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

Faustino A. Lichauco
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110-2804

MAILED

JUL 3 1 2002

Technology Center 2100

In re Application of: Sonny Vu, et al.	)	
Application No. 09/908,443	)	
Filed: July 18, 2001	)	**DECISION ON REQUEST FOR**
For: AUTOMATIC SUMMARIZATION	)	**WITHDRAWAL AS ATTORNEY.**
OF A DOCUMENT	)	

This is a decision on the Request To Withdraw from Representation filed July 24, 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 This correspondence address is provided by the withdrawn attorney(s).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: Firespout, Inc.
P.O. Box 425816
Cambridge, MA 02142

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW Mar-06

MAYER, FORTKORT & WILLIAMS, PC
251 NORTH AVENUE WEST
2ND FLOOR
WESTFIELD NJ 07090

COPY MAILED

MAR 13 2006

OFFICE OF PETITIONS

In re Application of	:	
Krishnaswamy et al.	:	
Application No. 09/908,459	:	DECISION ON PETITION
Filed: 18 July, 2001	:	
Atty Docket No. PH01-00-12	:	

This is a decision on the petition filed on 11 October, 2005, under 37 CFR 1.137(b),[1] to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on 11 August, 2004, for failure to timely reply to the non-final Office action mailed on 10 May, 2004, which set a three (3) month shortened statutory period for reply. No extensions of time under 37 CFR 1.136(a) were obtained. Notice of Abandonment was mailed on 29 May, 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)).

Petitioners have filed an amendment as the required reply.

The statement contained in the instant petition does not set forth that the entire delay from the due date of the required reply to the date of the filing of a grantable petition was unintentional as required by 37 CFR 1.137(b)(3). However, the statement contained in the instant petition is being so construed. Petitioner **must** notify the Office if this is not a correct interpretation.

This 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

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

MAYER & WILLIAMS PC
251 NORTH AVENUE WEST, 2ND FLOOR
WESTFIELD, NJ 07090

MAILED

MAR 12 2009

OFFICE OF PETITIONS

In re Application of :
Murali **KRISHNASWAMY, et al.** :
Application No. 09/908,459 :
Filed: July 18, 2001 :
Attorney Docket No. **2060/3** :

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

This is a decision on the petition under 37 CFR 1.137(b), filed February 20, 2009, 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, July 25, 2007, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 26, 2007.

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

The application is being referred to Technology Center Art Unit 2613 for consideration of the amendment filed February 20, 2009.

Telephone inquiries concerning this decision should be directed to Monica A. Graves at (571) 272-7253.

Brian W. Brown
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

MAYER & WILLIAMS PC
251 NORTH AVENUE WEST
2ND FLOOR
WESTFIELD NJ 07090

MAILED

APR 15 2010

OFFICE OF PETITIONS

In re Application of	:	
Krishnaswamy et al.	:	
Application No. 09/908,459	:	ON APPLICATION FOR
Filed: July 18, 2001	:	PATENT TERM ADJUSTMENT
Atty Docket No. 2060/3	:	

This is in response to the APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION UNDER 37 CFR § 1.705(b) filed on December 21, 2009. Applicants submit that the correct patent term adjustment to be indicated on the patent is one thousand six hundred five (1605) days, not zero (0) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants request this correction, in part, on the basis that the Office will take in excess of three years to issue this patent.

The request is **GRANTED to the extent indicated**.

To the extent the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of

issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee[1].

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

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

---

[1] For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

To the extent that the instant application for patent term adjustment requests reconsideration of the PTA at the time of the mailing of the Notice of Allowance, the request is **granted to the extent indicated**.

The Office has updated the PALM and PAIR screens to reflect that the 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 PALM screen, showing the corrected determination, is enclosed.

On September 21, 2009, the Office mailed a Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. Applicant was advised that the patent term adjustment to date was zero (0) days. The period of adjustment was 876 days of PTO delay and 996 days of applicant delay.

On December 21, 2009, the subject application for patent term adjustment was timely filed.[2]

Applicants dispute the period of reduction of 427 days for applicant delay in connection with the abandonment of the application for failure to timely file a response to the Office action mailed on May 10, 2004, and the filing of a petition to revive on October 11, 2005. Applicants assert the correct period of reduction is 327 days.

37 CFR 1.704(c)(3) states:

> 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: Abandonment of the application or late payment of the issue fee, in which case the period of adjustment set forth in §1.703 shall be reduced by the number of days, if any, beginning on the date of abandonment or the date after the date the issue fee was due and ending on the earlier of:

[2] Office records indicate that the issue fee was paid on December 21, 2009.

(i) The date of mailing of the decision reviving the application or accepting late payment of the issue fee; or

(ii) The date that is four months after the date the grantable petition to revive the application or accept late payment of the issue fee was filed;

Applicants are reminded that 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 (or, as is the case in the first period of abandonment in this application, by the notation of the application as abandoned in Office records). 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). Further, 37 CFR 1.704(c)(3) states that the period of reduction begins on the date that the application becomes abandoned, not on the date of mailing of a notice of abandonment.

On May 10, 2004, an Office action was mailed, setting a three (3)-month shortened statutory period for reply. No reply having been received, the application became abandoned as a matter of law on August 11, 2004, not March 21, 2005, as asserted by applicants. On October 11, 2005, a petition to revive the application was filed. On March 13, 2006, the petition to revive was granted. Therefore, the period of reduction under 37 CFR 1.704(c)(3) the period beginning on the date of abandonment, August 11, 2004, and ending on the date for months after the date the grantable petition was filed, or February 11, 2006, or 550 days.

Accordingly, the period of reduction of 427 days for applicant delay will be removed and a period of reduction of 550 days will be entered.

Applicants further dispute the period of 484 day period of reduction for applicant delay in connection with the abandonment of the application for failure to timely file a response to the Office action mailed on July 25, 2007. Applicants assert the period of reduction should be 387 days rather than 484 days.

On July 25, 2007, an Office action was mailed, setting a three (3) month shortened statutory period for reply. No reply having been received, the application became abandoned as matter of law on October 26, 2007, not February 19, 2008, as asserted by applicants. On February 20, 2009, a petition to revive the application was filed. On March 12, 2009, the petition to revive was granted. Therefore, the period of reduction under 37 CFR 1.704(c)(3) is the period beginning on the date of abandonment, October 26, 2007, and ending on the date of mailing of the decision reviving the application, March 12, 2009, or 504 days.

Accordingly, the period of reduction of 484 days for applicant delay will be removed, and a period of reduction of 504 days will be entered.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is zero (0) days (876 days of Office delay reduced by 1139 (550 + 85 + 504) days of applicant delay).

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

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

Anthony Knight
Director
Office of Petitions

Encl: Copy of updated PALM screen

Day : Thursday
Date: 4/15/2010

PALM INTRANET

Time: 08:35:53

PTA Calculations for Application: 09/908459			
Application Filing Date:	07/18/2001	PTO Delay (PTO):	876
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	996
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-143		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
62	04/15/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		143	
51	09/21/2009	MAIL NOTICE OF ALLOWANCE			
50	09/19/2009	ISSUE REVISION COMPLETED			
49	09/19/2009	DOCUMENT VERIFICATION			
48	09/17/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
47	09/17/2009	CASE DOCKETED TO EXAMINER IN GAU			
46	09/17/2009	NOTICE OF ALLOWABILITY			
45	09/05/2009	DATE FORWARDED TO EXAMINER			
44	07/06/2009	RESPONSE AFTER NON-FINAL ACTION			
43	04/17/2009	MAIL NON-FINAL REJECTION			
42	04/13/2009	NON-FINAL REJECTION			
41	04/06/2009	DATE FORWARDED TO EXAMINER			
40	02/20/2009	RESPONSE AFTER NON-FINAL ACTION		484	31
39	04/06/2009	MAIL NOTICE OF RESCINDED ABANDONMENT			
38	04/05/2009	NOTICE OF RESCINDED ABANDONMENT IN TCS			
37	04/01/2009	CASE DOCKETED TO EXAMINER IN GAU			
36	03/12/2009	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
35	03/12/2009	PETITION TO REVIVE APPLICATION - GRANTED			
34	02/20/2009	PETITION ENTERED			
33	02/20/2008	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
32	02/19/2008	ABAND. FOR FAILURE TO RESPOND TO O. A.			
31	07/25/2007	MAIL NON-FINAL REJECTION			

30	07/23/2007	NON-FINAL REJECTION			
29	05/15/2007	DATE FORWARDED TO EXAMINER			
28	05/10/2007	RESPONSE AFTER NON-FINAL ACTION		85	26
27	05/10/2007	REQUEST FOR EXTENSION OF TIME - GRANTED			
26	11/14/2006	MAIL NON-FINAL REJECTION	276		22
25	11/13/2006	NON-FINAL REJECTION			
24	09/10/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
23	09/10/2006	DATE FORWARDED TO EXAMINER			
22	10/11/2005	RESPONSE AFTER NON-FINAL ACTION		427	12
21	09/11/2006	MAIL NOTICE OF RESCINDED ABANDONMENT			
20	09/10/2006	NOTICE OF RESCINDED ABANDONMENT IN TCS			
19	09/10/2006	CASE DOCKETED TO EXAMINER IN GAU			
18	03/13/2006	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			
17	10/11/2005	PETITION ENTERED			
16	03/29/2005	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			
15	03/21/2005	ABAND. FOR FAILURE TO RESPOND TO O. A.			
14	03/21/2005	CASE DOCKETED TO EXAMINER IN GAU			
13	02/15/2005	CASE DOCKETED TO EXAMINER IN GAU			
12	05/10/2004	MAIL NON-FINAL REJECTION	600		-1
11	05/03/2004	NON-FINAL REJECTION			
10	03/25/2004	CASE DOCKETED TO EXAMINER IN GAU			
9	12/22/2002	CASE DOCKETED TO EXAMINER IN GAU			
8	02/07/2002	CASE DOCKETED TO EXAMINER IN GAU			
7	01/10/2002	PRELIMINARY AMENDMENT			
6	01/23/2002	APPLICATION DISPATCHED FROM OIPE			
5	01/22/2002	APPLICATION IS NOW COMPLETE			
4	08/30/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	08/30/2001	CORRESPONDENCE ADDRESS CHANGE			
2	07/27/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/18/2001	INITIAL EXAM TEAM NN			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

DEC 0 2 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of
Qian, Zhen et al.
Application No. 09/908,464
Filed: July 17, 2001
Attorney Docket No. 017067-003300US

This is a decision on the petition under 37 CFR 1.137(b), filed November 10, 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 on January 27, 2003. 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 March 28, 2003.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Accordingly, since the $1480 extension of time submitted with the petition on November 10, 2003 was subsequent to the maximum extendable period for reply, the payment will be credited to petitioner's deposit account, as authorized.

The application file is being forwarded to Technology Center AU 1615 for further processing. Telephone inquiries concerning this decision should be directed to Latrice Bond at (703) 308-6911.

Latrice Bond

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

JOHN C. GORECKI
165 HARVARD ST.
NEWTON, MA 02460

COPY MAILED

AUG 1 5 2003

OFFICE OF PETITIONS

In re Application of	:	
Charles Gram et al	:	
Application No. 09/908,503	:	ON PETITION
Filed: July 18, 2001	:	
Attorney Docket No. ALT2001-1	:	

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 Notice to File Missing Parts of Application (Notice) mailed August 31, 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 November 1, 2001.

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

The application file is being forwarded to Initial Patent Examination Unit.

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

AKERMAN SENTERFITT & EIDSON PA
POST OFFICE BOX 3188
WEST PALM BEACH FL 33402-3188

COPY MAILED

FEB 0 4 2002

OFFICE OF PETITIONS

In re Application of
Guy B. Snowden et al
Application No. 09/908,524
Filed: July 18, 2001
Attorney Docket No: 6737-18CON

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

This is in response to the petition under 37 CFR 1.47(a), filed October 9, 2001.

The petition is granted.

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

The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status. As provided in Rule 1.47(c), this Office will forward notice of this application's filing to the nonsigning inventor at the address given in the petition. Notice of the filing of this application will also be published in the Official Gazette.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center AU 2166 for examination in due course.

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

Lynn D. Smith
24822 Stanhope, #H
Dana Point CA 92629

COPY MAILED

FEB 0 4 2002

OFFICE OF PETITIONS

In re Application of
Guy B. Snowden; Paul R. Averill; and Lynn D. Smith
Application No. 09/908,524
Filed: July 18, 2001
For: SYSTEM AND METHOD FOR AUTOMATED CREATION OF PATIENT CONTROLLED RECORDS

Dear Mr. Smith:

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

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

Telephone inquiries regarding this communication should be directed to the undersigned at (703) 305-8680. Requests for information regarding your application should be directed to the File Information Unit at (703) 308-2733. Information regarding how to pay for and order a copy of the application, or a specific paper in the application, should be directed to Certification Division at (703) 308-9726 or 1 (800) 972-6382 (outside the Washington D.C. area).

Frances Hicks

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

cc:

Akerman Senterfitt & Eidson PA
Post Office Box 3188
West Palm Beach FL 33402-3188

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)
6848537	2005-02-01	09908557	2001-07-20	8050-0002

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

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

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

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

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

A Joint Patentee and I certify that I am authorized to sign this submission on behalf of all the other patentees			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature.			
Signature	/Richard J.Deslauriers/	Date (YYYY-MM-DD)	2009-07-07
Name	Richard J. Deslauriers		

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

Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

In re Patent No. 6848537
Issue Date: February 1,2005
Application No. 09908557
Filed: July 20,2001
Attorney Docket No. 064361.0118

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

This is a decision on the electronic petition, filed July 7,2009 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of July 7,2009 .
This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 18, 2005

TO SPE OF : ART UNIT 1647

SUBJECT : Request for Certificate of Correction on Patent No.: 6,472,512

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:

_____

_____

_____

_____

_____

Gary Benzion — **SPE**

1646 — **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OIPE JC139
MAY 13 2004
PATENT & TRADEMARK OFFICE

Paper No. ____

OBLON SPIVAK McCLELLAND
MAIER & NEUSTADT PC
1940 DUKE STREET
ALEXANDRIA, VA 22314

RECEIVED: 1/20/04
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 1/20/04
Type of Resp(s): ____
Due Date(s): ____

COPY MAILED

JAN 06 2004

OFFICE OF PETITIONS

In re Application of
Kiyoshi Hayashi et al
Application No. 09/908,618
Filed: July 20, 2001
Attorney Docket No. 211633USOCIP

: DECISION GRANTING PETITION
: UNDER 37 CFR 313(c)(2)

This is a decision on the petition, filed December 16, 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 October 10, 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 2815 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Frances Hicks

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

---

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

pew

UNITED STATES PATENT AND TRADEMARK OFFICE

NOV - 2 2004

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

Paper No. 11

In re Application of	:	
Shenq Ruey Chao	:	
Application No. 09/908,647	:	DECISION ON PETITION
Filed: July 20, 2001	:	
Attorney Docket No. MR933-549	:	
(Prospective Docket No. CHAO32022/WP)		

This is a decision on the petition filed on September 3, 2004, by which petitioner requests withdrawal of the holding that this application stands abandoned for failure to file a proper and timely reply to the final Office action dated May 28, 2003. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioner alleges that this application is not abandoned because petitioner did in fact file a timely reply to the Office letter in question. Petitioner supports this allegation by submitting a copy of the reply, comprising a Request for Continued Examination (RCE) under 37 CFR 1.114, a petition for a three month extension of time, an amendment, and the fees for the RCE and extension. Petitioner further supports the allegation of the filing of a proper and timely reply by including copy of a post card receipt for the filing of the reply, showing that the reply was in fact received in the Office on November 26, 2003, a date within the period for filing a reply to Office letter in question, as extended. Therefore, it is clear that this application is not abandoned. Office financial records confirm receipt of the above mentioned fees.

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 and petition for extension that is attached to the petition. The date to which these papers are entitled is November 26, 2003. In addition, the Head Supervisory Applications Examiner will enter the Revocation and Power of Attorney also dated November 26, 2003, but will not accept the same and will mail a letter explaining that this paper is not acceptable because it is not signed by a person having authority to bind the assignee of this application as required by 37 CFR 3.73(b) and MPEP § 324. Thereafter, the application will be forwarded to the Supervisory Patent Examiner of Art Unit 3723, who will hold the application until an acceptable revocation and new power of attorney are filed. As a courtesy, a copy of this decision will be sent to the prospective attorneys, but no further communications will be sent to other than the correspondence address of record.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Leong C. Lei
PMB 1008
1867 Ygnacio Valley Road
Walnut Creek, CA 94598

cc: Bacon & Thomas, PLLC
625 Slaters Lane - 4th Floor
Alexandria, VA 22314-1176

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
www.uspto.gov

spg

Mailed: FEB 7 2005

In re application of Tomonori Niwa Serial No. 09/908,663 Filed: July 20, 2001 For: CERAMIC BALL, BALL BEARING, MOTOR HAVING BEARING, HARD DISK DRIVE, POLYGON SCANNER, AND METHOD FOR MANUFACTURING CERAMIC BALL	DECISION ON PETITION

This is a response to the PETITION UNDER 37 CFR § 1.181 TO WITHDRAW A HOLDING OF ABANDONMENT AND, ALTERNATIVELY, PETITION UNDER 37 CFR § 1.137(b) TO REVIVE ABANDONED APPLICATION filed June 8, 2004. The petition requests that the abandonment, as set forth in the Notice of Abandonment of June 3, 2004, for failure to timely file a proper reply to the Office letter mailed September 9, 2003 be withdrawn since the applicants did timely file a reply on October 1, 2003. (A copy of the reply is attached to the instant petition as well as a copy of the USPTO date stamped postcard receipt.)

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 October 1, 2003 as evidenced by the copy of the USPTO date stamped return receipt postcard indicating receipt of the reply at the USPTO on October 1, 2003. Accordingly, any holding of abandonment for failure to timely file a proper reply to the Office letter mailed September 9, 2003 is hereby vacated, and the application is returned to pending status.

The application shall be forwarded to the examiner for entry, processing and consideration of the reply originally filed October 1, 2003.

The Petition is **GRANTED**.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington DC 20037-3213

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HICKS & PENMAN LTD.
3553 31ST STREET NW
SUITE 123
CALGARY AB T2L2K-7 CA CANADA

COPY MAILED

APR 2 5 2006

OFFICE OF PETITIONS

In re Application of

BONNIER et al.
Application No. 09/908,675
Filed: July 20, 2001
Attorney Docket No. P 157 US

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 October 7, 2005.

The request is **APPROVED**.

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

The request was signed by Andrew R. Hicks on behalf of all attorneys of record who are associated with Customer No. 49127. All attorneys/agents associated with the Customer Number 49127 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 is an outstanding Office action mailed March 16, 2006 that requires a reply from the applicant.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4787.

Denise Pothier
Petitions Examiner
Office of Petitions

cc: Marc Bonnier/Bich Hoang
AB Software Technology Inc.
55 Sierra Morena Close SW
Calgary, AB T3H 3G2
CANADA

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HUMAN GENOME SCIENCES INC
9410 KEY WEST AVENUE
ROCKVILLE MD 20850

COPY MAILED

SEP 0 6 2002

OFFICE OF PETITIONS

Applicant: Rosen et al.
Appl. No.: 09/908,711
Filing Date: July 20, 2001
Title: NUCLEIC ACIDS, PROTEINS, AND ANTIBODIES
Attorney Docket No.: PA128P1
Pub. No.: US 2002/0045230
Pub. Date: April 18, 2002

This is a decision on the request for corrected patent application publication under 37 CFR 1.221(b), filed on June 5, 2002 for the above-identified application.

The request is DISMISSED.

Applicant requests that the application be republished because the patent application publication omits some of the continuity data. Applicant argues that the mistake is material because the missing priority data affects the use of the published application as prior art under 35 U.S.C. § 102(e), as a member of the public would be unable to determine the correct effective date of the publication as a reference.

37 CFR 1.221(b) is applicable "only when the Office makes a material mistake which is apparent from Office records." A material mistake must affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication, or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent.[1] The instant request does not identify a material mistake in the publication made by the Office:

The error in the continuity claim is an Office mistake, but it is not a material mistake as required by 37 CFR 1.221(b). The improper priority claim is not a material mistake because it does not affect the public's ability to appreciate the technical disclosure of the patent application publication, to determine the scope of the patent application publication or to determine the scope of the provisional rights that an applicant may seek to enforce upon issuance of a patent. The specification and claims were accurately published, thus one can read and understand the content of the application. The error also does not affect the use of the patent application publication as a prior art reference, because the earliest priority date is correctly published. While some of the related continuity data is missing, anyone looking to determine the effective date of the publication as a reference would have to order the international application files and would be reviewing PALM, additionally the two omitted international applications are listed in the first sentence of the specification.

---

[1] Changes to Implement Eighteen-Month Publication of Patent Applications, 65 FR 57023, 57038 (Sept. 20, 2000), 1239 Off. Gaz. Pat. Office Notices 63, 75 (Oct. 10, 2000) (final rule).

The applicant is advised that a "request for republication of an application previously published" may be filed under 37 CFR 1.221(a). Such a request for republication "must include a copy of the application in compliance with the Office's electronic filing system requirements and be accompanied by the publication fee set forth in § 1.18(d) and the processing fee set forth in § 1.17(i)." If the request for republication does not comply with the electronic filing system requirements, the republication will not take place and the publication fee set forth in § 1.18(d) will be refunded. The processing fee will be retained.

The application is being forwarded to Technology Center 1600 to await further examination in due course.

Any request for reconsideration of this decision, should be addressed as follows:

By mail to: Box PGPUB
Commissioner for Patents
Washington DC 20231

By facsimile: 703-305-8568

Inquiries relating to this matter may be directed to Mark Polutta at (703) 308-8122 (voice) or (703) 746-3465 (facsimile).

Mark D. Polutta

Mark Polutta
Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/908,720	07/20/2001	Karl-Heinz Alexander Stoll	0430-0158P	7858

2292 7590 09/16/2004

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER
STINSON, FRANKIE L

ART UNIT	PAPER NUMBER
1746	

DATE MAILED: 09/16/2004

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

SEP 16 2004

In re Application of STOLL, KARL-HEINZ ALEXANDER Serial No. 09/908720 Filed: July 20, 2001 For: METHOD FOR WASHING LAUNDRY IN A TANK-FREE WASH PATH AS WELL AS WASH PATH FOR CARRYING OUT THE METHOD	: : : : : : : : :	NOTICE OF WITHDRAWAL FROM ISSUE UNDER 37 CFR 1.313(b)

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 Michael Barr (571) 272-1414.

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

JNStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

cc: Niomi Farmer
Tamara Greene
Mary McAskill

UNITED STATES PATENT AND TRADEMARK OFFICE

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

CHIEN-TZU HOU
1555 RANGEWOOD DRIVE
SAN JOSE CA 95138

COPY MAILED

FEB 27 2008

OFFICE OF PETITIONS

In re Application of :
Chien-Tzu Hou :
Application No. 09/908,725 : DECISION ON PETITION
Filed: July 20, 2001 :
Attorney Docket No. MR2561-65 :

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 8, 2007, to revive the above-identified application.

The petition is **DISMISSED.**

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(b)." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

The application became abandoned for failure to timely pay the issue and publication fees on or before October 14, 2004, as required by the Notice of Allowance and Fee(s) Due, mailed July 14, 2004, which set a statutory period for reply of three (3) months. A Notice of Abandonment was mailed on November 24, 2004.

A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the required reply, unless previously filed; (2) the petition fee as set forth in 37 CFR 1.17(m); (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required by 37 CFR 1.137(d). Where there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137 was unintentional, the Director may require additional information. *See* MPEP 711.03(c)(II)(C) and (D). The instant petition lacks items (1) and (3).

In regard to Item (1) - 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 this case, petitioner submitted an issue fee payment of $700 on November 8, 2007; however, effective September 30, 2007 the issue fee for a small entity was increased to $720. Since any fee amount paid on or after September 30, 2007, must be paid in the revised amount, the issue fee payment is deficient by $20. It is noted that the petition did not include an authorization to charge a fee deficiency to a deposit account.

In regard to Item (3) - There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of $500 or a fee of $50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (over three years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on October 15, 2004. That party, in turn must explain what effort(s) was made to further reply to the outstanding Office action and, further, why no reply was filed. If no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in

seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (here, over three years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

> (A) the date that the applicant first became aware of the abandonment of the application; and
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Any renewed petition may be addressed as follows:

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

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

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

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO. In this case, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

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

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
www.uspto.gov

KARL F. MILDE, JR., ESQ
MILDE & HOFFBERG, LLP
10 BANK STREET, SUITE 460
WHITE PLAINS NY 10606

COPY MAILED

MAY 21 2008

OFFICE OF PETITIONS

In re Application of :
Chien-Tzu Hou :
Application No. 09/908,725 : DECISION ON PETITION
Filed: July 20, 2001 :
Attorney Docket No. MR2561-65 :

This is a decision in response to a renewed petition, filed March 31, 2008, to revive the above-identified application under the unintentional provisions of 37 CFR 1.137(b).

The petition is **DISMISSED**.

Any further 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 application became abandoned on October 15, 2004 for failure to timely pay the issue and publication fees on or before October 14, 2004, as required by the Notice of Allowance and Fee(s) Due, mailed July 14, 2004. On November 8, 2007, a petition under 37 CFR 1.137(b) was filed; however, the petition was dismissed in a decision mailed February 27, 2008. In response, on March 31, 2008, the present petition was filed.

Petitioner argues that 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 indicates that he first learned of the abandonment on or about November 1, 2007, while making a routine check of the status on the Office's web site. Petitioner explains that that the application was prepared and prosecuted by the law firm of Rosenberg, Klein & Lee; however, "this law firm did not report the Notice of Allowance of this Application to me and I was unaware of its allowance."

A review of the record shows that applicant appointed the law firm of Rosenberg, Klein & Lee to represent him in all matters before the United States Patent and Trademark Office by a Power of Attorney filed July 20, 2001. Since petitioner is bound by the actions or inactions of his duly appointed attorney, Rosenberg, Klein & Lee should explain why this application became abandoned while it was under their control and what efforts Rosenberg, Klein & Lee made to further reply of itself and with whom this matter was discussed outside of Rosenberg, Klein & Lee. Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s) at Rosenberg, Klein & Lee and whoever else was involved with this application at the time of abandonment. Statements are required from any and all persons then at Rosenberg, Klein & Lee, and the responsible person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action.

Petitioner is advised to send a letter (accompanied by a copy of this decision) to Rosenberg, Klein & Lee, by certified or registered mail (return receipt requested) indicating that the U.S. Patent and Trademark Office (USPTO) is requesting assistance in ascertaining the cause of abandonment of the above-identified application, and that the USPTO is requesting that Rosenberg, Klein & Lee provide within a specified period (*e.g.*, one month) a statement setting forth why appropriate action was not timely taken to prevent the application from becoming abandoned. Petitioner is advised that, in the event that Rosenberg, Klein & Lee does not provide such a statement, petitioner should submit a copy of such letter and a copy of the return receipt.

The foregoing was given for information purposes only and should not be construed as a recommended course of action, or that such a course of action, if undertaken, would be likely to succeed.

The petition was reconsidered, but the result is the same. The delay has not been shown to the satisfaction of the Director to be unintentional within the meaning of 37 CFR 1.137(b).

Any further renewed petition may be addressed as follows:

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

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

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

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

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

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
www.uspto.gov

ERIC ROBINSON
PMB 955
21010 SOUTHBANK ST.
POTOMAC FALLS, VA 20165

COPY MAILED

OCT 1 5 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Hisashi Ohtani et al :
Application No. 09/908,727 :
Filed: July 20, 2001 :
Attorney Docket No. 740756-2328 :

This is a decision on the petition, filed October 14, 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). See37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on September 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 Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2812 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

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

---

[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

OIPE JC32
JAN 3 1 2005
PATENT & TRADEMARK OFFICE

ERIC ROBINSON
PMB 955
21010 SOUTHBANK ST.
POTOMAC FALLS, VA 20165

COPY MAILED
OCT 1 5 2004
OFFICE OF PETITIONS

In re Application of
Hisashi Ohtani et al
Application No. 09/908,727
Filed: July 20, 2001
Attorney Docket No. 740756-2328

ON PETITION

This is a decision on the petition, filed October 14, 2004, which is being treated under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on September 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 Wan Laymon at (571) 272-3220.

This matter is being referred to Technology Center AU 2812 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed IDS.

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

---

[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

ERIC ROBINSON
PMB 955
21010 SOUTHBANK ST.
POTOMAC FALLS VA 20165

FEB 14 2005

In re Application of: Ohtani et al	:	
Application No. 09/908,727	:	NOTICE OF WITHDRAWAL
Filed: 7/20/2001	:	FROM ISSUE
Attorney Docket No. 740756-2328	:	UNDER 37 CFR э 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 October 28, 2004, are hereby vacated.

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

The issue fee is refundable upon request. However, the 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, the applicant may request either a refund or a credit to a Deposit Account.

Telephone inquires should be directed to Michael S. Lebentritt, Supervisory Patent Examiner, at (571) 272-1873.

The above-identified application is being forwarded to the examiner for prompt appropriate action.

Sharon Gibson, 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
www.uspto.go

DANIELS DANIELS & VERDONIK PA
GENERATION PLAZA
STE 200
1822 N.C. HIGHWAY 54 EAST
DURHAM NC 27713

MAIL

JUN 0 3 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re Application of
TERRY
Application No. 09/908,754
Filed: July 19, 2001
For: PRIORITY PACKET TRANSMISSION SYSTEM FOR TELEPHONY, LATENCY-SENSITIVE DATA, BEST-EFFORT DATA AND VIDEOS STREAMS IN A SHARED TRANSMISSION MEDIA SUCH AS PASSIVE COAX DISTRIBUTION

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request to withdraw as attorney/agent of record filed on May 02, 2005.

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.

All attorneys/agents associated with Customer Number 26108 have withdrawn.

Petitioner has satisfied the requirements for successfully requesting withdrawal. Accordingly, ***the request is granted.*** Future correspondence will be sent to the below address which has been provided by the withdrawing attorney(s).

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications
(571) 272-7288

cc: JOHN L. DOUGHTY
ARRIS INTERNATIONAL INC.
3871 LAKEFIELD DRIVE
SUWANEE GA 30024

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ROBERT E. BUSHNELL
SUITE 300
1522 K STREET, N.W.
WASHINGTON DC 20005

COPY MAILED
MAR 01 2010

In re Application of	:	
Yei-Chin Chao, et al.	:	
Application No. 09/908,773	:	NOTICE
Patent No. 6,700,652	:	
Filed: July 20, 2001	:	
Attorney Docket No. P56555		

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28.

The Office no longer investigates or rejects original or reissue patent under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

This patent is no longer entitled to small entity status. Accordingly, all future fees paid in this patent must be paid at the large entity rate.

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 documents must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Inquiries related to this communication should be directed to the undersigned at (571) 272-2991.

Terri Johnson

Terri Johnson
Petitions Examiner
Office of Petitions

cc: **LOWE HAUPTMAN HAM & BERNER, LLP**
1700 Diagonal Road, Suite 310
Alexandria, VA 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Microsoft Corporation
One Microsoft Way
Redmond, WA 98052

COPY MAILED

FEB 21 2008

OFFICE OF PETITIONS

In re Application of	:	
L. Roger Soles et al.	:	
Application No. 09/908,782	:	DECISION ON PETITION
Filed: July 18, 2001	:	
Attorney Docket No. 302379.02	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 14, 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-Complaint Amendment (37 CFR 1.121) mailed June 21, 2007, which set a shortened statutory period for reply of one (1) month. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on July 22, 2007. A Notice of Abandonment was mailed on January 14, 2008.

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 after non-final, (2) the petition fee of $1,540.00, and (3) a proper statement of unintentional delay.

While the assignee attempted to intervene in the above-identified application, the Power of Attorney filed on April 18, 2006, does not comply with the requirements of 37 CFR 3.73(b), in that, the statement under 3.73(b) fails to show a complete chain of title from the original owners to the current assignee (See box B on 3.73(b) form). Therefore, in order to perfect the power of attorneys filed on April 7, 2003 April 18, 2006, compliance with 37 CFR 3.73(b) must be fully satisfied.

In accordance with 37 CFR 1.34, the signature of James T. Strom appearing on the correspondence shall constitute a representation to the United States Patent and Trademark Office that he is authorized to represent the particular party in whose behalf he acts.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 2153 for appropriate action by the Examiner in the normal course of business on the reply received January 14, 2008.

Andrea Smith
Petitions Examiner
Office of Petitions

cc: James T. Strom
22317 NE 160th Place
Woodinville, WA 98077

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW 03-05

EDWARD J. LYNCH
DUANE MORRIS LLP
ONE MARKET
SPEAR TOWER STE 2000
SAN FRANCISCO CA 94105

COPY MAILED

MAR 17 2005

OFFICE OF PETITIONS

In re Application of	:	
Burbank et al.	:	DECISION ON PETITION
Application No. 09/908,815	:	UNDER 37 CFR 1.78(a)(6)
Filed: 20 July, 2001	:	
Atty Docket No. R0368-00900	:	

This is a decision on the petition under 37 CFR 1.78(a)(6), filed on 20 December, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional application.

The petition is **DISMISSED**.

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

> **(1)** the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
> **(2)** the surcharge set forth in § 1.17(t); and
> **(3)** a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on 20 July, 2001, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/279,477, which was filed on 28 March, 2001, and for which priority is claimed.

A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title.

However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew 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 applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See* In re deSeversky, *supra*. *Note also* MPEP 201.06(c).

It is additionally noted that the amendment filed on 8 February, 2005, does not state the relationship of the prior nonprovisional or provisional applications referenced therein. Petitioners must state whether the present nonprovisional application is a continuation, divisional, or continuation-in-part of the prior nonprovisional application, and state which nonprovisional application claims benefit of the prior provisional application.

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a substitute amendment[1] deleting the incorporation by reference statement and addressing the deficiencies noted above, along with a renewed petition under 37 CFR 1.78(a)(6), is required.

As authorized, the $1,370.00 fee required by 37 CFR 1.78(a)(6)(ii) will be charged to petitioner's Deposit Account No. 04-1679.

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: (703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Frances M. Hicks
Lead Paralegal
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] *Note* 37 CFR 1.121

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW May-05

EDWARD J. LYNCH
DUANE MORRIS LLP
ONE MARKET
SPEAR TOWER STE 2000
SAN FRANCISCO CA 94105

COPY MAILED

MAY 12 2005

OFFICE OF PETITIONS

In re Application of	:	
Burbank et al.	:	DECISION ON PETITION
Application No. 09/908,815	:	UNDER 37 CFR 1.78(a)(6)
Filed: 20 July, 2001	:	
Atty Docket No. R0368-00900	:	

This is a decision on the renewed petition under 37 CFR 1.78(a)(6), filed on 22 April, 2005, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional application.

The petition is again **DISMISSED**.

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

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on 20 July, 2001, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/279,477, which was filed on 28 March, 2001, and for which priority is claimed. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title.

The petition must be dismissed, however, because the amendment states that this application is a continuation of Application No. 09/556,934, filed on 20 April, 2000, which is based on Application No. 60/279,477, filed on 28 March, 2001. The amendment as drafted attempts to add a claim of benefit of Application No. 09/556,934, filed on 20 April, 2000, to Application No. 60/279,477, filed on 28 March, 2001. As an application may not claim the benefit of a subsequently-filed application, the amendment as drafted is improper.

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a substitute amendment[1] addressing the deficiencies noted above, along with a renewed petition under 37 CFR 1.78(a)(6), is required.

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: (703) 872-9306
ATTN: Office of Petitions

---

[1] *Note* 37 CFR 1.121

Any questions concerning this matter may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231.

Frances Hicks

Frances M. Hicks
Lead Paralegal
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
DIW Sep-05

EDWARD J. LYNCH
DUANE MORRIS LLP
ONE MARKET
SPEAR TOWER STE 2000
SAN FRANCISCO CA 94105

COPY MAILED

SEP 29 2005

OFFICE OF PETITIONS

In re Application of	:	
Burbank et al.	:	
Application No. 09/908,815	:	DECISION ON PETITION
Filed: 20 July, 2001	:	
Atty Docket No. R0368-00900	:	

This is a decision on the renewed petition under 37 CFR 1.78(a)(6), filed 19 August, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently-filed amendment.

The petition is **GRANTED**.

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

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The 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 provisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(5)(ii). Therefore, this is a proper petition under 37 CFR 1.78(a)(6).

The instant nonprovisional application was pending at the time of filing of the reference to the prior-fiiled provisional application as required by 37 CFR 1.78(a)(5)(iii). Additionally, the instant nonprovisional application was filed within twelve months of the filing date of the prior-filed provisional application, Application No. 60/279,477, which was filed on 18 March, 2001, for which priority is claimed.

The petition complies with the requirements for a grantable petition under 37 CFR 1.78(a)(6) in that (1) a reference to the above-noted, prior-filed provisional 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)(5)(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. § 119(e) to the above-noted, 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 that the instant application is entitled to the benefit of the filing date 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) 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.

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

Any inquiries concerning this decision may be directed to Senior Petitions Attorney Douglas I. Wood at (571) 272-3231. All other inquiries concerning either the examination procedures or status of the application should be directed to the Technology Center.

The application is being forwarded to Technology Center AU 3731 for appropriate action on the amendment submitted 19 August, 2005, including consideration by the examiner of the claim under 35 U.S.C. §119(e) for the benefit of priority to prior-filed provisional Application No. 60/279,477.

Frances M. Hicks
Lead Paralegal
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

EDWARD J. LYNCH
DUANE MORRIS LLP
ONE MARKET, SPEAR TOWER STE 2000
SAN FRANCISCO CA 94105

COPY MAILED

JAN 29 2007

OFFICE OF PETITIONS

In re Application of	:	
BURBANK, et al.	:	
Application No. 09/908,815	:	DECISION ON PETITION
Filed: July 20, 2001	:	
Attorney Docket No. 09875.1011	:	

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

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before September 20, 2006, as required by the Notice of Allowance and Fee(s) Due, mailed June 20, 2006 . Accordingly, the date of abandonment of this application is September 21, 2006 .

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $1400 and the publication fee of $300, (2) the petition fee of $1500; and (3) a proper statement of unintentional delay.

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

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be

submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Telephone inquiries concerning this decision should be directed to Monica Graves at (571) 272-7253.

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

David Bucci
Petitions Examiner
Office of Petitions

cc: **MELISSA J. SZANTO**
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENT
UNITED STATES PATENT AND TRADEMARK OFFIC
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
WWW.USPTO.GO

Paper No. 10

KEITH FRANTZ
401 WEST STATE STREET
SUITE 200
ROCKFORD, IL 61101

COPY MAILED
MAY 23 2003
OFFICE OF PETITIONS

In re Application of
Donald Mischo
Application No. 09/908,864
Filed: July 18, 2001
Attorney Docket No. MISCHO-5

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed May 16, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed July 5, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 6, 2002.

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on May 16, 2003.

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

The application file is being forwarded to Technology Center 3600 for further processing.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED
MAY 0 9 2006
OFFICE OF PETITIONS

Keith Frantz
401 West State Street
Suite 200
Rockford, IL 61101

In re Application of	:	
MISCHO	:	DECISION ON PETITION
Application No.: 09/908,864	:	
Filed: July 18, 2001	:	UNDER 37 CFR 1.137(b)
Attorney Docket No.: MISCHO-5	:	

This is a decision on the petition under 37 CFR 1.137(b), filed February 13, 2006, 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 November 22, 2004, which set a shortened statutory period for reply of three (3) months. While a timely reply was filed on May 26, 2005 (reply was accompanied by petition for a three-month extension of time with certificate of mailing of May 23, 2005), that reply did not prima facie place this application in condition for allowance as indicated by the Advisory Action of June 15, 2005. A Notice of Appeal was not filed. Accordingly, by operation of law, the above-identified application became abandoned on May 23, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a Request for Continued Examination (RCE) and submission as required by 37 CFR 1.114; (2) the petition fee and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of November 22, 2004 is accepted as having been unintentionally delayed.

The application is being referred to Technology Center AU 3643.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KEITH FRANTZ
401 WEST STATE STREET
SUITE 200
ROCKFORD, IL 61101

COPY MAILED

FEB 13 2008

In re Application of	:	
Donald J. Mischo	:	
Application No. 09/908,864	:	DECISION ON PETITION
Filed: July 18, 2001	:	
Attorney Docket No. MISCHO-5	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed December 26, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 14, 2006, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on September 15, 2006. A Notice of Abandonment was mailed on January 24, 2007.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment after non-final, (2) the petition fee of $1540.00, and (3) a proper statement of unintentional delay.

There is no indication that the person signing the instant petition was ever given a power of attorney or authorization of agent to prosecute the above-identified application. In accordance with 37 CFR 1.34(a), the signature appearing on the petition shall constitute a representation to the United States Patent and Trademark Office that he/she is authorized to represent the particular party in whose behalf he/she acts.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 3643 for appropriate action by the Examiner in the normal course of business on the reply received December 26, 2007.

Andrea Smith
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JUL 20 2010

OFFICE OF PETITIONS

Intellectual Property Dept.
Dewitt Ross & Stevens SC
2 East Mifflin Street
Suite 600
Madison WI 53703-2865

In re Application of	:	
Donald J. Mischo	:	
Application No. 09/908,864	:	DECISION ON PETITION
Filed: July 18, 2001	:	
Attorney Docket No.	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed April 22, 2010, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to reply in a timely manner to the non-final Office action mailed March 3, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on June 4, 2008. A Notice of Abandonment was mailed on October 6, 2008.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an amendment, (2) the petition fee of $1,620 and (3) a proper statement of unintentional delay. Accordingly, the amendment is accepted as being unintentionally delayed.

A Revocation of Power of Attorney was filed on June 7, 2010. All future correspondence will be forwarded to the current address of record.

Telephone inquiries concerning this decision should be directed to Kimberly Inabinet at (571) 272-4618.

This application is being referred to Technology Center AU 3643 for appropriate action by the Examiner in the normal course of business on the reply received April 22, 2010.

