003 (Certificate of Mailing dated January 14, 2003), which is being treated as a renewed petition under 37 CFR 1.47(a).

The renewed petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the nonsigning inventor. **Failure to respond will result in abandonment of the application**. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on February 28, 2001, without the filing fees or an executed oath or declaration. Accordingly, on April 13, 2001, the Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application. This Notice set a two month period for reply.

In reply, applicant filed a petition under 37 CFR 1.47(a) on January 2, 2002, and paid the filing fees together with the surcharge for late filing of the declaration. To make timely this petition, applicant purchased a five month extension of time and included a Certificate of Mailing dated November 13, 2001. Accompanying the petition were: 1) a declaration signed by inventors Nathaniel Fried, Ronald Berger, and Arkadiy Tsitlik, but lacking a signature from inventors Henry Halperin and Albert Lardo; 2) a declaration of facts from attorney Lisa Swiszcz Hazzard, and 3) copies of cover letters and e-mails to the nonsigning inventors (including Connie Bartosh - representative of assignee Johns Hopkins University), transmitting the 37 CFR 1.63 declaration, along with copies of assignment documents and small entity statements.

However, this petition was dismissed in a decision mailed on December 18, 2002. Petitioner did not demonstrate that a copy of the entire application papers had been sent to the nonsigning inventors for their review.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached after diligent effort 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. Rule 47 applicant has not met requirement (1) above.

On renewed petition, petitioner has submitted a copy of a declaration signed by all of the inventors.

However, the declaration will not be entered because it does not comply with 37 CFR 1.63(a)(3). The declaration fails to identify the citizenship of inventor Halperin.

The Change of Mailing Address submitted with the instant petition has been entered. Future correspondence concerning this application will be mailed to the above address of record.

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

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

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

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

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

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

Paper No. 13

EDWARDS & ANGELL LLP
PO BOX 9169
BOSTON MA 02209

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MAY 27 2003

OFFICE OF PETITIONS

In re Application of :
Fried, et al. :
Application No. 09/796,571 : DECISION NOTING JOINDER
Filed: February 28, 2001 : OF INVENTOR AND PETITION
Attorney Docket No. 55680(71699) : UNDER 37 CFR 1.47(a) MOOT

This is in response to the paper titled "Response to Decision Refusing Status Under 37 CFR 1.47(a)", filed May 12, 2003 (Certificate of Mailing dated May 5, 2003), and the 37 CFR 1.63 declarations filed January 21, 2003 and May 12, 2003.

The above-identified application was filed on February 28, 2001, without the filing fees or an executed oath or declaration. Accordingly, on April 13, 2001, the Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application. This Notice set a two month period for reply.

In reply, applicant filed a petition under 37 CFR 1.47(a) on January 2, 2002, and paid the filing fees together with the surcharge for late filing of the declaration. To make timely this petition, applicant purchased a five month extension of time and included a Certificate of Mailing dated November 13, 2001. Accompanying the petition were: 1) a declaration signed by inventors Nathaniel Fried, Ronald Berger, and Arkadiy Tsitlik, but lacking a signature from inventors Henry Halperin and Albert Lardo; 2) a declaration of facts from attorney Lisa Swiszcz Hazzard, and 3) copies of cover letters and e-mails to the nonsigning inventors (including Connie Bartosh - representative of assignee Johns Hopkins University), transmitting the 37 CFR 1.63 declaration, along with copies of assignment documents and small entity statements.

However, this petition was dismissed in a decision mailed on December 18, 2002. Petitioner did not demonstrate that a copy of the entire application papers had been sent to the nonsigning inventors for their review.

On renewed petition filed January 21, 2003, petitioner submitted a copy of a declaration signed by all of the inventors.

However, that declaration was not be entered because it did not comply with 37 CFR 1.63(a)(3). The declaration failed to identify the citizenship of inventor Halperin.

With the instant petition, petitioner has submitted a 37 CFR 1.63 declaration executed by Halperin, and in compliance with 37 CFR 1.63(a)(3).

In view of the **joinder** of the inventors, further consideration under 37 CFR 1.47(a) is not necessary and the petition is considered to be **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 is being forwarded to Technology Center 3700, Group Art Unit 3765, for prosecution.

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

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
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MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.
1800 DIAGONAL ROAD
SUITE 370
ALEXANDRIA VA 22314

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SEP 2 8 2006
OFFICE OF PETITIONS

In re Patent
Seki et al.
Application Number: 09/796,615
Patent: 7,035,264
Attorney Docket Number:
520.39806X00
Filing Date: March 2, 2001
Issue Date: April 25, 2006

DECISION ON PETITION

This is a decision on the petition under 37 CFR 3.81(b) 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**.

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

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

Charlema R. Grant

Charlema R. Grant
Petitions Attorney
Office of Petitions

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

MAILED

JAN 2 7 2005

Technology Center 2100

In re Application of: Maloney
Application No.: 09/796703
Filed: March 2, 2001
Attorney Docket No.: 2204-0040-2
For: INTERACTIVE MULTIMEDIA REPORT VIEWER

DECISION ON PETITION TO ACCEPT CORRESPONDENCE AS TIMELY FILED UNDER 37 CFR §1.8

This is a decision on the petition filed October 27, 2004 requesting to have an Information Disclosure Statement considered and acknowledged by the examiner.

The original Information Disclosure Statement (IDS) filed June 21, 2002 was never made of record in the file and there is no record of the IDS being received by the U.S. Patent and Trademark Office (USPTO).

In considering petitioners' submission under 37 CFR § 1.8(b), the correspondence will be considered timely filed if petitioners meet at least three conditions:

1. Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence.
2. Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
3. Includes a statement that attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

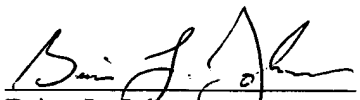
In support of the petition, Petitioner provides a copy of the Information Disclosure Statement filed on June 21, 2002 and the post card with a PTO stamp indicating receipt of the Information Disclosure Statement at the USPTO on June 21, 2002.

M.P.E.P. § 503 states:

A post card receipt which itemizes and properly identifies the items which are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO.

Accordingly, the petition is **GRANTED.**

The application is being forwarded to the Technology Center support staff for processing of the Information Disclosure Statement. After processing, the application will then be forwarded to the Examiner for appropriate action.



Brian L. Johnson
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security

1/19/05

MBS

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Commissioner for Patents
United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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Paper No. 18

HUMAN GENOME SCIENCES INC.
INTELLECTUAL PROPERTY DEPT.
14200 SHADY GROVE ROAD
ROCKVILLE MD 20850

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JUL 2 0 2004

OFFICE OF PETITIONS

In re Application of
Yanggu Shi et al
Application No. 09/796,844
Filed: March 2, 2001
Attorney Docket No. PF398P2

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3) AND
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the renewed petition filed May 12, 2004, which is being treated under 37 CFR 1.78(a)(3), 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 under 37 CFR 1.78(a)(6) for the claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional applications.

The petition is **Granted**.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) should not be construed as meaning that the instant application is entitled to the benefit of the filing date of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. §120 and 1.78(a)(1) and (a)(2) and under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(4) and (a)(5) must be met. 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.

Any questions concerning this matter may be directed to Karen Creasy at (703) 305-8859.

This application is being forwarded to Technology Center Art Unit 1646 for consideration by the examiner of the claim under 35 U.S.C. § §120 and 365(c) and 37 CFR 1.78(a)(2) for the benefit of the prior-filed applications, and for consideration of the claim under 35 U.S.C. §119(e) and 37 CFR 1.78(a)(5) for the benefit of the prior-filed provisional applications.

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Paper No. 16

HUMAN GENOME SCIENCES INC.
14200 SHADY GROVE ROAD
ROCKVILLE MD 20850

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MAR 1 2 2004

OFFICE OF PETITIONS

In re Application of
Yanggu Shi et al
Application No. 09/796,844
Filed: March 2, 2001
Attorney Docket No. PF398P2

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3) AND
: UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition filed August 1, 2003, under 37 CFR 1.78(a)(3), to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional applications, and on the petition under 37 CFR 1.78(a)(6) for the claim under 35 U.S.C. §119(e) for the benefit of priority to the prior-filed provisional applications set forth in the amendment filed August 1, 2003.

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 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 petition does not comply with item (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. Cross references to other related applications may be made when appropriate (*see* § 1.14).

The instant application was filed on March 2, 2001 and was pending at the time of filing of the instant petition.

The reference to the prior-filed nonprovisional applications was not included in the manner specified in 37 CFR 1.78(a)(2)(I) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2)(ii).

As to the benefit claim under 37 CFR 1.78(a)(6):

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the surcharge set forth in 37 CFR 1.17(t);

(2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional; and

(3) the reference to the prior filed provisional application supplied in an application data sheet (ADS)37 CFR 1.76) or as an amendment in the first sentence of the specification following the title. See 35 U.S.C. §119(e) and 37 CFR 1.78(a)(5)(I). The Commissioner may require additional information where there is a question whether the delay was unintentional.

The reference to the, prior-filed provisional applications was not included in the manner specified in 37 CFR 1.78(a)(5)(I) (i.e., in an ADS or in an amendment to the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(5)(ii).

The instant petition does not comply with item (3).

37 CFR 1.78(a)(2)(I) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(I) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See Manual of Patent Examining Procedure, 8th ed., (August 2001), Section 201.11, Reference to First Application. The amendment filed August 1, 2003 does not clearly state the relationship of the prior-filed applications to the instant application.

Additionally, since the issue fee has been paid; a petition to withdraw from issue and a request for continued examination under 37 CFR 1.114 are required for consideration by the examiner of the amendment submitted with the instant petition. See 37 CFR 1.313(c).

For the above-noted reason, the petition under 37 CFR 1.78(a)(3) and 37 CFR 1.78(a)(6) cannot be granted.

Further, a Change in Power of Attorney for the above-identified application was **inadvertently** mailed to you on **February 10, 2004.** The office sincerely apologize for any inconvenience caused by this matter.

Further correspondence with respect to the above should be addressed as follows:

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

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

By hand: Customer Window located at:

2011 South Clark Place
Crystal Plaza Two Lobby
Room 1B03
Arlington, VA 22202

Any telephone inquiries 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

#7
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

OCT - 2 2001

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OCT - 2 2001

Office of the Director
Group 3600

MALLINCKRODT & MALLINGCKRODT
Suite 510
10 Exchange Place
Salt Lake City, UT 84111

In re Application of : DECISION ON PETITION
Gregory G. Nelson, et.al. : TO MAKE APPLICATION
SERIAL NO: 09/796,851 : SPECIAL (AGE)
FILED: March 1, 2001
FOR: MULTI-FUNCTIONAL PORTABLE
FOLDING ROCKING CHAIR

This is a decision on your petition submitted on March 1, 2001, to make the above-referenced application special on the basis that applicant is over 65 years of age.