/Kimberly Inabinet/

Kimberly Inabinet
Petitions Examiner
Office of Petitions

cc: Keith Frantz
401 W. State Street, Ste. 200
Rockford, IL 61101

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2

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

#6 ~~JUL 30 2002~~

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

~~JUL 3 2002~~

In re Application of	: RESPONSE TO PETITION
Vierira, et al.	: UNDER 37 CFR 1.182
Application No. 09/908,888	: SEEKING SPECIAL
Filed: July 20, 2001	: TREATMENT OF DISCLOSURE
For: Fabrication Of A Wavelength	: STATEMENTS, AND
Locker Within A Semiconductor	: DECISION ON PETITION
Structure	: UNDER 37 CFR 1.183
Attorney Docket No. 211692US99	: SEEKING WAIVER OF
	: REQUIREMENTS UNDER
	: 37 CFR 1.98

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is **GRANTED IN PART** to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS."[1] Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

Any 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) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

TC Assignment Appendix
Bulk Filing List With TC Assignment

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
205680us-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737-99	09884150	2811
210790US-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467US-8737-8737-99	09907705	2811
211685US-8737-8737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
211585US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737 8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

TC Assignment Appendix
Bulk Filing List With TC Assignment

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-CIP	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-CIP	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
' 209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US-8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114 71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8-8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737- 99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-87377737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

TC Assignment Appendix
Bulk Filing List With TC Assignment

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US 8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

TC Assignment Appendix
Bulk Filing List With TC Assignment

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21105705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

2814

OIPE JC139
JAN 0 2 2003
PATENT & TRADEMARK OFFICE

Docket No.: 211692US99

OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.
ATTORNEYS AT LAW

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RE: Application Serial No.: 09/908,888
Applicants: Amarildo J. VIEIRA, et al.
Filing Date: July 20, 2001
For: FABRICATION OF A WAVELENGTH LOCKER WITHIN A SEMICONDUCTOR STRUCTURE
Group Art Unit: 2814
Examiner: WILLE

SIR:

Attached hereto for filing are the following papers:

SUBMISSION OF INFORMATION DISCLOSURE STATEMENT PURSUANT TO THE PETITION GRANTED JULY 31, 2002; DECISION (copy); PETITION AND SUPPLEMENTAL PETITION (copy); INFORMATION DISCLOSURE STATEMENT; FORM PTO 1449'S (23PP); CITED REFERENCES (712)

Our check in the amount of $0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Richard L. Treanor
Attorney of Record
Registration No. 36,379

22850

(703) 413-3000 (phone)

1755 JEFFERSON DAVIS HIGHWAY ▮ FOURTH FLOOR ▮ ARLINGTON, VIRGINIA 22202 ▮ U.S.A.
TELEPHONE: 703-413-3000 ▮ FACSIMILE: 703-413-2220 ▮ WWW.OBLON.COM

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2001

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

~~JUL 30 2002~~

RECEIVED: 8-5-02
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 8-5-02
Type of Resp(s):
Due Date(s):

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

OIPE JC139
JAN 0 2 2003
PATENT & TRADEMARK OFFICE

In re Application of	: RESPONSE TO PETITION
Vierira, et al.	: UNDER 37 CFR 1.182
Application No. 09/908,888	: SEEKING SPECIAL
Filed: July 20, 2001	: TREATMENT OF DISCLOSURE
For: Fabrication Of A Wavelength	: STATEMENTS, AND
Locker Within A Semiconductor	: DECISION ON PETITION
Structure	: UNDER 37 CFR 1.183
Attorney Docket No. 211692US99	: SEEKING WAIVER OF
	: REQUIREMENTS UNDER
	: 37 CFR 1.98

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is **GRANTED IN PART** to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

TC Assignment Appendix
Bulk Filing List With TC Assignment

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467U5-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
211585US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208834US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-3737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US-8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8-8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99 CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211517US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

OIPE JC117
MAY 0 8 2003
PATENT & TRADEMARK OFFICE

OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.
ATTORNEYS AT LAW

Docket No.: 211692US99

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

RECEIVED
MAY 12 2003
TECHNOLOGY CENTER 2800

RE: Application Serial No.: 09/908,888
Applicants: Amarildo J. VIEIRA, et al.
Filing Date: July 20, 2001
For: FABRICATION OF A WAVELENGTH LOCKER WITHIN A SEMICONDUCTOR STRUCTURE
Group Art Unit: 2814
Examiner: WILLE

SIR:

Attached hereto for filing are the following papers:

SUBMISSION OF INFORMATION DISCLOSURE STATEMENT PURSUANT TO THE PETITION GRANTED JULY 31, 2002 (copy); DECISION (copy); PETITION AND SUPPLEMENTAL PETITION (copy); INFORMATION DISCLOSURE STATEMENT; FORM PTO 1449'S (5PP); CITED REFERENCES (104)

Our check in the amount of $0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Richard L. Treanor
Attorney of Record
Registration No. 36,379

22850
(703) 413-3000 (phone)

1755 JEFFERSON DAVIS HIGHWAY FOURTH FLOOR ARLINGTON, VIRGINIA 22202 U.S.A.
TELEPHONE: 703-413-3000 FACSIMILE: 703-413-2220 WWW.OBLON.COM

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2001

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

MAY 0 8 2003

JUL 30 2002

RECEIVED: 8-5-02
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 8-5-02
Type of Resp(s):
Due Date(s):

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

In re Application of
Vierira, et al.
Application No. 09/908,888
Filed: July 20, 2001
For: Fabrication Of A Wavelength Locker Within A Semiconductor Structure
Attorney Docket No. 211692US99

: RESPONSE TO PETITION
: UNDER 37 CFR 1.182
: SEEKING SPECIAL
: TREATMENT OF DISCLOSURE
: STATEMENTS, AND
: DECISION ON PETITION
: UNDER 37 CFR 1.183
: SEEKING WAIVER OF
: REQUIREMENTS UNDER
: 37 CFR 1.98

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is **GRANTED IN PART** to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

TC Assignment Appendix
Bulk Filing List With TC Assignment

OIPE
MAY 0 8 2003
PATENT & TRADEMARK OFFICE

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467U5-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
211585US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US 8737 8737 99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US-8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8-8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2

MAR 27 2003 PATENT & TRADEMARK OFFICE

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

~~JUL 30 2002~~

RECEIVED: 8-5-02
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 8-5-02
Type of Resp(s):
Due Date(s):

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

In re Application of
Vierira, et al.
Application No. 09/908,888
Filed: July 20, 2001
For: Fabrication Of A Wavelength Locker Within A Semiconductor Structure
Attorney Docket No. 211692US99

: RESPONSE TO PETITION
: UNDER 37 CFR 1.182
: SEEKING SPECIAL
: TREATMENT OF DISCLOSURE
: STATEMENTS, AND
: DECISION ON PETITION
: UNDER 37 CFR 1.183
: SEEKING WAIVER OF
: REQUIREMENTS UNDER
: 37 CFR 1.98

RECEIVED
APR - 1 2003
TECHNOLOGY CENTER 2800

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is **GRANTED IN PART** to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467U5-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
21158!5US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
' 209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US~8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8~8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

Docket No. 210295US99

OIPE JC139
MAY 0 8 2003
PATENT & TRADEMARK OFFICE

2814

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: TOMASZ L. KLOSOWIAK ET AL

SERIAL NO: 09/897,059 GAU: 2814

FILED: JULY 3, 2001 EXAMINER: WILLE

FOR: STRUCTURE AND METHOD FOR FABRICATING SEMICONDUCTOR STRUCTURES AND DEVICES UTILIZING THE FORMATION OF A COMPLIANT SUBSTRATE FOR MATERIALS USED TO FORM THE SAME AND PIEZOELECTRIC STRUCTURES HAVING CONTROLLABLE OPTICAL SURFACES

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:
Applicant(s) wish to disclose the following information.

REFERENCES

■ The applicant(s) wish to make of record the references listed on the attached form PTO-1449. Copies of the listed references were submitted in application Serial No. 09/908,888 according to the attached copy of a Granted Petition. This application contains related subject matter.

☐ A check is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

☐ Attached is a list of applicant's pending application(s) or issued patent(s) which may be related to the present application. A copy of the patent(s), together with a copy of the claims and drawings of the pending application(s) is attached along with PTO 1449.

☐ A check is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

☐ Each item of information contained in this information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.

☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

■ Please charge any additional fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Richard L. Treanor
Registration No. 36,379

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 03/02)

Docket No. 210295US99

OIPE JC139
MAY 0 8 2003
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: TOMASZ L. KLOSOWIAK ET AL

SERIAL NO: 09/897,059 GAU: 2814

FILED: JULY 3, 2001 EXAMINER: WILLE

FOR: STRUCTURE AND METHOD FOR FABRICATING SEMICONDUCTOR STRUCTURES AND DEVICES UTILIZING THE FORMATION OF A COMPLIANT SUBSTRATE FOR MATERIALS USED TO FORM THE SAME AND PIEZOELECTRIC STRUCTURES HAVING CONTROLLABLE OPTICAL SURFACES

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:
Applicant(s) wish to disclose the following information.

REFERENCES

■ The applicant(s) wish to make of record the references listed on the attached form PTO-1449. Copies of the listed references were submitted in application Serial No. 09/908,888 according to the attached copy of a Granted Petition. This application contains related subject matter.

☐ A check is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

☐ Attached is a list of applicant's pending application(s) or issued patent(s) which may be related to the present application. A copy of the patent(s), together with a copy of the claims and drawings of the pending application(s) is attached along with PTO 1449.

☐ A check is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

☐ Each item of information contained in this information disclosure statement was first cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.

☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

■ Please charge any additional fees for the papers being filed herewith and for which no check is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Richard L. Treanor
Registration No. 36,379

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 03/02)

OIPE JC139
MAY 0 8 2003
PATENT & TRADEMARK OFFICE

Form PTO 1449 (Modified)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

LIST OF REFERENCES CITED BY APPLICANT

ATTY DOCKET NO.	SERIAL NO.
210295US99	09/897,059
APPLICANT	
Tomasz L. KLOSOWIAK, et al.	
FILING DATE	GROUP
July 3, 2001	2814

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	UT	5,528,209	06/18/96	Macdonald et al.			
	UV	5,998,781	12/07/99	Vawter et al.			
	UW	6,110,813	08/29/00	Ota et al.			
	UX	6,452,232 B1	09/17/02	Adan			
	UY	6,049,110	04/11/00	Koh			
	UZ	5,559,368	09/24/96	Hu et al.			
	VA	6,392,253 B1	05/21/02	Saxena			
	VB	5,585,288	12/17/96	Davis et al.			
	VC	5,268,327	12/07/93	Vernon			
	VD	6,198,119 B1	03/06/01	Nabatame et al.			
	VE	6,113,225	09/05/00	Miyata et al.			
	VF	5,262,659	11/16/93	Grudkowski et al.			
	VG	6,239,012 B1	05/29/01	Kinsman			
	VH	6,297,598	10/02/01	Wang et al.			
	VI	2002/140012	10/03/02	Droopad			
	VJ	4,866,489	09/12/89	Yokogawa et al.			
	VK	6,080,378	06/27/00	Yokota et al.			
	VL	5,508,554	04/16/96	Takatani et al.			
	VM	6,477,285 B1	11/05/02	Shanley			
	VN	4,695,120	09/22/87	Holder			
	VO	5,882,948	03/16/99	Jewell			
	VP	5,574,589	11/12/96	Feuer et al.			
	VQ	5,510,665	04/23/96	Conley			
	VR	4,804,866	02/14/89	Akiyama			
	VS	5,057,694	10/15/91	Idaka et al.			
	VT	5,635,453	06/03/97	Pique et al.			
	VU	5,719,417	02/17/98	Roeder et al.			
	VV	5,998,819	12/07/99	Yokoyama et al.			

Examiner | Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

OIPE JC139
MAY 0 8 2003
PATENT & TRADEMARK OFFICE

Form PTO 1449 (Modified)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

LIST OF REFERENCES CITED BY APPLICANT

ATTY DOCKET NO.	SERIAL NO.
210295US99	09/897,059
APPLICANT	
Tomasz L. KLOSOWIAK, et al.	
FILING DATE	GROUP
July 3, 2001	2814

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	VW	2002/0079576	06/27/02	Seshan			
	VX	5,148,504	09/15/92	Levi et al.			
	VY	2002/0195610 A1	12/26/02	Klosowiak			
	VZ	5,477,363	12/19/95	Matsuda			
	WA	5,905,571	05/18/99	Butler et al.			
	WB	5,570,226	10/29/96	Ota			
	WC	5,087,829	02/11/92	Ishibashi et al.			
	WD	2001/0020278 A1	09/06/01	Saito			
	WE	6,496,469 B1	12/17/02	Uchizaki			
	WF	5,679,947	10/21/97	Doi et al.			
	WG	2001/0036142 A1	11/01/01	Kadowaki et al.			
	WH	5,446,719	08/29/95	Yoshida et al.			
	WI	5,831,960	11/03/98	Jiang et al.			
	WJ	5,693,140	12/02/97	McKee et al.			
	WK	6,376,337 B1	04/23/02	Wang et al.			
	WL	4,177,094	12/04/79	Kroon			
	WM	5,216,359	06/01/93	Makki et al.			
	WN	6,307,996 B1	10/23/01	Nashimoto et al.			
	WO	5,371,621	12/06/94	Stevens			
	WP	2002/0145168 A1	10/10/02	Bojarczuk, Jr et al.			
	WQ	3,617,951	11/02/71	Anderson			
	WR	5,838,053	11/17/98	Bevan et al.			
	WS	5,684,302	11/04/97	Wersing et al.			
	WT	5,959,308	09/28/99	Shichijo et al.			
	WU	5,362,972	11/08/94	Yazawa et al.			
	WV	5,864,171	01/26/99	Yamamoto et al.			
	WW	5,028,563	07/02/91	Feit et al.			
	WX	5,937,115	08/10/99	Domash			

Examiner	Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

OIPE JC139
MAY 0 8 2003
PATENT & TRADEMARK OFFICE

Form PTO 1449 (Modified)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

LIST OF REFERENCES CITED BY APPLICANT

ATTY DOCKET NO.	SERIAL NO.
210295US99	09/897,059
APPLICANT	
Tomasz L. KLOSOWIAK, et al.	
FILING DATE	GROUP
July 3, 2001	2814

U.S. PATENT DOCUMENTS

EXAMINER INITIAL		DOCUMENT NUMBER	DATE	NAME	CLASS	SUB CLASS	FILING DATE IF APPROPRIATE
	WY	5,878,175	03/02/99	Sonoda et al.			
	WZ	4,801,184	01/31/89	Revelli			
	XA	5,140,387	08/18/92	Okazaki et al.			
	XB	5,410,622	04/25/95	Okada et al.			
	XC	6,064,783	05/16/00	Congdon et al.			
	XD	5,772,758	06/30/98	Collins et al.			
	XE	5,666,376	09/09/97	Cheng			
	XF	5,976,953	11/02/99	Zavracky et al.			
	XG	5,578,162	11/26/96	D'Asaro et al.			
	XH	5,585,167	12/17/96	Satoh et al.			
	XI	5,674,813	10/07/97	Nakamura et al.			
	XJ	5,574,296	11/12/96	Park et al.			
	XK	6,504,189	01/07/03	Matsuda et al.			
	XL	5,987,196	11/16/99	Noble			
	XM						
	XN						
	XO						
	XP						
	XQ						
	XR						
	XS						
	XT						
	XU						
	XV						
	XW						
	XX						
	XY						
	XZ						

Examiner	Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

OIPE JC13
MAY 0 8 2003
PATENT & TRADEMARK

Form PTO 1449 (Modified)

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

LIST OF REFERENCES CITED BY APPLICANT

ATTY DOCKET NO.	SERIAL NO.
210295US99	09/897,059
APPLICANT	
Tomasz L. KLOSOWIAK, et al.	
FILING DATE	GROUP
July 3, 2001	2814

FOREIGN PATENT DOCUMENTS

		DOCUMENT NUMBER	DATE	COUNTRY	TRANSLATION YES	TRANSLATION NO
	CBC	EP 1 035 759	09/13/00	Europe		
	CBD	EP 0 860 913	08/26/95	EUROPE		
	CBE	5-232307	09/10/93	JAPAN W/ENGLISH ABSTRACT		
	CBF	5-243525	09/31/93	JAPAN W/ENGLISH ABSTRACT		
	CBG	3-171617	07/25/91	JAPAN W/ENGLISH ABSTRACT		
	CBH	EP 1 089 338	04/04/01	EUROPE		
	CBI	01 294594	11/28/99	JAPAN (ABSTRACT)		
	CBJ	05 221800	08/31/93	JAPAN (ABSTRACT)		
	CBK	03-149882	11/07/89	JAPAN		
	CBL	0 614 256	09/07/94	EUROPE		
	CBM	1 054 442	11/22/00	EUROPE		
	CBN	0 852 416	07/08/98	EUROPE		
	CBO	WO 02/08806	01/31/02	WIPO		
	CBP	WO 01/59837	08/16/01	WIPO		
	CBQ	62-245205	10/26/87	JAPAN W/ENGLISH ABSTRACT		
	CBR	0 600 658	06/08/94	EUROPE		
	CBS	0 412 002	02/06/91	EUROPE		
	CBT	2000-349278	12/15/00	JAPAN (ENGLISH ABSTRACT)		
	CBU	01-196809	08/08/89	JAPAN (ENGLISH ABSTRACT)		
	CBV	0 619 283	10/12/94	EUROPE		
	CBW	0 661 561	07/05/95	EUROPE		
	CBX	0 331 338	09/06/89	EUROPE		
	CBY					
	CBZ					
	CCA					
	CCB					
	CCC					
	CCD					
	CCE					
	CCF					
	CCG					
	CCH					
	CCI					
	CCJ					
	CCK					
	CCL					
	CCM					
	CCN					
	CCO					
	CCP					

OIPE JC139
MAY 0 8 2003
PATENT & TRADEMARK OFFICE

Form PTO 1449 (Modified) U.S. DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE	ATTY DOCKET NO. 210295US99	SERIAL NO. 09/897,059
LIST OF REFERENCES CITED BY APPLICANT	APPLICANT Tomasz L. KLOSOWIAK, et al.	
	FILING DATE July 3, 2001	GROUP 2814

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, etc.)

	KKAO	Charles Kittel; "Introduction to Solid State Physics"; John Wiley & Sons, Inc. Fifth Edition; pp. 415
	KKAP	Chyuan-Wei Chen et al; "Liquid-phase epitaxial growth and characterization of InGaAsP layers grown on GaAsP substrates for application to orange light-emitting diodes"; 931 Journal of Applied Physics; 77 (1995) 15 January, No. 2; Woodbury, NY, US; pp. 905-909
	KKAQ	W. Zhu et al.; "Oriented diamond films grown on nickel substrates"; 320 Applied Physics Letters; 63(1993) September, No. 12, Woodbury, NY, US; pp. 1640-1642
	KKAR	M. Schreck et al.; "Diamond/Ir/SrTi03: A material combination for improved heteroepitaxial diamond films"; Applied Physics Letters; Vol. 74, No. 5; February 1, 1999; pp. 650-652
	KKAS	Yoshihiro Yokota et al.; "Cathodoluminescence of boron-doped heteroepitaxial diamond films on platinum"; Diamond and Related Materials 8(1999); pp. 1587-1591
	KKAT	J.R. Busch et al.; "LINEAR ELECTRO-OPTIC RESPONSE IN SOL-GEL PZT PLANAR WAVEGUIDE" ; Electronics Letters; 13th August 1992; Vol. 28, No. 17; pp. 1591-1592
	KKAU	R. Droopad et al; "Epitaxial Oxide Films on Silicon: Growth, Modeling and Device Properties" ; Mat. Res. Soc. Symp. Proc. Vol. 619; 2000 Materials Research Society; pp. 155-165
	KKAV	H. Ohkubo et al.; "Fabrication of High Quality Perovskite Oxide Films by Lateral Epitaxy Verified with RHEED Oscillation" ; 2419A Int. Conf. on Solid State Devices & Materials, Tsukuba, August 26-28 (1992); pp. 457-459
	KKAW	Lin Li; "Ferroelectric/Superconductor Heterostructures" ; Materials Science and Engineering; 29 (2000) pp. 153-181
	KKAX	L. Fan et al.; "Dynaamic Beam Switching of Vertical-Cavity Surface-Emitting Lasers with Integrated Optical Beam Routers" ; IEEE Photonics Technology Letters; Vol. 9, No. 4; April 4, 1997; pp. 505-507
	KKAY	Y. Q. Xu. et al.; "(Mn, Sb) dropped-Pb(Zr,Ti)03 infrared detector arrays" ; Journal of Applied Physics; Vol. 88, No. 2; 15 July 2000; pp. 1004-1007
	KKAZ	Kiyoko Kato et al.; "Reduction of dislocations in InGaAs layer on GaAs using epitaxial lateral overgrowth" ; 2300 Journal of Crystal Growth 115 (1991) pp. 174-179; December 1991
	LLAA	
	LLAB	
	LLAC	
	LLAD	
	LLAE	

Examiner	Date Considered

*Examiner: Initial if reference is considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2002

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

JUL 30 2002

RECEIVED: 8-5-02
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 8-5-02
Type of Resp(s):
Due Date(s):

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

In re Application of
Vierira, et al.
Application No. 09/908,888
Filed: July 20, 2001
For: Fabrication Of A Wavelength Locker Within A Semiconductor Structure
Attorney Docket No. 211692US99

: RESPONSE TO PETITION
: UNDER 37 CFR 1.182
: SEEKING SPECIAL
: TREATMENT OF DISCLOSURE
: STATEMENTS, AND
: DECISION ON PETITION
: UNDER 37 CFR 1.183
: SEEKING WAIVER OF
: REQUIREMENTS UNDER
: 37 CFR 1.98

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is **GRANTED IN PART** to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467US-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
21158!5US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
' 209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US-8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8-8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2001

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

~~JUL 30 2002~~

RECEIVED: 8-5-02
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 11-8-02
Type of Resp(s):
Due Date(s):

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

OIPE JC98
NOV 07 2003
PATENT & TRADEMARK OFFICE

In re Application of
Vierira, et al.
Application No. 09/908,888
Filed: July 20, 2001
For: Fabrication Of A Wavelength Locker Within A Semiconductor Structure
Attorney Docket No. 211692US99

: RESPONSE TO PETITION
: UNDER 37 CFR 1.182
: SEEKING SPECIAL
: TREATMENT OF DISCLOSURE
: STATEMENTS, AND
: DECISION ON PETITION
: UNDER 37 CFR 1.183
: SEEKING WAIVER OF
: REQUIREMENTS UNDER
: 37 CFR 1.98

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is <u>GRANTED IN PART</u> to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

RECEIVED
NOV 21 2003
TECHNOLOGY CENTER 2800

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

TC Assignment Appendix
Bulk Filing List With TC Assignment

OIPE JC
NOV 0 7 2003
PATENT & TRADEMARK OFFICE

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467U5-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
21158!5US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

7/17/02

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

TC Assignment Appendix
Bulk Filing List With TC Assignment

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
' 209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US-8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8-8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

TC Assignment Appendix
Bulk Filing List With TC Assignment

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2001

NOV 07 2003
PATENT & TRADEMARK OFFICE

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

~~JUL 30 2002~~

RECEIVED: 8-5-02
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 11-8-02
Type of Resp(s):
Due Date(s):

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

In re Application of
Vierira, et al.
Application No. 09/908,888
Filed: July 20, 2001
For: Fabrication Of A Wavelength Locker Within A Semiconductor Structure
Attorney Docket No. 211692US99

: RESPONSE TO PETITION
: UNDER 37 CFR 1.182
: SEEKING SPECIAL
: TREATMENT OF DISCLOSURE
: STATEMENTS, AND
: DECISION ON PETITION
: UNDER 37 CFR 1.183
: SEEKING WAIVER OF
: REQUIREMENTS UNDER
: 37 CFR 1.98

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is <u>GRANTED IN PART</u> to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

TC Assignment Appendix
Bulk Filing List With TC Assignment

OIPE JC34
NOV 0 7 2003
PATENT & TRADEMARK OFFICE

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467U5-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
211581 5US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

OIPE JC34
NOV 0 7 2003
PATENT & TRADEMARK OFFICE

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

TC Assignment Appendix
Bulk Filing List With TC Assignment

OIPE JC34
NOV 0 7 2003
PATENT & TRADEMARK OFFICE

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
' 209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US-8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8~8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

OIPE JC34
NOV 0 7 2003
PATENT & TRADEMARK OFFICE

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

OIPE JC34
NOV 07 2003
PATENT & TRADEMARK OFFICE

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

OIPE JC34
NOV 0 7 2003
PATENT & TRADEMARK OFFICE

OIPE JC34
NOV 0 7 2003
PATENT & TRADEMARK OFFICE

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2001

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

~~JUL 30 2002~~

RECEIVED: 8-5-02
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 8-5-02
Type of Resp(s):
Due Date(s):

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

OIPE
MAY 12 2004
PATENT & TRADEMARK OFFICE

In re Application of
Vierira, et al.
Application No. 09/908,888
Filed: July 20, 2001
For: Fabrication Of A Wavelength Locker Within A Semiconductor Structure
Attorney Docket No. 211692US99

: RESPONSE TO PETITION
: UNDER 37 CFR 1.182
: SEEKING SPECIAL
: TREATMENT OF DISCLOSURE
: STATEMENTS, AND
: DECISION ON PETITION
: UNDER 37 CFR 1.183
: SEEKING WAIVER OF
: REQUIREMENTS UNDER
: 37 CFR 1.98

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is **GRANTED IN PART** to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467U5-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
21158!5US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
' 209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US-8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8-8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31

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

MAR 14 2003

JUL 30 2002

RECEIVED: 8-5-02

OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 11-8-02
Type of Resp(s):
Due Date(s):

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

In re Application of	: RESPONSE TO PETITION
Vierira, et al.	: UNDER 37 CFR 1.182
Application No. 09/908,888	: SEEKING SPECIAL
Filed: July 20, 2001	: TREATMENT OF DISCLOSURE
For: Fabrication Of A Wavelength	: STATEMENTS, AND
Locker Within A Semiconductor	: DECISION ON PETITION
Structure	: UNDER 37 CFR 1.183
Attorney Docket No. 211692US99	: SEEKING WAIVER OF
	: REQUIREMENTS UNDER
	: 37 CFR 1.98

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is **GRANTED IN PART** to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

Copied from 10356550 on 10/16/2004

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Copied from 10356550 on 10/16/2004

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Copied from 10356550 on 10/16/2004

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Copied from 10356550 on 10/16/2004

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

Copied from 10356550 on 10/16/2004

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

Copied from 10356550 on 10/16/2004

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467U5-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
21158!5US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

Copied from 10356550 on 10/16/2004

OIPE JC109
MAR 1 4 2003
PATENT & TRADEMARK OFFICE

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

Copied from 10356550 on 10/16/2004

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
' 209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US~8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8~8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Copied from 10356550 on 10/16/2004

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

Copied from 10356550 on 10/16/2004

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

Copied from 10356550 on 10/16/2004

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

Copied from 10356550 on 10/16/2004

OIPE JC18
MAR 1 4 2003
PATENT & TRADEMARK OFFICE

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

Copied from 10356550 on 10/16/2004

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2001

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

OIPE JC45
OCT 18 2004
PATENT & TRADEMARK OFFICE

~~JUL 30 2002~~

RECEIVED: 8-5-02
OBLON SPIVAK McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 8-5-02
Type of Resp(s):
Due Date(s):

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

In re Application of
Vierira, et al.
Application No. 09/908,888
Filed: July 20, 2001
For: Fabrication Of A Wavelength Locker Within A Semiconductor Structure
Attorney Docket No. 211692US99

: RESPONSE TO PETITION
: UNDER 37 CFR 1.182
: SEEKING SPECIAL
: TREATMENT OF DISCLOSURE
: STATEMENTS, AND
: DECISION ON PETITION
: UNDER 37 CFR 1.183
: SEEKING WAIVER OF
: REQUIREMENTS UNDER
: 37 CFR 1.98

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is **GRANTED IN PART** to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

BEST AVAILABLE COPY

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467U5-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
21158!5US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
' 209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US-8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8-8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

This Page is Inserted by IFW Indexing and Scanning Operations and is not part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☐ FADED TEXT OR DRAWING
- ☐ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☑ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: _____

IMAGES ARE BEST AVAILABLE COPY.
As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 31 2001

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

~~JUL 30 2002~~

RECEIVED: 8-5-02
OBLON SPIVAK McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 8-8-02
Type of Resp(s):
Due Date(s):

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

OIPE JC46
OCT 1 8 2004
PATENT & TRADEMARK OFFICE

In re Application of
Vierira, et al.
Application No. 09/908,888
Filed: July 20, 2001
For: Fabrication Of A Wavelength Locker Within A Semiconductor Structure
Attorney Docket No. 211692US99

: RESPONSE TO PETITION
: UNDER 37 CFR 1.182
: SEEKING SPECIAL
: TREATMENT OF DISCLOSURE
: STATEMENTS, AND
: DECISION ON PETITION
: UNDER 37 CFR 1.183
: SEEKING WAIVER OF
: REQUIREMENTS UNDER
: 37 CFR 1.98

BEST AVAILABLE COPY

This is a response to a petition under 37 CFR 1.182 filed on April 12, 2002 and supplements filed on July 1, 2002 and on July 12, 2002. The § 1.182 petition requests special treatment of disclosure statements filed pursuant to 37 CFR 1.98. Additionally, the petition requests waiver of the rules which waiver is treated as a request under 37 CFR 1.183, for relief from the current requirements for Information Disclosure Statements under 37 CFR 1.98. The request for special treatment and waiver are made in view of the need to file multiple applications relating to different aspects of a particular invention. The § 1.182 petition also contains a request seeking permission to submit prior art submissions on compact disc and the establishment and searching of an Official classification(s) based on the prior art submission. The petition under 37 CFR 1.183, is requesting relief from the § 1.98 provision which requires filing paper copies of references in each of many related applications where the references are being cited by Petitioner.

The petition under 37 CFR 1.182 requesting special treatment of disclosure statements, and the petition under 37 CFR 1.183 regarding the submission of a reduced number of paper copies of IDS references is **GRANTED IN PART** to the extent set forth below.

The Decision is set forth in five parts:

- Part I. Background
- Part II. Petition Under 37 CFR 1.182 - Special Treatment
- Part III. Petition Under 37 CFR 1.183 - Paper Copies
- Part IV. Summary
- Part V. Further Correspondence

Part I. Background

The instant application filed under 35 U.S.C. 111 is one of about 330 U.S. applications (either filed or to be filed) relating to

different aspects of an invention listed in the July 1, 2002 supplement to the petition. An appendix prepared by Technology Center 2800 indicates approximately 300 of the applications have been classified for examination in Technology Center 2800. The balance of about 30 applications are in five other Technology Centers. The July 12, 2002 supplement to the petition indicates that an Information Disclosure Citation List has in excess of 400 reference citations.

Petitioner's submission of an Information Disclosure Statement is taken as an attempt to comply with 37 CFR 1.56(b)(1) that requires disclosure to the Office of information that "establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim...." Such disclosure can be made by an Information Disclosure Statement (IDS) in the manner prescribed by 37 CFR 1.97 and 1.98.

Part II. Petition Under 37 CFR 1.182 - Special Treatment

The petition requests the establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

As is the case with all search Digests, their creation and usefulness is continually evaluated. The Office will create and place appropriate references in Digests as they are discovered. The Office will not commit to placement of each IDS citation, made in all of the bulk filing applications, in any Digest(s) as the particular relevancy of the citations at this time is uncertain because petitioner has supplied no explanation of any of the citations. The Office will not require that any digest(s) created be searched for each of the bulk filing applications as the appropriate search for any particular application is within the determination and discretion of individual examiner based on the claim(s) of that application.

The petition also mentions the submission of additional copies of the references on compact disc for the examiner's convenience which appear to be courtesy copies. Courtesy copies will not be made part of the Official record of any application and cannot be relied upon for meeting any requirement for the submission of an information disclosure statement. There is insufficient information in the petition concerning the data formats and software requirements to accord the compact discs any other status. Further, as discussed below, the Office has a procedure for electronically submitting citations without paper copies for an Information Disclosure Statement. Hence it is not clear why relief is required under § 1.182. In view of the relief granted below, and that no specific action is requested concerning the compact disc submission, no further discussion of the compact discs is required in this decision.

Petition under § 1.182 is Dismissed.

Part III. Petition Under 37 CFR 1.183 - Paper Copies

37 CFR 1.98 requires that any information disclosure statement provide a copy of all patents, publications or other information submitted under 37 CFR 1.97 for consideration by the Office. 37 CFR 1.97 notes that information disclosure statements are considered in regard to the application in which they are filed. See also MPEP 609, pages 600-118 and 600-119.

Paper copies: Petitioner notes that the instant application is one of about 330 bulk filing applications that will be or have been filed in regard to a particular technology. Accordingly, Petitioner requests that individual paper copies of each citation brought to the attention of the Office in regard to the instant individual application, the "holding" application, not be required to be submitted in each related "bulk filing" application. Rather, it is requested that three complete sets of paper copies be permitted to be filed as a substitute for filing in each application.

Rather than be required to submit, via a paper copy, 400 reference in each of 330 applications, Petitioner seeks to have:

(1) Three complete sets of paper copies of each IDS citation submitted;

(2) One application (the instant application) identified as a "holding" application which would contain one complete set of paper copies of references; the paper copies of U.S. patents to be submitted in only the "holding" application;

(3) The other related pending U.S. applications, hereafter referred to as the "bulk filing" applications, be exempt from containing a paper set of the references; the bulk filing applications will contain other information, e.g., a copy of the decision on petition permitting such procedure, a copy of the Form 1449 (or equivalent). The petition does not indicate whether the paper references that are to be submitted as a numbered compendium, which numbering will correspond to the numbering in a PTO-1449 form.

(4) The information supplied via the bulk filing IDS will be updated approximately monthly.

Once past the initial IDS submission, the petition proposes the waiver to apply to updates.

Suspension of action: In view of the use of the instant application as a holding application (to contain a complete set of paper copies of reference citations, which can be consulted by the examiner when examining any of the other bulk filing applications that have a Form 1449 but not the paper copies of the references), the petition does not address how upon allowance the instant holding application will be treated. Whether the application can remain as the holding application without a suspension of action is not addressed. An alternative not discussed in the petition is that an alternate application may be designated as the holding application.

Termination: Petitioner does not seek a specific right of termination. Termination by the Office is to be by written notice to the attorney giving a 2 month period. Termination by Petitioner is to be by returning to compliance with 37 CFR § 1.98. The Office will accept and specifically reserve the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Termination by Applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

Different Technology Centers: It appears from the petition that Petitioner intends to cite every reference cited in any of the 330 applications in every other application. No references will be omitted because they are less relevant or cumulative of those already of record in a particular application. At least 30 of the applications are of such divergent technologies that they are in 5 technology centers outside Technology Center 2800. The applications outside Technology Center 2800 will be examined in areas without convenient access to the paper copies in Technology Center 2800. The 5 other technology centers have requested more access to the paper copies than the relief granting this petition for all 330 applications will afford. It is not clear from the petition why citing every reference in every application when they are in such diverse technologies is necessary or required by § 1.56. Relieving petitioner of the burden of filing paper copies in applications outside Technology Center 2800 will create an additional burden on the examiners of those applications. It is also possible for applicant to comply with 37 CFR 1.98 for U.S. Patents and Patent application publications by submitting references via "e-IDS.[1]" Hence it appears that petitioner has not demonstrated why a waiver for those applications filed outside Technology Center 2800 is necessary.

Decision: 37 CFR 1.183 provides relief for extraordinary situations, when justice requires suspension of any requirement of the regulations which is not a requirement of the statutes. The instant petition urges that not only would applicant be spared the necessity of submitting duplicative paper copies of U.S. patents in over 300 applications, but also the Office would benefit from not having to handle and store the duplicative sets of copies. While there may be some negative effects from the Office's point of view in terms of making the copies available to different examiners handling the various applications, on balance, there is seen to be sufficient benefit to justify waiver in this instance for the applications filed in Technology Center 2800. With respect to those applications being examined outside

---

[1]The instructions for submitting an e-IDS can be downloaded at: http://www.uspto.gov/ebc/efs/downloads/documents/EFSePAVE_April23.pdf.

Technology Center 2800, on balance, the burden on petitioner is substantially less to provide an additional paper copy for each application with significantly less benefit to the Office waiving the requirement. Further with respect to other 30 applications the need to submit these references has not been established nor has petitioner addressed alternative methods of compliance.

Accordingly, the petition under 37 CFR 1.183 is granted to the extent indicated and under the terms and conditions as are set forth below.

The § 1.98(a)(2) requirement for (the submission of) a copy of each IDS citation in a bulk filing application will be waived in the bulk filing applications examined in Technology Center 2800 provided that the following 9 conditions are complied with:

1) Three paper copies of each IDS citation are or have been submitted to the Office;

2) Each (bulk filing) application for which waiver of § 1.98(a)(2) is desired refers to the instant holding application, such as by a claim of priority under 35 U.S.C. 120, or as containing related technology;

3) The information is or has also been cited in the holding application;

Note: Applicant is not required to cite in each bulk filing application every item of information that is cited in the instant holding application. Items should be cited in each bulk filing application on the basis of relevancy and materiality to the particular claims in the bulk filing application and what each piece of information teaches.

A waiver is not granted (for the requirement to supply a paper copy of an IDS citation in another bulk filing application) where the citation is not, or has not been, made in the instant holding application.

4) A copy of this Decision is filed in each bulk filing application for which waiver is requested;

5) Explanatory information related to a particular citation, such as the concise explanation of a foreign language reference under § 1.98(a)(2), once submitted in the holding application must be supplied in each bulk filing application where the citation is made.

6) The Office accepts and specifically reserves the right to terminate the waiver grant in regard to § 1.98(a)(2) without provision of reasons. In such event, a two month period will be given where paper copies would have to be supplied in all applications where new citations are made. Should a termination of the waiver be desired by the Office, the Office will provide written notice to the correspondence address of record. Termination by applicant may be by returning to compliance with § 1.98(a)(2) without formal notice thereof and no transition/continuing period after termination is required.

7) The grant of the § 1.183 petition re § 1.98(a)(2) does

not indicate that the Office would favorably treat a petition to suspend action under § 1.103(a) should the instant holding application be allowed. Issuance of the instant application as a patent is not seen to terminate its usefulness either: (1) as a holding application for references by examiners working on other related applications, or (2) as a vehicle for the storage of references to be cited even after the patent issues (35 U.S.C. 301, 37 CFR 1.501, and MPEP 2202). Should the instant application become abandoned, the issue of continued introduction of paper copies of new citations could be taken up at that time. The Office, however, may consider suspending or taking other appropriate action in the instant holding application in the event the holding application is allowed, if it is in the best interest of the Office to do so.

8) There will be no waiver of any aspects of 37 CFR 1.98 in any application after allowance or final rejection of that application.

9) The copies will be submitted as a compendium with the reference numbering in the Form 1449 corresponding to the presentation of the references in the compendium.

Part IV. Summary

The petition under 37 CFR 1.182 requesting special treatment by creation of special digests and accepting compact disc submissions is dismissed because there is no showing that the relief granted below under 37 CFR 1.183 is not sufficient for compliance with 37 CFR 1.56.

The petition under 37 CFR 1.183 agreeing to supply three copies of each IDS citation in a holding application and requesting waiver of the paper copy requirement for submission in every related application under § 1.98(a)(2) is granted for those applications examined in Technology Center 2800, however, the following is not agreed to:

- the waiver of supplying a paper copy of each reference in applications examined outside Technology Center 2800.
- the creation of Official search classifications and the mandatory search thereof.
- The establishment of an Official search classification containing all of the references cited in the IDS and that the examiners be required to search that classification.