The petition has been found to comply with all requirements of section 708.02, part IV of the Manual of Patent Examining Procedures, and will be **GRANTED** for that reason.

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 examiner 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, throu out 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.

The application is being forwarded to the examiner for accelerated examination consistent with the provisions of section 708.02 of the MPEP.

Kenneth J. Dorner
Special Programs Examiner
Technology Center 3600

Rjb-9/26/01

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. 10

BEYER WEAVER & THOMAS LLP
P. O. BOX 778
BERKELEY, CA 94704-0778

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JUL 2 5 2003

OFFICE OF PETITIONS

In re Application of :
Jonathan D. Reid, et al. :
Application No. 09/796,856 :
Filed: February 28, 2001 :
Attorney Docket No. NOVLP073/NVLS-000360 :

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 to the non-final Office action mailed October 2, 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 January 3, 2003.

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

The application file is being forwarded to Technology Center 1700, Art Unit 1742 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 16

Lisa M. Soltis
Illinois Tool Works Inc.
3600 West Lake Avenue
Glenview, IL 60025

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DEC 1 8 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of
Walter J. Taylor, et. al.
Application No. 09/796,923
Filed: March 1, 2001
Attorney Docket No. 12754

This is a decision on the petition under 37 CFR 1.137(b), filed December 8, 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 April 8, 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 after midnight July 8, 2003.

In response to the final Office action, petitioner submitted with the instant petition $1,330 for the petition to revive fee, an amendment, $86 for an independent claim, and a Request for Continued Examination (RCE), along with $770 for the RCE filing fee.

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

Since the requirements for a grantable petition have been met, the petition is **GRANTED**.

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

The application file is being forwarded to Technology Center 3700, for further processing of the Request for Continued Examination under 37 CFR 1.114, and for consideration of the amendment.

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

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

CC: Lawrence J. Crain
Greer, Burns & Crain, Ltd.
300 South Wacker Drive
Suite 2500
Chicago, IL 60606

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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Paper No. 12

Date : July 28, 2003

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of **Application No. 09/796,924**

Applicant(s) : Frederick A. Ware et al
Application No. : 09/796,924
Filed : February 28, 2001

The above-identified application has been assigned Patent No. 6,600,682 and an issue date of July 29, 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 July 29, 2003:

> **"All reference to Patent No. 6,600,682 to Frederick A. Ware et al of California for ASYNCHRONOUS, HIGH-BANDWIDTH MEMORY COMPONENT USING CALIBRATED TIMING ELEMENTS appearing in the Official Gazette of July 29, 2003 should be deleted since no patent was granted."**

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

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

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Paper No. 16

LEE & HAYES PLLC
421 W. RIVERSIDE AVENUE, SUITE 500
SPOKANE, WA 99201

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JUL 2 8 2003

OFFICE OF PETITIONS

In re Application of
Frederick A. Ware et al
Application No. 09/796,924
Filed: February 28, 2001
Attorney Docket No. RB1-024US

: DECISION GRANTING PETITION
: UNDER 37 CFR 313(c)(2)

This is a decision on the petition, filed July 25, 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 June 5, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2818 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

[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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MEDLEN & CARROLL, LLP
101 HOWARD STREET
SUITE 350
SAN FRANCISCO CA 94105

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SEP 2 8 2006
OFFICE OF PETITIONS

In re Application of :
Tim :
Application No. 09/796,929 : DECISION ON PETITION
Filed: February 28, 2001 : TO WITHDRAW
Attorney Docket No. E-BX-04795 : 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 24, 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 Jason R. Bond on behalf of all attorneys of record who are associated with customer No. 23535.

All attorneys/agents associated with the Customer Number 23535 have been withdrawn.

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

It is noted that the change of address is not affected by this withdrawal. However, since all the attorneys of record have been withdrawn from this application and will no longer prosecute, it is necessitated that the address be changed to the first named inventor at the first cc: address below.

All future correspondence will be directed to the first named inventor Yoon Weng Tim at the address indicated below.

The request to change the correspondence of record is not acceptable as the requested correspondence address is not that of: (1) the first named signing inventor; or (2) an intervening assignee of the entire interest under 37 C.F.R 3.71. All future communications from the Office will be directed to the first named signing inventor at the first copied address below until otherwise properly notified by the applicant.

In order to request or take action in a patent matter, the assignee must establish its ownership of the patent to the satisfaction of the Director. In this regard, a Statement under 37 CFR 3.73(b) must have either: (i) documentary evidence of a chain of title from the original owner to the assignee (*e.g.*, copy of an executed assignment), and a statement affirming that 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 § 3.11; or (ii) a statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (*e.g.*, reel and frame number).

There is an outstanding Office action mailed August 25, 2006 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to April Wise at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: Yoon Weng Tim
1-16-02. No. 1 & 2 Persiaran Tanjung Bunga
Mutiara Towers
Tanjung Bunga 11200 Penang
MALAYSIA

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, DC 20231
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Paper No. 6

FRANK R. OCCHIUTI
FISH & RICHARDSON P.C.
225 FRANKLIN STREET
BOSTON MA, 02110-2804

MAIL

NOV 2 7 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of:)
Gregory D. Girard)
Application No.: 09/796,934)
Filed: February 28, 2001)
For: APPARATUS AND METHOD FOR)
TELEPHONY SERVICE INTERFACE TO)
SOFTWARE SWITCH CONTROLLER)

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed October 22, 2002.

A grantable request to withdraw as attorney of record should indicate thereon the present mailing addresses of the attorney(s) who is/are withdrawing from the record and of the applicant. The request for withdrawal must be signed by every attorney seeking to withdraw or contain a clear indication that one attorney is signing on behalf of another/others. A request to withdraw will not be approved unless at least 30 (thirty) days would remain between the date of approval and the later of the expiration date of a time to file a response or the expiration date of the maximum time period which can be extended under 37 C.F.R. § 1.136(a). The effective date of withdrawal being the date of decision and not the date of request. See M.P.E.P. § 402.06. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The signer of the petition, Frank R. Occiuti, is not appointed as an attorney or agent of record.

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

All future communications from the Office will continue to be directed to the above-listed address unless the Office receives proper notification of a change in Power of Attorney and/or correspondence address.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications & Information Processing

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Paper No. 9

ERIC L. PRAHL
FISH & RICHARDSON P.C.
225 FRANKLIN STREET
BOSTON MA 02110-2804

MAILED

MAR 2 4 2003

Technology Center 2600

In re Application of :
Gregory D. Girard :
Application No. 09/796,934 :
Filed: February 28, 2001 :
For: **APPARATUS AND METHOD FOR TELEPHONY SERVICE INTERFACE TO SOFTWARE SWITCH CONTROLLER** :

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the request to withdraw as attorney/agent of record filed on March 5, 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 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: IPERIA, INC.
77 South Bedford Street
Burlington, MA 01803

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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WASHINGTON, D.C. 20231
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JAN 14 2003

Technology Center 2100

Paper No. 7

Squire, Sanders & Dempsey L.L.P.
Two Renaissance Square
40 N. Central Avenue, Suite 2700
Phoenix, AZ 85004-4498

In re Application of: Zhi Wang, et al.	)	
Application No. 09/796,945	)	
Filed: February 28, 2001	)	
For: SYSTEM AND METHOD FOR TRANSCODING INFORMATION FOR AN AUDIO OR LIMITED DISPLAY USER INTERFACE	)	**DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed December 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 **GRANTED**.

Because no request was made for a change in correspondence address, all future communications from the United States Patent and Trademark 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.

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

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Paper No. 14

PILLSBURY WINTHROP LLP
725 S FIGUEROA STREET
SUITE 2800
LOS ANGELES CA 90017

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OFFICE OF PETITIONS

In re Application of	:	
Michael Metcalf	:	
Application No. 09/796,946	:	ON PETITION
Filed: March 1, 2001	:	
Attorney Docket No. 80039-250512	:	

This is a decision on the petition to revive the above-identified application under 37 CFR 1.137(b), filed June 1, 2004.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to timely a proper reply to the final Office action mailed May 21, 2003. 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 application became abandoned on August 22, 2003. A Notice of Abandonment was mailed on December 31, 2003.

With the instant petition, petitioner paid the petition fee, filed a reply in the form of an RCE and amendment, and made the proper statement of unintentional delay.

There is no indication that the person signing the present petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. If the person signing the present petition desires to receive future correspondence regarding this application, the appropriate power of attorney or authorization of agent and change of correspondence address must be submitted. While a courtesy copy of this decision is being mailed to the person signing the present petition, all future correspondence will be directed to the address currently of record until such time as appropriate instructions are received to the contrary.

The application file is being forwarded to Group Art Unit 2645 for consideration of the RCE and the submission under 37 CFR 1.114, an amendment filed June 1, 2004.

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

Cliff Congo
Petitions Attorney
Office of Petitions

cc: Hardy Myers
27121 Towne Centre Drive
Suite 210
Foothill Ranch, California 92610

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Alexandria, VA 22313-1450
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KAROLINE K.M. SHAIR, PH.D.
CHOATE, HALL & STEWART,
EXCHANGE PLACE
53 STATE STREET
BOSTON MA 02109

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OCT 0 8 2004

OFFICE OF PETITIONS

In re Application of	:	
Samuel J. Danishefsky et al	:	
Application No. 09/796,959	:	ON PETITION
Filed: March 1, 2001	:	
Attorney Docket No. 2003080-0080 (SK-744-B-Z)	:	

This is a decision on the petition, filed October 4, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on April 19, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 1626 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).

UNITED STATES PATENT AND TRADEMARK OFFICE

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KAROLINE K.M. SHAIR, PH.D.
CHOATE, HALL & STEWART, EXCHANGE PLACE
53 STATE STREET
BOSTON MA 02109

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OFFICE OF PETITIONS

In re Application of	:	
Dainishefsky et al	:	
Application Number: 09/796,959	:	
Patent: 6,867,305		
Attorney Docket Number: 2003080-0080	:	
Filing Date: March 1, 2001	:	
Issue Date: March 15, 2005	:	DECISION ON PETITION
	:	

This is a decision on the petition to correct the name of the assignee under 37 CFR 1.183 filed on June 3, 2005. The petition is properly treated under 37 CFR 3.81 (b)[1] to correct the name of the assignees on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **Granted** to the extent outlined above.

Deposit account no. 03-1721 will be charged the $100.00 certificate of correction fee.