Part V. Further Correspondence

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

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

Docket Number	Application #	Art Unit
	10125540	1631
	9984471	1641
	9624877	1725
	9911539	1725
	9911493	1743
	9832354	1753
	9842735	1765
	9884981	1765
	9911702	1765
	9921910	1765
	9975930	1765
	10124460	1765
	09273929	1765
	09662390	1765
	9905110	1772
	9621771	1775
	9870830	1775
	9871958	1775
	9901109	1775
	9960402	1775
	09274268	1775
	09465623	1775
	09813779	1775
	9865446	2631
	9930171	2633
	09617640	2633
	9910032	2663
	10152783	2673
	09607239	2681
	09607420	2682
	9900885	2811
	10125486	2811
	10128262	2811
	10141876	2811
	10145734	2811
	10150065	2811
	09607386	2811
205954US-8737-8737-99	09607434	2811
20568ous-8737-8737-99	09712425	2811
205890US-8737-8737-99	09721566	2811
2061 ssus-8737-s737-ss	09766046	2811
208836US-8737-8737-99	09861636	2811
210044US-8737-8737 99	09884150	2811
210790US.-8737-8737-99	09897965	2811
210260US-8737-8737-99	09900887	2811
211327US-8737-8737-99	09905869	2811
211318US-8737-8737-99	09905935	2811
211467U5-8737-8737-99	09907705	2811
211685US-87378737-99	09908695	2811
211535US-8737-8737-99	09908860	2811
211689US-8737-8737-99	09908886	2811
21158!5US-8737-8737-99	09909936	2811
211891 US-8737-8737-99	09911455	2811
211804US-8737-8737-99	09911456	2811
211642US-8737-8737-99	09911465	2811
211805US-8737-8737-99	09911475	2811
213020US-8737-8737-99	09930247	2811

Docket Number	Application #	Art Unit
214975US-8737-8737-99	09978096	2811
216416 US-8737-8737-99	09994066	2811
217300US-8737-8737-99	10017596	2811
217730US,8737-8737-99	10026446	2811
219105US-8737-8737-99	10062429	2811
220526 US-8737-236694-99	10091452	2811
	10137383	2812
	10150066	2812
205958US-8737-8737-99	09678372	2812
	09801881	2812
209888 US-8737-8737-99	09884082	2812
210236US-8737-8737-99	09900921	2812
210800US,8737-8737-99	09903741	2812
211147US-8737-8737-99	09903784	2812
211214US-8737-8737-99	09904892	2812
211398US-8737 8737-99	09905981	2812
211691 US-8737-8737-99	09908902	2812
211699US-8737-8737-99	09909941	2812
211574US-8737-8737-99	09910022	2812
211644US-8737-8737.99	09910754	2812
21217005-8737-8737-99	09921901	2812
21288605-8737-8737-99	09929021	2812
216420US-8737-8737-99	09993523	2812
218840US-8737-8737-99	10059411	2812
	10134506	2813
205962US-8737-8737-99	09624526	2813
205881 US-8737-8737-99-CIP	09780119	2813
291419US-8737-8737-99	09906783	2813
21189705.8737-8737-99	09911496	2813
211806US-8737-8737-99	09911496	2813
29 2171 US-8737-8737-99	09921905	2813
215930US-8737-8737-99	09986899	2813
	9930275	2814
	10137369	2814
	10140939	2814
205949US-8737-8737-99	09607408	2814
205924US-8737-8737-99	09621779	2814
205925US-8737 8737-99	09624699	2814
205917US-8737-8737-99	09642558	2814
205906US-8737-8737-99-CIP	09740219	2814
208835US-8737-8757-99	09861638	2814
208833US-8737-8737-99	09861639	2814
209079US-8737-8737-99	09865428	2814
209117US-8737-8737-99	09865429	2814
209080US-8737-8737-99	09865448	2814
208889US-8737-8737-99	09865449	2814
209995US-8797-8737-99	09882063	2814
210295US-8737-8737-99	09897059	2814
210789US-8737-8737-99	09897968	2814
211334US-8737-8737-99	09905980	2814
211323US-8737-8737-99	09906138	2814
211662US-8737-8737-99	09908888	2814
210139US-8737-8737-99	09909939	2814
211580US-8737-8737-99	09910019	2814
211719US-8737-8737-99	09911458	2814
211920US-x737-8737-99	09911459	2814
211720US-8737-8737-99	09911478	2814
21195505-8737-8737-99	09911488	2814

Docket Number	Application #	Art Unit
21202205-8737-8737-99	09911518	2814
21241905-8737$737-99	09921898	2814
21287705-8737-8737-99	09929018	2814
21294505-8737-8737-99	09929748	2814
212949US-8737-8737-99	09930188	2814
212960US-8737-8737-99	09930259	2814
212958US-8737-8737-99	09930278	2814
215560US-8737-8737-99	09983859	2814
21 B359US 8737-8737-99	10053588	2814
205920US-8737-8737-99-C1P	09607207	2815
20591 OUS-8737-8737-99	09621130	2815
205927US-8737-8737-99	09624691	2815
205918US-8737-8737-99	09629283	2815
205877US-8737-8737-99	09692568	2815
205887US-8737-8737-99	09733181	2815
205922US-8737-8737-99-C1P	09755340	2815
205961 US-8737-8737.99	09755341	2815
205960uS-8737-8737-99	09755691	2815
205966us-8737-8737-99-cIP	09824376	2815
205967US-8737-8737-99-CIP	09824615	2815
209279US-8737-8737-99	09849172	2815
209340US-8737'8737.99	09870592	2815
' 209997US-8737-8737-99	09882062	2815
210140US-8737-8737-99	09884982	2815
210243US-8737-8737-99	09900882	2815
210798US-8737-8737-99	09901601	2815
210827US-8737-8737-99	09903742	2815
211400US-8737-8737-99	09904841	2815
210828US-8737-8737-99	09905932	2815
211677US-8737.-8737-99	09908892	2815
211675US-8737-8737-99	09910021	2815
211645US 8737-8737-99	09911412	2815
211894US-8737-8737-99	09911490	2815
212423US-8737-8737-99	09911491	2815
211896US-8737-8737-99	09911542	2815
2114.71 US-8737-8737-99	09911691	2815
21202405-8737-8737-99	09918801	2815
212543US-8737-8737-99	09924481	2815
21266905-8737-8737-99	09927396	2815
212761 US-8737-8737-99	09928356	2815
212954US-8737-8737-99	09929020	2815
29 287805-8737-8737-99	09929022	2815
212947US-8737-8737-99	09929261	2815
212944 US-8737-8737-99	09930145	2815
29290605-8737-8737-99	09930175	2815
212948US-8737-8737-99	09930176	2815
213012US-8737-8737-99	09930260	2815
212953US-8737-873799	09930261	2815
212959 US-8737-8737-99	09930276	2815
213130US-8737-8737-99	09934836	2815
215512US•8737-8737-99-CIP	09983854	2815
215878US-8737-.8737-99-DIV	09986034	2815
219625US-8737-8737-99-DIV	10076450	2815
211573US-8737-8737-99	09909938	2816
211637US-87378737-99	09910799	2817
	10161743	2818
205955US-8737-8737-99	09609071	2818
205913U8-8737-8737•99	09656337	2818
205957US-8737-8737-99	09712875	2818

Docket Number	Application #	Art Unit
205908US$737-8737-99	09740268	2818
206160US-8737-8737-99	09753808	2818
205909US-.8737-8737-99	09822499	2818
205969US,8737-8737-99	09822499	2818
205971 US-8737-8737-99	09824259	2818
205970US-8737-8737-99	09824388	2818
209278US-8737-8737-99	09849159	2818
209280US-8737-8737-99-CIP	09859700	2818
209341 US-8737-8737-99	09870589	2818
209164US-8737-8737-99	09870828	2818
209166US-8737-8737-99	09870829	2818
210132US-8737-8737-99	09884149	2818
210148US-8737-8737-99	09885409	2818
211314US-8737-8737-99	09905868	2818
211422US-8737-8737-99	09906769	2818
211472US-8737-8737-99	09908898	2818
211670U&8737-8737-99	09910018	2818
211686US-8737-8737-99	09910020	2818
211640US-8737-8737-99	09910798	2818
21195805-8737-8737-99	09911429	2818
211584US-8737-8737-99	09911448	2818
211578US-8737-8737-.99	09911628	2818
211425US-8737-873799	09911629	2818
215562 US-8737-8737-99	09983869	2818
217459US-8737-8737-99	10020900	2818
218843US 8737-8737-99	10059409	2818
215820US 8737-8737-99	09986534	2821
208826US-8737-8737-99	09861637	2822
209078US-8737-8737-99	09865447	2822
209077US-8737-8737-99	09866637	2822
210792US-8737-8737-99	09899997	2822
211469 US-8737-8737-99	09907707	2822
211534US-8737-8737-99	09908707	2822
211684US-8737-8737-99	09908887	2822
211673US-8737-8737-99	09908897	2822
211674US-8737-8737-99	09909937	2822
211956 US-8737-8737-99	09911447	2822
211850US.8737-8737-99	09911507	2822
212021 US-8737-873798	09911517	2822
21202505-87378737-99	09911627	2822
212131 US-8737-8787-99	09919967	2822
21290705-8737-8737-99	09930170	2822
	10136324	2823
205959US-87378737•99	09689583	2823
210150US-8737-8737-99	09884983	2823
210244US-8737-8737-99	09900883	2823
210216US-8737-8737-99	09903743	2823
211413US-8737-8737-99	09905863	2823
211315US-8737-8737-99	09905933	2823
211474US-8737-8737-99	09907703	2823
211555US-8737-8737-99	09908883	2823
211671 US-8737-8737-99	09910023	2823
211676US-8737-8737-99	09910034	2823
211618US-8737-8737-99	09910753	2823
29 2955US-8737-8737-99	09930444	2823
215873US-8737-8737-99-D IV	09986024	2823
216598US-8737-8737-99-DN	09993514	2823
205889US-8737737-99	09733688	2824
205914US-8737-8737-99	09795784	2824

Docket Number	Application #	Art Unit
210259US-8737-873799	09897128	2824
210784US-8737-8737-99	09905098	2824
211577US-8737-9737-99	09909905	2824
21301 OUS-8737-8737-99	09930308	2824
	10125410	2825
205912US-8737$737 99	09624690	2825
205893US-8737-873799	09625100	2825
210788US-8737-8737-99	09901110	2825
211317US-8737-8737-99	09906730	2825
211688US-8737-8737-99	09908891	2825
211579US-8737-8737-99	09909940	2825
211917US-8737-8737-99	09911460	2825
205973US-8737-8737-99	09584601	2826
205938US-8737-8737-99	09624296	2826
205934US-8737-8737.89	09624754	2826
205884US-8737-8737-99-CIP	09758723	2826
205968US-8737-8737-99	09824273	2826
206669US-8737-873799	09838273	2826
209491 US-8737-8737-99-CIP	09840213	2826
209284U S,B737-8737-99	09842734	2826
209281 US-8737-8737-99	09853744	2826
209336US-8737-8737-99	09870834	2826
209505US-8737-8737-99	09874984	2826
210826US-8737-873799	09904894	2826
210786US-8737-87379	09905902	2826
211326US-8737-8737-99	09905903	2826
211328US-8737-8737-99	09905930	2826
211325US-8737-8737-99	09905934	2826
211431 US-8737-8737-99	09906784	2826
211468US-8737-8737-99	09907704	2826
211672 US-8737-8737-99	09910024	2826
211582US-8737-8737-99	09910044	2826
21202005-8737-8737-99	09911444	2826
211724us-6737-8737-99	09911464	2826
211803US-8737-8737-99	09911473	2826
211690US-8737-8737-99	09911484	2826
211890US-8737-8737-99	09911494	2826
211722US-8737-8737-99	09911543	2826
212421 U&8737-8737-99	09921894	2826
292946US-8737-8737-99	09929024	2826
213009US-8737-8737-99	09930254	2826
21290905-8737-8737-99	09930270	2826
	9985757	2828
209282U5-8737•873799	09852109	2828
210787US-8737-8737-99	09901905	2828
210785US-8737-8737-99	09903740	2828
210257US-8737-8737-99	09910035	2828
21217305-8737-8737-99	09921900	2828
213011 US-8737-8737-99	09930243	2828
	10166196	2829
206166US-8737-8737-99	09425945	2829
209696US-8737-8737-99	09882064	2829
211324US-8737-8737-99	09904895	2829
211332 US-87378737-99	09905116	2829
211893US-8737-8737-99	09911445	2829
211723US-8737-8737-99	09911446	2829
21181 OUS-8737-8737-99	09911495	2829
215295US-8737-8737-99	09983326	2829

Docket Number	Application #	Art Unit
205915US-8737-9737-99	09624803	2834
211916US-8737-8737-99	09911487	2839
217731 US-8737-8737-99	10026812	2841
	10151950	2851
217354US-8737-8737-99	10020898	2861
205972US-8737-873799	09624698	2872
205939US-8737 837-99	09669602	2873
205950U"737-8737-99	09607236	2874
205951 US-8737-8737-99	09607744	2874
205947US-8737-8737-99	09608807	2874
209409U$-8737-8737-99	09870836	2874
209162US-8737r8737-99	09870837	2874
217678US-8737-8737-99	09908885	2874
210824US-8737-8737-99	09909906	2874
211854US-8737-8737-99 -	09911457	2874
211808US-8737-8737-99	09911466	2874
211807US-8737-8737-89	09911469	2874
211911 US-8737-8737-99	09911472	2874
21195705-8737-8737-99	09911492	2874
21209905-8737-8737-99	09918802	2874
21209805-8737-8737-99	09919927	2874
212950US-8737-8737-99	09929019	2874
215539US-8737-8737-99-CONT	09983866	2874
205949 US-8737-8737-99	09607237	2876
205944US-8737-8737 99	09609262	2877
209403US-8737-8737-99	09870831	2877
209338US-8737-8737-99	09870832	2877
209695US-8737-8737-99	09882067	2878
209402US'.8737-8737-99	09870835	2881
210794US-8737-8737-99	09899996	2881
211427US-8737-8737-99	09906782	2881
21242505-8737-8737-99	09921895	2881
212426US-8737.-8737-99	09921896	2881
212590US-8737-8737-99	09927393	2881
209342US-87378737-99	09870833	2882
	9905115	3662
	9911420	3663
	09607722	3736

By FAX: (703) 872-9005

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

Telephone inquiries should be directed to Michael L. Lewis at (703)306-5585.

Robert J. Spar
Director
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: TC Assignment Appendix

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

ROGER R. WISE
PILLSBURY WINTHROP
725 S. FIGUEROA STREET, #2800
LOS ANGELES, CA 90017

COPY MAILED

JUL 2 5 2002

OFFICE OF PETITIONS

In re Application of	:	
Satoshi Sekine	:	
Application No. 09/908,906	:	ON PETITION
Filed: July 19, 2001	:	
Attorney Docket No. 51270-277007	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 28, 2002, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Application (Notice) mailed August 31, 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 November 1, 2001.

The Change of Correspondence Address Notice filed June 28, 2002 has been noted and made of record.

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

Wan Laymon
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
PO BOX 1450 Alexandria VA 22313-1450
WWW.USPTO.GOV

NOV 28 2003

MARSHALL, GERSTEIN & BORUN LLP
233 SOUTH WACKER DRIVE, SUITE 6300
SEARS TOWER
CHICAGO, ILLINOIS 60606-6357

In re Application of	:
YAN et al	:
Serial No.: 09/908,943	: Decision on Petition
Filing Date: 19 JULY 2001	:
Attorney Docket No. 29915/00281a	:

This letter is in response to the Petition under 37 CFR 1.181, filed on 30 September 2003, to withdraw finality of the office action.

A review of the file history shows that the Office mailed a Final Office action on 21 July 2003. On 21 November 2003, the telephonic interview summary form mailed concurrently with this decision shows that the Examiner informed Applicants David Glassq and Nabeela McMillian that the last action was mistakenly made final. The Examiner will prepare another non-final action and restart applicants' response time.

Accordingly, the petition is **GRANTED** in view of the telephone interview summary date 21 November 2003. The application is being forwarded to the examiner for action consistent with this decision.

Should there be any questions with regard to this letter, please contact Special Program Examiner Julie Burke by letter addressed to the Director, Technology Center 1600, PO Box 1450, Alexandria VA 22313-1450 or by telephone at (703) 308-7553 or by facsimile transmission at (703) 308-7230.

Bruce Kisliuk
TC1600 Group Director

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S. WACKER DRIVE
CHICAGO IL 60606

In re Application of	:	
Yan et al.	:	
Serial No.: 09/908,943	:	PETITION DECISION
Filed: July 19, 2001	:	
Attorney Docket No.: 29915/00281A.US	:	

This is in response to the petition under 37 CFR 1.181 and 1.144, filed March 15, 2004, requesting withdrawal of an improper restriction requirement. The delay in acting upon this petition is regretted.

BACKGROUND

A review of the file history shows that this application was filed on July 19, 2001, and contained claims 1-82. In a first Office action, mailed September 19, 2002, the examiner set forth a restriction requirement under 35 U.S.C. 121, as follows:

> Group 1, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 5, classified in class 530, subclass 327.
> Group 2, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 6, classified in class 530, subclass 326.
> Group 3, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 7, classified in class 530, subclass 327.
> Group 4, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 8, classified in class 530, subclass 328.
> Group 5, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 9, classified in class 530, subclass 328.
> Group 6, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 10, classified in class 530, subclass 328.
> Group 7, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 11, classified in class 530, subclass 328.
> Group 8, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 12, classified in class 530, subclass 328.

Group 9, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 13, classified in class 530, subclass 328.
Group 10, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 14, classified in class 530, subclass 328.
Group 11, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 15, classified in class 530, subclass 328.
Group 12, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 16, classified in class 530, subclass 328.
Group 13, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 17, classified in class 530, subclass 328.
Group 14, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 18, classified in class 530, subclass 328.
Group 15, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 120, classified in class 530, subclass 328.
Group 16, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 133, classified in class 530, subclass 328.
Group 17, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 134, classified in class 530, subclass 328.
Group 18, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 135, classified in class 530, subclass 328.
Group 19, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 136, classified in class 530, subclass 328.
Group 20, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 137, classified in class 530, subclass 328.
Group 21, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 138, classified in class 530, subclass 328.
Group 22, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 141, classified in class 530, subclass 328.
Group 23, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 143, classified in class 530, subclass 328.
Group 24, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 144, classified in class 530, subclass 328.
Group 25, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 145, classified in class 530, subclass 328.
Group 26, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 147, classified in class 530, subclass 328.
Group 27, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 148, classified in class 530, subclass 328.
Group 28, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 149, classified in class 530, subclass 328.
Group 29, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 150, classified in class 530, subclass 328.
Group 30, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 151, classified in class 530, subclass 328.
Group 31, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 152, classified in class 530, subclass 328.

Group 32, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 153, classified in class 530, subclass 328.
Group 33, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 154, classified in class 530, subclass 327.
Group 34, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 155, classified in class 530, subclass 326.
Group 35, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 156, classified in class 530, subclass 325.
Group 36, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 157, classified in class 530, subclass 324.
Group 37, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 158, classified in class 530, subclass 327.
Group 38, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 159, classified in class 530, subclass 326.
Group 39, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 160, classified in class 530, subclass 326.
Group 40, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 161, classified in class 530, subclass 324.
Group 41, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 162, classified in class 530, subclass 327.
Group 42, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 163, classified in class 530, subclass 326.
Group 43, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 164, classified in class 530, subclass 326.
Group 44, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 165, classified in class 530, subclass 324.
Group 45, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 166, classified in class 530, subclass 327.
Group 46, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 167, classified in class 530, subclass 326.
Group 47, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 168, classified in class 530, subclass 326.
Group 48, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 169, classified in class 530, subclass 324.
Group 49, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 190, classified in class 530, subclass 327.
Group 50, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 191, classified in class 530, subclass 326.
Group 51, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 192, classified in class 530, subclass 326.
Group 52, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 193, classified in class 530, subclass 326.
Group 53, claims 21-27, drawn to a peptide wherein P2 is N, classified in class 530, subclass 330.
Group 54, claims 21-27, drawn to a peptide wherein P2 is S, classified in class 530, subclass 330.

Group 55, claims 21-27, drawn to a peptide wherein P2 is D, classified in class 530, subclass 330.
Group 56, claims 21-27, drawn to a peptide wherein P1 is Y, classified in class 530, subclass 330.
Group 57, claims 21-27, drawn to a peptide wherein P1 is L, classified in class 530, subclass 330.
Group 58, claims 21-27, drawn to a peptide wherein P1 is Nle, classified in class 530, subclass 330.
Group 59, claims 21-27, drawn to a peptide wherein P1' is E, classified in class 530, subclass 330.
Group 60, claims 21-27, drawn to a peptide wherein P1' is A, classified in class 530, subclass 330.
Group 61, claims 21-27, drawn to a peptide wherein P1' is D, classified in class 530, subclass 330.
Group 62, claims 21-27, drawn to a peptide wherein P2' is A, classified in class 530, subclass 330.
Group 63, claims 21-27, drawn to a peptide wherein P2' is V, classified in class 530, subclass 330.
Groups 64-126, claims 36-42 and 52-54, drawn to a polynucleotide that encodes the polypeptide of claims 1-35, a vector, a host cell and a method of producing a substrate for a B-secretase assay, classified in class 435, subclass 320.1 and 252.3 and class 536, subclass 232.1. The groups 64-126 correspond to groups 1-63.
Groups 127-189, claims 43-50, drawn to a method for assaying for modulators of B-secretase activity, a method of inhibiting B-secretase activity *in vivo*, classified in class 435, subclass 23. The groups 127-189 correspond to groups 1-63.
Groups 190-252, claims 51 and 55-57, drawn to a method of inhibiting the B-secretase activity *in vivo* comprising administering a modulator according to claim 50, a pharmaceutical composition comprising a modulator, a method of treating a disease comprising administering the pharmaceutical composition and the use of a modulator to treat Alzheimer's disease, classified in various classes and subclasses depending upon what the inhibitor is. The groups 190-252 correspond to groups 1-63.
Groups 253-315, claims 58-64, and 66-67, drawn to a method for identifying agents that inhibit Asp2 aspartyl protease and a method of identifying agents that modulate Asp2 aspartyl protease, classified in class 435, subclass 219. The groups 252-315 correspond to groups 1-63.
Groups 316-378, claims 65 and 68-69, drawn to a method of treating Alzheimer's disease comprising using an inhibitor of Hu-Asp2, classified in various classes and subclasses depending upon the identity of the inhibitor. The groups 316-378 correspond to groups 1-63.
Groups 379-441, claims 70-72, drawn to a kit for performing a B-secretase assay, classified in class 435, subclass 23. The groups 379-441 correspond to groups 1-63.
Group 442, claims 73-82, drawn to a peptide, classified in class 530, subclass 328, 327, 326, and 324.

The examiner agued the following:

Groups 1-63 and 64-126 are drawn to completely different chemical compounds that are patentably distinct. Groups 1-63 and 442 are drawn to different structural peptides and are patentably distinct.

Inventions 1-63 and 127-189 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 190-252, 253-315, 316-378, and in the kit or groups of 379-441.

Inventions 1-63 and 190-252 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 127-189, 253-315, 316-378, and in the kit or groups of 379-441.

Inventions 1-63 and 253-315 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 127-189, 190-252, 316-378, and the kit or groups of 379-441.

Inventions 1-63 and 316-378 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 127-189, 190-252, 316-378, and the kit or groups of 379-441.
Inventions 379-441 are drawn to a product (kit) that is patentably distinct from the products of groups 1-63 and 64-126.

Claim 33 is presumed to be drawn to a polypeptide instead of a fusion protein, since there is no antecedent basis for fusion protein in claims 28-32.

The examiner argued that the restriction is proper because the inventions are distinct for the reasons above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter.

Applicants replied on November 19, 2002, electing Group 56, claims 21-27, drawn to a peptide of a generic sequence in which P1 is Y, with traverse, specifically arguing the examiner has failed to articulate a proper restriction requirement and that the invention should not be restricted 442 ways; and that the examiner has simply failed to establish that there is a serious burden to examine all of the claims. Applicants further argue that restriction practice under 35 USC 121 allows the Commissioner discretion to require restriction between two or more "independent and distinct" inventions and that in the present invention, the claims are not "independent". For example, the peptide/polypeptide subject matter of claims 1-35 and 73-82 is directly connected in design (i.e. The protein or peptide sequences all comprise a scissile bond that is cleaved by a human aspartyl protease), they operate in the same manner (i.e. the peptides are cleaved by human aspartyl protease), and have the same effect (i.e. mimic the effects of wild-type substrate for human aspartyl protease).

The examiner mailed a non-Final Office action to applicants on February 21, 2003, acknowledging applicants' election of Group 56, claims 21-27, wherein P1 is Y, and making the restriction requirement final. The examiner responded to the traversal by indicating, for example, that examining groups 1-35 and 73-82, as one group, as suggested by applicants would require the search of 52 different specific sequences as well as claims 1 and 21 that are drawn to a multitude of different peptides. Each of the peptides of claims 1-35 and 73-82 are structurally different and therefore properly restricted. The examiner further states that the search of 52

different sequences would, in itself, be an unreasonable burden upon the examiner, not taking into account the search of claims 1 and 21, which read on numerous embodiments.

Applicants replied on March 15, 2004 by filing this petition. Applicants filed a full reply to the Office action on May 21, 2003.

DISCUSSION

The application, file history and petition have been carefully considered.

Applicants state that the current restriction requirement is defective insofar as it specifies 442 overlapping groups such that individual species of the invention fall within multiple groups, and that it is impossible for restriction groups to be independent or distinct from one another when the same polypeptide falls within at least six of the groups. While this appears to be true, it is noted that such overlapping is the result of the extreme breadth of the claims. The examiner could have properly restricted each of the groups that encompassed a plurality of the peptides to a single specific peptide since each would have different structure and/or function although he did not choose to do so. Applicants further argue that the requirement is defective because it fails to clearly assign the entirety of the claimed subject matter to individual groups. For example, original claim 1 was split into fifty-two distinct groups which each define a particular peptide species, yet the claim actually encompasses more that 52 species. It is agreed that claim 1 reads on more than 52 individual species. It reads on 30,720 species. The examiner stated in the answer to the traversal that claims 1 and 21 read on a "multitude" of species but in order to simplify the restriction he chose not to further restrict. Applicants have suggested that the invention should be restricted to nine groups instead of the 442 groups suggested by the examiner; and that the examiner has simply failed to establish that there is a serious burden to examine all of the claims. However, it would be a very serious burden to restrict the invention in this manner as the nine groups proposed would read on 240 groups for the peptides only and each would not be limited to a single sequence. It would also put the peptide and nucleotides together. As to the argument that the groups must be both independent and distinct, there are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) the inventions must be independent (see MPEP 802.01, 806.04, 808.01) or distinct as claimed (see MPEP 806.05-806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP 803.02, 806.04(a)-806.04(i), 808.01(a), and 808.02).

In the instant case, the two criteria are met and the restriction is proper.

DECISION

The petition is **DENIED**. This application will be forwarded to the examiner for consideration of the amendment of March 19, 2004.

Should there be any questions about this decision please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 703-872-9306.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 2 7 2004

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

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S WACKER DRIVE
CHICAGO IL 60606

In re Application of	:
YAN et al.	:
Serial No.: 09/908,943	:Petition Decision
Filed: July 19, 2001	:
Attorney Docket No.: 29915/0028 IA.US	:

This decision is in response to the petition under 37 CFR 1. 181 and 1.144, filed March 15, 2004, requesting withdrawal of an improper restriction requirement. The decision mailed 14 October 2004 (as determined by PTO PALM records, although the petition decision itself apparently did not contain a mail room date stamped on the action) has been vacated as premature. The confusion arising from the incomplete decision inadvertently mailed 14 October 2004 and the delay in acting upon this petition are regretted.

BACKGROUND

A review of the file history shows that this application was filed on July 19, 2001, and contained claims 1-82. In a first Office action, mailed September 19, 2002, the examiner set forth a restriction requirement under 35 U.S.C. 121, as follows:

> Groups 1-52, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 5-18, 120, 133-138, 141, 143-145, 147-169, 190-193, respectively, classified in class 530, subclass 327.
>
> Groups 53-55, claims 21-27, drawn to a peptide wherein P2 is N, S or D, respectively, classified in class 530, subclass 330.
>
> Groups 56-58, claims 21-27, drawn to a peptide wherein P1 is Y, L or Nle, respectively, classified in class 530, subclass 330.
>
> Groups 59-61, claims 21-27, drawn to a peptide wherein P1' is E, A or D, respectively, classified in class 530, subclass 330.

Groups 62-63, claims 21-27, drawn to a peptide wherein P2' is A or V, classified in class 530, subclass 330.

Groups 64-126, claims 36-42 and 52-54, drawn to a polynucleotide that encodes the polypeptide of claims 1-35, a vector, a host cell and a method of producing a substrate for a B-secretase assay, classified in class 435, subclass 320.1 and 252.3 and class 536, subclass 232.1. The groups 64-126 correspond to groups 1-63.

Groups 127-189, claims 43-50, drawn to a method for assaying for modulators of B- secretase activity, a method of inhibiting B-secretase activity in vivo, classified in class 435, subclass 23. The groups 127-189 correspond to groups 1-63.

Groups 190-252, claims 51 and 55-57, drawn to a method of inhibiting the B-secretase activity in vivo/ comprising administering a modulator according to claim 50, a pharmaceutical composition comprising a modulator, a method of treating a disease comprising administering the pharmaceutical composition and the use of a modulator to treat Alzheimer's disease, classified in various classes and subclasses depending upon what the inhibitor is. The groups 190-252 correspond to groups 1-63.

Groups 253-315, claims 58-64, and 66-67, drawn to a method for identifying agents that inhibit Asp2 aspartyl protease and a method of identifying agents that modulate Asp2 aspartyl protease, classified in class 435, subclass 219. The groups 252-315 correspond to groups 1-63.

Groups 316-378, claims 65 and 68-69, drawn to a method of treating Alzheimer's disease comprising using an inhibitor of Hu-Asp2, classified in various classes and subclasses depending upon the identity of the inhibitor. The groups 316-378 correspond to groups 1-63.

Groups 379-441, claims 70-72, drawn to a kit for performing a B-secretase assay, classified in class 435, subclass 23. The groups 379-441 correspond to groups 1-63.

Group 442, claims 73-82, drawn to a peptide, classified in class 530, subclass 328, 327, 326, and 324.

The examiner provided the following reasons for the Restriction Requirement:

Groups 1-63 and 64-126 are drawn to completely different chemical compounds that are patentably distinct. Groups 1-63 and 442 are drawn to different structural peptides and are patentably distinct.

Inventions 1-63 and 127-189 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 190-252, 253-315, 316-378, and in the kit or groups of 379-441.

Inventions 1-63 and 190-252 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 127-189, 253-315, 316-378, and in the kit or groups of 379-441.

Inventions 1-63 and 253-315 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 127-189, 190-252, 316-378, and the kit or groups of 379-441.

Inventions 1-63 and 316-378 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 127-189, 190-252, 316-378, and the kit or groups of 379-441.

Inventions 379-441 are drawn to a product (kit) that is patentably distinct and the products of groups 1-63 and 64-126.

Claim 33 is presumed to be drawn to a polypeptide instead of a fusion protein, since there is no antecedent basis for fusion protein in claim 28-32.

The examiner argued that the restriction is proper because the inventions are distinct for the reasons above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter.

Applicants replied on November 19, 2002, electing Group 56, claims 21-27, drawn to a peptide of a generic sequence in which P1 is Y, with traverse, specifically arguing the examiner has failed to articulate a proper restriction requirement and that the invention should not be restricted 442 ways; and that the examiner has simply failed to establish that there is a serious burden to examine all of the claims. Applicants further argued that restriction practice under 35 USC 121 allows the Commissioner discretion to require restriction between two or more independent and distinct" inventions and that in the present invention, the claims are not independent. For example, the peptide/polypeptide subject matter of claims 1-35 and 73-82 is directly connected in design (i.e. the protein or peptide sequences all comprise a scissile bond that is cleaved by a human aspartyl protease), they operate in the same manner (i.e. the peptides are cleaved by human apartyl protease), and have the same effect (i.e. mimic the effects of wild-type substrate for human aspartyl protease).

The examiner mailed a non-Final Office action on February 21, 2003, acknowledging applicants' election of Group 56, claims 2 1-27, wherein P1 is Y, and making the restriction requirement final. The examiner responded to the traversal by indicating, for example that examining groups 1-35 and 73-82, as one group, as suggested by applicants would require the search of 52 different specific sequences as well as claims 1 and 2 1 that are drawn to a multitude of different peptides. Each of the peptides of claims 1-35 and 73-82 are structurally different and therefore properly restricted. The examiner further states that the search of 52 different sequences would, in itself, be an unreasonable burden upon the examiner, not taking into account the search of claims 1 and 21, which read on numerous embodiments.

Applicants replied on March 15, 2004 by filing this petition. Applicants filed a full reply to the Office action on May 21, 2003.

DISCUSSION

The application, file history and petition have been considered carefully.

The petition raises the following concerns (A)-(E), each of which will be addressed in turn:

(A) The peptide claims define a genus of peptide substrates using the formula: P2P1-P1'P2' adopting the nomenclature of Schechter and Berger (Biochem. Biophys. Res. Commun. 27:15741967) and Biochem. Biophys. Res. Commun. 32:898 (1968), in which the amino acid residues in the peptide substrate that undergo the cleavage are defined as P1 . .. Pn moving from the scissile bond toward the N-terminus and P1, . . . Pn' moving from the scissile bond toward the C-terminus. (See specification paragraph bridging pages 18 and 19).

The peptides defined by the foregoing formula share common structural features as evident from the genus defined by a single chemical formula wherein each amino acid position near the scissile bond has specified characteristics. Likewise, the peptides share a common functionality due to their common structure, as evinced by the fact that the peptides all serve as peptide substrates that are recognized and cleaved between residue Pl and P1' by a particular human aspartyl protease.

(B) Claim 1 as filed embraces a number of species that do not fall within restriction groups 1-52 and that were not explicitly assigned by the examiner to any other restriction group.

The restriction requirement is further facially defective because it fails to clearly assign the entirety of the claimed subject matter to individual groups. For example, original claim 1 was split into fifty-two distinct groups which each define a particular peptide species, yet the claim 1 actually encompasses more than 52 species.

(C) An exemplary peptide disclosed in the specification and referenced in at least original claims 20 and 73-78 is SEQ ID NO: 152, which has the following amino acid sequence: SEISY-EVEFR. Applying the Schechter and Berger nomenclature 2), SEQ ID NO: l52 is written as P5P4P3P2P1—P1'P2'P3'P4'P5', wherein P5 is S; P4 is E, P3 is I, P2 is S; P1 is Y, Pl' is E, P2' is V; P3' is E, P4' is F, and P5' is R.

A peptide satisfying SEQ ID N0: l52 falls into at least six different restriction groups as defined by the examiner:

(a) Group 31 defines an allegedly independent and distinct group with the sequence SEQ ID NO: 152,

(b) Group 54 defines an allegedly independent and distinct group with the requirement that P2 be S. In SEQ ID NO: 152, P2 is S. Thus, a peptide comprising SEQ ID NO: 152 falls within Group 54.

(c) Group 56 defines an allegedly independent and distinct group with the requirement that Pl be Y. In SEQ ID NO: 152, P1 is Y. Thus, a peptide comprising SEQ ID NO 152 falls within Group 56.

(d) Group 59 defines an allegedly independent and distinct group with the requirement that Pl' be E. In SEQ ID NO: 152, Pl. is E. Thus, a peptide comprising SEQ ID NO: 152 falls within Group 59.

(e) Group 63 defines an allegedly independent and distinct group with the requirement that P2' be V. In SEQ ID NO: 152, P2. is V. Thus, a peptide comprising SEQ ID NO: 152 falls within Group 63.

(f) Group 442 includes claim 73, which explicitly recites SEQ ID NO: 152.

Numerous other peptides of the invention besides SEQ ID NO: 152 , fall within two or more restriction groups because the groups do not define independent or distinct inventions.

By obvious extension, the analysis in paragraph 8 (C, above) is equally applicable to restriction groups 64-126, which define polynucleotide subject matter, restriction groups 127-378, which define various method subject matter; and groups 379-441, directed to kits. In each instance, the Examiner used the alleged independence or distinctness of the peptide groups 1-63 as a basis for restricting the other categories of subject matter. In fact, groups 127-441 were not individually defined, except to specify that they corresponded to be peptide groups 1-63. As exemplified in claim 21 as filed, P1 may be selected from the group consisting of Y, L, and Nle; P1' may be selected from the group consisting of E, A and D.

It is both axiomatic and required by the patent statute that claims only be restricted when they define independent and distinct inventions. The current restriction requirement is defective insofar as it specifies 442 overlapping groups such that individual species of the invention fall within multiple groups. It is impossible for restriction groups to be "independent" or "distinct" from one another when the same polypeptide falls within at least six of the groups.

(D) According to the Patent Office guidelines set forth in the MPEP, restriction practice under 35 U.S.C. 121 allows the Commissioner discretion to require restriction between two or more "independent and distinct" inventions (See M.P.E.P. 802.01 defining independent and distinct). M.P.E.P. 802.01 defines "independent" in relation to this practice, to mean:

> that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed', or (2) process and apparatus incapable of being used in practicing the process."

As stated in MPEP 806.04(a), the rules provide that a reasonable number of species may still be claimed in one application. Moreover, the MPEP requires that "where there is a relationship disclosed between the species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction." MPEP 808.0l(a). Even when restriction is proper, the MPEP requires that the Examiner should clearly identify each of the disclosed species to which claims are restricted and identify the distinguishing characteristics of species. See, e.g., MPEP 809.02(a).

(E) The petition then proposes the following Groups:

Group I: An isolated peptide defined by the formula P2P1-Pl'P2', wherein P1-P1' is Y-E; kits comprising the same; polynucleotides encoding the same and methods of making or using the same

Group II: An isolated peptide defined by the formula P2P1-P1'P2', wherein P1-P1' is Y-A,' kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group III: An isolated peptide defined by the formula P2P1-Pl'P2', wherein P1-P1' is Y-D; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group IV: An isolated peptide defined by the formula P2P1-P1'P2', wherein P1-P1' is L-E; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group V: An isolated peptide defined by the formula P2P1-P1',P2', wherein Pl-P1' is L-A; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group VI: An isolated peptide defined by the formula P2P1-P1'P2', wherein P1-P1' is L-D; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group VII: An isolated peptide defined by the formula P2Pl-P1'P2', wherein Pl-P1' is Nle-E; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group VIII: An isolated peptide defined by the formula P2P1-P1'P2', wherein P1-P1' is Nle-A; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group lX: An isolated peptide defined by the formula P2P1-Pl'P2', wherein P1-P1' is N1e-D; kits comprising the same; polynucleotides encoding the same and methods of making or using the same.

Representative claims are set forth below:

From original Groups 1-52

1. An isolated peptide comprising a sequence of at least four amino acids defined by formula P2Pl-P1'P2' wherein
P2 is a charged amino acid, a polar amino acid, or an aliphatic amino acid but is not an aromatic amino acid;
Pl is an aromatic amino acid or an aliphatic amino acid but not a polar amino acid or a charged amino acid;
P1' is a charged amino acid, or aliphatic amino acid, or a polar amino acid but is not an aromatic amino acid',
P2' is an uncharged aliphatic polar amino acid or an aromatic amino acid; and
wherein said peptide is cleaved between P1 and P1' by a human aspartyl protease encoded by the nucleic acid sequence of SEQ ID NO:1 or SEQ ID NO:3 and said peptide does not comprise the corresponding P2P1-P1'P2, portion of amino acid sequences depicted in SEQ ID NO:19; SEQ ID NO:20, SEQ ID NO:21, SEQ ID NO:26; SEQ ID N0:27; SEQ ID NO:28; SEQ ID NO:31; SEQ ID NO:32; SEQ ID NO:33; SEQ ID NO:34; SEQ ID NO:35, SEQ ID NO:36; SEQ ID NO:37; SEQ ID NO:38; SEQ ID NO:39; or SEQ ID NO:40.

From original Groups 127-189

49. The method claim of any of claims 43-48, further comprising a step of treating Alzheimer 's Disease with an agent identified as an inhibitor of Hu-Asp2.

From original Groups 316-378

65. A method according to 58 or 64, further comprising a step of treating Alzheimer's Disease with an agent identified as an inhibitor of Hu-Asp2.

From original Groups 379-441:

70. A kit for performing a beta secretase assay comprising a beta secretase substrate comprising a peptide according to any of claims 1 through 27 and a beta secretase enzyme.

Under (A), the petition argues that the peptides share a common function and a common structure. MPEP 803.02, which is directed at Markush groups, specifies when compounds claimed in the alternative may be considered for species election, and states:

> If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions.

MPEP 803.02 goes on to specify when elements in a Markush may be considered to have "unity of invention" as defined by In re Harnisch.

> Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Four randomly selected peptides recited in the Markush Group of claim 20 are set forth below. Common structure among the four or even between any two of the four is not apparent.

SEQ ID No 6
Lys Val Glu Ala Asn Tyr Glu Val Glu Gly Glu Arg Cys Lys Lys

SEQ ID No 11
Ile Ile Lys Met Asp Asn Phe Gly

SEQ ID No 13
Thr His Gly Phe Gln Leu Xaa His

SEQ ID No 137
Lys Thr Ile Ser Leu Asp Val Glu Pro Ser

The Markush Group of claim 20 specifies structure for the combination of P2P1-P1'P2' and recites about 50 peptide sequences. The number "fifty" is not considered as few in number. The sequences recited in claim 20 are not so closely related as to be examined without undue burden.

For these reasons, concurrent examination of the 50-odd sequences in claim 20 is not required by the first sentence of MPEP 803.02.

While the compounds in this invention share a common utility, there is no shared common structure essential for that utility. For these reasons, the peptides are not considered as species eligible for treatment under specific practice and the petition's concern (A) is not persuasive.

Concerning (B), (C) and (D), applicants are correct that the restriction requirement groupings are incorrect and the inventions are not clearly identified. A review of the restriction requirement prompted by the petition identified the following problems with the way in which the groups are set forth:

(1) some inventions are not placed in any group
(2) same invention is encompassed by multiple groups
(3) linking claims not identified or properly treated.

The Groups are correctly set forth as follows:

Groups 1-2940, claims 1-23, 25-35, 70-101, drawn to a peptide which has P2P1-P1'P2' wherein P2, P1, P1' and P2' are each selected from the amino acid residues set forth in claims 6, 7, 8 and 9, respectively. Please see Table 1, below for further explanation of how each peptide invention is defined. Each combination represents one invention. The peptide groups are classified in class 530, subclass 327.

Groups 2941-5,430 claims 36-42 and 52-54, drawn to a polynucleotide that encodes one of the polypeptides of Groups 1-2940, a vector, a host cell and a method of producing a substrate for a B-secretase assay, classified in class 435, subclass 320.1 and 252.3 and class 536, subclass 232. 1.

Groups 5,430-8,370, claims 43-48, 50, 58-64, and 66-67, drawn to a method for assaying for modulators of B- secretase activity, identifying agents that inhibit Asp2 aspartyl protease or modulate Asp2 aspartyl protease of Groups 1-2940, classified in class 435, subclass 23.

Groups 8,370-11,310, claims 49, 51, 55-57, 65, 68-69 drawn to a method of inhibiting the B-secretase activity in vivo comprising administering a modulator of Groups 1-2940, a pharmaceutical composition comprising a modulator, a method of treating a disease comprising administering the pharmaceutical composition and the use of a modulator to treat Alzheimer's disease, classified in various classes and subclasses depending upon what the inhibitor is.

Table 1. Peptide inventions defined as a combination of one of each of P2, P1, P1' and P2'.

P2	P1	P1'	P2'
Claim 6	Claim 7	Claim 8	Claim 9
N	Y	E	V
L	L	A	A
K	M	D	N
S	Nle	M	T
G	F	Q	L
T	H	S	F
D		G	S
A			
Q			
E			

The number of inventions has been calculated as 2,940, by multiplying each of 10 choices for P2, 6 choices for P1, 7 choices for P1', and 7 choices for P2'.

When selecting a combination defining P2P1-P1'P2', applicants are under obligation to specify which claims and which sequences read upon the selected invention.

For example, if applicants elect P2P1-P1'P2' as SY-EV, applicants should point out that this peptide is encompassed by on SEQ ID NO 152, 158 and191 and claims 96, 97, 99, to name a few. (It is noted that other sequences and claims may also encompass this invention, but for purpose of explanation in this petition decision, the Office will not continue the analysis through the entire set of claims or list of sequences.)

The restriction requirement is proper for the following reasons:

The peptides, the polynucleotides and inhibitors of are structurally, functionally and patentably distinct molecules. Each of the peptides as defined in Table 1 are structurally and patentably distinct molecules. Each of the polynucleotides are structurally and patentably distinct molecules. The methods are patentably distinct from the products in view of the fact that more than one materially different product may be used in the method and more than one materially different method may be practice by each product. For example, each product can be used for either screening method to identify inhibitors or immunological method to raise antibodies. It would require undue burden to examine two or more inventions in view of the structural divergence of the peptides and polynucleotides and in view of the different classification. For example, a search for peptide having SEQ ID No 6 would not identify prior art which reads upon peptide having SEQ ID No 137 and vice versa. The restriction requirement is proper because the inventions are shown as distinct for the reason set forth above and have acquired a different status in the art as shown by their divergent classification and recognized divergent subject matter.