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

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

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JJGJR.: 03-06

Paper No: __

WILSON SONSINI GOODRICH & ROSATI
650 PAGE MILL ROAD
PALO ALTO CA 94304-1050

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OFFICE OF PETITIONS

In re Application of
Goldszmidt, et al. :
Application No. 09/797,006 :
Filing Date: 28 February, 2001
Attorney Docket No. 22436-713 :

This is a decision on the petition filed on 7 February, 2006, to revive the instant application 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

For the reasons set forth below, the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the non-final Office action mailed on 24 September, 2004, with reply due absent extension of time on or before 24 December, 2004;
- the instant application went abandoned after midnight 24 December, 2004;
- the Office mailed the Notice of Abandonment on 10 May, 2005;
- with the instant petition and fee, Petitioner filed an amendment as the required reply and made the statement of unintentional delay.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).[1]

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.[2]

Delays in responding properly raise the question whether delays are unavoidable.[3] Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).[4] And the Petitioner must be diligent in attending to the matter.[5] Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.[6]))

Allegations as to Unintentional Delay

A grantable petition under 37 C.F.R. §1.137(b) requires a petition, fee, statement of unintentional delay, reply, and a terminal disclaimer and fee if appropriate.

---

[1] 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[2] Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

[3] 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).

[4] See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

[5] See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

[6] Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

Petitioner has satisfied the requirements of the regulation.

The record (including the petition filed on 7 February, 2006) does not necessitate a finding that the delay between midnight 24 December, 2004 (date of abandonment), and 7 February, 2006 (date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on duty of candor and good faith of Petitioner's Counsel Daniel D. Ledesma (Reg. No. 57,181) when accepting Petitioner's representation that the delay in filing the response was unintentional.[7]

CONCLUSION

The petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to Technology Center 2100 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.

John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[7] See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

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COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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#10

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OCT 1 2003

Office of the Director
Group 3600

TAYLOR & AUST P C
142 S Main St
P O Box 560
Avilla IN 46710

Paper No 10

In re Application of
Susan Sharpe
Application No. 09/797011
Filed: March 1, 2001
For: ANIMAL GARMENT

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

The paper filed July 9, 2003 has been treated as a Petition to Withdrawal the Holding of Abandonment.

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

☐ Postcard receipt being dated_____

☐ USPTO return facsimile receipt dated _____.

☒ Certificate of Mailing/Transmission signed on September 13, 2002 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 examiner for appropriate action.

en/9/24/03

STEVEN N. MEYERS
SPECIAL PROGRAM EXAMINER
TECHNOLOGY CENTER 3600

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WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA PA 19104-2891

MAILED

MAY 20 2009

OFFICE OF PETITIONS

ON PETITION

In re Application of
Ganesan
Application No. 09/797,017
Filed: March 1, 2001
Attorney Docket No. MSFT-0248/148522.1
For: SPECIFYING RIGHTS IN A DIGITAL RIGHTS LICENSE ACCORDING TO EVENTS

This is a decision on the petition under 37 CFR 1.181, filed May 7, 2009, requesting that the Office withdraw the holding of abandonment in the above-identified application.

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

On September 21, 2007, the Board of Patent Appeals and Interferences affirmed the rejection of claims 28, 35, and 41 under 35 U.S.C. 101 as being directed to non-statutory subject matter and affirmed the rejection of claims 24-33, 35-44 and 68-82 under 35 U.S.C. 102(e) as being anticipated by Krishnan, et al.(U.S. Patent 6,073,124). In addition, the Board provided new grounds of rejection. Applicant was given a 2 month period to either reopen prosecution or to request a rehearing.

Applicant filed an amendment on November 21, 2007 to re-open prosecution.

On May 12, 2008, the Office mailed a Notice of Abandonment because the 2 month period for seeking court review of the September 21, 2007 decision had expired and no claim was allowed.

Petitioner argues that the application is not abandoned because the November 21, 2007 amendment is a proper follow-up submission to the Board's September 21, 2007 decision.

Per MPEP 1214.01 [R-3] Procedure Following New Ground of Rejection by Board:

> When the Board makes a new rejection under 37 CFR 41.50(b), the appellant, as to each claim so rejected, has the option of:

(A) reopening prosecution before the examiner by submitting an appropriate amendment and /or new evidence (37 CFR 41.50(b)(1)); or
(B) requesting rehearing before the Board (37 CFR 41.50(b)(2)).

The amendment and/or new evidence under 37 CFR 41.50(b)(1), or the request for rehearing under 37 CFR 41.50(b)(2), must be filed within 2 months from the date of the Board's decision.

I. SUBMISSION OF AMENDMENT OR NEW EVIDENCE states:

37 CFR 41.50(b)(1) provides that the application will be remanded to the examiner for reconsideration if the appellant submits "an appropriate amendment" of the claims rejected by the Board, "or new evidence relating to the claims so rejected, or both." An amendment is "appropriate" under the rule if it amends one or more of the claims rejected, or substitutes new claims to avoid the art or reasons adduced by the Board. Ex parte Burrowes, 110 O.G. 599, 1904 C.D. 155 (Comm'r Pat. 1904). Such amended or new claims must be directed to the same subject matter as the appealed claims. Ex parte Comstock, 317 O.G. 4,1923 C.D. 82 (Comm'r Pat.1923).

Petitioner argues that the November 21, 2007 amendment is a proper reply because it is in compliance with 37 CFR 41.50(b)(1). Petitioner states that the amendment is appropriate because it cancels the appealed claims, substitutes new claims to avoid the art or reasons adduced by the Board, and the new substitute claims are directed to the same subject matter as the appealed claims.

The November 21, 2007 amendment appears to be a timely and proper follow-up submission to the September 21, 2007 Board decision. The petition under 37 CFR 1.181 is **granted** and the May 12, 2008 Notice of Abandonment is **vacated**. No petition fee has been or will be charged in connection with this matter.

This application is being returned to Technology Center A.U. 2164 for the examiner's consideration of the amendment filed on November 21, 2007.

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

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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MARINA PORTNOVA
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN, LLC
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085

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SEP 29 2006

OFFICE OF PETITIONS

In re Application of :
Raffel et al. :
Application No. 09/797,053 : DECISION ON PETITION
Filed: February 27, 2001 : TO WITHDRAW
Attorney Docket No. 005306.P111 : 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 May 25, 2006

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Blakely, Sokoloff, Taylor & Zafman, LLC has been revoked by the assignee of the patent application on August 18, 2006. 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 April Wise at 571-272-1642.

April M. Wise
Petitions Examiner
Office of Petitions

cc: Sam Campbell
Campbell, Stephenson Asocolese, LLP
4807 Spicewood Spring Road
Bldg. 4, Suite 201
Austin TX 78759

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CSA LLP
4807 SPICEWOOD SPRINGS RD.
BLDG. 4, SUITE 201
AUSTIN TX 78759

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OCT 0 2 2006

OFFICE OF PETITIONS

In re Application of
Raffel, et al.
Application No. 09/797,053
Filed: February 27, 2001
Attorney Docket No. 5306.P111

DECISION DISMISSING PETITIONS
UNDER 37 CFR 1.78(a)(3)

This is a decision on the petition under 37 CFR §§ 1.78(a)(3), filed May 3, 2006, to accept an unintentionally delayed claim under 35 USC 20 and 365(c) for the benefit of priority to the prior-filed nonprovisional and PCT applications set forth in the concurrently filed amendment.

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 and 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) and 1.78(a)(5)(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 where there is a question whether the delay was unintentional.

The petition does not comply with item (1).

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.78(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent

nonprovisional application. *See* MPEP Section 201.11, Reference to Prior Nonprovisional Applications. The amendment fails to comply with the provisions of 37 CFR 1.78(a)(2)(i) and is therefore unacceptable.

Before the petition under 37 CFR 1.78(a)(3) can be granted, a renewed petition and either an Application Data Sheet or a substitute amendment (complying with the provisions of 37 CFR 1.121 and 37 CFR 1.76(b)(5)) to correct the above matters are required.

As to item (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 appearing in the petition varies from the required language, the statement is being construed as the statement required by 37 CFR §1.78(a)(3). If this is not a correct reading of the statement appearing in the petition, petitioner should promptly notify the Office.

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 Petitions Attorney Alesia M. Brown at (571) 272-3205.

FRANCES HICKS
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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CAMPBELL STEPHENSON LLP
11401 CENTURY OAKS TERRACE
BLDG. H, SUITE 250
AUSTIN TX 78758

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SEP 27 2007

OFFICE OF PETITIONS

In re Application of :
Raffel, et al. :
Application No. 09/797,053 : DECISION ON PETITION
Filed: February 27, 2001 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. OIC0062US :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed May 14, 2007, to accept an unintentionally delayed claim under 35 U.S.C. §§ 120 and 365(c) for the benefit of priority to prior-filed international Application No. US/99/19766, filed August 27, 1999, as set forth in the accompanying amendment.

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 priority under 35 U.S.C. §§ 120 and 365(c) 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 the application is entitled to the benefit of the prior-filed application. In order for the application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. §§ 120 and

365(c) 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 application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Alesia M. Brown at (571) 272-3205. 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 3600 for consideration of applicant's entitlement to claim benefit of priority under 35 U.S.C. §§ 120 and 365(c) to the above-noted, prior-filed PCT application.

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
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APPL NO.	FILING OR 371(c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	TOT CLMS	IND CLMS
09/797,053	02/27/2001	3623	5254	OIC0062US	103	7

CONFIRMATION NO. 7627

CORRECTED FILING RECEIPT

OC000000026030632

60975
CAMPBELL STEPHENSON LLP
11401 CENTURY OAKS TERRACE
BLDG. H, SUITE 250
AUSTIN, TX 78758

Date Mailed: 09/26/2007

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

Applicant(s)

Keith Raffel, Palo Alto, CA;
Robert M. Schulman, Atherton, CA;
Dixie Baker, Carmel, CA;
Robert E. Currie, Hollywood, MD;
Christine Currie, Hollywood, CA;

Power of Attorney: The patent practitioners associated with Customer Number **60975**.

Domestic Priority data as claimed by applicant

This application is a CON of PCT/US99/19766 08/27/1999
which claims benefit of 60/098,194 08/27/1998

Foreign Applications

If Required, Foreign Filing License Granted: 06/11/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/797,053

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Method and apparatus for network-based sales force management

Preliminary Class

705

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

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

date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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

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

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Clarence A. Green
Perman & Green
425 Post Road
Fairfield CT 06430

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AUG 0 7 2007

OFFICE OF PETITIONS

In re Application of :
Rotola-Pukkila, et al. :
Application No. 09/797,115 : ON PETITION
Filed: March 1, 2001 :
Attorney Docket No. 297-010141-US (PAR) :
For: SPEECH DECODER AND A METHOD FOR DECODING SPEECH

This is a decision on the petition under 37 CFR 1.181, filed August 24, 2006, to withdraw the holding of abandonment in the above-identified application.

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

The Office contended that the above-identified application became abandoned for failure to submit a reply to the July 1, 2005 final Office action, which set a three month extendable period for reply. No extensions of time or reply being received, the Office contended that this application became abandoned on October 2, 2005. The filing of the present petition precedes the mailing of A Notice of Abandonment.

Petitioners allege that the July 1, 2005 final Office action was not received at the correspondence address of record.

The showing required to establish non-receipt 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]

[1] See notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

Petitioners have submitted a copy of the docket records where the requirement would have been entered had the July 1, 2005 final Office action been received. In addition, practitioner referenced the record in the petition and stated that a review of the application's file for the July 1, 2005 final Office action was fruitless. Petitioners have submitted incoming daily mail logs for the period of July 1, 2005 to August 16, 2005 and a declaration from the docketing clerk for Perman & Green, LLP to further support the allegation of non-receipt.

Petitioners have established non-receipt. The petition is **granted** and the holding of abandonment is withdrawn.

After the mailing of this decision, the application will be returned to Technology Center AU 2626 for the re-mailing of the July 1, 2005 final Office action with a new period set for reply.

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

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
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FEB 4 2002

#6

HAMILTON, BROOK, SMITH
& REYNOLDS, P.C.
530 VIRGINIA ROAD
P.O. BOX 9133
CONCORD, MA 01742-9133

In re Application of	:	
Horace W. Furumoto et al	:	DECISION ON PETITION
Serial No.: 09/797,124	:	
Filed: March 1, 2001	:	
For: Laser Treatment of Wrinkles	:	

This is in response to applicants' petition filed ~~October 16, 2001~~ Dec. 7, 2001, to make the above-identified application special under the provisions of 37 CFR 1.102(c), based on the age of the applicant.

Applicant has satisfied the provisions set forth in M.P.E.P. 708.02, IV. Therefore the petition is **GRANTED**.

The application will be forwarded to the examiner for action on the merits commensurate with this decision.

Should there be any questions with regard to this letter please contact John Kittle by letter addressed to the Director, Technology Center 3700/2900, Washington, DC 20231, or by telephone at (703) 308-0873 or by facsimile transmission at (703) 308-3139.

John E. Kittle
Director
Technology Center 3700/2900

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DEC 1 8 2002

Technology Center 2100

Paper No. 7

Skjerven Morrill LLP
25 Metro Drive
Suite 700
San Jose, CA 95110

In re Application of: Amr M. Mohsen	)	
Application No. 09/797,159	)	
Filed: February 28, 2001	)	**DECISION ON REQUEST FOR**
For: FIELD PROGRAMMABLE PRINTED CIRCUIT BOARD	)	**WITHDRAWAL AS ATTORNEY**

This is a decision on the Request To Withdraw from Representation filed November 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. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

The request is **GRANTED**.

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

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

cc: Alan MacPherson
MacPherson Kwok Chen Heid LLP
2001 Gateway Pl., Suite 195
San Jose, CA 95110

UNITED STATES PATENT AND TRADEMARK OFFICE

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BANNER & WITCOFF
1001 G STREET N W
SUITE 1100
WASHINGTON DC 20001

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MAR 0 9 2006

OFFICE OF PETITIONS

In re Application of :
Amr M. Mohsen :
Application No. 09/797,159 : DECISION ON PETITION
Filed: 28 February, 2001 :
Atty Docket No. 003921.00246 :

This is a decision on the petition filed on 23 September, 2005, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 24 March, 2005, for failure to timely file a response to the non-final Office action mailed on 23 December, 2004, which set a three (3) month shortened statutory period for reply. Notice of Abandonment was mailed on 27 June, 2005.

---

[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.

The revocation and power of attorney filed on 18 January, 2006, cannot be accepted because (a) it does not include a statement that the person who signed the paper is authorized to act on behalf of the assignee and (b) because a chain of title from the inventor(s) to the current assignee has not been provided. Specifically, the power of attorney shows an assignment from Aptix Corporation to Mentor Graphics Corporation, but there is no showing of the chain of title from the inventor to Aptix Corporation. A new revocation and power of attorney in accordance with 37 CFR 3.73(b) should be filed.

This application is being referred to Technology Center 2128 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

Encl: Statement Under 37 CFR 3.73(b)

#7
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

JUL 14 2003

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JUL 14 2003

OFFICE OF THE DIRECTOR
TC 3600

Alston & Bird, LLP
Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000

In re Application of
Dennis Barts et al.
Application No. 09/797,168
Filed: February 28, 2001
For: DELIVERY SYSTEM AND METHOD FOR VEHICLES AND THE LIKE

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 April 21, 2003.

The petition is **GRANTED**.

A review of the file record indicates that an Office action, setting a one-month shortened statutory period for reply, was mailed on October 7, 2002. Since no timely response to the October 7, 2002 Office action was received before the expiration of the six month statutory period for reply, the application was held to be abandoned, although a Notice of Abandonment has yet been mailed.

Applicants' petition includes a copy of a response having a certificate of mailing dated November 6, 2002 contained on a separate sheet. MPEP 512 states "[w]hen the certification is presented on a separate sheet, that sheet must ... fully identify ... the paper it accompanies. The required identification should include ... the type of paper being filed, e.g., reply to rejection or refusal, Notice of Appeal, etc. Moreover, without the proper identifying data, a certification presented on a separate sheet will not be considered acceptable if there is any question or doubt concerning the connection between the sheet and the paper filed." Since, the certification fails to fully identify the paper as a response to the restriction requirement, there is nothing to "tie-in" the response to the certification. Thus, the certification is unacceptable.

Applicants' petition also includes a copy of a post card identifying the response and which included a USPTO Mail Room receipt date of November 13, 2002. However, the receipt date is after the expiration of the shortened statutory period for reply, which expired on November 6, 2002. A one-month extension of time is required in order for the response to be timely. Included in the response is a request for an extension of time and a charge authorization to petitioner's deposit account.

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 with instructions to charge petitioner's deposit account number 16-0605 the required $110 for a one-month extension of time before entering the response filed with the petition, then to the Examiner for prompt action on merits.

Steven N. Meyers, Special Programs Examiner
Patent Technology Center 3600
Telephone No.: (703) 308-3868
Facsimile No.: (703) 605-0586

SNM/tpl: 7/10/03

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WASHINGTON DC 20005

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OFFICE OF PETITIONS

In re Application of :
Osborne, Nicholas D. :
Application No. 09/797,181 :
Filed: March 2, 2001 :
Attorney Docket No. 1517-0120000/JAG/TJS :

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 June 16, 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 Linda E. Horner. Linda E. Horner has been withdrawn as attorney of record; all other attorneys remain of record.

The correspondence address of record remains unchanged.

The application became abandoned for failure to timely reply to the Office action mailed March 30, 2006.

Telephone inquires concerning this decision should be directed to the undersigned at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Liana Walsh
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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Paper No. 8

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SEP 1 5 2003

OFFICE OF PETITIONS

In re Application of
Scott C. Johnson et al
Application No. 09/797,195
Filed: March 1, 2001
Attorney Docket No. SURG:146

:DECISION ON PETITIONS
:UNDER 37 CFR 1.181; 37
:CFR 1.183 AND 37 CFR
:1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 4, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.
>
> (iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/45836 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

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[1] Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001) prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 4, 2002, 78 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official Gazette with

regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 4, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 4, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C.

> 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 4, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the USPTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the USPTO 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 Nonpublication Request which sets forth the projected publication date of December 25, 2003 accompanies this decision on petition.

Telephone inquiries regarding this decision should be directed to Frances Hicks at (703) 305-8680.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for
Brian Hearn
Senior 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
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Paper No. 9

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FEB 2 6 2004

OFFICE OF PETITIONS

In re Application of	:	
Roger K. Richter, et al.	:	DECISION ON PETITIONS
Application No. 09/797,197	:	UNDER 37 CFR 1.181,
Filed: March 1, 2001	:	37CFR 1.183 AND
Attorney Docket No. SURG:131	:	37 CFR 1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001 . With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 11, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.

(iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/45518 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

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[1] Emphasis added.

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b) provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on

October 18, 2001) prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 11, 2002, 85 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official Gazette with regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 11, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 11, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is

> rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C. 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 11, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U6S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing

implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the USPTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the USPTO 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.

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

This application is being forwarded to Technology Center AU 2155 for examination in due course.

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
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Paper No. 8

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SEP 15 2003

OFFICE OF PETITIONS

In re Application of
Scott C. Johnson, et al.
Application No. 09/797,199
Filed: March 1, 2001
Attorney Docket No. SURG:129

:DECISION ON PETITIONS
:UNDER 37 CFR 1.181; 37
:CFR 1.183 AND 37 CFR
:1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 3, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.
>
> (iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/46214 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

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[1] Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001 prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 3, 2002, 77 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official Gazette with

regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 3, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 3, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C.

> 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 3, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the US 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 Nonpublication Request which sets forth the projected publication date of December 25, 2003 accompanies this decision on petition.

Telephone inquiries regarding this decision should be directed to Sherry Brinkley at (703) 305-9220.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for
Brian Hearn
Senior 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
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Paper No. 13

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SEP 1 5 2003

OFFICE OF PETITIONS

In re Application of
Scott C. Johnson et al
Application No. 09/797,200
Filed: March 1, 2001
Attorney Docket No. SURG:130

:DECISION ON PETITIONS
:UNDER 37 CFR 1.181; 37
:CFR 1.183 AND 37 CFR
:1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 3, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.
>
> (iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/46217 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

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[1] Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001) prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 3, 2002, 77 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official Gazette with

regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 3, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 3, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C.

> 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 3, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the USPTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the USPTO 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.

Telephone inquiries regarding this decision should be directed to Frances Hicks at (703) 305-8680.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for
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
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OFFICE OF PETITIONS
ON PETITION

SEED INTELLECTUAL PROPERTY LAW GROUP
701 FIFTH AVENUE, SUITE 6300
SEATTLE, WASHINGTON 98104-7092

In re Application of
Valerio Pisati et al
Application No. 09/797,204
Filed: February 27, 2001
Attorney Docket No. 856063.680

This is a decision on the petition, filed by facsimile transmission on August 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 August 5, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2816 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, D.C. 20231
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Paper No. 8

Boyle Fredrickson Newholm Stein & Gratz, SC
250 E. Wisconsin Ave.,
Suite 1030
Milwaukee, WI 53202

APR 28 2003

In re Application of:	:	
Turner et al.	:	NOTICE OF WITHDRAWAL
Application No. 09/797,231	:	FROM ISSUE
Filed: March 1, 2001	:	UNDER 37 CFR § 1.313
Attorney Docket No. 297.002	:	

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 above-identified application is hereby withdrawn from issue. The Notice of Allowance and Issue Fee Due and the Notice of Allowability mailed October 31, 2002, are hereby vacated.

The application is being withdrawn for consideration of pertinent references submitted with the IDS filed December 2, 2002.

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.

Telephone inquiries should be directed to Nestor R. Ramirez at (703) 308-1371.