Concerning (B), Applicants are correct that the original restriction requirement failed to identify and properly treat linking claims, which describes the inventions in generic terms and encompass (1) some or all of the inventions in claims 1-19, 21, 23, 25-35, 70-72, 83-95 and (2) also include inventions directed at other isolated peptides encompassed by but not specifically listed in the claims. Indeed the groupings set forth in the original restriction requirement do not specifically

account for all the possible combination of peptides in claim 1. Linking claim practice is the correct way to handle this breadth of claims, as follows.

The examiner should have included the following paragraph in the Restriction Requirement and Office actions to identify the linking claims:

> Claims 1-19, 21, 23, 25-35, 70-72, 83-95 link(s) peptide inventions of recited in the combination of claims 6-9, as set forth above.
> Polynucleotide claims which refer to peptides in Claims 1-19, 21, 23, 25-35, 70-72, 83-95 link(s) polynucleotide inventions.
> Assay method claims which refer to peptides in Claims 1-19, 21, 23, 25-35, 70-72, 83-95 link(s) the assay method inventions.
> Administration method claims which refer to the peptides in Claims 1-19, 21, 23, 25-35, 70-72, 83-95 link(s) administration method inventions.
>
> The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Additionally, the examiner erred in limiting the examination of the generic linking claims to the elected invention. Applicants are correct that they deserve examination of the generic linking claims along with the elected invention.

MPEP 809.04 states that

> Where the requirement for restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the nonelected invention or inventions.
>
> If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.

The restriction requirement between the products and the kits comprising the products is improper and has been withdrawn. The corresponding kit will be examined along with any elected product.

The restriction requirement between the methods of claims 49 and 65 comprising a step of treating Alzheimer's Disease with an agent identified as an inhibitor of Hu-Asp2 is improper as it contains subject which overlaps in scope.

Concerning (E), applicants' proposed groups I-IX are not are acceptable for one of the same reasons that the Examiner's Restriction Requirement was not acceptable. The Groups I-IX fail to account for all the claimed subject matter. For example, P1 as defined in Groups I-IX can be only Y or L, however, current claims also specify that P1 could be aromatic or aliphatic (claim 1) or M or Nle or F or H (claim 6), etc.

DECISION

The petition under 37 CFR 1.144 filed 15 March, 2004 is **GRANTED-in-PART** as follows:

The restriction requirement mailed 19 September 2002 has been withdrawn and replaced with the restriction requirement contained in this petition decision.

Applicants will be given ONE MONTH to respond to this restriction requirement and select both
(1) a particular the type of invention (protein, polypeptide, assay method or method of administration) and
(2) particular peptide used in or referred to by the invention, by specifying residues for P2P1-P1'P2' as recited in claims 6-9, respectively. Applicants must also inform the Office of which claims and which sequences read upon the elected invention.

Upon election, the application will be forwarded to a different examiner in art unit 1639 for preparation of an Office action which is consistent with this petition decision and which follows linking claim practice with regard to the generic claim and which is responsive to the election and to the amendment and response filed 19 March 2004.

Any request for reconsideration of this petition decision must be filed within 2 (two) months of mail date of this petition.

There was no fee required for the filing of this petition.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-872-9306.

Bruce Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

OCT 2 7 2004

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

MARSHALL, GERSTEIN & BORUN LLP
6300 SEARS TOWER
233 S WACKER DRIVE
CHICAGO IL 60606

In re Application of	:
YAN et al.	:
Serial No.: 09/908,943	:Petition Decision
Filed: July 19, 2001	:
Attorney Docket No.: 29915/0028 IA.US	:

This decision is in response to the petition under 37 CFR 1. 181 and 1.144, filed March 15, 2004, requesting withdrawal of an improper restriction requirement. The decision mailed 14 October 2004 (as determined by PTO PALM records, although the petition decision itself apparently did not contain a mail room date stamped on the action) has been vacated as premature. The confusion arising from the incomplete decision inadvertently mailed 14 October 2004 and the delay in acting upon this petition are regretted.

BACKGROUND

A review of the file history shows that this application was filed on July 19, 2001, and contained claims 1-82. In a first Office action, mailed September 19, 2002, the examiner set forth a restriction requirement under 35 U.S.C. 121, as follows:

> Groups 1-52, claims 1-20, 28-35, drawn to a peptide of SEQ ID NO: 5-18, 120, 133-138, 141, 143-145, 147-169, 190-193, respectively, classified in class 530, subclass 327.
>
> Groups 53-55, claims 21-27, drawn to a peptide wherein P2 is N, S or D, respectively, classified in class 530, subclass 330.
>
> Groups 56-58, claims 21-27, drawn to a peptide wherein P1 is Y, L or Nle, respectively, classified in class 530, subclass 330.
>
> Groups 59-61, claims 21-27, drawn to a peptide wherein P1' is E, A or D, respectively, classified in class 530, subclass 330.

Groups 62-63, claims 21-27, drawn to a peptide wherein P2' is A or V, classified in class 530, subclass 330.

Groups 64-126, claims 36-42 and 52-54, drawn to a polynucleotide that encodes the polypeptide of claims 1-35, a vector, a host cell and a method of producing a substrate for a B-secretase assay, classified in class 435, subclass 320.1 and 252.3 and class 536, subclass 232.1. The groups 64-126 correspond to groups 1-63.

Groups 127-189, claims 43-50, drawn to a method for assaying for modulators of B- secretase activity, a method of inhibiting B-secretase activity in vivo, classified in class 435, subclass 23. The groups 127-189 correspond to groups 1-63.

Groups 190-252, claims 51 and 55-57, drawn to a method of inhibiting the B-secretase activity in vivo/ comprising administering a modulator according to claim 50, a pharmaceutical composition comprising a modulator, a method of treating a disease comprising administering the pharmaceutical composition and the use of a modulator to treat Alzheimer's disease, classified in various classes and subclasses depending upon what the inhibitor is. The groups 190-252 correspond to groups 1-63.

Groups 253-315, claims 58-64, and 66-67, drawn to a method for identifying agents that inhibit Asp2 aspartyl protease and a method of identifying agents that modulate Asp2 aspartyl protease, classified in class 435, subclass 219. The groups 252-315 correspond to groups 1-63.

Groups 316-378, claims 65 and 68-69, drawn to a method of treating Alzheimer's disease comprising using an inhibitor of Hu-Asp2, classified in various classes and subclasses depending upon the identity of the inhibitor. The groups 316-378 correspond to groups 1-63.

Groups 379-441, claims 70-72, drawn to a kit for performing a B-secretase assay, classified in class 435, subclass 23. The groups 379-441 correspond to groups 1-63.

Group 442, claims 73-82, drawn to a peptide, classified in class 530, subclass 328, 327, 326, and 324.

The examiner provided the following reasons for the Restriction Requirement:

Groups 1-63 and 64-126 are drawn to completely different chemical compounds that are patentably distinct. Groups 1-63 and 442 are drawn to different structural peptides and are patentably distinct.

Inventions 1-63 and 127-189 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 190-252, 253-315, 316-378, and in the kit or groups of 379-441.

Inventions 1-63 and 190-252 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 127-189, 253-315, 316-378, and in the kit or groups of 379-441.

Inventions 1-63 and 253-315 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 127-189, 190-252, 316-378, and the kit or groups of 379-441.

Inventions 1-63 and 316-378 are related as product and process of use, and that, in the instant case, the product as claimed can be used in a materially different process such as in the methods of groups 127-189, 190-252, 316-378, and the kit or groups of 379-441.

Inventions 379-441 are drawn to a product (kit) that is patentably distinct and the products of groups 1-63 and 64-126.

Claim 33 is presumed to be drawn to a polypeptide instead of a fusion protein, since there is no antecedent basis for fusion protein in claim 28-32.

The examiner argued that the restriction is proper because the inventions are distinct for the reasons above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter.

Applicants replied on November 19, 2002, electing Group 56, claims 21-27, drawn to a peptide of a generic sequence in which P1 is Y, with traverse, specifically arguing the examiner has failed to articulate a proper restriction requirement and that the invention should not be restricted 442 ways; and that the examiner has simply failed to establish that there is a serious burden to examine all of the claims. Applicants further argued that restriction practice under 35 USC 121 allows the Commissioner discretion to require restriction between two or more independent and distinct" inventions and that in the present invention, the claims are not independent. For example, the peptide/polypeptide subject matter of claims 1-35 and 73-82 is directly connected in design (i.e. the protein or peptide sequences all comprise a scissile bond that is cleaved by a human aspartyl protease), they operate in the same manner (i.e. the peptides are cleaved by human apartyl protease), and have the same effect (i.e. mimic the effects of wild-type substrate for human aspartyl protease).

The examiner mailed a non-Final Office action on February 21, 2003, acknowledging applicants' election of Group 56, claims 2 1-27, wherein P1 is Y, and making the restriction requirement final. The examiner responded to the traversal by indicating, for example that examining groups 1-35 and 73-82, as one group, as suggested by applicants would require the search of 52 different specific sequences as well as claims 1 and 2 1 that are drawn to a multitude of different peptides. Each of the peptides of claims 1-35 and 73-82 are structurally different and therefore properly restricted. The examiner further states that the search of 52 different sequences would, in itself, be an unreasonable burden upon the examiner, not taking into account the search of claims 1 and 21, which read on numerous embodiments.

Applicants replied on March 15, 2004 by filing this petition. Applicants filed a full reply to the Office action on May 21, 2003.

DISCUSSION

The application, file history and petition have been considered carefully.

The petition raises the following concerns (A)-(E), each of which will be addressed in turn:

(A) The peptide claims define a genus of peptide substrates using the formula: P2P1-P1'P2' adopting the nomenclature of Schechter and Berger (Biochem. Biophys. Res. Commun. 27:15741967) and Biochem. Biophys. Res. Commun. 32:898 (1968), in which the amino acid residues in the peptide substrate that undergo the cleavage are defined as P1 . .. Pn moving from the scissile bond toward the N-terminus and P1, . . . Pn' moving from the scissile bond toward the C-terminus. (See specification paragraph bridging pages 18 and 19).

The peptides defined by the foregoing formula share common structural features as evident from the genus defined by a single chemical formula wherein each amino acid position near the scissile bond has specified characteristics. Likewise, the peptides share a common functionality due to their common structure, as evinced by the fact that the peptides all serve as peptide substrates that are recognized and cleaved between residue Pl and P1' by a particular human aspartyl protease.

(B) Claim 1 as filed embraces a number of species that do not fall within restriction groups 1-52 and that were not explicitly assigned by the examiner to any other restriction group.

The restriction requirement is further facially defective because it fails to clearly assign the entirety of the claimed subject matter to individual groups. For example, original claim 1 was split into fifty-two distinct groups which each define a particular peptide species, yet the claim 1 actually encompasses more than 52 species.

(C) An exemplary peptide disclosed in the specification and referenced in at least original claims 20 and 73-78 is SEQ ID NO: 152, which has the following amino acid sequence: SEISY-EVEFR. Applying the Schechter and Berger nomenclature 2), SEQ ID NO: 152 is written as P5P4P3P2P1—P1'P2'P3'P4'P5', wherein P5 is S; P4 is E, P3 is I, P2 is S; P1 is Y, Pl' is E, P2' is V; P3' is E, P4' is F, and P5' is R.

A peptide satisfying SEQ ID N0: 152 falls into at least six different restriction groups as defined by the examiner:

(a) Group 31 defines an allegedly independent and distinct group with the sequence SEQ ID NO: 152,

(b) Group 54 defines an allegedly independent and distinct group with the requirement that P2 be S. In SEQ ID NO: 152, P2 is S. Thus, a peptide comprising SEQ ID NO: 152 falls within Group 54.

(c) Group 56 defines an allegedly independent and distinct group with the requirement that Pl be Y. In SEQ ID NO: 152, P1 is Y. Thus, a peptide comprising SEQ ID NO 152 falls within Group 56.

(d) Group 59 defines an allegedly independent and distinct group with the requirement that Pl' be E. In SEQ ID NO: 152, Pl. is E. Thus, a peptide comprising SEQ ID NO: 152 falls within Group 59.

(e) Group 63 defines an allegedly independent and distinct group with the requirement that P2' be V. In SEQ ID NO: 152, P2. is V. Thus, a peptide comprising SEQ ID NO: 152 falls within Group 63.

(f) Group 442 includes claim 73, which explicitly recites SEQ ID NO: 152.

Numerous other peptides of the invention besides SEQ ID NO: 152 , fall within two or more restriction groups because the groups do not define independent or distinct inventions.

By obvious extension, the analysis in paragraph 8 (C, above) is equally applicable to restriction groups 64-126, which define polynucleotide subject matter, restriction groups 127-378, which define various method subject matter; and groups 379-441, directed to kits. In each instance, the Examiner used the alleged independence or distinctness of the peptide groups 1-63 as a basis for restricting the other categories of subject matter. In fact, groups 127-441 were not individually defined, except to specify that they corresponded to be peptide groups 1-63. As exemplified in claim 21 as filed, P1 may be selected from the group consisting of Y, L, and Nle; P1' may be selected from the group consisting of E, A and D.

It is both axiomatic and required by the patent statute that claims only be restricted when they define independent and distinct inventions. The current restriction requirement is defective insofar as it specifies 442 overlapping groups such that individual species of the invention fall within multiple groups. It is impossible for restriction groups to be "independent" or "distinct" from one another when the same polypeptide falls within at least six of the groups.

(D) According to the Patent Office guidelines set forth in the MPEP, restriction practice under 35 U.S.C. 121 allows the Commissioner discretion to require restriction between two or more "independent and distinct" inventions (See M.P.E.P. 802.01 defining independent and distinct). M.P.E.P. 802.01 defines "independent" in relation to this practice, to mean:

> that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect, for example: (1) species under a genus which species are not usable together as disclosed', or (2) process and apparatus incapable of being used in practicing the process."

As stated in MPEP 806.04(a), the rules provide that a reasonable number of species may still be claimed in one application. Moreover, the MPEP requires that "where there is a relationship disclosed between the species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction." MPEP 808.0l(a). Even when restriction is proper, the MPEP requires that the Examiner should clearly identify each of the disclosed species to which claims are restricted and identify the distinguishing characteristics of species. See, e.g., MPEP 809.02(a).

(E) The petition then proposes the following Groups:

> Group I: An isolated peptide defined by the formula P2P1-Pl'P2', wherein P1-P1' is Y-E; kits comprising the same; polynucleotides encoding the same and methods of making or using the same
>
> Group II: An isolated peptide defined by the formula P2P1-P1'P2', wherein P1-P1' is Y-A,' kits comprising the same; polynucleotides encoding the same and methods of making or using the same;
>
> Group III: An isolated peptide defined by the formula P2P1-Pl'P2', wherein P1-P1' is Y-D; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;
>
> Group IV: An isolated peptide defined by the formula P2P1-P1'P2', wherein P1-P1' is L-E; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;
>
> Group V: An isolated peptide defined by the formula P2P1-P1',P2', wherein Pl-P1' is L-A; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;
>
> Group VI: An isolated peptide defined by the formula P2P1-P1'P2', wherein P1-P1' is L-D; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group VII: An isolated peptide defined by the formula P2Pl-P1'P2', wherein Pl-P1' is Nle-E; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group VIII: An isolated peptide defined by the formula P2P1-P1'P2', wherein P1-P1' is Nle-A; kits comprising the same; polynucleotides encoding the same and methods of making or using the same;

Group lX: An isolated peptide defined by the formula P2P1-Pl'P2', wherein P1-P1' is N1e-D; kits comprising the same; polynucleotides encoding the same and methods of making or using the same.

Representative claims are set forth below:

From original Groups 1-52

1. An isolated peptide comprising a sequence of at least four amino acids defined by formula P2Pl-P1'P2' wherein
P2 is a charged amino acid, a polar amino acid, or an aliphatic amino acid but is not an aromatic amino acid;
Pl is an aromatic amino acid or an aliphatic amino acid but not a polar amino acid or a charged amino acid;
P1' is a charged amino acid, or aliphatic amino acid, or a polar amino acid but is not an aromatic amino acid',
P2' is an uncharged aliphatic polar amino acid or an aromatic amino acid; and
wherein said peptide is cleaved between P1 and P1' by a human aspartyl protease encoded by the nucleic acid sequence of SEQ ID NO:1 or SEQ ID NO:3 and said peptide does not comprise the corresponding P2P1-P1'P2, portion of amino acid sequences depicted in SEQ ID NO:19; SEQ ID NO:20, SEQ ID NO:21, SEQ ID NO:26; SEQ ID N0:27; SEQ ID NO:28; SEQ ID NO:31; SEQ ID NO:32; SEQ ID NO:33; SEQ ID NO:34; SEQ ID NO:35, SEQ ID NO:36; SEQ ID NO:37; SEQ ID NO:38; SEQ ID NO:39; or SEQ ID NO:40.

From original Groups 127-189

49. The method claim of any of claims 43-48, further comprising a step of treating Alzheimer 's Disease with an agent identified as an inhibitor of Hu-Asp2.

From original Groups 316-378

65. A method according to 58 or 64, further comprising a step of treating Alzheimer's Disease with an agent identified as an inhibitor of Hu-Asp2.

From original Groups 379-441:

70. A kit for performing a beta secretase assay comprising a beta secretase substrate comprising a peptide according to any of claims 1 through 27 and a beta secretase enzyme.

Under (A), the petition argues that the peptides share a common function and a common structure. MPEP 803.02, which is directed at Markush groups, specifies when compounds claimed in the alternative may be considered for species election, and states:

> If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all the members of the Markush group in the claim on the merits, even though they are directed to independent and distinct inventions.

MPEP 803.02 goes on to specify when elements in a Markush may be considered to have "unity of invention" as defined by In re Harnisch.

> Broadly, unity of invention exists where compounds included within a Markush group (1) share a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

Four randomly selected peptides recited in the Markush Group of claim 20 are set forth below. Common structure among the four or even between any two of the four is not apparent.

SEQ ID No 6
Lys Val Glu Ala Asn Tyr Glu Val Glu Gly Glu Arg Cys Lys Lys

SEQ ID No 11
Ile Ile Lys Met Asp Asn Phe Gly

SEQ ID No 13
Thr His Gly Phe Gln Leu Xaa His

SEQ ID No 137
Lys Thr Ile Ser Leu Asp Val Glu Pro Ser

The Markush Group of claim 20 specifies structure for the combination of P2P1-P1'P2' and recites about 50 peptide sequences. The number "fifty" is not considered as few in number. The sequences recited in claim 20 are not so closely related as to be examined without undue burden.

For these reasons, concurrent examination of the 50-odd sequences in claim 20 is not required by the first sentence of MPEP 803.02.

While the compounds in this invention share a common utility, there is no shared common structure essential for that utility. For these reasons, the peptides are not considered as species eligible for treatment under specific practice and the petition's concern (A) is not persuasive.

Concerning (B), (C) and (D), applicants are correct that the restriction requirement groupings are incorrect and the inventions are not clearly identified. A review of the restriction requirement prompted by the petition identified the following problems with the way in which the groups are set forth:

(1) some inventions are not placed in any group
(2) same invention is encompassed by multiple groups
(3) linking claims not identified or properly treated.

The Groups are correctly set forth as follows:

Groups 1-2940, claims 1-23, 25-35, 70-101, drawn to a peptide which has P2P1-P1'P2' wherein P2, P1, P1' and P2' are each selected from the amino acid residues set forth in claims 6, 7, 8 and 9, respectively. Please see Table 1, below for further explanation of how each peptide invention is defined. Each combination represents one invention. The peptide groups are classified in class 530, subclass 327.

Groups 2941-5,430 claims 36-42 and 52-54, drawn to a polynucleotide that encodes one of the polypeptides of Groups 1-2940, a vector, a host cell and a method of producing a substrate for a B-secretase assay, classified in class 435, subclass 320.1 and 252.3 and class 536, subclass 232. 1.

Groups 5,430-8,370, claims 43-48, 50, 58-64, and 66-67, drawn to a method for assaying for modulators of B- secretase activity, identifying agents that inhibit Asp2 aspartyl protease or modulate Asp2 aspartyl protease of Groups 1-2940, classified in class 435, subclass 23.

Groups 8,370-11,310, claims 49, 51, 55-57, 65, 68-69 drawn to a method of inhibiting the B-secretase activity in vivo comprising administering a modulator of Groups 1-2940, a pharmaceutical composition comprising a modulator, a method of treating a disease comprising administering the pharmaceutical composition and the use of a modulator to treat Alzheimer's disease, classified in various classes and subclasses depending upon what the inhibitor is.

Table 1. Peptide inventions defined as a combination of one of each of P2, P1, P1' and P2'.

P2	P1	P1'	P2'
Claim 6	Claim 7	Claim 8	Claim 9
N	Y	E	V
L	L	A	A
K	M	D	N
S	Nle	M	T
G	F	Q	L
T	H	S	F
D		G	S
A			
Q			
E			

The number of inventions has been calculated as 2,940, by multiplying each of 10 choices for P2, 6 choices for P1, 7 choices for P1', and 7 choices for P2'.

When selecting a combination defining P2P1-P1'P2', applicants are under obligation to specify which claims and which sequences read upon the selected invention.

For example, if applicants elect P2P1-P1'P2' as SY-EV, applicants should point out that this peptide is encompassed by on SEQ ID NO 152, 158 and191 and claims 96, 97, 99, to name a few. (It is noted that other sequences and claims may also encompass this invention, but for purpose of explanation in this petition decision, the Office will not continue the analysis through the entire set of claims or list of sequences.)

The restriction requirement is proper for the following reasons:

The peptides, the polynucleotides and inhibitors of are structurally, functionally and patentably distinct molecules. Each of the peptides as defined in Table 1 are structurally and patentably distinct molecules. Each of the polynucleotides are structurally and patentably distinct molecules. The methods are patentably distinct from the products in view of the fact that more than one materially different product may be used in the method and more than one materially different method may be practice by each product. For example, each product can be used for either screening method to identify inhibitors or immunological method to raise antibodies. It would require undue burden to examine two or more inventions in view of the structural divergence of the peptides and polynucleotides and in view of the different classification. For example, a search for peptide having SEQ ID No 6 would not identify prior art which reads upon peptide having SEQ ID No 137 and vice versa. The restriction requirement is proper because the inventions are shown as distinct for the reason set forth above and have acquired a different status in the art as shown by their divergent classification and recognized divergent subject matter.

Concerning (B), Applicants are correct that the original restriction requirement failed to identify and properly treat linking claims, which describes the inventions in generic terms and encompass (1) some or all of the inventions in claims 1-19, 21, 23, 25-35, 70-72, 83-95 and (2) also include inventions directed at other isolated peptides encompassed by but not specifically listed in the claims. Indeed the groupings set forth in the original restriction requirement do not specifically

account for all the possible combination of peptides in claim 1. Linking claim practice is the correct way to handle this breadth of claims, as follows.

The examiner should have included the following paragraph in the Restriction Requirement and Office actions to identify the linking claims:

> Claims 1-19, 21, 23, 25-35, 70-72, 83-95 link(s) peptide inventions of recited in the combination of claims 6-9, as set forth above.
> Polynucleotide claims which refer to peptides in Claims 1-19, 21, 23, 25-35, 70-72, 83-95 link(s) polynucleotide inventions.
> Assay method claims which refer to peptides in Claims 1-19, 21, 23, 25-35, 70-72, 83-95 link(s) the assay method inventions.
> Administration method claims which refer to the peptides in Claims 1-19, 21, 23, 25-35, 70-72, 83-95 link(s) administration method inventions.
>
> The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Additionally, the examiner erred in limiting the examination of the generic linking claims to the elected invention. Applicants are correct that they deserve examination of the generic linking claims along with the elected invention.

MPEP 809.04 states that

> Where the requirement for restriction in an application is predicated upon the nonallowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the nonelected invention or inventions.
>
> If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the nonelected inventions that are linked to the elected invention by such allowed linking claim.

The restriction requirement between the products and the kits comprising the products is improper and has been withdrawn. The corresponding kit will be examined along with any elected product.

The restriction requirement between the methods of claims 49 and 65 comprising a step of treating Alzheimer's Disease with an agent identified as an inhibitor of Hu-Asp2 is improper as it contains subject which overlaps in scope.

Concerning (E), applicants' proposed groups I-IX are not are acceptable for one of the same reasons that the Examiner's Restriction Requirement was not acceptable. The Groups I-IX fail to account for all the claimed subject matter. For example, P1 as defined in Groups I-IX can be only Y or L, however, current claims also specify that P1 could be aromatic or aliphatic (claim 1) or M or Nle or F or H (claim 6), etc.

DECISION

The petition under 37 CFR 1.144 filed 15 March, 2004 is **GRANTED-in-PART** as follows:

The restriction requirement mailed 19 September 2002 has been withdrawn and replaced with the restriction requirement contained in this petition decision.

Applicants will be given ONE MONTH to respond to this restriction requirement and select both
(1) a particular the type of invention (protein, polypeptide, assay method or method of administration) and
(2) particular peptide used in or referred to by the invention, by specifying residues for P2P1-P1'P2' as recited in claims 6-9, respectively. Applicants must also inform the Office of which claims and which sequences read upon the elected invention.

Upon election, the application will be forwarded to a different examiner in art unit 1639 for preparation of an Office action which is consistent with this petition decision and which follows linking claim practice with regard to the generic claim and which is responsive to the election and to the amendment and response filed 19 March 2004.

Any request for reconsideration of this petition decision must be filed within 2 (two) months of mail date of this petition.

There was no fee required for the filing of this petition.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 703-872-9306.

Bruce Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MORRIS E. COHEN
1 PENN PLAZA, SUITE 2527
NEW YORK NY 10119

MAILED

AUG 25 2009

OFFICE OF PETITIONS

In re Application of
Robert C. Getts et al
Application No. 09/908,950
Filed: July 19, 2001
Attorney Docket No. 4081.006

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed June 26, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the nonfinal rejection mailed October 16, 2008, is accepted as having been unintentionally delayed.

As to the change of address noted on the transmittal letter submitted with the instant petition on June 26, 2009, petitioner is encouraged to note 37 CFR 1.4(c).

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

This application is being referred to Technology Center AU 1637 for appropriate action by the Examiner in the normal course of business on the reply received June 26, 2009.

/KOC/
Karen Creasy
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

COPY MAILED

SEP 0 2 2004

OFFICE OF PETITIONS

In re Application of
Anil K. Saksena et al
Application No. 09/908,955
Filed: July 19, 2001
Attorney Docket No. IN01159K

DECISION ON PETITION
UNDER 37 CFR 1.78(a)(6)

This is a decision on the petition under 37 CFR 1.78(a)(6), filed December 11, 2003, to accept an unintentionally delayed claim under 35 U.S.C. §119(e) for the benefit of the prior-filed provisional application set forth in the concurrently filed amendment.

The petition is **GRANTED**.

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

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending nonprovisional application was filed on July 19, 2001, within twelve months of the filing date of the prior-filed provisional application, Application No. 60/220,108, which was filed on July 21, 2000, for which priority is claimed. A reference to the prior-filed provisional application has been included in an amendment to the first sentence of the specification following the title.

The instant nonprovisional application was filed after November 29, 2000, and the claim for priority herein is submitted after expiration of the period specified in 37 CFR 1.78(a)(5)(ii).

Also, the reference to the prior-filed provisional application was submitted during the pendency of the nonprovisional application for which the benefit is sought. *See* 35 U.S.C. §119(e). Accordingly, having found that the instant petition satisfies the conditions of 37 CFR 1.78(a)(6) for acceptance of an unintentionally delayed claim for priority under 35 U.S.C. §119(e), the petition to accept an unintentionally delayed claim of benefit to prior-filed provisional Application No. 60/220,108 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 that the instant application is entitled to the benefit of the filing date 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) 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.

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

Any inquiries concerning this decision may be directed to Irvin Dingle at (703) 306-5684.[1]

This matter is being referred forwarded to Technology Center AU 1653.

Frances Hicks

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

Attachment: Corrected Filing Receipt

[1] Effective September 27, 2004, the phone number will be 571-272-3210.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

MAR 0 2 2007

OFFICE OF PETITIONS

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

In re Patent No. 7,012,066	:
Issued: March 14, 2006	: DECISION ON APPLICATION FOR
Application No. 09/908,955	: PTA and NOTICE OF INTENT
Filed: July 19, 2001	: TO ISSUE CERTIFICATE OF
Atty. Dkt. No.: IN01159K	: CORRECTION

This decision is in response to the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(d)," filed March 17, 2006.

The request for reconsideration of patent term adjustment is **GRANTED**.

The above-identified application matured into U.S. Patent No. 7,012,066 on March 14, 2006. The instant request for reconsideration was timely filed March 17, 2006 in accordance with 37 C.F.R. § 1.705(d). The patent issued with a PTA of 145 days. Applicants argue that the correct adjustment is 218 days.

A review of the application history reveals that an overall adjustment of 449 days can be attributed to the Office[1]. The adjustment is reduced a total of 231 days for applicants' failure to engage in reasonable efforts to conclude prosecution[2].

In view thereof, the patent is entitled to an adjustment of 218 days as argued by patentees.

---

[1] An adjustment of 376 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(1) and 1.703(a)(1) in connection with the non-final Office action mailed September 30, 2003. A further adjustment of 73 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(4) and 1.703(a)(6) in connection with failure to issue the patent within four months of receipt of the issue fee payment.

[2] The adjustment is reduced 85 days in accordance with 37 CFR 1.704(b) in connection with the reply filed March 24, 2004. The adjustment is further reduced 37 days in accordance with 37 CFR 1.704(c)(8) in connection with the supplemental reply filed April 30, 2004. The adjustment is further reduced 95 days in accordance with 37 CFR 1.704(b) in connection with the reply filed December 20, 2004. The adjustment is further reduced 14 days in accordance with 37 CFR 1.704(c)(8) in connection with the supplemental reply filed January 3, 2005.

Receipt is hereby acknowledged of the required $200.00 patent term adjustment application fee.

This application file will be forwarded to the Certificate of Corrections branch for issuance of a certificate of correction to indicate that the term of this patent is extended or adjusted under 35 U.S.C. 154(b) by 218 days.

Telephone inquiries specific to this matter should be directed to Petitions Attorney Alesia M. Brown at (571) 272-3205.

Kery A. Fries

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

CC: Draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT	:	7, 012,066 B2
DATED	:	March 14, 2006
INVENTOR(S)	:	Saksena, 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 145 days

Delete the phrase "by 145 days" and insert – by 218 days--

OIPE JC141
OCT 3 1 2001
PATENT & TRADEMARK OFFICE

#2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 36688-0005

Applicant(s): Avi SHOSHAN *et al.*

Appl. No.: 09/908,975

Filing Date: July 20, 2001

Title: OLIGONUCLEOTIDE LIBRARIES FOR DETECTING RNA TRANSCRIPTS AND SPLICE VARIANTS THAT POPULATE A TRANSCRIPTOME

TRANSMITTAL OF MISSING PARTS OF PATENT APPLICATION

Commissioner for Patents
Washington, D.C. 20231
ATTN: BOX MISSING PARTS

Sir:

Transmitted herewith are the missing parts needed to complete the filing of the subject patent application. Applicants have not received the Notice to File Missing Parts of Application from the USPTO.

Enclosed are:

[X] Copy of Declaration and Power of Attorney

[X] Check in the amount of $130.00 in payment of $130.00 surcharge fee (37 C.F.R. § 1.16(e))

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-1641. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Assistant Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-1641.

Respectfully submitted,

Date: October 31, 2001

By _____

HELLER EHRMAN WHITE & MCAULIFFE
1666 K Street, N.W., Suite 300
Washington, D.C. 20006
Telephone: (202) 912-2000
Facsimile: (202) 912-2020

John P. Isacson
Attorney for Applicant
Reg. No.: 33,715

26633

11/01/2001 JBALINAN 00000077 081641 09908975

01 FC:101 740.00 CH
02 FC:102 756.00 CH
03 FC:103 720.00 CH
04 FC:105 130.00 CH

OIPE
APR 2 4 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 DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
09/908,975	07/20/2001	Avi Shoshan	36688-0005

CONFIRMATION NO. 6858

FORMALITIES LETTER

OC000000007704828

John P. Isacson
HELLER EHRMAN WHITE & MCAULIFFE
1666 K Street, N.W., Suite 300
Washington, DC 20006

Date Mailed: 03/25/2002

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:

- The compact disc(s) submitted fail to comply with 37 CFR 1.52(e) in that only Compact Disc-Read Only Memory (CD-ROM) or a Compact Disc-Recordable (CD-R) medial are permitted. A new duplicate copy of each compact disc must be provided on CD-ROM or CD-R media. Any replacement compact discs submitted should be accompanied by a certification as required by 37 CFR 1.52(e) that each disc of a duplicate set is identical to the other disc of the set.

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

MARK D. WIECZOREK, Ph.D., J.D.
P.O. Box 70072
SAN DIEGO, CA 92167

COPY MAILED

MAY 1 0 2002

OFFICE OF PETITIONS

In re Application of: Lincoln T. Evans-Beauchamp and Jeremy Link Application No. 09/908,984 Filed: July 18, 2001 Title of Invention: DECISION ENGINE AND METHOD AND APPLICATIONS THEREOF	:	ON PETITION

This is in response to a Petition to prevent the inventor from obtaining access to the above-identified application file, under the Manual of Patent Examining Procedure ("MPEP") § 106, filed February 20, 2002, and supplemented via facsimile on March 28, 2002.

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.

Petitioner avers that the present assignee is the assignee of record of the entire interest in the above-identified patent application. In support of the petition, Petitioner filed an Employee Confidentiality and Proprietary Information Agreement ("Agreement"), wherein the inventor for whom the exclusion is sought, Lincoln T. Evans-Beauchamp, agreed to assign, and thereby did assign, his entire right, title and interest, in and to each invention.

A review of Office records reveal that no assignment has been filed in the instant application.

The MPEP, § 106, provides that

> [t]he assignee of record of the entire interest in an application may intervene in the prosecution of the application, appointing an attorney or agent of his or her own choice. See 37 CFR 3.71. Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect.

Thus, in order for an assignee to prosecute an application, the assignee must become of record pursuant to 37 CFR 3.71(c). Paragraph (c) of 37 CFR 3.71 provides that "[a]n assignee becomes of record . . . by filing a statement in compliance with § 3.73(b) that is signed by a party who is authorized to act on behalf of the assignee."

Thirty seven CFR 3.73(b)(1) further provides that in order to request or take action in a patent or trademark matter, the assignee

must establish its ownership of the patent or trademark property . . . ." Petitioner may establish ownership

> by submitting to the Office a signed statement identifying the assignee, accompanied 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).

The documentary evidence of a chain of title from the original owner to the assignee, submitted by petitioner, is insufficient to demonstrate ownership in the above-identified patent application. While the Agreement assigns inventions, it does not assign the instant application. The agreement may yet prove sufficient as an assignment of the instant application, however, ownership and transfer questions regarding patents rest, not with this Office, but with state courts. *See, Farmland Irrigation Co., Inc. V. Dopplmaier*, 48 Cal. 2d 208, 308 P.2d 732, 113 USPQ 88 (1957). *See, also, University Patents, Inc. v. Kligman*, 762 F.Supp. 1212, 20 USPQ2d 1401, 1405 (E.D. Pa. 1991).

Petitioner must provide documentary evidence of a chain of title, in the above-identified application, from the original owner to the assignee.

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 related to this decision may be directed to Petitions Attorney Derek L. Woods at (703) 305-0014.

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. 8

MARK D. WIECZOREK, Ph.D., J.D.
P.O. Box 70072
SAN DIEGO, CA 92167

COPY MAILED

MAY 1 0 2002

OFFICE OF PETITIONS

In re Application of:	
Lincoln T. Evans-Beauchamp and Jeremy Link	
Application No. 09/908,984	DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)
Filed: July 18, 2001	
Title of Invention: DECISION ENGINE AND METHOD AND APPLICATIONS THEREOF	

This is in response to a Petition Under 37 CFR 1.47(a), filed January 16, 2002, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor.

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.

Petitioner has shown that the non-signing inventor, Lincoln T. Evans-Beauchamp, refuses to sign the declaration after being presented with the above-identified application and declaration.

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

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

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

Lincoln T. Evans-Beauchamp
116 Colorado Avenue
Palo Alto, CA 94301

COPY MAILED

MAY 1 0 2002

OFFICE OF PETITIONS

In re Application of:
Lincoln T. Evans-Beauchamp and
Jeremy Link
Application No. 09/908,984
Filed: July 18, 2001
Title of Invention: DECISION ENGINE
AND METHOD AND APPLICATIONS THEREOF

LETTER

Dear Mr. Evans-Beauchamp:

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 Derek L. Woods at (703) 305-0014. 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

COPY MAILED

AUG 0 5 2002

OFFICE OF PETITIONS

MARK D. WIECZOREK, Ph.D., J.D.
P.O. Box 70072
SAN DIEGO, CA 92167

In re Application of:
Lincoln T. Evans-Beauchamp and
Jeremy Link
Application No. 09/908,984
Filed: July 18, 2001
Title of Invention: DECISION ENGINE
AND METHOD AND APPLICATIONS THEREOF

ON PETITION

This is in response to a Request for Reconsideration of Petition to prevent the inventor from obtaining access to the above-identified application file, under the Manual of Patent Examining Procedure ("MPEP") § 106, filed June 14, 2002, which is being treated as a petition under 37 CFR 1.182.

The petition under 37 CFR 1.182 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 1.182." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Background:

The original petition, filed February 20, 2002, alleged that the present assignee was the assignee of record of the entire interest in the above-identified patent application. In support of that petition, Petitioner filed an Employee Confidentiality and Proprietary Information Agreement ("Agreement"), wherein the inventor for whom the exclusion was sought, Lincoln T. Evans-Beauchamp, agreed to assign, and thereby did assign, his entire right, title and interest, in and to each invention. The Agreement specifically included two technologies, neither of which is the subject of the instant application.

The petition was dismissed because petitioner provided no documentary evidence of a chain of title, in the above-identified application, from the original owner to the assignee.

The instant petition:

Petitioner files the instant Request for Reconsideration wherein Petitioner avers that "the patent assignee is the assignee of record of the entire interest in the above-entitled patent application by virtue of an assignment filed December 31, 2001." The petition "points to the assignment recorded under Reel/Frame No. 012601/0484 on February 12, 2002."

A review of the putative assignment reveals that it is not an assignment of the above-identified application, but is a copy of the Agreement filed with the original petition on February 20, 2002.

Petitioner is directed to *Arachnid, Inc. v. Merit Industries, Inc.* 939 F.2d 1574, 1580 19 USPQ2d 1513, 1518 (Fed. Cir. 1991). There, the court said that "[l]egal title to an invention can pass to another only by a conveyance which operates upon the thing invented after it has become capable of being made the subject of an application for a patent." *Id.* at 1580. The Agreement relied upon by Petitioner does not identify the above-identified application. There is, therefore, a question of ownership and transfer in this application.

As iterated in the Decision Dismissing the February 20, 2002 petition, ownership and transfer questions regarding patents rest, not with this Office, but with state courts. *See, Farmland Irrigation Co., Inc. V. Dopplmaier*, 48 Cal. 2d 208, 308 P.2d 732, 113 USPQ 88 (1957). *See, also, University Patents, Inc. v. Kligman*, 762 F.Supp. 1212, 20 USPQ2d 1401, 1405 (E.D. Pa. 1991).

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 22202

Telephone inquiries related to this decision may be directed to Petitions Attorney Derek L. Woods at (703) 305-0014.

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

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6-11-07

TO SPE OF : ART UNIT 1637

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/499061 Patent No.: 6787316

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 check claims

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

Ennis Young

Certificates of Correction Branch

703-308-9390 ext. 117

Thank You For Your Assistance

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

Note your decision on the appropriate box.

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

Comments: At page 1 of the request for a COC "In column 32, beginning on line 1, please cancel claims 3-5." should be to cancel claims 3 and 4 as claim 5 is renumbered at the next line

Gary Benzion — SPE

1637 — 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

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH, NJ 07033-0530

COPY MAILED

APR 13 2005

OFFICE OF PETITIONS

In re Application of	:	
Anil K. Saksena et al	:	
Application No. 09/909,012	:	DECISION GRANTING PETITION
Filed: July 19, 2001	:	UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. INO1158K	:	

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

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on March 25, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 1653 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of an amendment 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

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

UR

PAPER NO.7

FEB 22 2002

In re Application of
Emanuel S. Kemeny
Serial Number: 09/909,014
Filed: July 20, 2001
For: MEAL-EQUIVALENT FOOD BAR

DECISION
ON
PETITION UNDER
M.P.E.P. 708.02(IV)

This is in response to the petition filed January 4, 2002, requesting that the above-identified application be granted Special Status under Section 708.02 (IV) of the MPEP and 37 CFR 1.102(c).

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

The petition is **GRANTED.**

Richard V. Fisher

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

Emanuel S. Kemeny
1400 S. Joyce St # 602
Arlington, VA 22202

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6,484,357	2002-11-26	09/909,024	2001-07-19	

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

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

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

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

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

◉ A sole patentee

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

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

○ The assignee of record of the entire interest

Sole Patentee			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature.			
Signature	/Shengjie Dong/	Date (YYYY-MM-DD)	2008-10-28
Name	Shengjie Dong		

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. 6484357
Issue Date: November 26,2002
Application No. 09909024
Filed: July 19,2001
Attorney Docket No. 06124.0001U1

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

This is a decision on the electronic petition, filed October 28,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

JUL 1 0 2008

OFFICE OF PETITIONS

AKA CHAN LLP / CISCO
900 LAFAYETTE STREET
SUITE 710
SANTA CLARA, CA 95050

In re Application of :
Suresh Katukam et al :
Application No. 09/909,049 : ON PETITION
Filed: July 18, 2001 :
Attorney Docket No. CISCP694 :

This is a decision on the petition under 37 CFR 1.137(b), filed April 3, 2008, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed July 2, 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) were obtained. Accordingly, the above-identified application became abandoned on October 3, 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 2153 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

AUG 10 2004

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

In re Application of:
Saksena et al.
Serial No.: 09/909,062
Filed: July 19, 2001
Attorney Docket No.: IN01157K

DECISION ON PETITION

This is in response to applicants' petition under 37 CFR. § 1.181 filed on May 10, 2004, to revive the instant application.