The above-identified application is being forwarded to the examiner for prompt appropriate action.

Richard K. Seidel, Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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QWEST COMMUNICATIONS INTERNATIONAL INC
LAW DEPT INTELLECTUAL PROPERTY GROUP
1801 CALIFORNIA STREET, SUITE 3800
DENVER, CO 80202

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JUN 09 2006

OFFICE OF PETITIONS

In re Application of :

Verbil, et al. :

Application No. 09/797,242 : DECISION ON PETITION

Filed: March 1, 2001 :

Attorney Docket No. 1829 USW
0625PUS

This is a decision on the petition under 37 CFR 1.137(b), filed February 8, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-cited application became abandoned for failure to reply in a timely manner to the final Office action mailed March 17, 2005, which set a shortened statutory period for reply of three (3) months. A response was filed on June 20, 2005. An Advisory Action was mailed on July 8, 2005, informing applicant that the response of June 20, 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 June 18, 2005.

Examiner Nguyen has determined that the amendment filed February 8, 2006, places the application in condition for allowance.

The address cited on the petition differs from the address of record. Although a courtesy copy of this decision is being mailed to the address cited on the petition, all future correspondence will be mailed solely to address of record until appropriate written instructions to the contrary are received.

The application is being forwarded to Technology Center 2600, GAU 2616 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

cc:
Mark D. Chuey, Ph.D.
Brooks Kushman, PC
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238

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

MR. PETER F. CORLESS
EDWARDS & ANGELL, LLP
130 WATER STREET
BOSTON, MA 02109-4280

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NOV 0 6 2001

OFFICE OF PETITIONS

In re Application of :
Lin, et al. :
Application No. 09/797,282 : DECISION GRANTING
Filed: February 28, 2001 : PETITION
Attorney Docket No. 55638 (71987) :

This is a decision on the petition under 37 CFR 1.10(c) filed April 27, 2001, requesting that the above-identified application be accorded a filing date of February 28, 2001, instead of the presently accorded date of March 2, 2001.

Petitioners allege that the application was deposited in "Express Mail" service with the United States Postal Service (USPS), on February 28, 2001. In support, petitioners provided a copy of the Express Mail label, receipt no. EL835032093US, showing a Date-In of February 28, 2001. The same Express Mail receipt number was listed on the itemized New Application Transmittal letter. Petitioners request that the application be accorded a filing date of February 28, 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 February 28, 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 February 28, 2001 and issuance of a corrected filing receipt.

Thereafter, the application will be forwarded to Technology Center 1600 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
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Townsend and Townsend and Crew, LLP
Two Embarcadero Center
Eighth Floor
San Francisco, CA 94111-3834

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MAY 31 2006

OFFICE OF PETITIONS

In re Application of:
Yaniv Gvily
Application No.: 09/797,318
Filing Date: March 01, 2001
Attorney's Docket No.: 17900-001710US
For: ADDING DATA TO TEXT PAGES BY MEANS OF AN INTERMEDIARY PROXY

DECISION ON PETITION FOR REVIVAL OF ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed February 21, 2006, to revive the above-entitled application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed June 14, 2005, which set a shortened period for reply of three (3) months. While a timely reply was filed on December 19, 2005, bearing an executed certificate of mailing dated December 14, 2005, that reply did not prima facie place this application in condition for allowance as indicated by the Advisory Action of January 26, 2006. No extension of time under the provisions of 37 CFR 1.1376(a) were obtained and an Notice of Appeal was not filed. Accordingly, by operation of law, the above-identified application became abandoned on September 14, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a Request for Continued Examination (RCE); (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of June 14, 2005 is accepted as having been unintentionally delayed.

The applicaiton file is being referred to Technology Center AU 2144.

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

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of Petitions/Office of PCT Legal Administration
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

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

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JUN 29 2007

OFFICE OF PETITIONS

In re Application of :
Yaniv GVILY :
Application No. 09/797,318 : DECISION ON PETITION
Filed: March 1, 2001 : TO WITHDRAW
Attorney Docket No. 017900-001710US : 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 May 8, 2007.

The request is **NOT APPROVED**.

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.

There is an outstanding Office action mailed May 31, 2007 that requires a reply by the applicant.

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

April Wise
Petitions Examiner
Office of Petitions

cc: KURT MASCHOFF
BUCKLEY, MASCHOFF &
TALWALKAR
50 LOCUST AVENUE
NEW CANAAN, CT 06840

UNITED STATES PATENT AND TRADEMARK OFFICE

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WASHINGTON, DC 20231
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Paper No. 6

MAIL

SEP 23 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

In re Application of :
Bortolini et al. :
Application No. 09/797,337 : DECISION ON REQUEST TO
Filed: March 1, 2001 : WITHDRAW AS ATTORNEY
For: MTA INTERCOM FEATURE :
:

This is a decision on the request to withdraw as attorney/agent of record filed on August 5, 2002.

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

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

All attorneys in the application are withdrawn 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.

Reinhard J. Eisenzopf
Special Program Examiner
Technology Center 2600
Communications
(703) 305-4711

cc: Lucent Technologies, Inc.
Room 3J-219
101 Crawfords Corner Road
Holmdel, NJ 07733

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

RICHARD D. EGAN
O'KEEFE EGAN & PETERMAN LLP
BUILDING C, SUITE 200
1101 CAPITAL OF TEXAS HIGHWAY SOUTH
AUSTIN, TX 78746

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MAR 2 3 2004

OFFICE OF PETITIONS

In re Application of	:	
Roger K. Richter, et al.	:	DECISION ON PETITIONS
Application No. 09/797,404	:	UNDER 37 CFR 1.181,
Filed: March 1, 2001	:	37CFR 1.183 AND
Attorney Docket No. SURG:134	:	37 CFR 1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001 . With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 11, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time**.
>
> (iii) 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.

(iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/45552 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

---

[1] Emphasis added.

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b) provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on

October 18, 2001) prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 11, 2002, 85 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official Gazette with regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 11, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 11, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is

> rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C. 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 11, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U6S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing

implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S. 282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the USPTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the USPTO 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.

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

This application is being forwarded to Technology Center AU 2662 for examination in due course.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

NOV 2 0 2003

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
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Perkins Coie LLP
P.O. Box 2168
Menlo Park, CA 94026

Paper No. 13

In re Application of	:	DECISION ON PETITION
David L. Morris et al	:	TO WITHDRAW
Serial No. : 09/797,409	:	HOLDING OF
Filed : February 28, 2001	:	ABANDONMENT
For : Tissue Surface Treatment Apparatus and Method	:	

This is a decision on petitioner's request filed October 27, 2003 to review the holding of abandonment mailed August 27, 2003, for failure to respond to the Office action mailed January 29, 2003. The basis for the request is that applicant did not receive the communication mailed January 29, 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 October 27, 2003 includes all the above elements. The request is therefore GRANTED. Upon the mailing of this decision, the application will be forwarded to the Legal Instruments Examiner for the re-mailing of the Office action of January 29, 2003.

Summary: Holding of Abandonment Withdrawn.

John E. Kittle, Director
Groups 3730 and 3760
Phone: (703) 308-0873

ak/11/11/03

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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OFFICE OF PETITIONS

In re Application of :
Morris, Daniel, and Balbierz :
Application No. 09/797,409 : Decision on Petition
Filing Date: February 28, 2001 :
Attorney Docket No. 37167-8043 :

This is a decision on the petition under 37 CFR 1.183, filed December 22, 2006.

The petition is **dismissed**.

Facts:

The application was filed February 28, 2001.

A declaration signed by *all* the inventors was filed June 11, 2001. The declaration gave a power of attorney to Joel Harris and indicated all correspondence should be sent to Joel Harris.

On March 6, 2003, a new power of attorney and change of correspondence address was filed. The power of attorney was signed by Stephen Williams as Chief Operating Officer of Rite Medical Systems, Inc. Petitioner contends the "assignment" to Rite Medical Systems, Inc. was invalid and asserts Rite Medical is not the assignee of the entire interest.

Petitioner seeks acceptance of the power of attorney filed with the petition despite the fact it is not signed by only one of the three inventors.

The application is currently abandoned.

Law:

MPEP 402.10 states,

> Papers giving or revoking a power of attorney in an application generally require signature by all the applicants or owners of the application. Papers revoking a power of attorney in an application (or giving a power of attorney) will not be accepted by the Office when signed by less than all of the applicants or owners of the application unless they are accompanied by a petition under 37 CFR 1.36(a) and fee under 37 CFR 1.17(f)

with a showing of sufficient cause (if revocation), or a petition under 37 CFR 1.183 and fee under 37 CFR 1.17(f) (if appointment) demonstrating the extraordinary situation where justice requires waiver of the requirement of 37 CFR 1.32(b)(4) that the applicant, or the assignee of the entire interest of the applicant sign the power of attorney. The petition should be directed to the Office of Petitions. The acceptance of such papers by petition under 37 CFR 1.36(a) or 1.183 will result in more than one attorney, agent, applicant, or owner prosecuting the application at the same time. Therefore, each of these parties must sign all subsequent replies submitted to the Office. See In re Goldstein, 16 USPQ2d 1963 (Dep. Assist. Comm'r Pat. 1988)....

Upon accepting papers appointing and/or revoking a power of attorney that are signed by less than all of the applicants or owners, the Office will indicate to applicants who must sign subsequent replies. Dual correspondence will still not be permitted. Accordingly, when the acceptance of such papers results in an attorney or agent and at least one applicant or owner prosecuting the application, correspondence will be mailed to the attorney or agent. When the acceptance of such papers results in more than one attorney or agent prosecuting the application, the correspondence address will continue to be that of the attorney or agent first named in the application, unless all parties agree to a different correspondence address

Discussion:

Prosecution of the application has ended and the application is abandoned. Therefore, the petition is dismissed as moot.

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

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Alexandria, VA 22313-1450
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OFFICE OF PETITIONS

In re Application of :
Morris, Daniel, and Balbierz :
Application No. 09/797,409 : Decision on Petition
Filing Date: February 28, 2001 :
Attorney Docket No. 37167-8043 :

Corrected Decision

This is a decision on the petition under 37 CFR 1.183, filed December 22, 2006.

The petition is **DISMISSED**.

The request to give power of attorney to the representatives associated with customer number 53186 will not be entered. While a courtesy copy of this decision is being mailed to the person signing the instant petition, all future correspondence will be directed solely to the address currently of record until such time as appropriate instructions are received to the contrary.

Facts:

The application was filed February 28, 2001.

A declaration signed by *all* the inventors was filed June 11, 2001. The declaration gave a power of attorney to Joel Harris and indicated all correspondence should be sent to Joel Harris at Rita Medical Systems, Inc.

On March 6, 2003, a new power of attorney and change of correspondence address was filed. Stephen Williams, Chief Operating Officer of Rite Medical Systems, Inc., signed the power of attorney. The power of attorney states in part,

> This appointment is to the exclusion of the inventor(s) and their attorney(s) and agent(s) in accordance with the provisions of 37 CFR 3.71.

The new law firm was Perkins Coie LLP ("Perkins").

A Notice of Appeal was filed September 5, 2006.

Petitioner filed a continuation application based on the instant application on November 28, 2006. The continuation application has been assigned application no. 11/605,905.

The instant petition was filed December 22, 2006.

A RCE and proper request for a five-month extension of time were filed April 5, 2007.

Discussion:

Petitioner asserts the assignment to Rita Medical Systems, Inc. ("Rita") is invalid because the assignment does not include the name of the assignee. A review of the assignment indicates, due to inadvertent error, the name of the assignee was omitted.

Although the assignment may be vague as to the exact identity of the assignee, the assignment clearly demonstrates Morris no longer owns any property interest in the patent. Morris assigned his entire right, title, and interest to Assignee X.

Issues concerning a contract or assignment are matters of state law. Since the address of record and the requested new address are in California, the Office will assume California law is applicable to the instant assignment.

In California, courts appear to follow the general rule that every contract includes an implied covenant of good faith and fair dealing that requires all parties not to take any action that will harm the right of any other party to receive the benefits of the agreement.[1]

As a result of the covenant of good faith, courts will alter a contract/assignment if necessary to effectuate the intent of the parties. As stated by the California Court of Appeal,

> [A] contract includes not only the terms that have been expressly stated but those implied provisions indispensable to effectuate the intention of the parties.[2]

The Court of Appeal has also stated, with emphasis added,

> If necessary to carry out the intention of a contract, words may be transposed, rejected, *or supplied*, to make its meaning more clear.[3]

California Civil Code § 1643 (2007) states,

> A contract must receive such a interpretation as will make it lawful, operative, definite, reasonable, and capable of being carried into effect, if it can be done without violating the intention of the parties.

---

[1] *See* Brewer v. Simpson, 53 Cal 2d 567 (1960). The Restatement (Second) of Contracts § 205 states, "Every contract imposes upon each party a duty of good faith and fair dealing in its performance and enforcement."

[2] Tonkin Construction Co. v. County of Humboldt, 188 Cal. App. 3d 838, 832 (1987).

[3] Heidlebaugh v. Miller, 126 Cal. App. 2d 25, 38 (1954) (citation omitted).

The assignment in this case is missing terms that are essential to carry out the intent of the parties. Specifically, the assignment lacks the name of the assignee.

The Office is unaware of any to conclude inventor Morris did not intend to convey his property interest to Rita when he signed the assignment.

Petitioner has failed to prove the assignment is invalid under California state law.

Since petitioner has failed to prove Rita is not the assignee of the entire interest, Rita will be allowed to prosecute the application to the exclusion of the inventors.

Any request for reconsideration must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are NOT permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.183." This is **not** a 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
P.O. Box 1450
Alexandria, VA 22313-1450

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

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

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

Charles Steven Brantley
Senior Petitions Attorney
Office of Petitions

cc: COURTNEY STANIFORD & GREGORY LLP
P.O. BOX 9686
SAN JOSE, CA 95157

UNITED STATES PATENT AND TRADEMARK OFFICE

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OFFICE OF PETITIONS

In re Application of :
David L. Morris, et al :
Application No. 09/797,409 : DECISION ON PETITION
Filed: February 28, 2001 : TO WITHDRAW
Attorney Docket No. 37167-8043 : 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 May 16, 2008.

The request is **DISMISSED** as moot.

A review of the file record indicates that the power of attorney to Perkins Coie LLP, has been revoked by the assignee of the patent application on June 6, 2008. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

All future communications from the Office will be directed to the address below.

Telephone inquires concerning this decision should be directed to the undersigned at 571-272-6735.

Diane Goodwyn
Petitions Examiner
Office of Petitions

cc: ABELMAN, FRAYNE & SCHWAB
666 THIRD AVENUE
NEW YORK, NY 10017-5621

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
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Paper No. 12

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AUSTIN, TX 78746

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SEP 1 5 2003

OFFICE OF PETITIONS

In re Application of
Rodney S. Canion, et al.
Application No. 09/797,411
Filed: March 1, 2001
Attorney Docket No. SURG:111

:DECISION ON PETITIONS
:UNDER 37 CFR 1.181; 37
:CFR 1.183 AND 37 CFR
:1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 11, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.
>
> (iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/45696 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

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[1] Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at ~~midnight December~~ 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001 prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 11, 2002, 85 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official

Gazette with regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 11, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 11, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C.

> 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 11, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the US 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.

Telephone inquiries regarding this decision should be directed to Sherry Brinkley at (703) 305-9220.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for

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
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Paper No. 11

O'KEEFE EGAN & PETERMAN LLP
BUILDING C, SUITE 200
1101 CAPITAL OF TEXAS HIGHWAY SOUTH
AUSTIN, TX 78746

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SEP 15 2003

OFFICE OF PETITIONS

In re Application of
Brian W. Bailey et al
Application No. 09/797,412
Filed: March 1, 2001
Attorney Docket No. SURG:144

:DECISION ON PETITIONS
:UNDER 37 CFR 1.181; 37
:CFR 1.183 AND 37 CFR
:1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 11, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.
>
> (iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/45722 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

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[1] Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001) prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 11, 2002, 85 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official

Gazette with regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 11, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 11, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C.

> 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 11, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the USPTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the US 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.

Telephone inquiries regarding this decision should be directed to Frances Hicks at (703) 305-8680.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for
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
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Paper No. 11

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SEP 15 2003

OFFICE OF PETITIONS

In re Application of
Scott C. Johnson, et al.
Application No. 09/797,413
Filed: March 1, 2001
Attorney Docket No. SURG:128

:DECISION ON PETITIONS
:UNDER 37 CFR 1.181; 37
:CFR 1.183 AND 37 CFR
:1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 4, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.
>
> (iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/45695 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

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[1] Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001 prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 4, 2002, 78 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official Gazette with

regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 4, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 4, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C.

122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
(5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 4, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the US 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 Nonpublication Request which sets forth the projected publication date of December 25, 2003 accompanies this decision on petition.

Telephone inquiries regarding this decision should be directed to Sherry Brinkley at (703) 305-9220.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for
Brian Hearn
Senior 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

Paper No. 9

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SEP 1 5 2003

OFFICE OF PETITIONS

In re Application of
Scott C. Johnson et al
Application No. 09/797,414
Filed: March 1, 2001
Attorney Docket No. SURG:108

:DECISION ON PETITIONS
:UNDER 37 CFR 1.181; 37
:CFR 1.183 AND 37 CFR
:1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 4, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.
>
> (iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/45694 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

---

[1] Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001) prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 4, 2002, 78 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official Gazette with

regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 4, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 4, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C.

> 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 4, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the USPTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 4, 2002. However, the USPTO 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 Nonpublication Request which sets forth the projected publication date of December 25, 2003 accompanies this decision on petition.

Telephone inquiries regarding this decision should be directed to Frances Hicks at (703) 305-8680.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for
Brian Hearn
Senior 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

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United States Patent and Trademark Office
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Alexandria, VA 22313-1450
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New York, New York 10022-2585

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SEP 29 2006

OFFICE OF PETITIONS

In re Application of Toshio Soumiya et al.
Application No.: 09/797,419
Filed: March 01, 2001
Attorney Docket No.: FUJS 18.293
For: TRANSMISSION PATH CONTROLLING APPARATUS AND TRANSMISSION PATH CONTROLLING METHOD AS. WELL AS MEDIUM HAVING. . . .

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 16, 2006. The petition is **GRANTED**.

The above-identified application became abandoned for failure to submit the issue fee and publication fees in a timely manner in reply to the Notice of Allowance mailed November 02, 2005, which set a statutory period for reply of three (3) months. On February 02, 2006, applicant submitted an Issue Fee Transmittal Form, however, the authorized signature was omitted from the Issue Fee Transmittal form. Accordingly, the above-entitled application became abandoned at midnight on February 02, 2006.

On February 16, 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 payment of the issue and publication fee. Accordingly, the payment of the issue and publication fees 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

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
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CHRISTOPHER C. WINSLADE
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CHICAGO IL 60661

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JUN 12 2006

OFFICE OF PETITIONS

In re Application of :
O.E. Agazzi, et al. :
Application No. 09/797,428 : DECISION ON PETITION
Filed: February 28, 2001 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 40561/SDB/B600 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 13, 2006, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional application set forth in the amendment filed with the 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;
(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 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 Sherry D. Brinkley at (571) 272-3204. 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 2613 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed application.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

Karen O. Creasy
Petitions Examiner
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPL NO.	FILING OR 371 (c) DATE	ART UNIT	FIL FEE REC'D	ATTY.DOCKET NO	DRAWINGS	TOT CLMS	IND CLMS
09/797,428	02/28/2001	2613	4168	40561/SDB/B600	19	38	8

CONFIRMATION NO. 6434

CHRISTOPHER C. WINSLADE
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CHICAGO, IL 60661

CORRECTED FILING RECEIPT

OC000000019188550

OC000000019188550

Date Mailed: 06/08/2006

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)

Oscar E. Agazzi, Irvine, CA;
Gottfried Ungerboeck, Irvine, CA;
Keshab K. Parhi, Mission Viejo, CA;
Christian A. Lutkemeyer, Irvine, CA;
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George McAndrews--22760
Timothy Malloy--25600
William Wesley--26521
L Jarvis--27341
George Wheeler--28766
Herbert Hart III--30063
Gregory Vogle--31313
Priscilla Gallagher--32223
Steven Hampton--33707

Domestic Priority data as claimed by applicant

This appln claims benefit of 60/185,538 02/28/2000
and is a CIP of 09/765,014 01/17/2001

Foreign Applications

If Required, Foreign Filing License Granted: 04/11/2001

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US09/797,428

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

System and method for high speed communications using digital signal processing

Preliminary Class

398

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).

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Paper No. 10

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APR 2 8 2003

OFFICE OF PETITIONS

In re Application of
Claude Q.C. Hayes
Application No. 09/797,453
Filed: March 1, 2001
Attorney Docket No. 432580.0009
(HAYE-108)

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed April 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 Notice to File Missing Parts of Nonprovisional Application (Notice) mailed April 13, 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 June 14, 2001.

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

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

The application file is being forwarded to the Office of Initial Patent Examination.

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

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OFFICE OF PETITIONS

LADAS & PARRY
5670 WILSHIRE BOULEVARD, SUITE 2100
LOS ANGELES CA 90036-5679

In re Patent No. 7,356,482 : DECISION GRANTING PETITION
Issue Date: April 8, 2008 : UNDER 37 CFR 1.78(a)(3) AND
Application No. 09/797,488 : REQUEST FOR CERTIFICATE OF
Filed: March 1, 2001 : CORRECTION
Attorney Docket No. 7356482/20020026339 :

This is a decision on the petition, filed July 24, 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 nonprovisional Application No. 09/215,898, filed December 18, 1998, by way of a 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 March 1, 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.