A review of the file history shows that the examiner mailed a Notice of Allowance to applicants on December 18, 2003. On May 19, 2004, a corrected Notice of Allowance was mailed to reflect the correct correspondence address.

Applicants' petition is **DISMISSED.** While this application could have been abandoned for failure to pay the issue fee, it never was as it was discovered that the Notice of Allowance of December 18, 2003 was not mailed to the correct correspondence address. When this error was brought to the attention of the USPTO, a corrected Notice of Allowance was mailed setting a new three month statutory period of time in which to pay the issue fee.

Patent term extensions should be applied for after the patent issues.

Should there be any questions about this decision, please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile at 703-872-9306.

Bruce Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK
600 SOUTH AVENUE WEST
WESTFIELD, NJ 07090

COPY MAILED

AUG 0 4 2005

OFFICE OF PETITIONS

In re Patent No. 6,800,434
Saksena et al.
Issue Date: October 5, 2004
Application No. 09/909,062
Filed: July 19, 2001
Atty Docket No. IN01157K

: DECISION ON
: APPLICATION FOR
: PATENT TERM ADJUSTMENT
: and
: DECISION ON REQUEST FOR
: RECONSIDERATION OF
: PATENT TERM ADJUSTMENT
: and
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is in response to both the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705" filed August 10, 2004, and the SUPPLEMENTAL APPLICATION FOR PATENT TERM ADJUSTMENT FILED UNDER 37 CFR § 1.705(e)," filed November 2, 2004. Patentees request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) of zero (0) days shown on the PTOL-85 mailed May 19, 2004 be revised to reflect a PTA of sixty (60) days. Patentees further request that the patent term adjustment indicated in the patent be corrected to not include a reduction of fifty-seven (57) days for the filing of the application for patent term adjustment on August 10, 2004.

The application for patent term adjustment under § 1.705(b) filed August 10, 2004 is **GRANTED** to the extent indicated herein. However, no correction of the patent term adjustment of 0 days at the time of the mailing of the Notice of Allowance is required.

The request for reconsideration of patent term adjustment under § 1.705(d) 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 fifty **(50)** days.

on Application for Patent Term Adjustment

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 0 days. The instant application for patent term adjustment was timely filed[1]. Then applicants asserted entitlement to additional periods of adjustment totaling 186 days. First, applicants asserted entitlement to a period of adjustment of 153 days for delay in mailing the notice of allowance to the correct customer. Applicants stated that the original notice mailed December 18, 2003 was mailed to an unrelated third party; and the corrected notice was not mailed until May 19, 2004. Second, applicants asserted entitlement to a period of adjustment of 33 days for Office delay until March 26, 2003 to respond to applicants' response filed October 21, 2002. Given the additional 186 days of adjustment, applicants asserted that at the time of the mailing of the notice of allowance, the application was entitled to 60 days of patent term adjustment[2].

The application history has been reviewed and it has been determined that the initial patent term adjustment of 0 days is correct. However, an additional period of adjustment should have been entered (but with a net result of 0 days of PTA).

A period of adjustment of 111 days, not 153 days, should have been entered for Office delay in responding to applicants' reply filed September 29, 2003. The Office mailed a notice of allowance under section 151 on December 18, 2003, within four months of the date of filing of applicant's reply, September 29, 2003. However, the Notice was not mailed to the correspondence address of record. Accordingly, a "corrected" notice of allowance was mailed on May 19, 2004. The record supports a conclusion that this re-mailing was due to an error on the part of the Office in mailing the first notice of allowance to applicants. Thus, the re-mailing of the notice of allowance does constitute a delay by the Office in the issuance of the patent within the meaning of 35 U.S.C. 154(b).

The number of days in the period of delay beginning on January 30, 2004, the day after the date that is four months after the date a reply under § 1.111 was filed, to May 19, 2004, the date of mailing of the corrected notice of allowance is 111 days. See § 1.703(a)(2).

However, applicants' contention that the application is entitled to an additional period of adjustment for Office delay in responding to their response to election requirement filed October 21, 2002 is not persuasive. On December 19, 2002, the examiner mailed an Office action, requiring compliance with sequence rules in order to continue prosecution of this application. This action by the Office was taken within four months of the date of filing of applicants' reply. In addition,

---

[1] The Issue Fee payment was also received on August 10, 2004.

[2] Applicants agreed with the period of adjustment of 13 days, and the reductions of 95 and 44 days.

this Office action was not issued as part of the pre-examination processing of the application, but was issued by the examiner as a result of an examination conducted pursuant to 35 U.S.C. 131. Compliance had to be obtained before the non-final Office action could be mailed. Entry of a period of adjustment, particularly where it would include a period during which Office action was delayed until applicants filed the papers necessary to place the application in compliance with the sequence rules[3], is not warranted.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is zero (0) days (111 + 13 days of Office delay) reduced by (44 + 95 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.

on Request for Reconsideration of PTA indicated in Patent

On October 5, 2004, the above-identified application matured into U.S. Patent No. 6,800,434, with a patent term adjustment of 0 days printed on the front page. The initial patent term adjustment of zero (0) days (reflecting a period of adjustment of 13 days minus a period of reduction of 139 days) was increased by 65 days for Office delay, but further reduced by 57 days for applicant delay. Patentees dispute the reduction of 57 days associated with a "Miscellaneous Incoming Letter" filed August 10, 2004.

A review of the application history reveals that the only paper filed August 10, 2004 was the application for patent term adjustment. 37 CFR 1.704(e) provides that:

> Submission of an application for patent term adjustment under § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.

Accordingly, the patent term adjustment should not have been reduced by 57 days.

In view thereof, it is concluded that the patent should have issued with a revised Patent Term Adjustment of fifty (50) days (189 days of Office delay reduced by 139 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 fee is required for consideration under § 1.705(d) and will not be waived.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in

---

[3] It is further noted that applicants obtained a one-month extension of time to comply with sequence rules.

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 **FIFTY (50)** days.

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

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

Enclosure: Copy of DRAFT Certificate of Correction

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 10/3/07

Paper No.: ____

TO SPE OF : ART UNIT 1654

SUBJECT : Request for Certificate of Correction on Patent No.: 6800434

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

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

Valerie Jackson

Thank You For Your Assistance

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

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

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

Comments:

Carlos Tsay
SPE

1654
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

SCHERING-PLOUGH CORPORATION
PATENT DEPARTMENT (K-6-1, 1990)
2000 GALLOPING HILL ROAD
KENILWORTH NJ 07033-0530

COPY MAILED

SEP 2 3 2004

OFFICE OF PETITIONS

In re Application	:	
Arasappan et al.	:	
Application No. 09/909,077	:	DECISION ON APPLICATION
Filed: July 19, 2001	:	FOR PATENT TERM ADJUSTMENT
Atty Docket No. IN01156	:	

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. §1.705(b)," filed May 6, 2004. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from two hundred ninety-nine (299) days to three hundred ninety-one (391) days.

For the reasons set forth below, a decision on the request for reconsideration of the patent term adjustment indicated on the patent application is being **HELD IN ABEYANCE** until issuance of the patent.

On April 7, 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 two hundred ninety-nine (299) days. On May 6, 2004, applicants timely[1] submitted an application for

[1] PALM records indicate that applicants filed the PTA prior to payment of the issue fee.

patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is three hundred ninety-one (391) 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 two hundred ninety-nine (299) days based on an adjustment for PTO delay of two hundred ninety-nine (299) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1). The PTO delay of 299 days has been reviewed and found to be correct.

However, applicants assert additional PTO delay of ninety-two (92) days for the failure on the part of the Office to issue the patent within three years of its filing. As the patent has not yet issued, this determination cannot yet be made. Accordingly, applicants are given **TWO (2) MONTHS from issuance of the patent** to seek any additional time based on the Office issuing the patent beyond the three-year time frame. A copy of this letter should accompany then patentees written request. No additional fee under § 1.18(e) for reconsideration of PTA on this basis will be required.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **two hundred ninety-nine (299) days.**

Receipt of the $200.00 fee set forth in 37 C.F.R. §1.18(e) is acknowledged.

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

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (703) 305-0272.

Karin A Ferriter
/per

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

Kleinberg & Lerner, LLP
2049 Century Park East
Suite 1080
Los Angeles, CA 90067-3112

COPY MAILED

JUL 27 2005

OFFICE OF PETITIONS

In re Application of	:	
Thomas Paul Downs	:	
Application No. 09/909,087	:	ON PETITION
Filed: July 20, 2001	:	
Attorney Docket No. N/A	:	

This is a decision on the petition under 37 CFR 1.137(b), filed June 15, 2005, to revive the above-identified application.

In response to the final Office action mailed April 22, 2003, petitioner hereby submits $750 for the petition to revive fee, a continuation-in-part application, and the statement of unintentional delay as required by 37 CFR 1.137(b).

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

The above-identified application is being revived solely for purposes of continuity. As continuity has been established by this decision reviving the above application, this application is again abandoned in favor of continuing application No. 11/154,166.

This application is being referred to Files Repository.

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

In re Patent No. 6,559,057	:	
Issue Date: May 6, 2003	:	**DECISION GRANTING**
Appl No.: 09/909,111	:	**PETITION**
Filed: July 18, 2001	:	*37 CFR 1.324*
For: Semiconductor Processing Methods of Forming a Conductive Projection and Methods of Increasing Alignment Tolerances	:	

This is a decision on the petition filed April 6, 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.

Nadine Norton
Supervisory Patent Examiner
Art Unit 1765
Technology Center 1700

WELLS ST. JOHN P.S.
601 W. FIRST AVENUE, SUITE 1300
SPOKANE, WA 99201

UNITED STATES 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

SAMUEL H. DWORETSKY
AT&T CORP.
P.O. BOX 4110
MIDDLETOWN, NJ 07748-4110

COPY MAILED

AUG 2 0 2003

OFFICE OF PETITIONS

In re Application of Robert Cahn Application No. 09/909,123 Filed: July 19, 2001 Attorney Docket No. 2000-0328	DECISION GRANTING PETITION UNDER 37 CFR 1.137(b)

This is a decision on the petition, filed by facsimile transmission on May 21, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in an eighteen month publication country on July 18, 2002. However, the USPTO was unintentionally not notified of this filing within 45 days subsequent to the filing of the subject application in an eighteen month publication country.

In view of the above, this application became abandoned pursuant to 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) for failure to timely notify the Office of the filing of an application in a foreign country or under a multilateral international agreement that requires publication of applications 18 months after filing.

A petition to revive an application abandoned pursuant to 35 U.S.C. 122(b)(2)(B)(iii) for failure to notify the USPTO of a foreign filing must be accompanied by:

(1) the required reply which is met by the notification of such filing in a foreign country or

under a multinational treaty;
(2) the petition fee as set forth in 37 CFR 1.17(m); and
(3) a statement that the entire delay in filing the required reply from the due date of the reply until the filing of a grantable petition was unintentional.

The instant petition has been found to be in compliance with 37 CFR 1.137(b). Accordingly, the failure to timely notify the USPTO of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. § 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122(b)(2)(B)(i) has been rescinded. A Notice Regarding Rescission of Nonpublication Request which sets forth the projected publication date of November 27, 2003 accompanies this decision on petition.

Pursuant to petitioner's authorization, Deposit Account No. 01-2745 was charged $1,300.00 for the petition to revive an unintentionally abandoned application (37 CFR 1.137(f)).

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

This application is being forwarded to Technology Center Art Unit 2661 for examination in due course.

Frances Hicks

Frances Hicks
Lead Petitioners 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. 21

JOHN S. PRATT
KILPATRICK STOCKTON LLP
1100 PEACHTREE STREET
SUITE 2800
ATLANTA, GA 30309

COPY MAILED

AUG 1 5 2003

OFFICE OF PETITIONS

In re Application of
Max P. McDaniel et al
Application No. 09/909,152
Filed: July 19, 2001
Attorney Docket No. 33633US1

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 30, 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 November 15, 2002, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on February 16, 2003.

The above-identified application is being revived solely for purposes of continuity with a Request For Continued Examination (RCE) filed on July 30, 2003.

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

The application file is being forwarded to Technology Center 1700 for further processing.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

MILBANK TWEED HADLEY & McCLOY LLP
1 CHASE MANHATTAN PLAZA
NEW YORK, NY 10005-1413

COPY MAILED

SEP 16 2003

OFFICE OF PETITIONS

In re Application of
Kouichi Saitou et al
Application No. 09/909,195
Filed: July 19, 2001
Attorney Docket No. 35061-02500

: DECISION GRANTING PETITION
: UNDER 37 CFR 313(c)(2)

This is a decision on the petition, filed September 12, 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 4, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

Upon receipt of the file in the Office of Petitions, the file will be forwarded to Technology Center AU 2875 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

Date : September 16, 2003

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of **Application No. 09/909,195**

Applicant(s) : Kouichi Saitou et al
Application No. : 09/909,195
Filed : July 19, 2001

The above-identified application has been assigned Patent No. 6,628,063 and an issue date of September 30, 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 September 30, 2003:

> **"All reference to Patent No. 6,628,063 to Kouichi Saitou et al of Japan for PROJECTION TUBE HAVING DIFFERENT NECK DIAMETERS appearing in the Official Gazette of September 30, 2003 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MOTOROLA, INC.
1303 EAST ALGONQUIN ROAD
IL01/3RD
SCHAUMBURG IL 60196

COPY MAILED

MAY 17 2006

OFFICE OF PETITIONS

ON PETITION

In re Application of
Jens Nagel et al.
Application No. 09/909,202
Filed: July 19, 2001
Attorney Docket No. CML00010H

This is a decision on the petition filed May 15, 3006, to withdraw the holding of abandonment which is treated under 37 CFR 1.181.

The petition to withdraw the holding of abandonment is **GRANTED**.

The application was held abandoned on November 15, 2004 for failure to file a timely response to the non-Final Office Action mailed August 12, 2004, which set a three (3) month shortened period for reply. No extensions of time in accordance with 37 CFR 1.136(a) were obtained. Accordingly, a Notice of Abandonment was mailed April 21, 2006.

Petitioner asserts that a proper response, was filed via facsimile transmission on August 23, 2004. In support, petitioner submits a copy of the reply said to have been filed, which includes a certificate of facsimile transmission pursuant to 37 CFR 1.8 and was acknowledged by the U.S. Patent and Trademark Office in an Auto-Reply Facsimile Transmission.

The evidence submitted corroborates a timely response to the non-Final Office Action. Accordingly, the holding of abandonment is withdrawn and the Notice of Abandonment is vacated. No petition fee Is due and none has been charged.

This matter is being referred to Technology Center 2624 for appropriate action on the amendment filed August 23, 2004, a copy of which was submitted May 15, 2006 with the instant petition.

Telephone inquiries concerning this matter should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

SCAN! **Please forward case and paper to address shown below.**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5/22/07

TO SPE OF : ART UNIT 1713

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/909230 Patent No.: 6441097

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

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

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

HENRY RANDALL
Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

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

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

Comments: _____

SPE

1713
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

PATENT ADMINISTRATOR
SUITE 1600
525 WEST MONROE STREET
CHICAGO IL 60661-3693

COPY MAILED

SEP 29 2008

OFFICE OF PETITIONS

In re Application of :
Banerjee, et al. :
Application No. 09/909,248 : DECISION
Filed 19 July, 2001 :
Attorney Docket No. 11465/491 :

This is a decision on the petition, filed on 12 February, 2007, under 37 C.F.R. §1.137(a) for revival of an application abandoned due to unavoidable delay.

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.

The petition under 37 C.F.R. §1.137(a) is **DISMISSED**.

Any further petition to revive 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(a)."

Petitioner's alternative is to file a petition under 37 C.F.R. §1.137(b), discussed below.

This is **not** a final agency action within the meaning of 5 U.S.C.§704.

As to Allegations of
Unavoidable Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(a) are the petition and fee therefor, a reply, a proper showing of unavoidable delay under the regulation, and, where applicable, a terminal disclaimer and fee.

Petitioner's attention is directed to the the guidance in the Commentary in the Manual of Patent Examining Procedure at MPEP §711.03(c) as to any petition to revive.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the Notice of non-Compliant Appeal Brief mailed on 23 September, 2005, with reply due absent extension of time on or before 23 October, 2005.

Petitioner filed a supplemental Appeal Brief on 22 December, 2005, accompanied by a request and fee for extension of time.

The instant application went abandoned by operation of law after midnight 23 December, 2005.

The Office mailed the Notice of Abandonment on 4 December, 2006.

The statement in the Notice of Abandonment indicated that Petitioner failed to comply with the applicable rules (e.g., 37 C.F.R. §41.37) and applicable guidance (e.g., MPEP §1205.02, §1205.03)..

Petitioner filed the instant petition with fee on 12 February, 2007, with a reply in the form of a second supplemental Appeal Brief, and averred, *inter alia*, that "Applicants believed that their response to Notice of Nom-Compliant Appeal Brief was acceptable to the Patent Office and thus compliant." Petitioner makes the statement notwithstanding his failure to include expressly required components of an appeal brief (e.g., 37 C.F.R. §41.37(c), et seq.).

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[1]

The availability of applications and application papers online to Petitioners/practitioners who diligently associate their Customer Number with the respective application(s) now provides practitioners on-demand information as to events/transactions in an application.

[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)(Petitioner 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).

As to Allegations of
Unavoidable Delay

The requirements under 37 C.F.R. §1.137(a) have not been satisfied as of this writing in that Petitioner failed to make the showing of unavoidable delay as required.

CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.137(a) is **dismissed**.

ALTERNATIVE VENUE

Should Petitioner wish to revive the application, Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (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 petition fee, a terminal disclaimer and fee where appropriate 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:

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

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

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[2]) 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./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[2] 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 Petitioners 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

PATENT ADMINISTRATOR
SUITE 1600
525 WEST MONROE STREET
CHICAGO IL 60661-3693

In re Application of	:	
Banerjee, et al.	:	
Application No. 09/909,248	:	DECISION
Filed 19 July, 2001	:	
Attorney Docket No. 11465/491	:	

This is a decision on the petitions, filed on 9 October, 2008, to revive an application under 37 C.F.R. §1.137(b) as having been abandoned due to unintentional delay.

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

As to Allegations of
Unintentional Delay

The requirements of a grantable petition pursuant to 37 C.F.R. §1.137(b) are the petition and fee therefor, a reply, a proper statement of unintentional delay under the regulation, and, where applicable, a terminal disclaimer and fee. (However, it does not appear that a terminal disclaimer and fee are due here.)

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the Notice of non-Compliant Appeal Brief mailed on 23 September, 2005, with reply due absent extension of time on or before 23 October, 2005.

Petitioner filed a supplemental Appeal Brief on 22 December, 2005, accompanied by a request and fee for extension of time.

The instant application went abandoned by operation of law after midnight 23 December, 2005.

The Office mailed the Notice of Abandonment on 4 December, 2006.

The statement in the Notice of Abandonment indicated that Petitioner failed to comply with the applicable rules (e.g., 37 C.F.R. §41.37) and applicable guidance (e.g., MPEP §1205.02, §1205.03)..

Petitioner filed a petition with fee on 12 February, 2007, with a reply in the form of a second supplemental Appeal Brief, and averred, *inter alia*, that "Applicants believed that their response to Notice of Non-Compliant Appeal Brief was acceptable to the Patent Office and thus compliant." Petitioner makes the statement notwithstanding his failure to include expressly required components of an appeal brief (e.g., 37 C.F.R. §41.37(c), et seq.)-and the petition was dismissed on 29 September, 2008.

On 9 October, 2008, Petitioner filed the instant petition with fee, pointed to the reply in the form of the previously filed corrected Appeal Brief, and made the statement of unintentional delay.

The record (including the petitions filed on 12 February, 2007, and 9 October, 2008) does not necessitate a finding that the delay between midnight 23 December, 2005 (the date of abandonment), and 9 October, 2008 (the date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioner/Counsel John S. Paniaguas (Reg. No. 31,052) when accepting Petitioners' representation that the delay in filing the response was unintentional.[1]

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.

Out of an abundance of caution, Petitioners always are reminded that those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation–since all owe to the Office the continuing duty to disclose.[2]

---

[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).

[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.

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.[4]))

As to Allegations of
Unintentional Delay

The requirements under 37 C.F.R. §1.137(b) have been satisfied.

CONCLUSION

Accordingly, The petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is released to Technology Center/AU (TC/AU) 2628 to await the Examiner's Answer in due course.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the instant decision to ensure that the revival has been acknowledged by the TC/AU in response to this decision. It is noted that all inquiries with regard to that change in status need be directed to the TC/AU where that change of status must be effected—that does not occur in the Office of Petitions.

---

[3] 35 U.S.C. §133 provides:
35 U.S.C. §133 Time for prosecuting application.
Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

[4] Therefore, by example, an 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.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[5]) 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./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[5] 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
WASHINGTON, DC 20231
www.uspto.gov

MAIL

NOV 01 2006
DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

CAPITOL PATENT & TRADEMARK LAW FIRM, PLLC
ATTN: JOHN CURTIN
P.O. BOX 1995
VIENNA VA 22183

In re Application of	:	
SMITH, et al.	:	
Application No. 09/909,265	:	DECISION ON REQUEST TO
Filed: July 19, 2001	:	CORRECT INVENTORSHIP
For: **WAVELENGTH ROUTING AND SWITCHING ...**	:	

This is a decision on the request to correct inventorship filed on August 18, 2003.

A grantable request to correct inventorship of a nonprovisional application for adding additional inventors must:
(1) A request to correct the inventorship that sets forth the desired inventorship change;
(2) A statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part;
(3) An oath or declaration by the actual inventor or inventors as required by §1.63 or as permitted by §1.42, §1.43 or §1.47;
(4) The processing fee set forth in §1.17(i); and
(5) If an assignment has been executed by any of the original named inventors, the written consent of the assignee.

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

Accordingly, this application has been corrected in compliance with 37 C.F.R. 1.48(a), the inventorship of this application has been changed by adding Robert Alan Nadon as additional inventor.

This application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

SKL

Shi K. Li
Primary Patent Examiner
Technology Center 2600
Communications
(571) 272-3031

UNITED STATES 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

JUN 0 9 2005

OFFICE OF PETITIONS

BARNES & THORNBURG
11 SOUTH MERIDAN
INDIANAPOLIS IN 46204

In re Application of :
Joseph M. Dewig et al :
Application No. 09/909,284 : ON PETITION
Filed: July 19, 2001 :
Attorney Docket No. 5723-68359 :

This is a decision on the petition, filed June 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 May 9, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

The examiner of Technology Center AU 2854 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
www.uspto.gov

Paper No. 8

EDWARD G. POPLAWSKI, ESQ.
SIDLEY AUSTIN BROWN & WOOD LLP
555 WEST FIFTH STREET, 40TH FLOOR
LOS ANGELES, CA 90013-1010

COPY MAILED

JAN 3 0 2004

OFFICE OF PETITIONS

In re Application of	:	
Betty P. Tsao, et al.	:	
Application No. 09/909,317	:	ON PETITION
Filed: July 18, 2001	:	
Attorney Docket No. 18810-82152	:	

This is a decision on the petition under 37 CFR 1.137(b), filed January 21, 2004, to revive the above-identified application.

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the Notice to File Missing Parts of Nonprovisional Application mailed September 19, 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 November 20, 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. 6

ORRICK, HERRINGTON & SUTCLIFFE, LLP
4 PARK PLAZA
SUITE 1600
IRVINE CA 92614-2558

COPY MAILED

APR 1 8 2003

OFFICE OF PETITIONS

In re Application of	:
Louis J. Barbato	:
Application No. 09/909,357	: DECISION GRANTING PETITION
Filed: July 18, 2001	: UNDER 37 CFR 1.137(f)
Attorney Docket No. 263/071	:

This is a decision on the petition, filed March 24, 2003, to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country on July 15, 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 in compliance with 37 CFR 1.137(f). However, while the statement of unintentional delay does not comply with the rule, the statement presented will be construed as meaning that "the entire delay in filing the required reply [Notice to Rescind Previous Nonpublication Request Under 35 U.S.C. § 122(b)(2)(B)(ii)] until the filing of a grantable petition was unintentional." Accordingly, the failure to timely notify the Office 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.

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 July 24, 2003 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 2621 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

JJGJR.: 07-06

Paper No: __

COPY MAILED

JUL 17 2006

OFFICE OF PETITIONS

JOSEPH E. CHOVANES
SUITE 329
5 GREAT VALLEY PARKWAY
MALVERN PA 19355

In re Application of	:	
Palumbo, et al.	:	
Application No. 09/909,382	:	DECISION
Filing Date: 23 July, 2001	:	
Attorney Docket No.: 33-99CIP	:	

This is a decision on the petition filed on 15 April, 2005, alleging unintentional delay under 37 C.F.R. §1.137(b).

The Office regrets the delay in addressing this matter, however, it was received by the attorneys of the Office of Petitions only at this writing

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 Notice of Allowance/Allowability and Fees Due mailed on 29 May, 2003, with reply due under a non-extendable deadline on or before 29 August, 2003;

- the instant application went abandoned after midnight 29 August, 2003;

- the Office mailed a Notice of Abandonment on 1 October, 2003;
- on 15 April, 2005, Petitioner filed the instant petition (with fee), reply in the form of fees due, made the statement of unintentional delay, and further alleged, *inter alia*, non-receipt of the Notice of Allowance because the Office mailed it to an incorrect address, to wit: 2027 Locust Street, rather than 2047 Locust Street..

Review of the transmittal of the instant application reveals, as Petitioner acknowledges, that Petitioner's office submitted the papers with the 2027 Locust Street address.

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

---

[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.

constitute the care required under Pratt,[6] 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]))

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.

The record (including the petition filed on 15 April, 2005) does not necessitate a finding that the delay between midnight 29 August, 2003 (date of abandonment), and 15 April, 2005 (date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Petitioners Palumbo and Ohl and their Counsel Joseph E. Chovanes (Reg. No. 33,481) when accepting Petitioners' representation that the delay in filing the response was unintentional.[8]

It appears that Petitioner has satisfied the requirements of the regulation.

CONCLUSION

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

The instant application is released to Publications Branch to be processed into a patent in due course.

---

[6] The test of diligence in the prosecution of an application before the Commissioner is, in the context of ordinary human affairs, the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

[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 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).

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

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

Please type a plus sign (+) inside this box → ⊞

PTO/SB/05 (11-00)

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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

UTILITY PATENT APPLICATION TRANSMITTAL

(Only for new nonprovisional applications under 37 CFR 1.53(b))

Attorney Docket No.	33-99 CIP
First Inventor	Charles E. PALUMBO, II
Title	LASER ALIGNMENT METHOD AND APPARATUS
Express Mail Label No.	EL875326731US

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents

ADDRESS TO: Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

1. [X] Fee Transmittal Form (e.g. PTO/SB/17)
   (Submit an original and a duplicate for fee processing)
2. [X] Applicant claims small entity status. See 37 CFR 1.27.
3. [X] Specification [*Total Pages* 17]
   (preferred arrangement set forth below)
   - Descriptive title of the invention
   - Cross Reference to Related Applications
   - Statement Regarding Fed sponsored R & D
   - Reference to sequence listing, a table, or a computer program listing appendix
   - Background of the Invention
   - Brief Description of the Drawings (*if filed*)
   - Detailed Description
   - Claim(s)
   - Abstract of the Disclosure
4. [X] Drawing(s) (35 U.S.C. 113) [*Total Pages* 14]
5. Oath or Declaration [*Total Pages*]
   a. [ ] Newly executed (original or copy)
   b. [ ] Copy from a prior application (37 CFR 1.63(d))
   (for continuation divisional with Box 18 completed)
   i. DELETION OF INVENTOR(S)
   ☐ Signed statement attached deleting inventor(s) named in the prior application (see 37 CFR) 1.63(d)(2) and 1.33(b)
6. [ ] Application Data Sheet. See 37 CFR 1.76
7. [ ] CD-ROM or CD-R in duplicate, large table or Computer Program (*Appendix*)
8. [ ] Nucleotide and/or Amino Acid Sequence Submission (*if applicable, all necessary*)
   a. [ ] Computer Readable Form (CRF)
   b. [ ] Specification Sequence Listing on:
   i. ☐ CD-ROM or CD-R (2 copies); or
   ii. ☐ paper
   c. [ ] Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

9. [ ] Assignment Papers (cover sheet & document(s))
10. [ ] 37 CFR 3.73(b) Statement (when there is an assignee) [ ] Power of Attorney
11. [ ] English Translation Document (*if applicable*)
12. [ ] Information Disclosure Statement (IDS)/PTO-1449 [ ] Copies of IDS Citations
13. [ ] Preliminary Amendment
14. [X] Return Receipt Postcard (MPEP 503) (*Should be specifically itemized*)
15. [ ] Certified Copy of Priority Document(s) (*if foreign priority is claimed*) Request and Certification under 35 U.S.C. 122 (b)(2)(B)(i).
16. [ ] Applicant must attach form PTO/SB/35 or its equivalent.
17. [ ] Other:

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

[ ] Continuation [ ] Divisional [X] Continuation-in-part (CIP) of prior application No.: 09/326,424

Prior application information: Examiner: R. Gibson Group Art Unit: 2859

For CONTINUATION OR DIVISIONAL APPS ONLY: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relief upon when a portion has been inadvertently omitted frm the submitted application parts.

19. CORRESPONDENCE ADDRESS

[ ] Customer Number or Bar Code Label (Insert Customer No. or Attach bar code label here) or [X] Correspondence address below

Name	Joseph E. Chovanes				
Address	2027 Locust Street				
City	Philadelphia	State	Pennsylvania	Zip Code	19103
Country	US				
Name (Print/Type)	Joseph E. Chovanes	Registration No. (Attorney/Agent)			33,481
Signature				Date	July 20, 2001

CERTIFICATION UNDER 37 CFR § 1.10

I hereby certify that this correspondence and the documents referred to as attached therein are being deposited with the U.S. Postal Service on 07/20/2001, in an envelope as "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 CFR § 1.10, Mailing Label Number EL875326405US addressed to the: Assistant Commissioner for Patents, Washington, DC 20231.

PTO/SB/17 (11-00)
Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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

FEE TRANSMITTAL for FY 2001

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT ($) 355

Complete if known	
Application Number	
Filing Date	
First Named Inventor	PALUMBO
Examiner Name	
Group Art Unit	
Attorney Docket No.	33-99 CIP

METHOD OF PAYMENT

1. [X] The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit Account: 50-0979

Deposit Account Name:

☒ 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	710	201	355	Utility filing fee	
106	320	206	160	Design filing fee	
107	490	207	245	Plant filing fee	
108	710	208	355	Reissue filing fee	
114	150	214	75	Provisional filing fee	
				SUBTOTAL (1)	$355

2. EXTRA CLAIMS FEES

			Extra Claims		Fee from below		Fee Paid
Total Claims	17	-20**	= 0	X	9	=	$
Independent Claims	2	-3**	= 0	X	18	=	$
Multiple Independent				+	135	=	$

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee Code	Fee Description
103	18	203	9	Claims in excess of 20
102	80	202	40	Independent claims in excess of 3
104	270	204	135	Multiple dependent claim, if not paid
109	80	209	40	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) $

**or number previously paid, if greater; For Reissue, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee Code	Fee Description	Fee Paid
105	130	205	65	Surcharge – late filing fee or oath	
127	50	227	25	Surcharge – late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for *ex parte* reexamination	
112	920*	112	920*	Requesting publication of SIR prior to Examiner action	
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for reply within first month	
116	390	216	195	Extension for reply within second month	
117	890	217	445	Extension for reply within third month	
118	1,390	218	695	Extension for reply within fourth month	
128	1,890	228	945	Extension for reply within fifth month	
119	310	219	155	Notice of Appeal	
120	310	220	155	Filing a brief in support of an appeal	
121	270	221	135	Request for oral hearing	
138	1,510	138	1,510	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive – unavoidable	
141	1,240	241	620	Petition to revive – unintentional	
142	1,240	242	620	Utility issue fee (or reissue)	
143	440	243	220	Design issue fee	
144	600	244	300	Plant issue fee	
122	130	122	130	Petition 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)	
146	710	246	355	Filing a submission after final rejection (37 CFR § 1.129(a))	
149	710	249	355	For each additional invention to be examined (37 CFR § 1.129(b))	
179	710	279	355	Request for Continued Examination (RCE)	
169	900	169	900	Request for expedited examination of a design application	
Other fee (specify):					

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) $

SUBMITTED BY CUSTOMER NO. Complete (if applicable)

Name (Print/Type)	Joseph E. Shovanes	Registration No. (Attorney/Agent)	33,481	Telephone	(215) 575-7000
Signature				Date	July 20, 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NOTICE OF ALLOWANCE AND FEE(S) DUE

7590 05/29/2003

Joseph E. Chovanes
2027 Locust Street
Philadelphia, PA 19103

EXAMINER
GIBSON, RANDY W

ART UNIT	PAPER NUMBER
2841	

DATE MAILED: 05/29/2003

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,382	07/20/2001	Charles E. Palumbo II	33-99 CIP	1730

TITLE OF INVENTION: LASER ALIGNMENT METHOD AND APPARATUS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	$650	$300	$950	08/29/2003

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PTOL-85 (Rev. 01/06) Approved for use through 04/30/2007.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail **Mail Stop ISSUE FEE**
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450
or Fax (571)-273-2885

INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

7590 05/29/2003

Joseph E. Chovanes
2027 Locust Street
Philadelphia, PA 19103

04/18/2005 EKOLI2 00000004 09909382
01 FC:2501 780.00 OP
02 FC:1504 380.00 OP

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)

(Signature)

(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,382	07/20/2001	Charles E. Palumbo II	33-99 CIP	1730

TITLE OF INVENTION: LASER ALIGNMENT METHOD AND APPARATUS

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	YES	$650	$300	$950	08/29/2003

EXAMINER	ART UNIT	CLASS-SUBCLASS
GIBSON, RANDY W	2841	033-286000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).
   - ☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
   - ☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required.

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

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

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

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

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are enclosed:
- ☐ Issue Fee
- ☐ Publication Fee (No small entity discount permitted)
- ☐ Advance Order - # of Copies _____

4b. Payment of Fee(s):
- ☐ A check in the amount of the fee(s) is enclosed.
- ☐ Payment by credit card. Form PTO-2038 is attached.
- ☐ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)
- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27.
- ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

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

Authorized Signature _____ Date _____

Typed or printed name _____ Registration No. _____

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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

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.
09/909,382	07/20/2001	Charles E. Palumbo II	33-99 CIP	1730

7590 05/29/2003

Joseph E. Chovanes
2027 Locust Street
Philadelphia, PA 19103

EXAMINER
GIBSON, RANDY W

ART UNIT	PAPER NUMBER
2841	

DATE MAILED: 05/29/2003

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b)
(application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 147 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 147 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

PTOL-85 (Rev. 01/06) Approved for use through 04/30/2007.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ROBERT A. PARSONS
4000 N. CENTRAL AVENUE, SUITE 1220
PHOENIX, AZ 85012

MAILED

SEP 28 2009

OFFICE OF PETITIONS

In re Application :
Akira Taguchi
Application No. 09/909,383 :
Filed: July 19, 2001 : LETTER
Attorney Docket No. 4196-A1JPUS :

This is in response to the paper filed July 15, 2009 which is being treated under 37 CFR 1.27(c) seeking status as a small entity.

The Verified Statement Claiming Small Entity Status of July 15, 2009 has been made of record and small entity status has been accorded.

Inquiries related to this communication should be directed to Irvin Dingle at (571) 272-3210.

Irvin Dingle
Petitions Examiner
Office of Petitions

#4
DW

UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 16 2003

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

MAILED

JUN 16 2003

OFFICE OF THE DIRECTOR
TC 3600

David & Raymond Patent Group
1050 Oakdale Lane
Arcadia, CA 91006

In re Application of
Hong-Jiun Gu et al.
Application No. 09/909,399
Filed: July 18, 2001
For: SAFETY DRIVING EQUIPMENT FOR SCOOTER

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is in reply to applicants petition to withdraw the holding of abandonment under 37 CFR 1.181, filed in the United States Patent and Trademark Office on January 29, 2003 and supplemented on June 12, 2003.

The petition is **GRANTED**.

A review of the file record indicates that an Office action was mailed to applicants on June 25, 2002. Since a timely response to the June 25, 2002 Office action has not been filed and the six month statutory period for reply has expired, the application is abandoned, although a Notice of abandonment has yet been mailed.

Any petition to withdraw the holding of abandonment based upon a Returned Post Card must include the following requirements:

(1) A copy of the response and

(2) A copy of the postcard identifying the response including a USPTO Mail Room receipt date.

The returned postcard included in the petition bears a USPTO Mail Room receipt date of July 15, 2002. However, the application number listed on the returned postcard does not correspond to that of the above-noted application. This is unacceptable evidence of a timely filed response.

However, the copy of the response included with the petition includes a Certificate of Mailing dated July 11, 2002. A statement by Raymond Y. Chan was received on June 12, 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 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 claims.

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868
Facsimile No.: (703) 605-0586

SNM/tpl: 6/13/03

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

APR - 2 2004

Paper No. 17

In re Application of
David H. Gracias *et al*
Application No. 09/909,420
Filed: July 19, 2001
Attorney Docket No. H0498.70151US00

DECISION ON PETITION

This is a decision on the petition filed on October 29, 2003 by which petitioners request that the final Office action mailed on September 29, 2003 be vacated, and that the amendment filed on October 21, 2003 be entered into the record. The petition is considered pursuant to 37 CFR 1.181, and no fee is required. A refund of the $130.00 petition fee tendered with the petition will be credit to Deposit Account No. 23-2825.

The petition is granted

A review of the record shows that on May 29, 2003, the examiner mailed an Office action in which the claims were treated on their merits. That Office action set a three month shortened statutory period for response. Within the Office action, the examiner set a two month shortened statutory period for response with respect to certain drawing objections. This was improper; an Office action cannot set two shortened statutory periods running for different lengths of time.

The record further shows that petitioners filed a reply to the May 29, 2003. The reply was filed on July 31, 2003 with a 37 CFR 1.8(a) certificate of mailing dated July 29, 2003. The reply was styled as "Partial Response to Office Action", and explained that it was a reply only to that portion of the outstanding Office action that had required a reply to be filed within two months. This reply was an attempt to comply with the examiner's erroneous setting of two running shortened statutory periods. The reply should have been treated as informal/nonresponsive, and should further have been held to be other than a *bona fide* attempt to reply to the outstanding Office action, because, on its face, it did not reply to all matters raised in the outstanding Office action. See 37 CFR 1.111 and 37 CFR 1.135(c), as well as MPEP § 710.01. The result would have been a letter informing petitioners of the informality, and indicating that the period for filing a complete response to the May 29, 2003 Office action continued to run as set therein, that is, three months from the date of the Office action.

The record additionally shows that the examiner accepted the July 32, 2003 response, and simply repeated the substance of the May 29, 2003 action, and made that action final. Thereafter, when petitioners filed an amendment and an extension of time on October 31, 2003 (with a 37 CFR 1.8(a) certificate of mail dated October 29, 2003), the examiner treated the response as a reply to a final rejection and refused to enter it.

It is clear that the examiner's actions in promulgating an Office action with two running shortened statutory periods was an error, as was the acceptance of an obviously incomplete reply to the Office letter. Petitioners were fully entitled to enjoy the full shortened statutory period of three months, plus any extensions of time to the full statutory limit of six months in accordance with 35 USC § 133 to reply to the May 29, 2003 Office action. In fact, accepting the examiner's erroneous action in setting both a two month and a three month shortened statutory period, petitioners were entitled to extend the two month period to the statutory myxoma. The examiner should not that this is the meaning of the language appearing in the penultimate sentence of paragraph 5 of paper No. 7.

In order to correct these errors, the final rejection dated May 29, 2003 is hereby vacated, as is the advisory action dated November 13, 2003. The amendment filed on October 31, 2003 will be entered as a matter of right pursuant to 37 CFR 1.111.

This application is being forwarded to the Head Supervisory Applications Examiner to refund the $130.00 petition fee by crediting $130.00 to Deposit Account No. 23-2825 and to have the amendment dated October 31, 2003 entered. Thereafter, the application will be forwarded to the Supervisory Patent Examiner in Art Unit 3729 who will ensure that the examiner takes action not inconsistent with this Decision.

PETITION GRANTED.

E. Rollins-Cross, Director
Technology Center 3700

Wolf Greenfield & Sacks, PC
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210-2211

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 16

GERARD F. DUNNE
156 FIFTH AVENUE
SUITE 1223
NEW YORK, NY 10010

COPY MAILED

JUN 17 2003

OFFICE OF PETITIONS

In re Application of :
Craig Novak et al :
Application No. 09/909,423 :
Filed: July 19, 2001 :
Attorney Docket No. 394-137 :

NOTICE

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989).** Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center AU 3632.

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. 14

FORD GLOBAL TECHNOLOGIES, LLC.
SUITE 600 - PARKLANE TOWERS
EAST
ONE PARKLANE BLVD.
DEARBORN, MI 48126

COPY MAILED

MAY 0 6 2003

OFFICE OF PETITIONS

In re Application of :
Michael Choi :
Application No. 09/909,430 : DECISION ON PETITION
Filed: July 19, 2001 :
Attorney Docket Number: :
FMC 1305 R :

This is a decision on the Petition under 37 CFR 1.183, filed September 18, 2002, requesting waiver of 37 CFR 1.78(a)(3).

This Petition is hereby **dismissed as moot**.

A petition under 37 CFR 1.78(a)(3) is only applicable to nonprovisional applications filed under 35 U.S.C. §111(a)[1]. The instant application is a reissue application under 35 U.S.C. §251; therefore, 37 CFR 1.78(a)(3) is inapplicable.

In view of the above, a refund of the petition fee has been credited to Petitioner's Deposit Account.

The application is being returned to Technology Center AU 3742 to await a response to the non-final Office action, mailed March 11, 2003.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Derek L. Woods at (703) 305-0014.