The Office is in receipt of the $1,410 surcharge fee, as well as the $100 certificate of correction fee.

Any inquiries concerning this decision may be directed to Charlema Grant at (571) 272-3215.

In light of the issuance of the Certificate of Correction on September 23, 2008, this application does not need to be referred to the Certificates of Correction Branch.

Anthony Knight
Supervisor
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
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Paper No. 9

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AUSTIN, TX 78746

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SEP 15 2003

OFFICE OF PETITIONS

In re Application of
Scott C. Johnson, et al.
Application No. 09/797,506
Filed: March 1, 2001
Attorney Docket No. SURG:145

:DECISION ON PETITIONS
:UNDER 37 CFR 1.181; 37
:CFR 1.183 AND 37 CFR
:1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On February 12, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.
>
> (iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/46091 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

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[1] Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001 prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until February 12, 2002, 117 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official

Gazette with regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on February 12, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until February 12, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C.

> 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until February 12, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the US 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.

Telephone inquiries regarding this decision should be directed to Sherry Brinkley at (703) 305-9220.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for
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
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Alexandria, VA 22313-1450
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Paper No. 11

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SEP 15 2003

OFFICE OF PETITIONS

In re Application of
Roger K. Richter, et al.
Application No. 09/797,507
Filed: March 1, 2001
Attorney Docket No. SURG:135

:
:DECISION ON PETITIONS
:UNDER 37 CFR 1.181; 37
:CFR 1.183 AND 37 CFR
:1.137(b)

This is a decision on the papers titled "Petition Concerning Notice of Foreign Filing a Foreign Application of a U.S. Patent Application For Which A Nonpublication Request Was Rescinded Under 35 USC 122(b)(2), " filed August 22, 2003. The petition is being treated as a petition under 37 CFR 1.181, 37 CFR 1.183, and 37 CFR 1.137(b).

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

The petition under 37 CFR 1.183 is **DISMISSED.**

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

BACKGROUND

The above-identified application was filed on March 1, 2001. With the filing, applicants included a Request and Certification under 35 U.S.C. 122(b)(2)(B)(i) requesting that the application not be published. The nonpublication request reads:

> I hereby certify that the invention disclosed in the attached application **has not been and will not be** the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing. I hereby request that the attached application not be published under 35 U.S.C. 122(b). [Emphasis applicants.]

On November 2, 2001, applicants filed a counterpart international application relating to the subject matter of the above-identified application. Applicants provided the notice of the foreign filing as required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) when applicants filed this petition on August 22, 2003.

On January 11, 2002, applicants filed a Request to Rescind Nonpublication Request (35 U.S.C. § 122(b)(2)(B()(ii)), which bears a certificate of mailing date under 37 CFR 1.8 of October 18, 2001. This request stated that "I hereby rescind the previous request that the above-identified application not be published under 35 U.S.C. 122(b)." The rescission request does not make any mention of the fact that this application is, has been or will be the subject of an application filed in another country, or under a multilateral agreement, that requires publication at eighteen months after filing.

On August 22, 2003, applicants filed the instant petition and stated that the invention disclosed in the above-identified application was filed in a foreign country on November 2, 2001. From these dates, the notice of the foreign filing as required by 35 U.S.C. 122(b)(2)(B(iii) was not filed within 45 days after the date of filing of the international application.

STATUTE AND LEGISLATIVE HISTORY

35 U.S.C. (b)(2)(B) states, in pertinent part:

> (i) If an applicant makes a request upon filing, certifying that the invention disclosed in the 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 of applications 18 months after filing, the application shall not be published as provided in paragraph (1).
>
> (ii) **An applicant may rescind a request made under clause (i) at any time.**
>
> (iii) 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.
>
> (iv) If an applicant rescinds a request made under clause (i) **or** notifies the Director that an application was filed in a foreign country or under a multilateral international agreement specified in clause (i), the application shall be published in accordance with the provisions of paragraph (1) on or as soon as is practical after the date that is specified in clause (i).[1]

The Congressional record explains that, if applicant has requested nonpublication because the application will not be filed "in a foreign country with a publication requirement, subparagraph (B)(iii) imposes a duty on the applicant to notify the Director of this fact. An unexcused failure to notify the Director will result in abandonment of the application." See 145 Cong. Rec. S14,718 (November 17, 1999).

PETITIONS UNDER 37 CFR 1.181 AND 1.183

Requested Relief under 37 CFR 1.181

As to the petition under **37 CFR 1.181**, applicants have requested that the foreign application filed by transmittal of PCT Application Serial No. PCT/US01/46102 by Express Mail on November 2, 2001, which included information identifying the above-captioned application by title, inventors, filing date and application number, be regarded as satisfying the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii).

Decision on Petition under 37 CFR 1.181

The argument that the filing of the PCT application satisfied the notification requirement of 35 U.S.C. § 122(b)(2)(B)(iii) of foreign filing is not persuasive. 37 CFR 1.213(c) requires the applicant to provide notice, and 37 CFR 1.4(b)

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[1] Emphasis added.

provides that each application must be complete in itself. An international application would not be placed into the file of an application that it relies upon for the benefit of an earlier filing date, and so applicant was required to file a separate paper pursuant to 37 CFR 1.4(b) in the above-identified application. Therefore, the mere filing of a PCT application is not the notification required by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c). Petitioner's attention is also directed to 37 CFR 1.4(c), which states:

> Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office, each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

Pursuant to 37 CFR 1.4(c), the separate paper was required to address a distinct subject. Therefore, since a notification of foreign filing was required to be on a separate paper, the filing of the PCT application did not serve as the notification of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). It should be noted that the USPTO acts in a distinctly separate capacity, and in a dedicated, separate part of the Office, when it acts as a Receiving Office for the filing of applications and papers under the PCT. Accordingly, as a review of the contents of the file of the above-identified application shows that no notification of the November 2, 2001 filing of the PCT application was filed within 45 days after the filing date of the PCT application, applicants' failure to provide such timely notice of the filing of the PCT application, pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c), caused the above-identified application to become abandoned by operation of law at midnight December 17, 2001.

Requested Relief under 37 CFR 1.183

Alternatively, applicants request suspension of the rules under **37 CFR 1.183** if the Office finds that the filing of the PCT application does not satisfy the notification of foreign filing requirements of 35 U.S.C. § 122(b)(2)(B)(iii). In this regard, applicants contend that, despite the fact that the request to rescind the nonpublication request was mailed via certificate of mailing 15 days (i.e., on October 18, 2001 prior to the filing of the PCT application on November 2, 2001, the request to rescind was not processed and stamped by the USPTO until January 11, 2002, 85 days after the mailing of the request. With regard to the period during which the mails were delayed due to the anthrax discovery, applicants make reference to a notice published in the Official

Gazette with regard to the postal service delays caused by increased security procedures related to the discovery of anthrax in a Washington, D.C. mail facility and requests like relief with regard to the request to rescind the nonpublication request received on January 11, 2002 in the USPTO.

Decision on Petition under 37 CFR 1.183

As noted above, the request to rescind the nonpublication request was mailed via certificate of mailing under 37 CFR 1.8 on October 18, 2001, which was not received and stamped into the USPTO until January 11, 2002, due to mail delays. However, the relief provided for by the notice published in the Official Gazette of October 9, 2001, applies only to correspondence deposited by Express Mail under 37 CFR 1.10 and does not apply to mail deposited by first class mail under 37 CFR 1.8. In this regard, applicants' attention is directed to 1251 Official Gazette 55, which states:

> Parties submitting correspondence to the USPTO are reminded that 37 CFR 1.8 (certificate of mailing or transmission practice) does not provide for according a filing date as of the date of deposit with the USPS to correspondence submitted under 37 CFR 1.8. Therefore, it would be inappropriate to file a petition under 37 CFR 1.183 or 2.146(a)(5) and 2.148 to waive the requirements of 37 CFR 1.8.

In view of the above, applicants cannot rely on the notice published in the Official Gazette as a means for the requested relief under 37 CFR 1.183.

Moreover, the Notice published in the Official Gazette of July 1, 2003 (1272 Official Gazette 1), regarding the USPTO's clarification and interpretation of the provisions of 35 U.S.C. 122(b)(2)(B)(ii)-(iv), stated, in pertinent part under "In Summary:"

> (3) If an applicant makes a nonpublication request and subsequently files a counterpart application in an eighteen-month publication country before the nonpublication request is rescinded, 35 U.S.C. 122(b)(2)(B)(iii) requires the applicant to notify the USPTO of the foreign filing not later than forty-five days after the date such counterpart application was filed to avoid abandonment of the application.
> (4) When an application is abandoned by operation of 35 U.S.C.

> 122(b)(2)(B)(iii) due to the failure to timely notify the USPTO of the filing of a counterpart application in an eighteen-month publication country, applicant's sole remedy to restore the application to pending status is by filing a petition under 37 CFR 1.137(b) to revive the abandoned application.
> (5) Applicants should also provide a notice of foreign filing when rescinding a nonpublication request in anticipation of filing a counterpart application in an eighteen-month publication country because no benefit is given to a certificate of mailing or transmission under 37 CFR 1.8 on a rescission of a nonpublication request in determining whether applicant has rescinded the nonpublication request before or on the date a counterpart application is filed in an eighteen-month publication country.

Here, applicants' request to rescind the nonpublication request was mailed via certificate of mailing practice under 37 CFR 1.8, to which no benefit can be given. Further, since the request to rescind was not received in the USPTO until January 11, 2002, and the request did not provide any notice of foreign filing, compliance with 35 U.S.C. § 122(b)(2)(B)(iii) has not been satisfied. The Office has no authority pursuant to 37 CFR 1.183 to treat a rescission under 35 U.S.C. § 122(b)(2)(ii) as the notice of foreign filing required by 35 U.S.C. § 122(b)(2)(B)(iii). In addition, the Office has no authority to waive the 45 day period set forth in 35 U.S.C. § 122(b)(2)(B)(iii). As a result thereof, the application must be regarded as abandoned by operation of law. These are statutory requirements and a statutory requirement cannot be waived under the provisions of 37 CFR 1.183.

Moreover, as noted in item (4), applicants herein have a suitable remedy on hand that does not require the extraordinary remedy of invoking 37 CFR 1.183. It is brought to petitioner's attention that the USPTO will not normally consider an extraordinary remedy when the rules already provide an avenue for obtaining the relief sought. See Cantello v. Rasmussen, 220 USPQ 664 (Comm'r Pat. 1982). Furthermore, a standard principle of statutory construction is: *expressio unius est exclusion alterius* (the mention of one thing implies exclusion of another thing); namely, absent legislative intent to the contrary, when a statute expressly provides a specific remedy for a specific situation, the statute is deemed to exclude other remedies for such situation. See National R.R. Passenger Corp. v. National Ass'n Of R.R. Passengers, 414 U.S. 453, 458 (1974); see also Botany Worsted Mills v. United States, 278 U.S.