Beverly M. Flanagan
Supervisory Petitions Examiner
Office of Petitions

---

[1]*See, Changes to Patent Practice and Procedure; Final Rule Notice*, 66 Fed. Reg. 67,087, 67,088 (December 28, 2001)

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALLEMAN HALL MCCOY RUSSELL & TUTTLE LLP
806 SW BROADWAY
SUITE 600
PORTLAND, OR 97205-3335

COPY MAILED
APR 25 2006
OFFICE OF PETITIONS

In re Application of	:	
Michael Choi	:	
Application No. 09/909,430	:	DECISION ON PETITION
Filed: July 19, 2001	:	
Attorney Docket No. FMC 1305 R	:	

This is a decision on the "Petition to Withdraw Holding of Abandonment (37 CFR 1.181) and, in the Alternative Petition to Revive Unintentionally Abandoned Application (37 CFR 1.137)," filed January 18, 2006.

On January 26, 2004, the Office mailed an Office Action indicating that the amendment filed on August 11, 2003, did not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. The Office Action set a shortened statutory period of ONE (1) MONTH or THIRTY (30) DAYS, whichever was longer, for applicant to submit a supplemental paper correctly amending the reissue. In the absence of timely reply, the application became abandoned on February 27, 2004. On January 12, 2006, the Office mailed a Notice of Abandonment.

In the present petition, the practitioner explained that on January 26, 2004, he was the attorney responsible for this application and was employed by Kolisch Hartwell. The practitioner asserted that neither he nor Kolisch Hartwell ever received the Office Action of January 26, 2004, as evidenced by the attached docket records from Kolisch Hartwell (Attachment A, showing all replies docketed from the alleged mail date of the Office Action). The practitioner stated that he performed a search of the attached docket records and the file jacket where the non-received Office Action would have been entered had it been received and docketed.

A review of the record indicates no irregularity in the mailing of the Office Action, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office Action was properly mailed to the address of record. This presumption may be overcome by a showing that the Office Action was not in fact received. To establish non-receipt of an Office communication, applicant 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.[1] For example, if a three-month period for reply was set in the non-received Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the non-received Office action must be submitted as documentary proof of non-receipt 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).

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 the applicant submitted a copy of docket report from Kolisch Hartwell where the Office Action 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 report indicated that the Office Action was not received. As applicant has presented the required showing, the petition to withdraw the holding of abandonment is **granted**. The application will be restored to pending status.

In view of the above, the petition to revive under 37 CFR 1.137(b) is **dismissed as moot**. The $1,500.00 petition fee will be credited to the Deposit Account, as it is unnecessary.

This matter is being referred to Technology Center Art Unit 3747 for action consistent with this decision.

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

[1] M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALLEMAN HALL MCCOY RUSSELL & TUTTLE LLP
806 SW BROADWAY
SUITE 600
PORTLAND, OR 97205-3335

COPY MAILED
APR 26 2006
OFFICE OF PETITIONS

COPY MAILED
APR 25 2006
OFFICE OF PETITIONS

In re Application of
Michael Choi
Application No. 09/909,430
Filed: July 19, 2001
Attorney Docket No. FMC 1305 R

DECISION ON PETITION

This is a decision on the "Petition to Withdraw Holding of Abandonment (37 CFR 1.181) and, in the Alternative Petition to Revive Unintentionally Abandoned Application (37 CFR 1.137)," filed January 18, 2006.

On January 26, 2004, the Office mailed an Office Action indicating that the amendment filed on August 11, 2003, did not comply with 37 CFR 1.173(b), which sets forth the manner of making amendments in reissue applications. The Office Action set a shortened statutory period of ONE (1) MONTH or THIRTY (30) DAYS, whichever was longer, for applicant to submit a supplemental paper correctly amending the reissue. In the absence of timely reply, the application became abandoned on February 27, 2004. On January 12, 2006, the Office mailed a Notice of Abandonment.

In the present petition, the practitioner explained that on January 26, 2004, he was the attorney responsible for this application and was employed by Kolisch Hartwell. The practitioner asserted that neither he nor Kolisch Hartwell ever received the Office Action of January 26, 2004, as evidenced by the attached docket records from Kolisch Hartwell (Attachment A, showing all replies docketed from the alleged mail date of the Office Action). The practitioner stated that he performed a search of the attached docket records and the file jacket where the non-received Office Action would have been entered had it been received and docketed.

A review of the record indicates no irregularity in the mailing of the Office Action, and in the absence of any irregularity in the mailing, there is a strong presumption that the Office Action was properly mailed to the address of record. This presumption may be overcome by a showing that the Office Action was not in fact received. To establish non-receipt of an Office communication, applicant 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.[1] For example, if a three-month period for reply was set in the non-received Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the non-received Office action must be submitted as documentary proof of non-receipt 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).

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 the applicant submitted a copy of docket report from Kolisch Hartwell where the Office Action 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 report indicated that the Office Action was not received. As applicant has presented the required showing, the petition to withdraw the holding of abandonment is **granted**. The application will be restored to pending status.

In view of the above, the petition to revive under 37 CFR 1.137(b) is **dismissed as moot**. The $1,500.00 petition fee will be credited to the Deposit Account, as it is unnecessary.

This matter is being referred to Technology Center Art Unit 3747 for action consistent with this decision.

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

[1] M.P.E.P. § 711.03(c); See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

SPE: P. Achutamurthy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 5/14/07

TO SPE OF : ART UNIT 1652

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/909,474 Patent No.: 6881542

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: The amendment to The Specification Can be entered (approved) but amendment to The Claim should not be entered (denied) because The claim will be indefinite for lack of antecedent basis

[signature] 1652

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, D.C. 20231
WWW.USPTO.GOV

JUL 29 2002

UR
PAPER NO.7

In re Application of	:	
Willard K. McClintock et al.	:	DECISION
Serial No. 09/909,487	:	ON
Filed: July 20, 2001	:	PETITION
For: STEEL MAKING MATERIAL RECYCLING	:	
SYSTEM	:	UNDER 708.02, V

This is in response to the petition filed July 20, 2001, requesting that the above-identified application be granted Special Status under Sections 708.02 (V) of the MPEP and 37 CFR 1.102(c).

The petition has been considered and found to comply with the requirements set forth under the above-noted section. Accordingly the petition is **GRANTED.**

It is noted that Mr. McClintock is the first named inventor in the Declaration and is so referenced in the heading of this letter, even though previous correspondence listed Mr. Scott Kimmel as the first named inventor.

Richard V. Fisher

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

Todd W. Minor
P.O. BOX 157
Glencoe, KY 41046

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FOLEY & LARDNER
777 EAST WISCONSIN AVENUE
SUITE 3800
MILWAUKEE, WI 53202-5308

COPY MAILED
OCT 18 2004
OFFICE OF PETITIONS

In re Application of
Peter Bauerlein
Application No. 09/909,497
Filed: July 20, 2001
Attorney Docket No. 1201-01

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 1, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed October 3, 2003, which set a shortened statutory period for reply of three (3) months. A three-month extension of time under the provisions of 37 CFR 1.136(a) was obtained. An Advisory action was mailed April 6, 2004 indicating that the reply filed on March 10, 2004 failed to place the application in condition for allowance. Accordingly, the application became abandoned on April 4, 2004.

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 1745 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions
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. 19

Gilson Woo
19708 Balan Road
Rowland Heights, CA 91748

COPY MAILED

JAN 1 2 2004

OFFICE OF PETITIONS

In re Application of	:	
Gilson Woo	:	
Application No. 09/909,505	:	ON PETITION
Filed: July 20, 2001	:	
Attorney Docket No. n/a	:	

This is a decision on the petition filed December 19, 2003, which is being treated solely as a petition under 37 CFR 1.137(b), to revive the above-identified application.

The petition is granted.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed May 8, 2003, which set a shortened statutory period for reply of three (3) months. An Amendment and a three-month extension of time was filed on November 15, 2003, after expiration of the statutory period for reply. As no amendment prima facie placing the application in condition for allowance or Notice of Appeal (and appeal fee) was timely filed, the above-identified application became abandoned on August 8, 2003.

The application file is being forwarded to Technology Center AU 3736 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

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

Latrice Bond

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

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

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

COPY MAILED

MAR 1 2 2002

OFFICE OF PETITIONS

In re Application of	:	
Sheng Li	:	DECISION GRANTING
Application No. 09/909,542	:	PETITION
Filed: July 19, 2001	:	
Attorney Docket No. 3442P015	:	

This is a decision on the petition under 37 CFR 1.10(d) filed February 25, 2002, requesting that the above-identified application be accorded a filing date of July 19, 2001, rather than the presently accorded filing date of July 17, 2001.

Petitioner requests the later filing date on the basis that the application was purportedly deposited with the U.S. Postal Service (USPS) as Express Mail on July 19, 2001, pursuant to the requirements of 37 CFR 1.10. In support, petitioner provided, inter alia, a copy of the Express Mail label, receipt no. EL837201912US. The same Express Mail receipt number appears on the copy of the original transmittal letter submitted with the present petition. It is noted that while the Express Mail receipt shows a handwritten "date-in" of July 17, 2001, it also includes an official USPS notation in the form of a "San Diego CA USPS" receipt stamp dated July 19, 2001.

In view of the above, the evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on July 19, 2001.

The petition is granted. A copy of the corrected Filing Receipt is enclosed.

The application is being returned to Technology Center AU 2663 for examination in due course.

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

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

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

Paper No. 6

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE NC 28280-4000

COPY MAILED

APR 05 2002

OFFICE OF PETITIONS

In re Application of: Richard O. Schuler, Lynn Godbersen, James Norwood, Joseph Young, William Fleck, David Lind, Kevin DeHaan, Thomas Nicholson and Marcell J. Sarzen Application No. 09/909,587 Filed: July 20, 2001 Title of Invention: SYSTEMS AND METHODS FOR INTERACTIVE BEEF CATTLE MARKETPLACE	DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is in response to a Petition Under 37 C.F.R. 1.47(a), filed January 9, 2002, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor.

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.

Petitioner has shown that the non-signing inventor, Lynn Godbersen, refuses to sign the declaration after being presented with the above-identified application and declaration.

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

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

E. Shuree Willis for

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Lynn Godbersen
2431 Saint Charles Road
Winterset, IA 50273

In re Application of:
Richard O. Schuler, Lynn Godbersen,
James Norwood, Joseph Young,
William Fleck, David Lind,
Kevin DeHaan, Thomas Nicholson and
Marcell J. Sarzen
Application No. 09/909,587
Filed: July 20, 2001
Title of Invention: SYSTEMS AND METHODS FOR INTERACTIVE BEEF CATTLE MARKETPLACE

LETTER

COPY MAILED

APR 05 2002

OFFICE OF PETITIONS

Dear Mr. Godbersen:

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 Derek L. Woods at (703) 305-0014. 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).

E. Anne Wells for

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

Mail Date: 04/21/2010

Applicant	: Richard O. Shuler	: DECISION ON REQUEST FOR
Patent Number	: 7584136	: RECALCULATION of PATENT
Issue Date	: 09/01/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/909,587	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/20/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2910** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Todd S. Parkhurst
Holland & Knight LLP
131 S. Dearborn Street
30th Floor
Chicago, IL 60603

COPY MAILED

NOV 22 2005

OFFICE OF PETITIONS

In re Application of
Yakov Kamen
Application No. 09/909,630
Filed: July 19, 2001
Attorney Docket No. ISURFTV146

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed November 9, 2005, which is being treated as a petition to withdraw the holding of abandonment for the above-identified application.

This application was held abandoned for failure to respond timely to the nonfinal Office Action mailed on July 19, 2004, which set a three-month shortened statutory 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 September 25, 2005.

In the present petition, petitioner states that on January 24, 2005 (certificate of mailing dated January 19, 2005), petitioner submitted a reply in the form of an amendment, a request for an extension of time for response within the third month, and a check in the amount of $1,020.00 for the extension of time fee. Accompanying the petition is a copy of a Transmittal Form, bearing a certificate of mailing dated January 19, 2005, a "Petition For Extension Of Time Under 37 CFR 1.136(a)," Amendment B, and a copy of the return, itemized postcard receipt bearing an OIPE date stamp of January 24, 2005.

Pursuant to 37 CFR 1.8:

> (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the 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 Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

After reviewing the record and the papers submitted on petition, the response is considered timely filed on January 19, 2005. Accordingly, the petition is **granted**. The Notice of Abandonment is hereby withdrawn.[1] The application is restored to pending status in view of the fact that a response was timely submitted on January 19, 2005.

The matter is being referred to the Technology Center Art Unit 2676.

Telephone inquiries concerning this matter may be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

[1] The Transaction History in the Image File Wrapper Database indicates that the Office, *sua sponte*, withdrew the holding of abandonment and mailed petitioner a Notice of Rescinded Abandonment on October 21, 2005. Unfortunately, a copy of the Notice has not been located in the Database. Nevertheless, the holding of abandonment is hereby withdrawn by this decision and the application is restored to pending status.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ERNEST D. BUFF
ERNEST D. BUFF AND ASSOCIATES
231 SOMERVILLE ROAD
BEDMINSTER NJ 07921

COPY MAILED

AUG 31 2005

OFFICE OF PETITIONS

In re Application of	:
Andrew S. Kanter	:
Application No. 09/909,643	: DECISION GRANTING PETITION
Filed: July 20, 2001	: UNDER 37 CFR 1.137(b)
Attorney Docket No.0010-3	:

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

The petition is **GRANTED**.

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

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an RCE and previously filed amendment; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of December 10, 2004, is accepted as having been unintentionally delayed.

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

This matter is being referred to Technology Center AU 3622.

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

Ernest D. Buff
Ernest D. Buff & Associates, LLC
245 South Street
Morristown, NJ 07960

MAILED

JAN 08 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

In re application of
Andrew S. Kanter
Application No. 09/909,644
Filed: July 20, 2001
For: INTERNET ADVERTISING

DECISION ON PETITION TO MAKE SPECIAL (ACCELERATED EXAMINATION)

This is in response to the petition filed on September 22, 2003 to make the above-identified application special on the basis of special examining procedure for certain new applications - accelerated examination as set forth in MPEP § 708.02 VIII. The delay in deciding this petition is regretted.

The requirements for granting special status under this section are: (A) a petition to make special accompanied by the fee set forth in 37 CFR 1.17(i); (B) all claims being directed to a single invention, or an election without traverse if the Office determines that all the claims are not directed to a single invention; (C) a statement that a pre-examination search was made listing the field of search; (D) one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and (E) a detailed discussion of how the claimed subject matter is patentable over the references in accordance with 37 CFR 1.111 (b) and (c).

Since all of the requirements for special status under MPEP § 708.02 VIII have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

SUMMARY: Petition to Make Special **GRANTED**.

Randolph A. Reese

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703) 308-2121

RAR/cps 1/5/04

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED
JUL 3 1 2006
OFFICE OF PETITIONS

SCHWEGMAN LUNDBERG WOESSNER & KLUTH, P.A.
P.O. BOX 2938
MINNEAPOLIS, MN 55402

In re Application of	:	
James Anthony Smith et al	:	
Application No. 09/909,669	:	DECISION ON PETITION
Filed: July 20, 2001	:	TO WITHDRAW
Attorney Docket No. 1423.001US1	:	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 28, 2006.

The request is **NOT APPROVED**.

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

The Office cannot approve the request at this time since the reasons provided do not meet any of the conditions under the mandatory or permissive categories enumerated in 37 CFR 10.40. Section 10.40 of Title 37 of the Code of Federal Regulation states, "[a] practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office[.]" More specifically, 37 CFR 10.40 states, "[i]f paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matter pending before the Office unless such request or such withdrawal is" for one the permissive reasons listed in 37 CFR 10.40(c). The reasons set forth in the request, discontinuation of attorney/client relationship, do not appear to 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 Irvin Dingle at 571-272-3210.

David Bucci
Petitions Examiner
Office of Petitions

cc: Doug Bonestroo
11181 Bluestem Lane
Eden Prairle, MN 55347

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 3

Peter M. Ulman
Woodcock Washburn Kurtz
Mackiewicz & Norris LLP
One Liberty Place--46th Floor
Philadelphia, Pennsylvania 19103

COPY MAILED

AUG 2 9 2001

OFFICE OF PETITIONS

In re Application of :
Yoram Yaacovi :
Application No. 09/909,673 : DECISION GRANTING PETITION
Filed: July 20, 2001 :
Attorney Docket No. :

This is a decision on petition under 37 CFR 1.10(c) filed August 15, 2001, requesting that the above-identified application be accorded a filing date of July 20, 2001, rather than the presently accorded filing date of July 19, 2001.

Petitioner alleges that the application was deposited in Express mail service on July 20, 2001. In support, the petition is accompanied by a copy of Express Mail receipt No. EL650276013US (the same Express mail number found on the original application papers located on the official file) showing a "date in" of July 20, 2001.

In view of the above, the petition is **GRANTED**.

The petition fee of $130.00 will be credited to deposit account 23-3050, in due course, because the circumstances necessitating the filing of the petition were the result of an Office error.

The application file will be returned to the Initial Patent Examination Division for correction of the filing date to July 20, 2001.

Any inquiries related to this decision should be directed to Kenya A. McLaughlin, Petitions Attorney, at (703)305-0010

Christina L. Tartera for

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Philmore H. Colburn II
Cantor Colburn LLP
55 Griffin Road South
Bloomfield, CT 06002

COPY MAILED
JUN 30 2006
OFFICE OF PETITIONS

In re Application of :
Ayala et al. :
Application No. 09/909,686 :
Filed: July 20, 2001 : ON PETITION
Title of Invention: :
METHOD FOR DYNAMICALLY :
EVALUATING PROJECTED DAYS OF :
SUPPLY OF INVENTORY LEVELS IN :
A SUPPLY CHAIN :

This is a decision on the Petition to Withdraw Holding of Abandonment under 37 C.F.R. 1.181 (no fee), filed June 13, 2006. The delay in treating this petition is regretted.

The petition is **granted.**

Background

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed October 6, 2005. The Office action set a shortened statutory reply period of three (3) months, and provided for extensions of time under 37 CFR 1.136(a). No reply having been received, the application became abandoned January 7, 2006. A Notice of Abandonment was mailed June 2, 2006.

The instant Petition

Applicant files the instant petition wherein Applicant avers that a timely response to the Office action was filed. In support of this assertion, Applicant files a copy of the response and asserts that the copy includes, in relevant part, a certificate of transmission by facsimile; an Auto-Reply receipt with a date of February 6, 2006, and a petition for extension of time.

A review of the copy of the response to the Office action reveals that it included a Certificate Transmission by Facsimile dated February 6, 2006, executed by Sandy Yopp; however, no statement from Sandy Yopp has been included with the instant petition. See 37 CFR 1.8(b).

Applicant also includes a copy of an Auto-Reply Facsimile Transmission acknowledging receipt of 15 pages by this Office on February 6, 2006, which includes a copy of the Certificate Transmission by Facsimile dated February 6, 2006, executed by Sandy Yopp.

In view of the foregoing, the holding of abandonment is hereby withdrawn.

The copy of the Amendment in response to the Office action, re-filed with the instant petition, will be used for examination purposes.

No petition fee has been charged and none is due. The one (1) month extension of time fee has been charged to Applicant's deposit account.

The application file is being referred to Technology Center Art Unit 3627 for continued processing in due course.

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

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

OFFICE OF DATA MANAGEMENT

HICKMAN PALERMO TRUONG & BECKER, LLP
2055 GATEWAY PLACE
SUITE 550
SAN JOSE CA 95110

NOV 13 2008

In re Application of	:	
SWILDENS, ERIC SVEN-JOHAN et al.	:	**DECISION ON PETITION**
Application No. 09/909,711	:	
Filed: July 19, 2001	:	
Attorney Docket No. 60095-0024	:	

This is a decision on the Petition To Withdraw Holding Of Notice Of Abandonment received in the United States Patent and Trademark Office (USPTO) on March 18, 2008.

The petition is **GRANTED**.

The application was held abandoned for failure to timely pay the issue fee as required by the Notice of Allowance and Fee(s) Due, mailed October 4, 2008, which set forth a three (3) month statutory period for reply. Accordingly, the Notice of Abandonment was mailed on January 28, 2008.

Petitioner states that the Applicants responded by timely paying the Issue Fee on January 3, 2008.

In view of the foregoing, the holding of abandonment for failure to timely pay the issue fee is hereby withdrawn and the application restored to pending status.

Telephone inquires concerning this decision be directed to the undersigned at 703-305-9250 x 175.

Kay D. Pinkney
Application Assistance Unit
Office of Data Management

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 7-22-04

Paper No. 15

TO SPE OF : ART UNIT 3700

SUBJECT : Request for Certificate of Correction on Patent No.: 6682505

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 Drawings

Thank You For Your Assistance

Certificates of Correction Branch

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

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

Comments:

Primary Examiner

SPE Art 3763

3763 Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark O

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FINNEGAN HENDERSON FARABOW
GARRETT & DUNNER LLP
901 NEW YORK AVE NW
WASHINGTON DC 20001-4413

COPY MAILED

FEB 22 2006

OFFICE OF PETITIONS

In re	:
Pecquet, et al.	: DECISION ON APPLICATION
Application No. 09/909,797	: FOR PATENT TERM ADJUSTMENT
Filed: July 23, 2001	: AND
Patent No. 6,969,705 B2	: NOTICE OF INTENT TO ISSUE
Issued: November 29, 2005	: CERTIFICATE OF CORRECTION

This decision is in response to the "REQUEST FOR RECALCULATION OF PATENT TERM ADJUSTMENT", filed January 30, 2006, notifying the Office of an error in Patentees' favor in the determination of patent term adjustment under 35 U.S.C. § 154(b).

The request for correction of the initial determination of patent term adjustment (PTA) is **GRANTED** to the extent indicated herein.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **zero (0)** days.

On November 29, 2005, the above-identified application matured into U.S. Patent No. 6,969,705 B2. The patent issued with a Patent Term Adjustment of ninety-three (93) days.

The Office determined a patent term adjustment of ninety-three days based on an adjustment for PTO delay of three days pursuant to 35 U.S.C. 154(b)(1)(C)(ii) and 37 C.F.R. §1.703(a)(3), one hundred twenty days pursuant to 35 U.S.C. 154(b)(1)(A)(iv) and 37 C.F.R. § 1.703(a)(6), and one hundred thirteen days pursuant to 35 U.S.C. 154(b)(1)(B)(iii) and 37 C.F.R. § 1.703(b), reduced by applicants' delays of fifty-one days and ninety-two days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b).

A review of the application reveals that applicants also should have been assessed additional delay pursuant to 37 C.F.R. 1.704(b) on two separate occasions. The Office mailed a Notice to File Missing Parts on September 6, 2001. Applicants did not file a reply until January 15, 2002. Accordingly, forty (40) days of applicant delay should have been assessed. In addition, applicants should have been assessed delay of ninety-one (91) days for filing an RCE on November 16, 2004, in response to a final Office action mailed on May 17, 2004.

Accordingly, issuance of a certificate of correction pursuant to 35 U.S.C. 254 and 37 CFR § 1.322 is appropriate. No petition fee was required and none has been charged. The Office thanks Patentees for their good faith and candor in bringing this matter to the attention of the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. § 254 and 37 CFR 1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **zero (0)** days subject to any disclaimers.

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

Kery Fries

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

Enclosure: Copy of Draft Certificate of Correction (1 page)

Day : Tuesday
Date: 2/21/2006

PALM INTRANET

Time: 13:44:06

PTA Calculations for Application: 09/909797			
Application Filing Date:	07/23/2001	PTO Delay (PTO):	236
Issue Date of Patent:	11/29/2005	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	143
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-93		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
66	02/21/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		93	
62.5	11/09/2005	PTA 36 MONTHS	113		
62	11/29/2005	PATENT ISSUE DATE USED IN PTA CALCULATION	120		57
61	11/02/2005	RECEIPT INTO PUBS			
60	11/02/2005	DISPATCH TO FDC			
59	11/02/2005	APPLICATION IS CONSIDERED READY FOR ISSUE			
58	11/02/2005	WORKFLOW - REQUEST FOR RCE - FINISH			
57	04/01/2005	ISSUE FEE PAYMENT VERIFIED			
56	10/24/2005	RECEIPT INTO PUBS			
55	09/26/2005	TC RETURN TO PUBS			
54	09/13/2005	WORKFLOW - QUERY REQUEST - FINISH			
53	09/06/2005	PUBS CASE REMAND TO TC			
52	07/13/2005	WORKFLOW - QUERY REQUEST - BEGIN			
51	06/27/2005	WORKFLOW - QUERY REQUEST - FINISH			
50	04/08/2005	CORRESPONDENCE ADDRESS CHANGE			
49	04/01/2005	ISSUE FEE PAYMENT RECEIVED			
48	04/01/2005	WORKFLOW - QUERY REQUEST - BEGIN			
47	02/08/2005	RECEIPT INTO PUBS			
46	01/12/2005	EXPORT TO INITIAL DATA CAPTURE			
45	01/20/2005	WORKFLOW - FILE SENT TO CONTRACTOR			
44	01/21/2005	MAIL MISCELLANEOUS COMMUNICATION TO APPLICANT			
43	01/19/2005	MISCELLANEOUS COMMUNICATION TO APPLICANT - NO ACTION COUNT			
42	01/05/2005	MAIL NOTICE OF ALLOWANCE			

41	01/05/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
40	12/27/2004	NOTICE OF ALLOWABILITY			
39	11/16/2004	WORKFLOW - REQUEST FOR RCE - BEGIN			
38	11/22/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
37	11/16/2004	REFERENCE CAPTURE ON IDS			
36	11/16/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
35	11/22/2004	DATE FORWARDED TO EXAMINER			
34	11/16/2004	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
33	11/22/2004	DATE FORWARDED TO EXAMINER			
32	11/16/2004	REQUEST FOR CONTINUED EXAMINATION (RCE)			
31	11/22/2004	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
30	05/17/2004	MAIL FINAL REJECTION (PTOL - 326)	3		26
29	05/14/2004	FINAL REJECTION			
28	02/11/2004	IFW AMENDED CASE PROCESSING COMPLETE			
27	02/11/2004	DATE FORWARDED TO EXAMINER			
26	01/14/2004	RESPONSE AFTER NON-FINAL ACTION		92	24
25	01/14/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
24	07/14/2003	MAIL NON-FINAL REJECTION			
23	07/14/2003	NON-FINAL REJECTION			
22	06/19/2003	DATE FORWARDED TO EXAMINER			
21	06/11/2003	AMENDMENT AFTER FINAL REJECTION			
20	03/11/2003	MAIL FINAL REJECTION (PTOL - 326)			
19	03/10/2003	FINAL REJECTION			
18	01/06/2003	DATE FORWARDED TO EXAMINER			
17	12/20/2002	RESPONSE AFTER NON-FINAL ACTION		51	15
16	12/20/2002	REQUEST FOR EXTENSION OF TIME - GRANTED			
15	07/30/2002	MAIL NON-FINAL REJECTION			
14	07/29/2002	NON-FINAL REJECTION			
13	06/12/2002	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
12	06/12/2002	CASE DOCKETED TO EXAMINER IN GAU			
		REQUEST FOR FOREIGN PRIORITY (PRIORITY			

11	12/20/2001	PAPERS MAY BE INCLUDED)			
10	12/20/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	01/15/2002	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)			
8	01/31/2002	APPLICATION DISPATCHED FROM OIPE			
7	01/30/2002	APPLICATION IS NOW COMPLETE			
5	09/06/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
4	09/05/2001	CORRESPONDENCE ADDRESS CHANGE			
3	09/05/2001	CORRESPONDENCE ADDRESS CHANGE			
2	07/31/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/23/2001	INITIAL EXAM TEAM NN			

Search Another: Application# Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back use Back button on your browser toolbar.

Back to PALM | ASSIGNMENT | OASIS | Home page

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 6,969,705 B2

DATED : November, 2005

INVENTOR(S) : Pecquet, 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 (93) days

Delete the phrase "by 93 days" and insert – by 0 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

MAIL

NOV 1 0 2005

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

LEE & MORSE, P.C.
1101 WILSON BOULEVARD
SUITE 2000
ARLINGTON, VA 22209

In re Application of
Sung-Jin Kim et al.
Application No. 09/909,858
Filed: July 23, 2001
For: TRANSMISSION ANTENNA DIVERSITY METHOD, AND BASE STATION APPARATUS AND MOBILE STATION APPARATUS THEREFOR IN MOBILE COMMUNICATION SYSTEM

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the Petition for Withdrawal of Abandonment pursuant to MPEP §711.03(c)(II) and 37 C.F.R. § 1.181(a), filed October 13, 2005. No fee is required.

This application was held as abandoned for failure to timely respond to the non-final Office action mailed on January 5, 2005. A Notice of Abandonment was mailed October 4, 2005.

Petitioner alleges that the non-final Office action was not received.

A review of the application reveals that Applicant's copy of the Office action had been returned to the Office as not deliverable as addressed, unable to forward, return to sender.

Accordingly, it is evident that Applicants did not receive a copy of the non-final Office action. Given the apparent change of address, this petition is being granted under 37 C.F.R. § 1.181(a) given the evidence of the returned action having been matched with the application.

Applicant is reminded of the obligation to ***promptly*** inform the Office for all future changes of correspondence address.

The petition is **GRANTED.** The Notice of Abandonment is vacated and the holding of abandonment is withdrawn.

The application file is being forwarded to the TC2600's Technical Support Staff for remailing of the Office action.

Doris To
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

SEP 1 4 2004

Director's Office
Group 3700

Paper No. 32

In re Application of
Paul E. Dresens *et al*
Application No. 09/909,863
Filed: July 20, 2001
Attorney Docket No. 0100.2016-00

DECISION ON PETITION

This is a decision on the petition filed by facsimile transmission on May 29, 2003 by which petitioners request withdrawal of the technical state of abandonment that exists as a result of the failure to file a reply to the Office letter dated October 8, 2002. A Notice of Abandonment has not been mailed. The petition is considered pursuant to 37 CFR 1.181, and no fee is required.

The petition is granted.

Petitioners allege that this application is not abandoned because petitioners did not receive the Office letter in question. In support of this allegation, petitioners have made a showing as discussed at MPEP § 711.03(c). The showing has been reviewed and it clearly satisfies the requirements of the Notice published at 1156 OG 53 pertaining to abandonment resulting from nonreceipt of Office correspondence. Based upon the showing, it is clear this application is not technically abandoned. It is also noted that the originally mailed Notice of Allowance was returned to the Office by a firm not of record in this application.

Accordingly, this application is being forwarded to the Head Supervisory Applications Examiner for Technology Center 3700 to re-mail the office letter dated October 8, 2002, together with a complete all attachments thereto. The period for filing a reply to the re-mailed Office letter will run THREE MONTHS from the date upon which the new Notice of Allowance is mailed, and may be extended pursuant to 37 CFR 1.136(a).

PETITION GRANTED

Richard A. Bertsch

Richard A. Bertsch, Director
Technology Center 3700

Hamilton, Brook, Smith & Reynolds, P.C.
530 Virginia Road
P.O. Box 9133
Concord, Ma 01742-9133

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112

COPY MAILED

FEB 22 2006

OFFICE OF PETITIONS

In re Patent No. 6,963,430 B2	:	DECISION ON
Noriaki Matsui	:	PATENT TERM ADJUSTMENT
Issue Date: November 8, 2005	:	AND NOTICE OF INTENT
Application No. 09/909,877	:	TO ISSUE
Filed: June 23, 2001	:	CERTIFICATE OF
Attorney Docket No. 03500.015590	:	CORRECTION

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)", filed January 9, 2006. Patentee requests that the patent term adjustment indicated on the patent be corrected from seven hundred eighty-seven (787) days to eight hundred seventy-eight (878) 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 **eight hundred seventy-eight (878)** days.

On November 8, 2005, the above-identified application matured into U.S. Patent No. 6,963,430 B2. The instant request for reconsideration filed January 9, 2006 was timely filed within two months of the date the patent issued. See §1.705(d). See also §1.7(a). The Patent issued with a Patent Term Adjustment of seven hundred eighty-seven (787) days.

Patentee states that the patent is not subject to a terminal disclaimer.

Patentee asserts that he should not have been assessed applicant delay of ninety-one (91) days for the submission of a "LETTER" on August 10, 2005, after the Notice of Allowance was mailed on July 15, 2005.

A review of the record reveals that the "LETTER" is in actuality a response to the examiner's reasons for allowance, the filing of which has been deemed by the Director to not constitute a failure to engage in reasonable efforts under 37 C.F.R. §1.704(c)(10).[1] Accordingly, the assessment of ninety-one (91) days of applicant delay with respect to this filing is not warranted.

In view thereof, the correct determination of PTA at the time of issuance is eight hundred seventy-eight (878) days (878 days of PTO delay and 0 days of applicant delay).

Receipt of the $200.00 fee set forth in 37 C.F.R. §1.18(e) is acknowledged.

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 **eight hundred seventy-eight (878)** days subject to any disclaimers.

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

Enc: draft certificate of correction

---

[1] See Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. 111 (June 26, 2001).

Day : Tuesday
Date: 2/21/2006

PALM INTRANET

Time: 18:44:02

PTA Calculations for Application: 09/909877			
Application Filing Date:	07/23/2001	PTO Delay (PTO):	878
Issue Date of Patent:	11/08/2005	Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	91
Post-Issue Petitions:	0	Total PTA (days):	878
PTO Delay Adjustment:	91		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
48	02/21/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	91		
44.5	10/19/2005	PTA 36 MONTHS			
44	11/08/2005	PATENT ISSUE DATE USED IN PTA CALCULATION			
43	09/15/2005	RECEIPT INTO PUBS			
42	09/14/2005	DISPATCH TO FDC			
41	09/14/2005	APPLICATION IS CONSIDERED READY FOR ISSUE			
40	08/10/2005	ISSUE FEE PAYMENT VERIFIED			
39	09/13/2005	TC RETURN TO PUBS			
38	08/10/2005	MISCELLANEOUS INCOMING LETTER		91	
37	08/10/2005	ISSUE FEE PAYMENT RECEIVED			
36	07/20/2005	EXPORT TO INITIAL DATA CAPTURE			
35	07/20/2005	RECEIPT INTO PUBS			
34	07/15/2005	MAIL NOTICE OF ALLOWANCE	57		25
33	07/13/2005	ISSUE REVISION COMPLETED			
32	07/13/2005	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
31	07/13/2005	CASE DOCKETED TO EXAMINER IN GAU			
30	07/11/2005	NOTICE OF ALLOWABILITY			
29	01/19/2005	REFERENCE CAPTURE ON IDS			
28	04/26/2005	DATE FORWARDED TO EXAMINER			
27	03/16/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
26	04/26/2005	DATE FORWARDED TO EXAMINER			
25	01/19/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)			

24	04/26/2005	DISPOSAL FOR A RCE/CPA/129 (EXPRESS ABANDONMENT IF CPA)			
23	01/19/2005	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
22	03/16/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
21	03/14/2005	RECEIPT INTO PUBS			
20	03/08/2005	RECEIPT INTO PUBS			
19	01/03/2005	EXPORT TO INITIAL DATA CAPTURE			
18	01/11/2005	WORKFLOW - FILE SENT TO CONTRACTOR			
17	12/22/2004	MAIL NOTICE OF ALLOWANCE	821		-1
16	12/17/2004	ISSUE REVISION COMPLETED			
15	12/17/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
14	12/17/2004	CASE DOCKETED TO EXAMINER IN GAU			
13	12/13/2004	NOTICE OF ALLOWABILITY			
12	12/02/2004	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
11	10/25/2001	REQUEST FOR FOREIGN PRIORITY (PRIORITY PAPERS MAY BE INCLUDED)			
10	10/02/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
9	03/08/2002	CASE DOCKETED TO EXAMINER IN GAU			
8	01/06/2002	TRANSFER INQUIRY TO GAU			
7	11/23/2001	APPLICATION DISPATCHED FROM OIPE			
6	11/19/2001	APPLICATION IS NOW COMPLETE			
4	09/06/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	09/05/2001	CORRESPONDENCE ADDRESS CHANGE			
2	07/31/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/23/2001	INITIAL EXAM TEAM NN			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back use Back button on your browser toolbar.

Back to PALM | ASSIGNMENT | OASIS | Home page

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 6,963,430 B2

DATED : November 8, 2005

INVENTOR(S) : Noriaki Matsui

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 (787) days

Delete the phrase "by 787 days" and insert – by 878 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

Hendricks and Associates
P.O. Box 2509
Fairfax, VA 22031-2509

COPY MAILED

NOV 17 2006

OFFICE OF PETITIONS

In re Application of
Jose Walter
Application No. 09/909,893
Filed: July 23, 2001
Attorney Docket No. Walter artic.

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed on July 19, 2006, to revive the above-identified application.

The application became abandoned on August 19, 2003, as a result of petitioners' failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within two (2) months of the Notice of Appeal filed on June 18, 2003 (certificate of mailing dated June 16, 2003). The Office mailed a Notice of Abandonment on February 24, 2004.

Initially, the Office notes that petitioners indicated in the petition that the present nonprovisional application was assigned to Cbite, Inc. Santiago Balleza is the president of Cbite and the inventor, Jose Walter, is the vice-president. The USPTO assignment records do not indicate that Balleza, Walter or Cbite (also referred to as "petitioners") recorded the assignment with the Office to date.

The patent attorney of record, Glenna Hendricks, stated that on June 18, 2003, (the same day she filed the Notice of Appeal and Response), she sent a letter to Balleza and Walter, in which she enclosed a copy of the correspondence filed with the USPTO on June 16, 2003, and suggested a petition be filed relating to the entry of amended claims. Hendricks further stated that on August 1, 2004, she sent a second letter to Balleza and Walter, advising them that the application would become abandoned unless action was taken in the form of filing either a continuation application or an Appeal Brief. Hendricks asserted that she received no answer to either letter. Redacted copies of the letters accompany the petition. Hendricks asserted that during the extendable period for filing an Appeal Brief, she spoke to Walter to determine how petitioners intended to proceed; however, Walter informed her that petitioners were making changes and that costs were a major concern of petitioners. Hendricks stated that she believed that petitioners either did not intend to prosecute the application; changed attorneys; or were pursuing the matter on their own.

In a declaration submitted with the petition, Balleza explained that on May 1, 2002, and November 1, 2002, petitioners had moved the company twice and were in the process of moving the office. Balleza indicated that during that period there was some confusion in the office and that it appeared that communications from Hendricks were lost. Balleza stated: "In March of 2006, I understood, in a conversation with Ms. Hendricks, our patent attorney, that the application had gone abandoned, that she had filed a Notice of Appeal and that we had never given her permission to take action required to maintain the application." Balleza asserted that a search of petitioners' property led him to believe that the correspondence from Hendricks to them must have been lost because he could not find her letters. Lastly, Balleza stated that at not time did Cbite intend to abandon the application and the abandonment was contrary to their intentions.

DISCUSSION

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

(1) The reply required to the outstanding Office action or notice, unless previously filed.

(2) The petition fee as set forth in 37 CFR 1.17(l);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable.

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

This petition lacks item (3) above.

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable".[1] 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.[2]

---

[1] 35 U.S.C. § 133.

[2] 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-

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a).[3] 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, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.[4]

It appears that petitioners are asserting that the delay was unavoidable because they did not receive or lost the correspondence during their two moves, informing them of the status of the application and the necessary actions to be taken to avoid abandonment. Nevertheless, the showing of record is that the delay in taking action in the above-identified application was the result of petitioners' preoccupation with other matters. The Office notes that petitioners' preoccupation with other matters, which took precedence over the present application, does not constitute unavoidable delay.[5] Additionally, petitioners are reminded that the failure of communication between an applicant and counsel is not unavoidable delay within the meaning of 37 CFR 1.137(a).[6] There is nothing in the record to indicate that petitioners contacted their patent attorney and informed her of their change of address. Moreover, there is no showing that petitioner took any action to prevent the application from becoming abandoned such as simply inquiring into its status. An applicant may delay action until the end of the time period for reply. In doing so, however, the applicant must assume the risk attendant to such delay.[7]

The general standard applied by the Office requires petitioners to establish that they exercised the care and diligence in prosecuting the present application that is generally used and observed by prudent and careful men in relation to their most important business.[8] Lack of knowledge of the content of, or misunderstanding of the patent statutes, rules or the MPEP does not constitute unavoidable delay.[9]

---

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).

[3] See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay.

[4] Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

[5] See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

[6] In re Kim, 12 USPQ2d 1595 (Comm'r Pat. 1988).

[7] Ex parte Warren, 1901 Dec. Comm'r Pat. 137 (Comm'r Pat. 1901).

[8] In re Mattullah, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)).

[9] See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

According to Hendricks, during the extendable period for filing an Appeal Brief, she spoke to Walter to determine how petitioners intended to proceed; however, Walter informed her that petitioners were making changes and that costs were a major concern of petitioners. Therefore, petitioners first became aware of the status of the application and the need for action on or before January 18, 2004. Yet, petitioners did not take any action in the application until the filing of the present petition, approximately 2.5 years later. The record does not show that petitioners made any effort to communicate with their designated legal representative or to ensure that a timely response was filed to avoid abandonment of this application. Petitioners' inaction does not demonstrate the care and diligence generally observed by prudent and careful men in relation to their most important business. Regardless of the events surrounding the company's two moves, a reasonable and prudent person would have informed their attorney of the change of address, as well as ascertain information regarding the status of the application either through their attorney or by contacting the USPTO. Finally, the Office reminds petitioners that an intentional abandonment of an application, or an intentional delay in seeking the revival of an abandoned application precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137.[10]

An applicant has a duty to ensure that his application is being prosecuted.[11] "Diligent inquiry into the status of the application is required."[12] Therefore, petitioners must establish with a documentary showing that they exercised diligence in attempting to further the prosecution of the above-identified application.

CONCLUSION

Petitioners have not provided a sufficient showing to the satisfaction of the Director 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.

Accordingly, the petition is **dismissed**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time are permitted under 37 CFR 1.136(a).

ALTERNATIVE VENUE

Petitioners may wish to file a petition under 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by:

---

[10] See In re Maldague, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988); see also MPEP 711.03(c)(II)(C)(2).

[11] Douglas v. Manbeck, 1991 U.S. Dist. LEXIS 16404, 21 USPQ2d 1687, 1700 (E.D. Pa. 1991), aff'd, 975 F.2d 869, 24 USPQ2d 1318 (Fed. Cir. 1992); citing Winkler v. Ladd, 221 F. Supp. 550, 552 (D.D.C. 1962).

[12] Id.

(1) The reply required to the outstanding Office action or notice, unless previously filed.

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

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional.

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

Additionally, petitioners should submit additional information or a further explanation as to why the delay was unintentional.

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

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

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

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

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 16

Hendricks and Associates
P.O. Box 2509
Fairfax, VA 22031-2509

COPY MAILED

JUL 26 2007

OFFICE OF PETITIONS

In re Application of :
Jose Walter :
Application No. 09/909,893 : ON PETITION
Filed: July 23, 2001 :
Attorney Docket No. Walter artic. :

This is a decision on the petition under 37 CFR 1.137(b), filed on February 12, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned on August 19, 2003, as a result of petitioners' failure to file an appeal brief (and fee required by 37 CFR 41.20(b)(2)) within two (2) months of the Notice of Appeal filed on June 18, 2003 (certificate of mailing dated June 16, 2003). The Office mailed a Notice of Abandonment on February 24, 2004.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has submitted (1) the reply in the form of a Request for Continued Examination (RCE) (and fee) and a previously filed submission required by 37 CFR 1.114; (2) the petition fee; and (3) a proper statement of unintentional delay.

This application is being referred to Technology Center AU 3732 for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

JUL - 2 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 6

Kenneth F. Kozik
FISH & RICHARDSON P.C. (BOSTON)
225 Franklin Street
Boston, MA 02110-2804

In re Application of:	)	
Robert Olson Aberg	)	
Application No. 09/909,931	)	**DECISION ON REQUEST FOR**
Filed: July 20, 2001	)	**WITHDRAWAL AS ATTORNEY**
For: OPTIMIZED LOOK-UP TABLE CALCULATIONS IN BLOCK DIAGRAM SOFTWARE	)	

This is a decision on the Request To Withdraw from Representation filed June 11, 2003.

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

The request filed June 11, 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: Thomas V. Smurzynski, Esq.
LAHIVE & COCKFIELD LLP
29 State Street
Boston, MA 02109-1784

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

JAN 2 5 2008

OFFICE OF PETITIONS

LAHIVE & COCKFIELD, LLP/THE MATHWORKS
ONE POST OFFICE SQUARE
BOSTON, MA 02109-2127

In re Application of :
Robert Olson Aberg, et al. :
Application No. 09/909,931 : ON PETITION
Filed: July 20, 2001 :
Attorney Docket No. MWS-076RCE :

This is a decision on the petition under 37 CFR 1.137(b) to revive the above-identified application, filed September 28, 2007.

The petition is **GRANTED**.

The application became abandoned for failure to pay the issue fee on or before August 29, 2007. A Notice of Abandonment was mailed on September 21, 2007. In response, on September 28, 2007, the present petition was filed.

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

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

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : September 27, 2007

TO SPE OF : ART UNIT 2829

SUBJECT : Request for Certificate of Correction for Appl. No./09/909934 patent no.6867483

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: _____

B. W[illegible] BAUMEISTER

PATENT EXAMINER

TECHNOLOGY CENTER 2800

SPE

2891

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

MCDERMOTT, WILL & EMERY
600 13TH STREET, N.W.
WASHINGTON DC 20005-3096

COPY MAILED

JAN 10 2006

OFFICE OF PETITIONS

ON PETITION

In re Application of	:	
Yukio Maki	:	
Application No. 09/909,975	:	
Filed: July 23, 2001	:	
Attorney Docket No. 57454-162	:	

This is a decision on the petition, filed December 29, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on December 29, 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 2811 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).

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

FROMMER LAWRENCE & HAUG, LLP
745 FIFTH AVENUE
NEW YORK, NY 10151

COPY MAILED

NOV 1 5 2001

OFFICE OF PETITIONS

In re Application of
Ogawa, et al.
Application No. 09/910,102
Filed: July 20, 2001
Attorney Docket No. 450104-3165.1

DECISION GRANTING
PETITION

This is a decision on the petition entitled, "PETITION TO REQUEST A GRANT TO MAINTAIN ORIGINALLY ACCORDED FILING DATE ," filed August 23, 2001 (certificate of mailing date August 20, 2001), requesting that the above-identified application be accorded a filing date of July 20, 2001.

The application was deposited on July 20, 2001. On August 6, 2001, the Office of Initial Patent Examination mailed a " Notice of Omitted Items in a Nonprovisional Application" informing petitioners that drawing Figures 14 and 16 were missing. The Notice set a two month nonextendable period for reply from the August 6, 2001 mailing date of the Notice.

In response to the Notice, petitioners timely filed the present petition on August 23, 2001. Petitioners request a filing date on the basis that the entire application, including the missing Figures 14 and 16, was received in the Patent and Trademark Office (PTO) on July 20, 2001. In support, the petition is accompanied by a copy of applicants' itemized postcard receipt showing an Office generated barcode showing July 20, 2001 as the date of receipt. The postcard lists, *inter alia*, that the filing included 19 sheets of drawings

The return postcard constitutes *prima facie* evidence that this application, including Figures 14 and 16, was filed on July 20, 2001. MPEP 503. Accordingly, the request is granted.

As this is a feeless petition, petitioners may request a refund of the $130.00 fee by writing to the Office of Finance, Refund Section. A copy of this decision should accompany petitioner's request.

The application is being returned to Office of Initial Patent Examination for mailing of a corrected filing receipt and correction of Office records to show the filing date of the application as July 20, 2001. Because the original drawings of Figures 14 and 16 filed July 20, 2001 cannot be located in the Office, the copy of Figures 14 and 16, filed August 23, 2001, will be used for processing purposes.

Any inquiries pertaining to 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
www.uspto.go

JUN - 1 2004

HELLER EHRMAN WHITE & MCAULIFFE LLP
4350 LA JOLLA VILLAGE DRIVE
7TH FLOOR
SAN DIEGO CA 92122-1246

In re application of Dana Ault-Riche et al.	:
Serial No. : 09/910,120	: DECISION ON PETITION
Filed : July 18, 2001	:
Attorney Docket No.: 25885-1751	:

This is in response to applicants' petition, filed April 7, 2004 under 37 CFR 1.144, to withdraw the examiner's restriction requirement.

BACKGROUND

Review of the file history shows that the application was filed on July 18, 2001 under 35 U.S.C. 111(a) and claims priority to provisional application 60/219,813, filed July 19, 2000. The application as filed contained claims 1-98. On October 2, 2002 the examiner mailed a restriction requirement dividing the claims into 11 groups and requiring a further election of species should group I be elected. In a response filed December 27, 2002, applicants elected group 1, claims 1-37, 93-95 and newly added claim 99. Applicants further elected oligonucleotides having the formula 5'-E_m –3' as the species. Claims 34-48, 55-92 and 96-98 were cancelled. Applicants traversed the restriction requirement on grounds similar to those presented in the instant petition. On April 8, 2003 the examiner mailed an Office action wherein the restriction requirement among the 11 groups was maintained, the election of species requirement was withdrawn, and a new election of species requirement was made. Applicants were required to select a capture agent and a specific oligonucleotide for examination. On October 7, 2003, applicants filed a response electing oligonucleotides having the formula 5'-E_m –3' and capture agents that are antibodies. Applicants traversed the election of species requirement on the ground that all the pending claims read on the elected species. On February 25, 2004 the examiner mailed a first Office action on the merits wherein the restriction requirement was made final.

DISCUSSION

With regard to the restriction requirement, applicants request rejoinder of groups I (claims 1-37, 93-95 and 99) and III (claims 49-54). Applicants argue that group I is a subcombination of group III. MPEP 806.05(c)(II) states:

ABsp /Bsp No Restriction

> If there is no evidence that combination ABsp is patentable without the details of Bsp, restriction should not be required. Where the relationship between the claims is such that the separately claimed subcombination Bsp constitutes the essential distinguishing feature of the combination ABsp as claimed, the inventions are not distinct and a requirement for restriction must not be made, even though the subcombination has separate utility.

In this case it appears that the subcombination of elements in claim 1 is essential for patentability, and there is no evidence that the combination of claim 49 is patentable without the details of claim 1. Therefore applicants' argument is persuasive.

With regard to the election of species, applicants argue that all of the pending claims encompass oligonucleotides having an E_m region. MPEP 806.04(f) states:

> Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

Applicants' argument is persuasive because the claims are not drawn to mutually exclusive (patentably distinct) species.

DECISION

Applicants' petition is **GRANTED**.

The Office action mailed February 25, 2004 is VACATED.

The application will be forwarded to the examiner for examination of all the pending claims of groups I and III.

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

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

Jasemine C. Chambers

Jasemine Chambers
Director, Technology Center 1600

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

DEC 16 2002

GABRIEL P. KATONA
GOODWIN & PROCTER
599 LEXINGTON AVENUE
40TH FLOOR
NEW YORK, NY 10022

#11

In re Application of	:
Peter Emig et al	:
Serial No.: 09/910,141	: PETITION DECISION
Filed: July 10, 2001	:
Attorney Docket No.: 0691-070	:

This is a decision on the petition under 37 CFR 1.144, filed October 1, 2002, by facsimile transmission requesting review of a restriction requirement under 37 CFR 1.144.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111. The examiner assigned to the application mailed a first Office action to applicants on August 6, 2002, setting forth a restriction requirement as follows:

> Group I, claims 1-6 and 9-14 (all in part), drawn to compounds of formula I where X is carbon (an azine) and the ring has 7-10 members;
> Group II, claims 1-6 and 9-14 (all in part), drawn to compounds of formula I where X is nitrogen (a diazine) and the ring has 7-10 members;
> Group III, claims 1-6, 9-14 (all in part) and claims 7-8, drawn to compounds of formula I where X is nitrogen (a diazine) and the ring has six members;
> Group IV, claims 1-6 and 9-14 (all in part), drawn to compounds (azines) not belonging to the above groups.

The examiner reasoned that each of the Groups was directed to a different type of compound based on the ring size and variable X identification.

Applicants replied on September 9, 2002, electing Group III with traverse arguing that the restriction requirement was improper because the nucleus was always the same and only the substituents on the nucleus varied. It was also argued that restriction could not be based on the size of the ring or on differing classification..

The examiner replied to the traversal in the next Office action, mailed September 27, 2002. The restriction requirement was made Final. The examiner also rejected claims 1-6 under 35 U.S.C. 102(b) over Sugihara et al; claim 12 under 35 U.S.C. 112, first paragraph as lacking written description in the specification; and claims 1-14 under 35 U.S.C. 112, second paragraph, as indefinite.

Applicants have not yet replied to the Office action, however this petition with respect to the restriction requirement was filed on October 1, 2002.

DISCUSSION

Applicants argue that the examiner ignored the traversal argument presented - "that the claims were directed to compounds having a single common nucleus and only substituent sidechains differed" - in the response to the restriction requirement.

A review of the restriction requirement has been made. The requirement has been made on the differences in Formula I. Formula I, in addition to including sidechains R, R_1-R_4, P, Q and Z, includes variable X within the single ring substituent of the basic quinoline ring. This substituent ring also contains two optional CH_2 groups having variable numerical values from 0 to 3 thus giving the ring a variable size. Classification of organic chemical compounds is complicated but provides a basis upon which orderly examination of applications may be made. Classification is based on ring size, ring member heteroatoms, both type and frequency, and multiple (fused) ring existence. An established hierarchy taking into account these and other factors has been established. It has further been established that differences in the number and type of ring members and/or ring size is sufficient basis for establishing restriction of compounds. Thus applicants' argument that the nucleus for all compounds encompassed by Formula I is incorrect as evidenced by the existence of variable X within the ring structure as well as the variable number of CH_2 ring members.

Contrary to applicants argument that the examiner did not address applicants' arguments in answering the traversal, page 2 of the last Office action responds clearly to applicants' traversal. The explanation given may not be the same as that above, however it clearly sets out the basis for restriction and for denial of applicants' traversal. Applicants' argument relating to a common or invariant nucleus appears to be based on cnosideration of the quinoline fused ring system as the basis for classification. However, the unfused hetero ring system may equally be looked to as the basis for classification depending on the number and type of heteroatoms.

DECISION

Applicants' petition under 37 CFR 1.144 is **DENIED** for the reasons set forth above.

Applicants remain under obligation to reply to the last Office action, mailed September 27, 2002, within the time period set, or as may be extended under 37CFR 1.136.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

Bruce M. Kisliuk
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

Kenneth F. Kozik
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804

MAILED

JUN 0 4 2003

Technology Center 2100

In re Application of:	)	
Howard Taitel	)	
Application No. 09/910,170	)	**DECISION ON REQUEST FOR**
Filed: July 20, 2001	)	**WITHDRAWAL AS ATTORNEY**
For: PARTITIONING FOR MODEL-BASED DESIGN	)	

This is a decision on the Request To Withdraw from Representation filed May 22, 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 May 22, 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: Thomas V. Smurzynski, Esq.
LAHIVE & COCKFIELD LLP.
28 State Street
Boston, MA 02109-1784

Express Mailing Label No. EL 813 876 606 US

PATENT APPLICATION
Docket: 10256.50.3

OIPE JC180
MAR 0 5 2002
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of		)
	R.A.L. Griffiths et al	)
		) Art Unit
Serial No.	09/910,183	) 1655
Confirmation No.:	3168	)
Filed:	July 20, 2001	)
For:	FORENSIC IDENTIFICATION	)

CERTIFICATE OF EXPRESS MAIL UNDER 37 C.F.R. § 1.10

I hereby certify that the following documents are being deposited with the United States Postal Service as Express Mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington, DC 20231, on the 5th day of March 2002.

- Transmittal Letter (3 pages) (in duplicate)
- Response to Notice to File Corrected Application Papers (2 pages)
- Notice to File Corrected Application Papers (1 page)
- Letter to the Draftsperson (2 pages)
- 7 sheets of drawings
- Postcard

Respectfully submitted,

DANA L. TANGREN
Attorney for Applicant
Registration No. 37,246

WORKMAN, NYDEGGER & SEELEY
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 533-9800

DLT:dfw
G:\DATA\WPDOCS3\DFW\DLT\URQUHART\50_10256\0304incompletereply_trx.doc

Express Mailing Label No. EL 813 876 606 US

COPY OF PAPERS ORIGINALLY FILED

PATENT APPLICATION

Docket No. 10256.50.3

WORKMAN NYDEGGER & SEELEY

ATTORNEYS AT LAW

A PROFESSIONAL CORPORATION

1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UTAH 84111
TELEPHONE (801) 533-9800
FACSIMILE (801) 328-1707

RICK D. NYDEGGER
DAVID O. SEELEY
BRENT P. LORIMER
THOMAS R. VUKSINICK
LARRY R. LAYCOCK
JONATHAN W. RICHARDS
DAVID R. WRIGHT
JOHN C. STRINGHAM
JOHN M. GUYNN
CHARLES L. ROBERTS
GREGORY M. TAYLOR
DANA L. TANGREN
ERIC L. MASCHOFF
CHARLES J. VEVERKA
ROBYN L. PHILLIPS
RICHARD C. GILMORE†
DAVID B. DELLENBACH
R. BURNS ISRAELSEN
DAVID R. TODD
L. DAVID GRIFFIN

FRASER D. ROY
CARL T. REED
JESÚS JUANÓS I TIMONEDA, PH.D.
R. PARRISH FREEMAN, JR.
PETER F. MALEN, JR.
ADRIAN J. LEE
L. REX SEARS, PH.D.
ERIC M. KAMERATH
ROBERT E. AYCOCK
JENS C. JENKINS
KEVIN W. STINGER
WILLIAM J. ATHAY
WILLIAM R. RICHTER
TRENT H. BAKER
RYAN D. BENSON
SARA D. JONES
TIGE KELLER

† ADMITTED ONLY IN CALIFORNIA

PATENTS
TRADEMARKS
COPYRIGHTS
TRADE SECRETS
UNFAIR COMPETITION
LICENSING
COMPLEX LITIGATION

MAILING ADDRESS:
P.O. BOX 45862
SALT LAKE CITY, UT 84145

INTERNET
HOME PAGE: http://www.wnspatent.com
GENERAL E-MAIL: info@wnspatent.com

OIPE JC160
MAR 0 5 2002
PATENT & TRADEMARK OFFICE

COPY OF PAPERS ORIGINALLY FILED

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of		)
	R.A.L. Griffiths et al	)
		) Art Unit
Serial No.	09/910,183	) 1655
Confirmation No.:	3168	)
Filed:	July 20, 2001	)
For:	FORENSIC IDENTIFICATION	)

Assistant Commissioner for Patents
Washington, DC 20231

TRANSMITTAL FOR NOTICE TO FILE CORRECTED APPLICATION PAPERS

Sir:

Transmitted herewith is a Response for entry in the above-identified application.

___ Small entity status of this application under 37 C.F.R. § 1.9 and § 1.27 has been established by a verified statement previously submitted.

X To secure the approval of the Examiner for proposed amendments to the drawings, enclosed are the following:

X Letter to the Official Draftsperson;

X Set of seven (7) sheets of drawings containing Figures 1-3f including the proposed amendments therein; and

___ A duplicate set of the _____ (___) sheets of drawings with the changes therein highlighted in red.

___ To render the transmitted Response timely filed enclosed are the following:

___ Petition for a _____-Month Extension of Time; and

___ Form PTO-2038 submitting Credit Card Payment in the amount of $_____ to cover the fee for the extension of time.

X A Certificate of Express Mail Under 37 C.F.R. § 1.10.

X No fee is required.

The fee has been calculated as follows:

			SMALL ENTITY		LARGE ENTITY	
CLAIMS REMAINING AFTER	HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA	RATE	ADDT'L FEE	RATE	ADDT'L FEE
TOTAL	MINUS	=	X9		X18	
INDEPENDENT	MINUS	=	X42		X84	
1st PRESENTATION OF MULTIPLE DEPENDENT CLAIM			+140=		+280=	
			TOTAL		TOTAL	

___ Check No. _____ in the amount of $_____ is enclosed to cover the additional claim fee.

___ Please charge my Deposit Account No. 23-3178 in the amount of _____.

X The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 23-3178.

X Any filing fees under 37 CFR 1.16 for the presentation of extra claims.

X Any patent application processing fees under 37 CFR 1.17.

X A duplicate copy of this transmittal letter is attached.

Dated this 5th day of March 2002.

Respectfully submitted,

DANA L. TANGREN
Attorney for Applicant
Registration No. 37,246

022913

PATENT TRADEMARK OFFICE

DLT:dfw
G:\DATA\WPDOCS3\DFW\DLT\URQUHART\50_10256\0304incompletereply_trx.doc

C[illegible] OF PAPERS
O[illegible]ALLY FILED

Express Mailing Label No. EL 813 876 606 US

PATENT APPLICATION
Docket No. 10256.50.3

OIPE JC140
MAR 0 5 2002
PATENT & TRADEMARK OFFICE

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of		)
	R.A.L. Griffiths et al	)
		) Art Unit
Serial No.	09/910,183	) 1655
Confirmation No.:	3168	)
Filed:	July 20, 2001	)
For:	FORENSIC IDENTIFICATION	)

RESPONSE TO NOTICE TO FILE CORRECTED APPLICATION PAPERS

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

Responsive to the Notice to File Corrected Application Papers mailed from the United States Patent and Trademark Office on January 15, 2002, and pursuant to 37 C.F.R. § 1.111, please amend the above-identified patent application as follows:

IN THE DRAWINGS

Please replace the original drawings containing Figures 1-3f with the replacement set of drawings containing Figures 1-3f enclosed herewith.

REMARKS

The Notice requests that applicant submit a substitute set of drawings in compliance with 37 CFR § 1.84. Specifically, the originally submitted drawings were objected to in that they failed to meet the margin requirements. By this response, applicant submits herewith a replacement set of drawings containing Figures 1-3f to replace the drawings originally submitted with the present application. The replacement drawings have been amended to meet the margin requirements.

To facilitate the Examiner's consideration and approval of the proposed replacement drawings, sheets 1-7 containing Figures 1-3f are being transmitted herewith under a Letter to the Official Draftsperson.

In view of the foregoing, applicant respectfully requests that the replacement drawings be entered in the present application.

Dated this 5th day of March 2002.

Respectfully submitted,

Dana L. Tangren
Attorney for Applicant
Registration No. 37,246

WORKMAN, NYDEGGER & SEELEY
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 533-9800
Fax: (801) 328-1707

DLT:dfw
G:\DATA\WPDOCS3\DFW\DLT\URQUHART\50_10256\0304INCOMPLETEREPLY.DOC

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
09/910,183	07/20/2001	R. A.L. Griffiths	10256.50.3

CONFIRMATION NO. 3168

FORMALITIES LETTER

OC000000007312739

022913
WORKMAN NYDEGGER & SEELEY
1000 EAGLE GATE TOWER
60 EAST SOUTH TEMPLE
SALT LAKE CITY, UT 84111

COPY OF PAPERS
ORIGINALLY FILED

OIPE JC160
MAR 0 5 2002
PATENT & TRADEMARK OFFICE

Date Mailed: 01/15/2002

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:

- 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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SENNIGER POWERS LLP
100 NORTH BROADWAY
17TH FLOOR
ST LOUIS MO 63102

MAILED

MAR 0 3 2010

OFFICE OF PETITIONS

In re Application of	:	
J. ALEXANDER MARCHOSKY	:	
Application No. 09/910,190	:	ON APPLICATION FOR
Filed: July 19, 2001	:	PATENT TERM ADJUSTMENT
Attorney Docket No. JMA 2976.1	:	

This is in response to the "PETITION FOR PATENT TERM ADJUSTMENT PURSUANT TO 37 CFR §1.705(d)" filed October 14, 2009, which is properly treated under 37 CFR 1.705(b). Applicants submit that the correct patent term adjustment to be indicated on the patent is two thousand three hundred seventy-nine (2,379) days, not one thousand sixty-nine (1,069) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment. Applicants seek this correction solely on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within three years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentees are entitled to for Office failure to issue the patent within three years. See 37 CFR 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under 37 CFR 1.702(a)(4) or applicant delay under 37 CFR

1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office cannot make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss such a request as premature.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicants are advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicants must timely file an application for patent term adjustment prior to the payment of the issue fee.[1]

The Office acknowledges submission of the $200.00 fee set forth in 37 CFR 1.18(e) for consideration of the application for patent term adjustment under 37 CFR 1.705(b).

---

[1] For example, if applicants dispute both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed, and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicants must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the § 1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within two months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BELLA FISHMAN
VARIAN, INC.
3120 HANSEN WAY, D-102
PALO ALTO CA 94304-1030

COPY MAILED
APR 25 2006
OFFICE OF PETITIONS

In re Patent No. 6,818,456 :
Issued: November 16, 2004 :
Application No. 09/910,198 : DECISION ON PETITION
Filed: July 16, 2004 :
Attorney Docket No. NGED3001/EM :

This is a decision on the petition filed June 2, 2005 and resubmitted April 7, 2006, under 37 CFR 1.183, requesting a certificate of correction to correct the name of the inventor on the face of the patent. The petition is being treated under 37 CFR 1.182.

A review of Office PALM records indicates that the correction has been made and that the inventor's name has been corrected as follows:

Steven P. Sidwell

In view thereof, since the error in the printing of the first named inventor was caused by the USPTO, no fees are due and none have been charged.

This matter is being referred to the Certificate of Corrections Branch for issuance of a certificate of correction. Questions regarding the certificate of correction should be directed to that branch at 703-305-8309, inquiries regarding this decision should be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

COPY MAILED

JUN 30 2006

OFFICE OF PETITIONS

EDWARDS & ANGELL, LLP
P.O. BOX 55874
BOSTON, MA 02205

In re Application of	:	
Althoff, Johnston, and Abbott	:	
Application No.: 09/910,256	:	ON PETITION
Filing Date: July 20, 2001	:	
Attorney Docket No. 55185	:	

This is a decision on the petition under 37 CFR 1.47 filed March 10, 2006, which will be treated as a petition under 37 CFR 1.183 to waive the requirements of 37 CFR 1.131.

The petition is **dismissed**.

The record reflects that, by a final Office action mailed May 16, 2005, the examiner assigned to the subject application indicated that the declaration under 37 CFR 1.131 first filed April 20, 2005, was not proper, in part, because it lacked the signatures of all the joint inventors. On March 10, 2006, petitioner filed the instant petition under 37 CFR 1.47 to correct the deficiency. Petitioner requests that the declaration under 37 CFR 1.131 be accepted without the signature of inventor Abbott because inventor Abbott is allegedly refusing to sign the declaration.

It is noted that the provisions of 37 CFR 1.47 only apply to the execution of the original oath or declaration under 37 CFR 1.63. A petition under 37 CFR 1.47 is not appropriate in this case because inventor Abbott executed the original declaration. Relief can be granted, pursuant to 37 CFR 1.183, by the waiver or suspension of the requirements of 37 CFR 1.131 as to inventor Abbott.

Accordingly, the instant petition will be treated as petition under 37 CFR 1.183 to waive the requirement of 37 CFR 1.131 so as to accept the declaration filed March 10, 2006, without the signature of inventor Abbott. The petition must be dismissed, however, because the fee of $400.00 did not accompany the petition and the authorization to charge the deposit account was rejected.

Any renewed petition filed must be accompanied by the petition fee of $400.00, or a proper authorization to charge a deposit account of the same.

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

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

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

Telephone inquiries regarding this matter should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KAARDAL & ASSOCIATES PC
ATTN: IVAR M. KAARDAL
500 SOUTH FIRST AVENUE CIRCLE
SUITE 250
SIOUX FALLS, SD 57105-5802

COPY MAILED

APR 29 2005

OFFICE OF PETITIONS

In re Application of	:	
Earl J. MacLeod	:	
Application No. 09/910,265	:	DECISION GRANTING PETITION
Filed: July 20, 2001	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. 21-0134	:	

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

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue fee on or before September 30, 2003, as required by the Notice of Allowance and Fee(s) Due, mailed June 30, 2003. A Notice of Abandonment was mailed on November 6, 2003.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue fee payment of $665; (2) the petition fee of $665; and (3) the required statement of unintentional delay have been received. Accordingly, the issue fee is accepted as having been unintentionally delayed.

It appears that the petition herein was submitted by applicant. Applicant has appointed a representative to conduct all business before the U.S. Patent and Trademark Office (Office). The Office will not engage in dual correspondence with petitioner and petitioner's representative. Accordingly, petitioner must conduct all future correspondence with this Office through the representative of record. If petitioner no longer wishes to be represented by the representative of record, then a revocation of the power of attorney or authorization of agent must be submitted. A correspondence address must be included on the correspondence instructing the Office where all future communications should be mailed.

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

This matter is being referred to Publishing Division for processing into a patent.

Frances Hicks

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

cc:

Earl J. MacLeod
105 Jarvis
Whitehorse Yukon Y1A 2G7

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THE PROCTER & GAMBLE COMPANY
INTELLECTUAL PROPERTY DIVISION
WINTON HILL TECHNICAL CENTER - BOX 161
6110 CENTER HILL AVENUE
CINCINNATI, OH 45224

COPY MAILED

JUN 1 3 2005

OFFICE OF PETITIONS

In re Application of :
Peter Robert Foley et al :
Application No. 09/910,281 :
Filed: July 19, 2001 :
Attorney Docket No. CM2492 :

ON PETITION

This is a decision on the petition under 37 CFR 1.313, filed June 13, 2005, 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). See37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on December 21, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

This matter is being referred to Technology Center AU 1751 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).

UNITED STATES 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 : June 13, 2005

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of

Applicant(s) : Peter Robert Foley et al
Application No. : 09/910,281
Filed : July 19, 2001

The above-identified application has been assigned Patent No. 6,906,020 and an issue date of June 14, 2005.

It is hereby directed that this application be withdrawn from issue at the request of the applicants. 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 14, 2005:

> **"All reference to Patent No. 6,906,020 to Peter Robert Foley of Cincinnati, OH for CLEANING COMPOSITION appearing in the Official Gazette of June 14, 2005 should be deleted since no patent was granted."**

Wan Laymon

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

cc: Paul Harrison; Crystal Park 3, Suite 441 (FAX-703-306-2737)
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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

PLATON N. MANDROS
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. BOX 1404
ALEXANDRIA, VA 22313-1404

MAILED

NOV 12 2009

OFFICE OF PETITIONS

In re Application of :
Yasushi Yamade :
Application No. 09/910,282 : ON PETITION
Filed: July 19, 2001 :
Attorney Docket No. 011350-283

This is a decision on the petition, filed November 10, 2009 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 28, 2009 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 2194 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

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

Platon N. Mandros
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

Mail Date: 04/26/2010

Applicant	: Yasushi Yamade	: DECISION ON REQUEST FOR
Patent Number	: 7640554	: RECALCULATION of PATENT
Issue Date	: 12/29/2009	: TERM ADJUSTMENT IN VIEW
Application No	: 09/910,282	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/19/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **896** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

HANSRA PATENT SERVICES
4525 GLEN MEADOWS PLACE
BELLINGHAM, WA 98226

COPY MAILED

OCT 2 4 2005

OFFICE OF PETITIONS

In re Application of :
Ali Kheymehdooz :
Application No. 09/910,293 : ON PETITION
Filed: July 20, 2001 :
Attorney Docket No. Q01-1021-US1 :

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed June 14, 2004, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) was obtained. An Advisory action was mailed December 14, 2004 indicating that the reply filed on September 21, 2004, failed to place the application in condition for allowance. Accordingly, the application became abandoned on September 15, 2004.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment and a Request for Continued Examination (RCE); (2) the petition fee of $1500; and (3) the required statement of unintentional delay have been received. Accordingly, the petition filed September 19, 2005 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being forwarded to Technology Center 2600, Art Unit 2651 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

STATTLER JOHANSEN & ADELI
P O BOX 51860
PALO ALTO CA 94303

COPY MAILED

APR 0 7 2003

OFFICE OF PETITIONS

In re Application of Daniel Putterman et al Application No. 09/910,316 Filed: July 19, 2001 Attorney Docket No. MEDB.P0001	DECISION GRANTING PETITION UNDER 37 CFR 1.137(f)

This is a decision on the petition under 37 CFR 1.181, filed March 17, 2003, which is being treated as a petition to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country on July 19, 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). However, while the statement of unintentional delay does not comply with the rule, the statement presented will be construed as meaning that "the entire delay in filing the required reply [Notice to Rescind Previous Nonpublication Request Under 35 U.S.C. § 122(b)(2)(B)(ii)] until the filing of a grantable petition was unintentional." Accordingly, the failure to timely notify the Office 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.

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 July 17, 2003 accompanies this decision on petition.

The petition was accompanied by a fee of $130. However, the fee for reviving under the unintentional provisions of 37 CFR 1.137(f) is $1,300. Accordingly, as authorized, the balance due of $1,170 will be charged to petitioner's Deposit Account No. 50-1128.

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 2611 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. 14

GRAY CARY WARE & FREIDENRICH LLP
153 TOWNSEND
SUITE 800
SAN FRANCISCO, CA 94107

COPY MAILED

MAY 1 3 2003

OFFICE OF PETITIONS

In re Application of :
Shi et al. :
Application No. 09/910,358 : DECISION DISMISSING PETITION
Filed: July 19, 2001 :
Attorney Docket No. 2101363-991200 :

This is a decision on the "Petition in Response to Notice to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures," filed February 11, 2003. This petition is properly treated as a petition under 37 C.F.R. § 1.53(e)(2). Petitioners request correction of the record and inclusion of page 19 in the application at the time of the filing.

Application papers in the above-identified application were filed on July 19, 2001. However, on October 16, 2001, the Office of Initial Patent Examination (OIPE) mailed applicants a "Notice to File Corrected Application Papers." Applicants were thereby advised that the application had been accorded a filing date of July 19, 2001; however, the claim(s) commencing on a separate sheet (37 CFR 1.75(h)) and substitute computer readable form (CRF) of the sequence listing and statement under 1.821, as applicable, were required.

On January 28, 2002 (certificate of mailing December 10, 2001), applicants timely responded with *inter alia* a substitute specification (with the claims commencing on a separate sheet). However, on December 5, 2002, OIPE mailed applicants the Notice stating that page 19 of the specification appeared to have been omitted from the application. This Notice stated that a failure to timely file a petition would be treated as a constructive acceptance by the applicants of the application as deposited in the USPTO.

In response, applicants timely filed the instant petition (and petition fee). Applicants assert that page 19 of the application was included in the initial filing made on July 19, 2001 as indicated by the documents associated with the filing of the above-identified application. In support thereof, applicants pointed to indication on the Utility Patent Application Transmittal Letter and on the Fee Transmittal that page 19 of the specification was among the papers filed on July 19, 2001. In

addition, petitioner submitted a copy of their return postcard[1] from the USPTO.

A review of petitioner's evidence is not necessary to address whether page 19 of the specification was among the papers present in the application on filing. A review of the application file reveals that page 19 is present in the application and is considered (and always has been considered) a part of the original application disclosure. However, the Notice mailed December 5, 2002, was mailed in reference to the substitute specification filed January 28, 2002 (certificate of mailing December 10, 2001). A review of this paper as received in the Office reveals that page 19 appears to have been omitted.

Therefore, the Notice was properly mailed and will not be withdrawn.

In view thereof, the petition is **DISMISSED**.

As petitioners have not shown that page 19 was among the papers filed on January 28, 2002, the Notice is considered correct and the petition fee is not subject to refund.

Petitioners are given **ONE (1) MONTH** from the mailing date of this decision to submit page 19 omitted from the substitute specification filed January 28, 2002. This period is not extendable under § 1.136(a).

The application, with a filing date of July 19, 2001, is being returned to the Office of Initial Patent Examination for completion of pre-examination processing, including awaiting receipt of page 19 of the substitute specification.

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

Beverly Flanagan
Supervisory Petitions Attorney
Office of Petitions

Nancy Johnson
Petitions Attorney
Office of Petitions

---

[1] Petitioner is reminded that 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). See MPEP 503. Petitioner's postcard petition does not itemize the pages of specification or claims being submitted. Further, transmittal letters and fee transmittals do not generally serve as convincing evidence that any item listed thereon is present in the application.

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

COPY MAILED

APR 19 2002

OFFICE OF PETITIONS

QUALCOMM INCORPORATED
ATTN: PATENT DEPARTMENT
5775 MOREHOUSE DRIVE
SAN DIEGO, CA 92121-1714

In re Application of:	DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)
Parag Agashe and Giovanni Vannucci	
Application No. 09/910,365	
Filed: July 20, 2001	
Title of Invention: APPARATUS, METHOD, AND SYSTEM OF TRANSFERRING CORRECTION INFORMATION	

This is in response to a Petition Under 37 C.F.R. 1.47(a), filed January 18, 2002, to allow the other inventor(s) to proceed with the application on behalf of himself or herself and the nonsigning inventor(s).

The petition is **dismissed**.

The above-identified application was filed on July 20, 2001, without a fully executed oath or declaration. Accordingly, on August 31, 2001, a "Notice to File Missing Parts of Nonprovisional Application" (hereinafter "Notice"), was mailed to Petitioner. The Notice required an executed oath or declaration. Applicant was given two-months from the date of the Notice within which to file a fully executed oath or declaration.

In response to the Notice, Petitioner files the instant petition wherein Petitioner avers that an e-mail containing the Application, Combined Declaration and Power of Attorney and Assignment, was sent to the nonsigning inventor on October 16, 2001. The petition is supported by the Declaration of Victoria J. Pacey wherein she avers that she sent the e-mail to the nonsigning inventor, which was responded to by the signing inventor, Parag Agashe. Parag Agashe allegedly provided Victoria J. Pacey with the nonsigning inventor's new e-mail address. The Application, Combined Declaration and Power of Attorney and Assignment were then e-mailed to the nonsigning inventor at the new address, but he has been unwilling to satisfy [their] request. Finally, the petition is putatively supported by exhibits A through D, evincing the above e-mail transmissions.

A review of the file reveals no exhibits evincing the above e-mail transmissions were received by the Office.

Petitioner is further advised that the putative exhibits would fail to provide adequate proof that the nonsigning inventor has been presented the application. Confirmation that the e-mail address is correct, and that the application was received in a format such that the nonsigning inventor was able to read and review the application is required. Alternatively, Petitioner may wish to mail the application via the United States Postal Service to the nonsigning inventor at his last known mailing address.

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 22202

Telephone inquiries related to this decision may be directed to Petitions Attorney Derek L. Woods at (703) 305-0014.

Patricia Faison-Ball for

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mark R Wisner
WISNER & ASSOCIATES
Suite 400
1177 West Loop South
Houston, TX 77027-9012

COPY MAILED

APR 2 7 2005

OFFICE OF PETITIONS

In re Application of :
Eric P. Berg :
Application No. 09/910,414 :
Filed: November 12, 2003 :
Attorney Docket Number: NIGA,003 :

This is a decision on the petition under 37 CFR 1.137(b), filed November 22, 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 Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice"), mailed September 6, 2001. The Notice required an executed oath/declaration, and a late filing fee or oath or declaration surcharge. The Notice set a two (2) month period for reply 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 on November 7, 2001.

With the instant Renewed Petition, Petitioner has filed the appropriate fees and an executed oath or declaration in response to the Notice, and satisfied the requirements of a grantable petition under 37 CFR 1.137(b).

The oath or declaration has been entered and made of record.

The application is being returned to the Office of Initial Patent Examination for continued processing.

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

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

PEACOCK MYERS AND ADAMS PC
P O BOX 26927
ALBUQUERQUE NM 87125-6927

COPY MAILED

MAY 3 1 2005

OFFICE OF PETITIONS

In re Application of :
Meyers :
Application No. 09/910,415 : ON PETITION
Filed: July 20, 2001 :
Attorney Docket No. Mask :
For: MASK FOR USE WITH EYEGLASSES

This is a decision on the petition under 37 CFR 1.137(b), filed on February 28, 2005 (certificate of mailing date February 24, 2005) to revive the above-identified application.

The above-identified application became abandoned for failure to reply in a timely manner to the June 13, 2003 non-final Office action which set an extendable three (3) month period for reply. No extensions of time having been obtained pursuant to 37 CFR 1.136(a) and no reply being received in the Office, this application became abandoned on September 14, 2003. A Notice of Abandonment was mailed on January 6, 2004.

Applicant has submitted an amendment in reply to the June 13, 2003 non-final Office action, an acceptable statement of the unintentional nature of the delay in responding to the June 13, 2003 non-final Office action, and the petition fee.

The petition is **GRANTED**.

After the mailing of this decision the application will be forwarded to Technology Center G.A.U. 3765's technical support staff for entry of the amendment filed on February 28, 2005 (certificate of mailing date February 24, 2005).

The Revocation/Power of Attorney filed with the instant petition has been entered and made of record. Please find enclosed documents pertaining to the Change of Power of Attorney.

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

E. Shirene Willis

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions

enclosure: 2 Notices regarding the change in power of attorney

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Netarx Inc
30840 Northwestern Highway
Suite 250
Farmington Hills MI 48334

COPY MAILED

MAY 23 2006

OFFICE OF PETITIONS

In re Application of :
Kronenberg :
Application No. 09/910,416 : ON PETITION
Filed: July 20, 2001 :
Attorney Docket No. 0001-0003 :
For: METHOD AND SYSTEM FOR SECURED TRANSPORT AND STORAGE OF DATA ON A NETWORK

This is a decision on the petition under 37 CFR 1.181 to withdraw the holding of abandonment, filed on April 24, 2006.

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

The above-identified application became abandoned for failure to timely reply to the Notice of Allowance and Fee(s) Due, mailed August 19, 2005, which set a period for reply of three (3) months. Having received no reply, the Office considered the application abandoned on November 20, 2005. A Notice of Abandonment was mailed on April 6, 2006.

Petitioner contends that the August 19, 2005 Notice of Allowance and Fee(s) Due was not received at the correspondence address of record and, therefore, the application is not abandoned. The undersigned finds this assertion completely convincing because the Notice in question was returned to sender on August 29, 2005. It was re-mailed on October 5, 2005, but the period for response was erroneously maintained. A new period to run three months from October 5, 2005 should have been set.

The petition under 37 CFR 1.181 is granted. The holding of abandonment is withdrawn. No petition fee has been or will be charged in connection with this matter.

After the mailing of this decision, the application will be forwarded to Publications Division (Petitioner has submitted the issue fee and publication fee. The Notice does not need to be re-mailed.)

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

Shirene Willis Brantley

Shirene Willis Brantley
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KEN SONNENFELD, ESQ.
MORGAN & FINNEGAN LLP
345 PARK AVENUE
NEW YORK, NY 10154

COPY MAILED

JUL 1 9 2005

OFFICE OF PETITIONS

In re Application of	:	
Waugh et al.	:	
Application No. 09/910,432	:	ON PETITION
Filed: July 20, 2001	:	
Attorney Docket No. 4649-4006US1	:	

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed June 13, 2005, to revive the above-identified application.

The petition is **GRANTED.**

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 1600 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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Paper No. 9

FLIESLER MEYER, LLP
FOUR EMBARCADERO CENTER
SUITE 400
SAN FRANCISCO CA 94111

COPY MAILED

FEB 09 2005

OFFICE OF PETITIONS

In re Patent No. 6,780,848 Gluckman et al. Issue Date: August 24, 2004 Application No. 09/910,461 Filed: July 20, 2001 Attorney Docket No. 37522-1002C1	DECISION ON REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT and NOTICE OF INTENT TO ISSUE CERTIFICATE OF CORRECTION

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed September 7, 2004. Patentees request that the patent term adjustment indicated in the patent be corrected from twenty-one (21) days to one hundred twenty-eight (128) days.

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 twenty-eight **(128)** days.

On August 24, 2004, the above-identified application matured into U.S. Patent No. 6,780,848. The instant request for reconsideration filed September 7, 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 21 days. The initial determination of PTA of 128 days was reduced by 107 days for the submission of a "Miscellaneous Incoming Letter" filed May 10, 2004. Patentees state that the papers filed included an Issue Fee Transmittal, a Change of Status and a Response to the examiner's reasons for allowance, all of which are specifically excluded from the provisions of 37 CFR 1.704(c)(10) and cannot be used to reduce the patentee term extension.

Patentees' arguments are well-taken. By Official Gazette Notice dated June 26, 2001, the Director has advised applicants and patentees that the filing after the mailing of a Notice of Allowance of either a response to the examiner's reasons for allowance, a change of address, or a loss of entitlement to small

entity status, will not be considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application and will not result in reduction of a patent term adjustment pursuant to 37 CFR 1.704(c)(10) *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance*, 1247 OG 111 (June 26, 2001). A review of the application record reveals that the reduction of 120 days was based on the filing of such papers after allowance. Thus, it is concluded that the reduction of 120 days was incorrect.

In view thereof, the patent term adjustment indicated on the patent should have been one hundred twenty-eight **(128)** 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 TWENTY-EIGHT (128) days.