282, 289 (1929)("when a statute limits a thing to be done in a particular mode, it includes the negative of any other mode"). Since Congress has provided in Public Laws 97-247 and 106-103 specific schemes for the revival of abandoned applications (*i.e.*, the specific situations under which the PTO may revive an abandoned application and the specific requirements (fee amounts and standards) applicable to each specific situation), the creation of other schemes (e.g., the herein requested waiver of the rules under 37 CFR 1.183) for the revival of any abandoned application would be inconsistent with the patent statute. Thus, the Commissioner's authority to revive an abandoned application is limited to that specified in the statutory scheme set forth in 35 U.S.C. §§ 41(a)(7), 111, 122, 133, and 151. See Morganroth v. Quigg, 885 F.2d 843, 847, 12 USPQ2d 1125, 1128 (Fed. Cir. 1989)(the Commissioner lacks the authority to revive an application abandoned by termination of court proceedings because 35 U.S.C. §§ 41(a)(7), 133, or 151 do not provide for the revival of an application abandoned in such a manner).

PETITION UNDER 37 CFR 1.137(b)

Alternatively, applicants request revival of the instant application pursuant to the provisions of 37 CFR 1.137(b) 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).

Decision on Petition under 37 CFR 1.137(b)

As noted above, applicants stated in the petition that the instant nonprovisional application is the subject of a counterpart international application filed on November 2, 2001. However, the US 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.

Telephone inquiries regarding this decision should be directed to Sherry Brinkley at (703) 305-9220.

This application is being forwarded to Technology Center 2100 for examination in due course.

Frances Hicks for
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. 5

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NEW YORK NY 10154

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OFFICE OF PETITIONS

In re Application of
William Lobb et al
Application No. 09/797,532
Filed: March 1, 2001
Attorney Docket No. 4114-4001

DECISION GRANTING PETITION
UNDER 37 CFR 1.137(f)

This is a decision on the petition, filed May 10, 2002, 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 international application (PCT) filed on March 1, 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 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 September 5, 2002 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 2643 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
www.uspto.gov

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400

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OFFICE OF PETITIONS

In re Application of
Casati et al.
Application No. 09/797,536
Filed: 02-28-2001
Attorney Docket No. 10007858-1

DECISION ON PETITION

This is a decision on the petition filed December 29, 2006, to withdraw the holding of abandonment for the above-identified application.

On June 22, 2006, 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 was held abandoned on September 23, 2006. A Notice of Abandonment was mailed on October 30, 2006.

In the present petition, the practitioner requested that the Office withdraw the holding of abandonment due to non-receipt, remail the Notice of Allowance, and restart the period for reply.

PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

A review of the record indicates no irregularity in the mailing of the Notice of Allowance, and in the absence of any irregularity in the mailing, there is a strong presumption that the Notice of Allowance was properly mailed to the address of record. This presumption may be overcome by a showing that the Notice of Allowance was not in fact received. The showing required to establish non-receipt of an Office communication must include a statement from the practitioner, stating that the practitioner did not receive the Office communication and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the non-received Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. See MPEP 711.03(c)(I)(A). For example, if a three-month period for reply was set in the non-received Office communication, a copy of the docket report showing all replies docketed for a date three months from the mail date of the

non-received Office communication must be submitted as documentary proof of non-receipt of the Office communication. The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office communication may have been lost after receipt rather than a conclusion that the Office communication was lost in the mail (*e.g.* if the practitioner has a history of not receiving Office communications).

After reviewing the documents submitted on petition, the Office concludes that the showing of record is sufficient to warrant withdrawal of the holding of abandonment. The practitioner for applicants submitted copies of docket records where the Notice of Allowance would have been entered had it been received and docketed. The practitioner attested to the fact that a search of the file jacket and docket records indicated that the Notice of Allowance was not received. Accordingly, applicants presented the required showing under 37 CFR 1.181.

The petition under 37 CFR 1.181 is **GRANTED**. No petition fee is required.

Technology Center Art Unit 2191 has been advised of this decision. The matter is being referred to the Technology Center's technical support staff for mailing of a new Notice of Allowance. The three (3) month statutory time period for responding to the Notice of Allowance will be set to run from the mailing date of the new Notice of Allowance.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
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Paper No. 13

KEVIN L. RUSSELL
SUITE 1600
601 SW SECOND AVENUE
PORTLAND, OR 97204-3157

COPY MAILED
JUN 0 9 2004
OFFICE OF PETITIONS

In re Application of	:	
Detlef, Michael J.	:	
Application No. 09/797,538	:	ON PETITION
Filed: February 28, 2001	:	
Attorney Docket No. KLR 7146.0072	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed May 13, 2004, to revive the above-identified application.

The petition is **GRANTED.**

This application became abandoned for failure to timely reply within three months to the final Office action mailed November 4, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were timely obtained. Accordingly, this application became abandoned on February 5, 2004.

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

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $950.00 extension of time fee submitted with the petition on May 13, 2004 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account as authorized.

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

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

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

Pet. Dec.

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 29 2004

In re Application of	:	
Aoki, Hidemitsu et al.	:	NOTICE OF WITHDRAWAL
Serial No. 09/797587	:	FROM ISSUE
Filed: March 05, 2001	:	UNDER 37 CFR 1.313(b)
For: ANTICORROSIVE TREATING	:	
CONCENTRATE	:	

The above-identified application is withdrawn from issue after payment of the issue fee due to reopening of prosecution. 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 Vasu Jagannathan (571) 272-1119.

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

YOUNG & THOMPSON
745 SOUTH 23RD STREET 2ND FLOOR
ARLINGTON VA 22202

cc: Allowed Files—Pk3-910

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ALEXANDRIA, VA 22313-1450
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JUN 29 2004

In re Application of	:	
Aoki, Hidemitsu et al.	:	NOTICE OF WITHDRAWAL
Serial No. 09/797587	:	FROM ISSUE
Filed: March 05, 2001	:	UNDER 37 CFR 1.313(b)
For: ANTICORROSIVE TREATING	:	
CONCENTRATE	:	

The above-identified application is withdrawn from issue after payment of the issue fee due to reopening of prosecution. See 37 CFR 1.313 (b).

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Telephone inquiries should be directed to Vasu Jagannathan (571) 272-1119.

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

YOUNG & THOMPSON
745 SOUTH 23RD STREET 2ND FLOOR
ARLINGTON VA 22202

cc: Allowed Files—Pk3-910

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WASHINGTON, D.C. 20231
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Paper No. 6

J. Nicholas Gross, Attorney at Law
Suite 240
1385 Mission Street
San Francisco, CA 94103

MAIL

JUN 2 6 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Ming-Kang Liu)
Application No. 09/797,633)
Filed: March 1, 2001)
For: SCALEABLE ARCHITECTURE FOR MULTIPLE-PORT, SYSTEM-ON-CHIP ADSL COMMUNICATIONS SYSTEMS)

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation May 31, 2002 and the Supplemental Request To Withdraw filed June 19, 2002.

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

The request is **GRANTED**.

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

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

cc: Jim Williams, Chief Financial Officer
Integrated Telecom Express, Inc.
400 Race Street
San Jose, CA 95126

UNITED STATES PATENT AND TRADEMARK OFFICE

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Washington, D.C. 20231
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Paper No. 6

J. Nicholas Gross
Suite 240
1385 Mission Street
San Francisco, CA 94103

MAIL

JUN 2 7 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

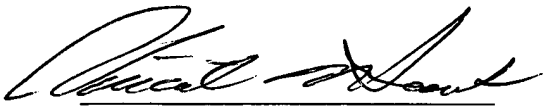
In re Application of:)
Liu)
Application No. 09/797,634) **DECISION ON REQUEST FOR**
Filed: March 1, 2001) **WITHDRAWAL AS ATTORNEY**
For: TRANSPORT CONVERGENCE)
SUB-SYSTEM WITH SHARED
RESOURCES FOR MULTIPOR xDSL
SYSTEM

This is a decision on the Request To Withdraw from Representation filed May 31, 2002.

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

The request filed May 31, 2002 meets all the requirements. Accordingly the request is **GRANTED**.

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



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cc: Jim Williams, Chief Financial Officer
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Paper No. 5

21 MAY 2002

Oppenheimer Wolff & Donnelly, LLP
P.O. Box 10356
Palo Alto, CA 94303

In re Application of: Matthew R. Muyres)
Application No. 09/797,639) **DECISION ON REQUEST FOR**
Filed: March 1, 2001) **WITHDRAWAL AS ATTORNEY**
For: LOCALLY DRIVEN ADVERTISING)
SYSTEM)

This is a decision on the Request To Withdraw from Representation filed January 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. 37 C.F.R. § 1.36 further requires that the applicant or patent owner be notified of the withdrawal of the attorney or agent.

There is no statement that Raymond E. Roberts is ***authorized*** to sign on behalf of the other listed attorneys. Therefore, the request is **DENIED**.

It is further noted that those attorneys/agents associated with customer number 25696 are associated with this application. However, the Request for Withdrawal from Representation only requests withdrawal for the following: Paul L. Hickman (#28,516), Brian R. Coleman (#39,145), Michael J. Hughes (#27,077), Robert D. Hayden (#42,645), Larry B. Guernsey (#40,008), Stefanie H. Howell (#45,929), Daphne L. Burton (#45,323), Steven S. Kelly (#43,449), Rambod Nader (#47,262), and Raymond E. Roberts ("#38,597). If it is desired to withdraw from representation all attorneys/agents associated with customer number 25696, then all those attorneys/agents associated with this customer number should be listed, or alternately, the Request for Withdrawal from Representation should request withdrawal for those attorneys/agents associated with customer number 25696.

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 Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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Washington, D.C. 20231
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Paper No. 6

J. Nicholas Gross
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1385 Mission Street
San Francisco, CA 94103

MAIL

JUN 2 7 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:)
Liu)
Application No. 09/797,648) **DECISION ON REQUEST FOR**
Filed: March 1, 2001) **WITHDRAWAL AS ATTORNEY**
For: PROGRAMMABLE TASK)
SCHEDULER FOR USE WITH
MULTIPORT xDSL PROCESSING
SYSTEM

This is a decision on the Request To Withdraw from Representation filed June 05, 2002.

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

The request filed June 05, 2002 meets all the requirements. Accordingly the request is **GRANTED**.

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

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

cc: Jim Williams, Chief Financial Officer
INTEGRATED TELECOM EXPRESS, INC.
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