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

Karin A Ferriter
per

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

Enclosure: Copy of DRAFT Certificate of Correction

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.:20081207

DATE : 07 Dec 2008

TO SPE OF : ART UNIT 1639

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

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

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - ST (South Tower) 9A22
Palm location **7590** - Tel. No. (703) 305-8309

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

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

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

Note your decision on the appropriated box.

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

Comments:

The Certificates of Correction dated 14 Mar 2005, 11 Nov 2006, and 26 Dec 2006 are approved

/ Christopher S. F. Low /
Supervisory Patent Examiner, Art Unit 1639

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SWANSON & BRATSCHUN, L.L.C
1745 SHEA CENTER DRIVE, SUITE 330
HIGHLANDS RANCH, CO 80129

COPY MAILED
APR 10 2006
OFFICE OF PETITIONS

In re Application of HUYN et al Application No. 09/910,463 Filed: July 20, 2001 Attorney Docket No. SURR.60	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 February 25, 2005.

The request is **NOT APPROVED** as moot.

A review of the file record indicates that the power of attorney to all attorneys of record has been revoked by the assignee of the patent application on August 1, 2005. Accordingly, the request to withdraw under 37 C.F.R. § 1.136(b) is moot.

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

Telephone inquires concerning this decision should be directed to Amelia Au at 571.272.7414.

Amelia Au
Petitions Examiner
Office of Petitions

cc: SHERIDAN ROSS PC
1560 BROADWAY
SUITE 1200
DENVER CO 80202

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FOLEY & LARDNER
1530 PAGE MILL ROAD
PALO ALTO, CA 94304

COPY MAILED

APR 2 6 2005

OFFICE OF PETITIONS

In re Patent No. 6,794,506	:	
Issue Date: September 21, 2004	:	
Application No. 09/910,466	:	ON PETITION
Filed: July 19, 2001	:	
Attorney Docket No. 002010-676	:	

This is a decision on the petition filed January 31, 2005, which is being treated under 37 CFR 1.182, requesting issuance of duplicate Letters Patent for the above-identified application.

The petition is **granted**.

The Publishing Division is directed to issue duplicate Letters Patent.

Any questions concerning this matter may be directed to the undersigned at (571) 272-3220. Any questions concerning the issuance of the Certificate of Correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

A copy of this decision is being forwarded to Publishing Division for issuance of a duplicate Letters Patent.

This matter is being referred to Files Repository.

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

cc: Krystal Paige, South Tower C-32 (FAX 746-4642)

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.
09/910,471	07/20/2001	Jeffrey K. Wilkins	WIL-102	1749

30869 7590 08/09/2004

LUMEN INTELLECTUAL PROPERTY SERVICES, INC.
2345 YALE STREET, 2ND FLOOR
PALO ALTO, CA 94306

EXAMINER
BORISSOV, IGOR N

ART UNIT	PAPER NUMBER
3629	

DATE MAILED: 08/09/2004

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

Paper No.

Notice of Non-Compliant Amendment (37 CFR 1.121)

The amendment document filed on 7/9/04 is considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see *68 Fed. Reg. 38611*, Jun. 30, 2003). In order for the amendment document to be compliant, correction of the following item(s) is required. **Only the corrected section of the non-compliant amendment document must be resubmitted (in its entirety), e.g., the entire "Amendments to the claims" section of applicant's amendment document must be re-submitted.** 37 CFR 1.121(h).

THE FOLLOWING CHECKED (X) ITEM(S) CAUSE THE AMENDMENT DOCUMENT TO BE NON-COMPLIANT:

☐ 1. Amendments to the specification:
- ☐ A. Amended paragraph(s) do not include markings.
- ☐ B. New paragraph(s) should not be underlined.
- ☐ C. Other _____

☐ 2. Abstract:
- ☐ A. Not presented on a separate sheet. 37 CFR 1.72.
- ☐ B. Other _____

☐ 3. Amendments to the drawings: _____

☒ 4. Amendments to the claims:
- ☐ A. A complete listing of all of the claims is not present.
- ☐ B. The listing of claims does not include the text of all claims (including withdrawn claims)
- ☒ C. Each claim has not been provided with the proper status identifier, and as such, the individual status of each claim cannot be identified.
- ☐ D. The claims of this amendment paper have not been presented in ascending numerical order.
- ☐ E. Other: _____

For further explanation of the amendment format required by 37 CFR 1.121, see MPEP Sec. 714 and the USPTO website at http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf.

If the non-compliant amendment is a **PRELIMINARY AMENDMENT,** applicant is given ONE MONTH from the mail date of this letter to supply the corrected section which complies with 37 CFR 1.121. Failure to comply with 37 CFR 1.121 will result in non-entry of the preliminary amendment and examination on the merits will commence without consideration of the proposed changes in the preliminary amendment(s). This notice is not an action under 35 U.S.C. 132, and **this ONE MONTH time limit is not extendable**.

If the non-compliant amendment is a reply to a **NON-FINAL OFFICE ACTION (including a submission for an RCE),** and since the amendment appears to be a *bona fide* attempt to be a reply (37 CFR 1.135(c)), applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit the corrected section which complies with 37 CFR 1.121 in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).**

If the amendment is a reply to a **FINAL REJECTION,** this form may be an attachment to an Advisory Action. **The period for response to a final rejection continues to run from the date set in the final rejection**, and is not affected by the non-compliant status of the amendment.

Legal Instruments Examiner (LIE) — 703/308-9032 Telephone No.

Rev. 10/03

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : Oct. 11, 2005

TO SPE OF : **Art Unit** 1742 (*Exr. is William Leader*)

SUBJECT : Request for Certificate of Correction on Patent No.: 6,921,468 09/910481

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 as allegedly omitted. Your denial or approval decision is needed below.

sp STAM

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 x120

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

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

Comments:

The initialed PTO-1449 is submitted to be scanned.

Roy Van Ching — **SPE**

2/14/06 — **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

WELSH & KATZ, LTD
120 S RIVERSIDE PLAZA, 22ND FLOOR
CHICAGO IL 60606

COPY MAILED

FEB 0 2 2007

OFFICE OF PETITIONS

In re Application of	:	
GLASS	:	
Application No. 09/910,516	:	DECISION ON PETITION
Filed: July 20, 2001	:	
Attorney Docket No. 82543	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed November 7, 2006, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before September 18, 2006, as required by the Notice of Allowance and Fee(s) Due, mailed June 16, 2006 . Accordingly, the date of abandonment of this application is September 19, 2006 .

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of payment of the issue fee of $700 and the publication fee of $300, (2) the petition fee of $750; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to Monica Graves at (571) 272-7253.

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

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
www.uspto.gov

JJGJR.: 06-06

Paper No: __

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

COPY MAILED

JUN 19 2006

OFFICE OF PETITIONS

In re Application of	:	
Mukai,et al.	:	
Application No. 09/910,583	:	DECISION
Filing Date: 20 July, 2001	:	
Attorney Docket No.: 5047	:	

This is a decision on the petition filed on 24 April, 2006, alleging unintentional delay under 37 C.F.R. §1.137(b).

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 3 December, 2004, with reply due absent extension of time on or before 3 March, 2005;
- 7 April, 2005, Petitioner filed with a request and fee for extension of time a reply in the form of an amendment, which was found informal and a Notice of Non-Compliant Amendment was mailed on 25 April, 2005, with a reply due on or before 25 May, 2005
- the instant application went abandoned after midnight 25 May, 2005;
- the Office mailed a Notice of Abandonment on 30 March, 2006;

- on 24 April, 2006, Petitioner filed the instant (with fee), reply in the form of an amendment and made the statement of unintentional delay–thus, Petitioner appears to have satisfied the requirements of a petition under 37 C.F.R. §1.137(b).

In light of the period from the date of abandonment after midnight 25 May, 2005, until the filing of the instant petition on 24 April, 2006, Petitioner is cautioned as to the appearance of the use of the former one-year limitation on abandonment as an unauthorized extension of time.

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

---

[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.

constitute the care required under Pratt,[6] 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]))

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 Petitioner has satisfied the requirements of the regulation.

The record (including the petition filed on 24 April 2006) does not necessitate a finding that the delay between midnight 25 May, 2005 (date of abandonment), and 24 April, 2006 (date of filing of grantable petition), was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on the duty of candor and good faith of Applicants (Mukai and Chandran) and their Counsel/Petitioner (Michael A. Bernadicou (Reg. No. 35,934)) when accepting Petitioners' representation that the delay in filing the response was unintentional.[8]

CONCLUSION

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

The instant application is released to Technology Center 1700 for further processing in due course.

---

[6] The test of diligence in the prosecution of an application before the Commissioner is, in the context of ordinary human affairs, the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r. Pat. 1913).

[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 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).

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

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

APPLIED MATERIALS/BSTZ
BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

Mail Date: 04/21/2010

Applicant	: Kevin Mukai	: DECISION ON REQUEST FOR
Patent Number	: 7638161	: RECALCULATION of PATENT
Issue Date	: 12/29/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/910,583	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/20/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1064** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NATIONAL INSTITUTE OF HEALTH
C/O NEEDLE & ROSENBERG, P.C.
SUITE 1000
999 PEACHTREE STREET
ATLANTA, GA 30303

COPY MAILED

MAR 2 6 2007

OFFICE OF PETITIONS

In re Application of	:	
Klein et al.	:	
Application No. 09/910588	:	
Filing or 371(c) Date: 07/20/2001	:	DECISION
Title of Invention:	:	ON PETITION
METHODS AND COMPOSITIONS FOR	:	
BISUBSTRATE INHIBITORS OF	:	
ACETYLTRANSFERASES	:	

This is a decision on the "Petition to Withdraw Notice of Abandonment Under 37 CFR § 1.181", filed December 11, 2006. The delay in treating this petition is regretted.

This Petition is hereby **granted**.

The above-identified application became abandoned for failure to timely and properly reply to the Office communication, mailed February 22, 2006. The Office communication set a one (1) month period for reply. Extensions of time were available under 37 CFR 1.136(a). No response having been received, the application became abandoned March 23, 2006. A Notice of Abandonment was mailed October 5, 2006.

Applicant's Assertion

Applicant files the instant petition and asserts that a timely reply to the Office action was filed on March 20 2006. In support of this assertion, Applicant files a copy of the response, and a copy of her return-receipt postcard.

Analysis and conclusion

A review of the response reveals that, while the copy of the return-receipt postcard does not contain a USPTO date stamp, the response contained a Certificate of Mailing under 37 CFR 1.8, certifying that the response was mailed to this Office on March 20, 2006. The Certificate of Mailing was executed by Petitioner herein.

In view of the foregoing, the petition is granted. The holding of abandonment is hereby withdrawn.

The application will be referred to Technology Center Art Unit 1632 for processing of the response, and for continued examination in due course.

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

Derek L. Woods
Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MERCHANT & GOULD PC
P.O. BOX 2903
MINNEAPOLIS, MN 55402-0903

COPY MAILED
APR 19 2006
OFFICE OF PETITIONS

In re Application of	:	
Hancock et al.	:	
Application No. 09/910,614	:	
Filed: July 23, 2001	:	NOTICE
Patent No.: 6,484,913	:	
Issued: November 26, 2002	:	
Title of Invention:	:	
BRACKET ASSEMBLY FOR ALL TERRAIN	:	
VEHICLE HANDLE BARS	:	

This is a notice regarding your request to change your entity status to large.

Office records reveal that SATV, LLC, is the assignee of the above-identified application.

In accordance with 37 CFR 1.27(g), said notice is hereby accepted. Office records have been corrected to indicate loss of small entity status in the above-identified application.

A review of the petition reveals that the address appearing on the petition differs from the correspondence address of record. Applicant is advised that, in patented files: requests for changes of correspondence address, powers of attorney, revocations of powers of attorney, withdrawal of attorney and submissions under 37 CFR 1.501: Designation of, or changes to, a fee address, should be addressed to Mail Stop M Correspondence.

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

Derek L. Woods
Attorney
Office of Petitions

Cc: INTELLECTUAL PROPERTY COUNSEL
K2 INC.
19215 VASHON HWY SW
VASHON, WA 98070

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KOHN & ASSOCIATES
SUITE 410
30500 NORTHWESTERN HIGHWAY
FARMINGTON HILLS, MI 48334

COPY MAILED
SEP 0 6 2006
OFFICE OF PETITIONS

In re Patent No. 6,962,808 :
Issued: November 8, 2005 :
Application No. 09/910,628 : ON PETITION
Filed: July 20, 2001 :
Attorney Docket Number: 3060.00021 :

This is a decision on the petition, filed January 11, 2006 and resubmitted July 3, 2006, under 37 CFR 1.183 to correct the assignee's name on the front of the Patent. The petition is treated under 37 CFR 3.81(b)[1]

The petition is **GRANTED**.

Petitioner states that the name of the second assignee, IA, Inc., was inadvertently omitted from the Fee(s) Transmittal form PTOL-85(b). Accordingly, petitioner requests that a certificate of correction be issued to reflect the name of the second assignee on the front page of the Letters Patent.

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

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

The request was accompanied by a certificate of correction (and fee) as required by 3.81(b), filed December 8, 2005. Further, the copy of the recorded assignment reflects that IA, Inc. is an assignee of an undivided one half interest in the patent identified

---

[1] *See* Official Gazette of June 22, 2004

above. Accordingly, as the request complies with the provisions of 37 CFR 3.81(b), it would be appropriate for a certificate of correction to issue.

Fees in the amount of $130.00 for the petition have been charged to deposit account no. 11-1449. The fee for the certificate of correction in the amount of $100.00 was received by check and has been applied.

Inquiries concerning this decision should be directed to the undersigned at (571) 272-3212. Any questions concerning the issuance of a certificate of correction should be directed to the Certificates of Correction Branch at (703) 305-8309.

This matter is being referred to the Certificates of Correction Branch for issuance of a certificate of correction.

Patricia Faison-Ball

Patricia Faison-Ball
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, DC 20231
www.uspto.gov

MAILED

MAR 11 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Richard M. Saccocio
Richard M. Saccocio, P.A.
100 Southeast 12th Street
Ft. Lauderdale, FL 33316

Paper No. 4

In re application of
Rodger Burrows
Application No. 09/910,654
Filed: July 20, 2001
For: METHODS AND APPARATUS FOR ELECTRONICALLY STORING TRAVEL AGENT'S COUPONS

DECISION ON PETITION TO MAKE SPECIAL (INFRINGEMENT)

This is a decision on the petition under 37 C.F.R § 1.102(d) filed January 21, 2003 to make the above-identified application special.

The petition requests that the above-identified application be made special under the procedure set forth in M.P.E.P. § 708.02, item II: Infringement.

MPEP 708.02 states that a Petition to Make Special based on Infringement must have the following: (1) the appropriate petition fee under 37 CFR 1.17(i); (2) a statement by the assignee, applicant, or attorney alleging: (A) that there is an infringing device or product actually on the market; (B) that a rigid comparison of the alleged infringing device or product with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (C) that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art, and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

The petition filed January 21, 2003 does not fully meet requirement 2(C), above. In view of this deficiency, the petition is **DISMISSED**.

Atached to the petition is a listing of 24 alleged pieces of prior art, including eight WIPO references. Applicant has not submitted complete copies of the WIPO references. Instead, Applicant has only submitted the first pages thereof.

Any request for reconsideration must be filed within TWO MONTHS of the date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Should petitioner desire reconsideration, he should supplement this petition by a declaration or statement giving the information as outlined above.

Applicant should promptly submit a renewed petition to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. The envelope should indicate that the correspondence be brought to the attention of Technology Center 3600.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.

SUMMARY: Petition to Make Special **DISMISSED**.

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703) 308-2121
(703) 605-0586 (facsimile)

RAR/tpl : 3/6/03

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

APR 17 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

Paper No. 6

Richard M. Saccocio
Richard M. Saccocio, P.A.
100 Southeast 12th Street
Ft. Lauderdale, FL 33316

In re application of
Rodger Burrows
Application No. 09/910,654
Filed: July 20, 2001
For: METHODS AND APPARATUS FOR ELECTRONICALLY STORING TRAVEL AGENT'S COUPONS

DECISION ON RENEWED PETITION TO MAKE SPECIAL (INFRINGEMENT)

This is a decision on the renewed petition under 37 C.F.R § 1.102(d) filed March 24, 2003 to make the above-identified application special.

The petition requests that the above-identified application be made special under the procedure set forth in M.P.E.P. § 708.02, item II: Infringement.

MPEP 708.02 states that a Petition to Make Special based on Infringement must have the following: (1) the appropriate petition fee under 37 CFR 1.17(i); (2) a statement by the assignee, applicant, or attorney alleging: (A) that there is an infringing device or product actually on the market; (B) that a rigid comparison of the alleged infringing device or product with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (C) that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art, and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

A petition to make special was filed on January 21, 2003. That petition was dismissed in a decision mailed March 11, 2003 wherein it was held that the petition did not fully meet requirement 2(C), above.

Since the requirement lacking in the original petition of January 21, 2003 has now been supplied, all the items above required for special status under MPEP § 708.02 II have been met, the petition is **GRANTED**.

The examiner is directed (1) to make an interference search for possible interfering applications, (2) to promptly examine this application out of turn, and (3) if any interfering application is discovered, to examine such application simultaneously and state in the first official letter of such application that it is being taken out of turn because of a possible interference.

Petitioner is advised that this application will continue to be special, throughout its entire prosecution and pendency, including interference or appeal, if any, only if petitioner makes a prompt ***bona fide*** effort, in response to each Office action, to place the application in condition for allowance, even if it is necessary to conduct an interview with the examiner to accomplish this purpose.

SUMMARY: Petition to Make Special **GRANTED**.

Steven N. Meyers
Special Programs Examiner
Technology Center 3600
(703) 308-3868
(703) 605-0586 (facsimile)

SNM/tpl: 4/16/03

DATE 10/22/07 APPLICATION NUMBER 09/910,654

DOC CODE CAFC, RH, PETD DOC DATE 10/4/07

DELIVER THE ATTACHED FIFLE/DOCUMENT TO THE TC SCANNING CENTER

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

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

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

2007-1091
(Serial No. 09/910,654)

IN RE RODGER BURROWS

O R D E R

NOTE: This order is nonprecedential.

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

ORDER

Before Rader, Circuit Judge, Schall, Circuit Judge, and Farnan, District Judge.*

A petition for rehearing having been filed by the Appellant,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED.

The mandate of the court will issue on October 11, 2007.

FOR THE COURT,

Jan Horbaly
Clerk

Dated: 10/04/2007

cc: Richard M. Saccocio
Stephen Walsh

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

OCT 4 - 2007

JAN HORBALY
CLERK

IN RE BURROWS, 2007-1091
(PTO - 09/910,654)

* Honorable Joseph J. Farnan, Jr., District Judge, United States District Court for the District of Delaware, sitting by designation.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

COPY MAILED

MAY 28 2002

OFFICE OF PETITIONS

LYON & LYON LLP
633 WEST FIFTH STREET
SUITE 4700
LOS ANGELES CA 90071

In re Application of
Hubbell, et al.
Application No. 09/910,663
Filed: July 19, 2001
Attorney Docket No. 266/013

DECISION DISMISSING PETITION

This is a decision on the petition filed February 26, 2002 (certificate of mailing date February 13, 2002), requesting in effect that a "Notice to File Corrected Application Papers," mailed December 13, 2001, in the above-identified application be withdrawn in part.

The application was filed on July 19, 2001. However, on January 28, 2001, the Office of Initial Patent Examination mailed a Notice stating that the application had been accorded a filing date of July 19, 2001, and advising applicants that Figures 8b,8d,8e,8f,16b, and 18b described in the specification appeared to be missing.

In response, the present petition was filed. The petition argues that Figure 8 was incorrectly referred to as "Figures 8A-F" in the specification and that Figure 16a and Figure 18A were incorrectly labeled "Figure 2b" and "Figure 4b." Petitioners have submitted corrected formal drawings and a preliminary amendment requesting, *inter alia*, that references to "Figures 8A-F" in the specification be altered to read "Figure 8"

A review of the drawings filed on July 19, 2001, confirms that they included all intended figures, albeit some with incorrect labels.
It appears from the petition that no drawing was actually missing on July 19, 2001, and that applicants do not wish to file any additional sheets of drawings. Instead, the references to Figures 8A-F in the specification are typographical errors and Figure 16a and Figure 18A were incorrectly labeled "Figure 2b" and "Figure 4b."

Therefore, the application will be processed and examined using the substitute sheets of drawings filed on with the instant petition.

However, the "Notice" mailed December 13, 2001, was correct in advising applicants that the drawings of Figures 8A-F, 16b, and 18b appeared to have been omitted. Therefore, the "Notice" was properly mailed and will not be withdrawn in part.

The petition is dismissed.

The application is being returned the Office of Initial Patent Examination with the presently accorded filing date of July 19, 2001, for further processing, using the 22 sheets of formal drawings submitted with the instant petition.

Telephone inquiries concerning this decision should 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

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6,751,601	2004-06-15	09/910,672	2001-07-20	

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	/DanielFNesbitt/	Date (YYYY-MM-DD)	2008-09-29
Name	Daniel F. Nesbitt	Registration Number	33746

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. 6751601
Issue Date: June 15,2004
Application No. 09910672
Filed: July 20,2001
Attorney Docket No.

:

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

:

This is a decision on the electronic petition, filed September 29,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of September 29,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

THELEN REID BROWN RAYSMAN & STEINER LLP
PO BOX 640640
SAN JOSE CA 95164-0640

COPY MAILED

MAR 3 1 2008

In re Application of	:	
Adam G. KERRISON et al.	:	
Application No. 09/910,676	:	DECISION ON PETITION
Filed: July 20, 2001	:	
Attorney Docket No. **3882/7**	:	

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed October 11, 2007, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely file a reply within the meaning of 37 CFR 1.113 to the final Office action of September 15, 2006. The proposed reply required for consideration of a petition to revive must be a Notice of Appeal (and appeal fee required by 37 CFR 41.20(b)(2), an amendment that *prima facie* places the application in condition for allowance, a Request for Continued Examination and submission (37 CFR 1.114), or the filing of a continuing application under 37 CFR 1.53(b). See MPEP 711.03(c)(III)(A)(2). No extension of time pursuant to the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the date of abandonment of this application is December 16, 2006.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of a Request for Continued Examination (RCE) and fee of $810, and the submission required by 37 CFR 1.114; (2) the petition fee of $1540; and (3) a proper statement of unintentional delay.

An extension of time under 37 CFR 1.136 must be filed prior to the expiration of the maximum extendable period for reply. See In re Application of S., 8 USPQ2d 1630, 1631 (Comm'r Pats. 1988). Since the $1050 extension of time fee submitted with the petition on October 11, 2007 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

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

There is no indication that the person signing the petition was ever given a power of attorney to prosecute the application. If the person signing the petition desires to receive future correspondence regarding this application, the appropriate power of attorney document must be submitted. While a courtesy copy of this decision is being mailed to the person signing the petition, all future correspondence will be directed to the address currently of record until appropriate instructions are received.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-2783.

This application is being referred to Technology Center AU 2155for processing of the RCE and for appropriate action by the Examiner in the normal course of business on the amendment submitted in accordance with 37 CFR 1.114.

David Bucel
Petitions Examiner
Office of Petitions

cc: **TIMOTHY J. BECHEN**
DREIER LLP
499 PARK AVENUE
NEW YORK, NY 10022

UNITED STATES 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

EUGENE R. MONTALVO
SHELL OIL COMPANY
LEGAL - INTELLECTUAL PROPERTY
P.O. BOX 2463
HOUSTON, TX 77252-2463

COPY MAILED
SEP 24 2003
OFFICE OF PETITIONS

In re Application of :
Bass, et al. :
Application No. 09/910,696 : ON PETITION
Filed: July 20, 2001 :
Attorney Docket No. 002484.0199 :

This is a decision on the petition under 37 CFR 1.137(b), filed August 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 Notice to File Missing Parts of Application (Notice) mailed September 5, 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 November 6, 2001.

The file is being forwarded to the Office of Initial Patent Examination for further processing and charging of the filing fees to deposit account no. 19-1800.

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

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

Best Available Copy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 2409

Paper No.: _____

TO SPE OF : ART UNIT 2651

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/910712 Patent No.: 6418109

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: Should COFC be approved

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

C. Young
Certificates of Correction Branch
703-308-9390 ext. 17

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: _____

WAYNE YOUNG
SUPERVISORY ~~PATENT EXAMINER~~ SPE

2627
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

MR. WALTER J. TENCZA JR.
SUITE 3
10 STATION PLACE
METUCHEN, NJ 08840

COPY MAILED

MAR 15 2005

OFFICE OF PETITIONS

In re Patent No. 6,819,340 :
Issued: November 16, 2004 :
Application No. 09/910,724 : ON PETITION
Filed: July 23, 2001 :
Patentee: Paul E. Burke :

This is a decision on the petition under 37 CFR 1.182, filed January 3, 2005, requesting issuance of a duplicate Letters Patent for the above-identified patent.

The petition is dismissed because it lacks the required petition fee pursuant to 37 CFR 1.17(f).

Effective December 8, 2003, the fee for a petition under 37 CFR 1.182 was increased to $400. Any fee amount paid on or after December 8, 2004, must be paid at the revised amount. Petitioner submitted a petition fee of $130.00. Since the petition does not include an authorization to charge a fee deficiency to a deposit account, a $270.00 petition fee deficiency exists.

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 the $270 petition fee deficiency and a cover letter entitled "Renewed Petition under 37 CFR 1.182." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Alternatively, petitioner may request a refund of the partial petition fee within the two-month period.

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 **(703) 872-9306**.

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

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

UNITED STATES 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

JUL 2 8 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400

In Re Application:
BAER, RICHARD L.
Appl No. **09/910,726**
Filed: July 24, 2001
Attorney Docket No. **10001850**

NOTICE OF WITHDRAWAL
FROM ISSUE
UNDER 37 CFR 1.313(b)

The above-identified application is withdrawn from issue after payment of the issue fee due to unpatentability of one or more claims. See 37 CFR 1.313(b).

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 Bhavesh Mehta 571-272-7453.

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

Leo Boudreau

Leo Boudreau
Acting Director TC 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MICHAEL A SANZO
FITCH EVEN TABIN & FLANNERY
1801 K ST NW
SUITE 401L
WASHINGTON DC 20006-1201

COPY MAILED

DEC 0 8 2004

OFFICE OF PETITIONS

In re Application	:	
Jack Rogers	:	
Application No. 09/910,757	:	DECISION ON APPLICATION
Filed: July 24, 2001	:	FOR PATENT TERM ADJUSTMENT
Atty Docket No. 81994/282402	:	

This is a decision on the "Petition for Correction of Patent Term Adjustment Calculation Under 37 C.F.R. § 1.705(b)," filed August 23, 2004. Applicant requests that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from one hundred ninety-three (193) days to three hundred forty-five (345) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **three hundred forty-five (345) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On July 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 (PTA) to date is one hundred ninety-three (193) days. On August 23, 2004, Applicant timely[1] submitted the instant application for patent term adjustment,

[1] Applicant filed the application for patent term adjustment prior to filing the issue fee.

asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is three hundred forty-five (345) days.

Applicant asserts entitlement to a patent term adjustment of three hundred forty-five (345) days on the basis that the PTO should have been assessed delay of three hundred forty-five days (345) for mailing a first Office action on September 4, 2003.

Applicant states 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 ninety-three (193) days based on an adjustment for PTO delay of one hundred ninety-three (193) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. § 1.703(a)(1), reduced by zero (0) days of applicant delay. The adjustment of one hundred ninety-three (193) days is at issue.

The adjustment of one hundred ninety-three (193) days has been found to be incorrect. The application was filed on July 24, 2001. The Office had fourteen months from that date, or until September 24, 2002, to mail either an action under 35 U.S.C. 132 or a Notice of Allowance. An action under 35 U.S.C. 132 was not mailed until September 4, 2003. Therefore, PTO delay should have been assessed as three hundred forty-five (345) days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **three hundred forty-five (345) days** (345 days of PTO delay and 0 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 (571)272-3207.

Karin A Ferriter
per

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

Enclosure: Copy of Revised PAIR Screen

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

TODD J. BURNS
FOLEY & LARDNER
SUITE 500, 3000 K STREET, N.W.
WASHINGTON, D.C. 20007-5109

COPY MAILED

AUG 2 6 2002

OFFICE OF PETITIONS

In re Application of	:	
Barry L. Reed et al	:	
Application No. 09/910,780	:	NOTICE
Filed: July 24, 2001	:	
Attorney Docket No. 017227/0176	:	

This is a notice regarding your request for acceptance of a fee deficiency submission under 37 CFR 1.28. On September 1, 1998, the Court of Appeals for the Federal Circuit held that 37 CFR 1.28(c) is the sole provision governing the time for correction of the erroneous payment of the issue fee as a small entity. **See DH Technology v. Synergystex International, Inc. 154 F.3d 1333, 47 USPQ2d 1865 (Fed. Cir. Sept. 1, 1998).**

The Office no longer investigates or rejects original or reissue applications under 37 CFR 1.56. **1098 Off. Gaz. Pat. Office 502 (January 3, 1989)**. Therefore, nothing in this Notice is intended to imply that an investigation was done.

Your fee deficiency submission under 37 CFR 1.28 is hereby **ACCEPTED**.

Inquiries related to this communication should be directed to the Office of Petitions Staff at (703) 305-9285.

This file is being forwarded to Technology Center 1600.

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

Supersed

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/19/09

TO SPE OF : ART UNIT 3621

SUBJECT : Request for Certificate of Correction for Appl. No.: 09910821 Patent No.: 7031945

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

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

Thank You For Your Assistance

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

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

Comments: _____

J Fischer
SPE

3621
Art Unit

SPE J. McKane

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 09/910,950

Paper No.: _____

DATE : 9/9/05

TO SPE OF : ART UNIT 1626

SUBJECT : Request for Certificate of Correction on Patent No.: 6,897,231 (09/910,950)

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

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

Lamonte M. Newsome

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-305-8309

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

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

Comments:

JOSEPH K. McKANE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

SPE

1626
Art Unit 9/19/05

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.
09/910,952	07/24/2001	Duck Chul Hwang	1567.1015	3638

49455 7590 05/14/2008
STEIN, MCEWEN & BUI, LLP
1400 EYE STREET, NW
SUITE 300
WASHINGTON, DC 20005

EXAMINER
WEINER, LAURA S

ART UNIT	PAPER NUMBER
1795	

MAIL DATE	DELIVERY MODE
05/14/2008	PAPER

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

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

UNITED STATES PATENT and TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
WWW.USPTO.GOV

5-14-08

chk

In re application of HWANG et al.
Serial no. 09/910952
Filed: July 24, 2001
For: ELECTROLYTE FOR A LITHIUM-SULFUR BATTERY AND A LITHIUM SULFUR BATTERY USING THE SAME

: DECISION
: ON
:PETITION

This is a decision on the PETITION FILED UNDER 37 CFR 1.181 TO WITHDRAW THE FINALITY OF THE OFFICE ACTION of September 17, 2007.

After filing an RCE on April 24, 2007, the examiner submitted a non-final office action including only 35 U.S.C. 112, first and second paragraph rejections. The examiner noted there was no support the instantly claimed lithium in the positive electrode and claims also lacked support for the sulfur in the negative electrode. Applicant responded by amending claims 4, 11 and 12 to include the positive electrode including sulfur and the negative electrode including lithium. Applicant also amended claim 11 to further define "first solvent" having a polarity sufficient to dissolve Li2Sn (n = 1, 2, 4, 6, 8). The examiner then finally rejected claims 4, 8-13, 29, 34 and 35. The examiner also indicated allowability of claims 14, 16, 17, 36-39.

Petitioner alleges that the finality is improper because the finality was not necessitated by amendments to the claims.

DECISION

The MPEP at 706.07 states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Applicant submitted claim amendments to overcome the rejections under 35 U.S.C., 112, first paragraph. It could not have been predicted that applicant would amend claims in the manner that was done. Applicant has limited the first solvent to have a sufficient polarity high enough to dissolve Li2Sn (n = 1, 2, 4, 6, 8). This feature was not previously claimed. Applicant also amended claims 4, 11 and 12 to include the positive electrode including sulfur and the negative electrode including lithium. Therefore, the final rejection was the result of amendments to claims 4, 11 and 12.

The petition is **DENIED**.

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

STEIN, MCEWEN & BUI
1400 EYE STREET
SUITE 300
WASHINGTON, D.C. 20005

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STEVENS DAVIS MILLER & MOSHER
1615 L STREET, N.W., SUITE 850
WASHINGTON, DC 20036

COPY MAILED

JUL 0 7 2005

OFFICE OF PETITIONS

In re Application of :
Ola Olofsson et al :
Application No. 09/910,960 : ON PETITION
Filed: July 24, 2001 :
Attorney Docket No. TPP 30887CIP2 :

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 within the meaning of 37 CFR 1.113 in a timely manner to the final Office action mailed September 9, 2004 which set a shortened statutory period for reply of three (3) months. A reply under 37 CFR 1.113 is limited to an amendment that *prima facie* places the application in condition for allowance or a Notice of Appeal (and appeal fee required by 37 CFR 1.17(b)). The amendment submitted on December 8, 2004 did not *prima facie* place the application in condition for allowance as noted in the Advisory Action mailed March 15, 2005. Therefore, as no Notice of Appeal (and appeal fee), Request for Continued Examination (RCE) or a continuing application was timely filed, and no extension of time under the provisions of 37 CFR 1.136(a) was obtained. Accordingly, the above-identified application became abandoned on December 10, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of a Request for Continued Examination (RCE); (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the final Office action of September 9, 2004 is accepted as having been unintentionally delay.

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

The application file is being forwarded to Technology Center AU 3679.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

STEVENS, DAVIS, MILLER & MOSHER, L.L.P.
Suite 850
1615 L Street, N.W.
Washington DC 20036

COPY MAILED

MAY 19 2008

In re Application of	:	
Ola Olofsson et al	:	
Application No. 09/910,960	:	ON PETITION
Filed: July 24, 2001	:	
Attorney Docket No. TPP 30887CIP2	:	

This is a decision on the petition under 37 CFR 1.137(b), filed January 28, 2008, 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 a complete and proper appeal brief within the time period provided in 37 CFR 41.37(a)(1). An appeal brief was filed September 25, 2006 but was non-compliant, see Notification of Non-Compliant Appeal Brief mailed December 4, 2006 which gave a response time of one month or 30 days. Another appeal brief was filed January 4, 2007 but was non-compliant, see the Notification of Non-Compliant Appeal Brief mailed April 24, 2007 which gave no extended time. A third appeal brief was filed May 2, 2007 (along with a four month extension of time) but was non-compliant, see Notification of Non-Compliant Appeal Brief mailed July 18, 2007. The appeal was dismissed and the proceedings as to the rejected claims were terminated. *See* 37 CFR 1.197(b). As no claims were allowed, the application became abandoned on May 5, 2007. *See* MPEP 1215.04.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an appeal brief; (2) the petition fee of $1,540; and (3) the required statement of unintentional delay have been received. Accordingly, the appeal brief is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to Carl Friedman at (571) 272-6842.

The application file is being referred to Technology Center Art Unit 3679 for consideration of the Appeal Brief.

Christopher Bottrell

for David Bucci
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

MAR 2 8 2007

OFFICE OF PETITIONS

In re Application of

Katsuaki Akama

Application No. 09/910,963

Filed: July 23, 2001

Attorney Docket No. FUJ 18.626

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment, filed January 22, 2007.

The petition under 37 CFR 1.181(a) to withdraw the holding of abandonment is **granted**.

This application was held abandoned on August 19, 2006, after it was believed that no response was received to the final Office action mailed April 18, 2006. The action allowed a shortend statutory period for reply of three-months from its mailing date. Extensions of the time set for reply were available pursuant to 37 CFR 1.136(a). A response was filed on August 7, 2006, with a request for an extension of time within the first month. An Advisory Action mailed August 17, 2006, explained that the response of August 7, 2006, did not place the application in condition for allowance. A Notice of Abandonment was mailed on January 16, 2007, indicating that a reply to the final Office action was not received.

The instant petition maintains that a Request for Continued Examination (RCE) responsive to the final Office action was transmitted via facsimile on September 8, 2006, along with a request for an extension of time within the second month. A copy of the RCE containing a certificate of facsimile transmission dated September 8, 2006, and a copy of the transmission sheet noting five pages as having been successfully transmitted to the USPTO on September 8, 2006, accompanied the petition.

Based on the aforementioned, it appears that the application was improperly held abandoned as a proper response was received prior to expiration of the period for reply. The holding of abandonment is withdrawn, accordingly.

Deposit account 50-1290 will be charged $790.00 for the RCE and $450.00 for the request for an extension of time within the second month.

The application file is being forwarded Technology Center 2600 GAU 2614, for further processing including the consideration of the RCE, which will be noted as having been timely received.

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

NOV 30 2004

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 3600

ANDERSON, LEVINE & LINTEL
12160 ABRAMS ROAD
SUITE 111
DALLAS TX 75243

In re application of Stephen G. Argenbright Application No. 09/910,964 Filed: July 20, 2001 For: ONLLINE INVESTMENT TRUST CREATION AND MANAGEMENT	: : : :	**DECISION ON PETITION TO MAKE SPECIAL (INFRINGEMENT)**

This is a decision on the petition under 37 C.F.R § 1.102(d) filed August 26, 2004 to make the above-identified application special.

The petition requests that the above-identified application be made special under the procedure set forth in M.P.E.P. § 708.02, item II: Infringement.

MPEP 708.02 states that a Petition to Make Special based on Infringement must have the following: (1) the appropriate petition fee under 37 CFR 1.17(h); (2) a statement by the assignee, applicant, or attorney alleging: (A) that there is an infringing device or product actually on the market or method in use; (B) that a rigid comparison of the alleged infringing device, product or method with the claims of the application has been made, and that, in his or her opinion, some of the claims are unquestionably infringed; and (C) that he or she has made a careful and thorough search of the prior art, or has good knowledge of the prior art, and has sent a copy of the references deemed most closely related to the subject matter encompassed by the claims.

The petition filed August 26, 2004 meets all of the requirements above and, therefore, the petition is **GRANTED**.

With regards to element 2(C) above, an Information Disclosure Statements were filed on September 27, 2004, June 14, 2004 and January 8, 2002.

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 and 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.

Randolph A. Reese
Special Programs Examiner
Technology Center 3600
(703) 308-2121

RAR: 11/23/04

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)
6568949	2003-05-27	09/910,972	2001-07-20	117914-1040

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	/Amelia F. Morani/	Date (YYYY-MM-DD)	2007-10-19
Name	Amelia F. Morani	Registration Number	52049

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. 6568949
Issue Date: May 27,2003
Application No. 09910972
Filed: July 20,2001
Attorney Docket No. 5907.36020

:

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

:

This is a decision on the electronic petition, filed October 19,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 19,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES 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. 5

SAMUEL H DWORETSKY
AT&T CORP
PO BOX 4110
MIDDLETOWN NJ 07748-4110

COPY MAILED

JUN 3 0 2003

OFFICE OF PETITIONS

In re Application of Chen, et al. Application No. 09/910,987 Filed: July 23, 2001 Attorney Docket No. 2000-0183	: : : : :	ON PETITION

This is a decision on the petition to revive under 37 CFR 1.137(f), filed May 19, 2003, which is being treated as a petition under 37 CFR 1.137(b).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of a PCT international application filed on July 22, 2002. However, the US Patent and Trademark Office was unintentionally not notified of this filing within 45 days subsequent to the filing of the PCT application.

In view of the above, 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 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 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 indicating a projected publication date of October 9, 2003 accompanies this decision on petition.

The application is being forwarded to Technology Center 2100 for examination in due course.

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

Cliff Congo

Cliff Congo
Petitions Attorney
Office of Petitions

Enc: Notice Regarding Rescission of Nonpublication Request
(1 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

Samuel H. Dworetsky
AT&T CORP.
P.O. Box 4110
Middletown NJ 07748-4110

COPY MAILED

JAN 28 2009

OFFICE OF PETITIONS

In re Application of
Yihsiu Chen, et. al.
Application No. 09/910,987
Filed: July 23, 2001
Attorney Docket No. 2000-0183

DECISION ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed January 15, 2009, 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 application became abandoned for failure to reply in a timely manner to the Restriction Requirement/Election, mailed August 31, 2006, 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 October 1, 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).

There are three periods to be considered during the evaluation of a petition under 37 CFR 1.137(b):

(1) the delay in reply that originally resulted in the abandonment;

(2) the delay in filing an initial petition pursuant to 37 CFR 1.137(b) to revive the application; and

(3) the delay in filing a grantable petition pursuant to 37 CFR 1.137(b) to revive the application.

Currently, the delay has not been shown to the satisfaction of the Director to be unintentional for periods (1) and (2).

As to Period (1):

The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "under this section a petition accompanied by either a fee of $500 or a fee of $50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), *reprinted in* 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Director to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where, as here, there is a question whether the initial delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). *See* In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989); 37 CFR 1.137(b). Here, in view of the inordinate delay (over 2 years) in resuming prosecution, there is a question whether the entire delay was unintentional. Petitioner should note that the issue is not whether some of the delay was unintentional by any party; rather, the issue is whether the entire delay has been shown to the satisfaction of the Director to be unintentional.

The question under 37 CFR 1.137(b) for period (1) is whether the delay on the part of the party having the right or authority to reply to avoid abandonment (or not reply) was unintentional. Accordingly, any renewed petition must clearly identify the party having the right to reply to avoid abandonment on September 1, 2006. That party, in turn must explain what effort(s) was made to further reply to the outstanding Office action and, further, why no reply was filed. If no effort was made to further reply, then that party must explain why the delay in this application does not result from a deliberate course of action (or inaction). Likewise, as AT&T Corp. was counsel of record at the time of abandonment, they should explain why this application became abandoned while it was under their control and what efforts they made to further reply of itself and with whom this matter was discussed. Copies of any correspondence relating to the filing, or to not filing a further reply to the outstanding Office action are required from responsible person(s), and whoever else was involved with this application at the time of abandonment. Statements are required from any and all person(s) having firsthand knowledge of the circumstances surrounding the lack of a reply to the outstanding Office action. As the courts have made clear, it is pointless for the USPTO to revive a long abandoned application without an adequate showing that the delay did not result from a deliberate course of action. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005); Lumenyte Int'l Corp. v. Cable Lite Corp., Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996) (unpublished) (patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional).

As to Period (2):

Likewise, where the applicant deliberately chooses not to seek or persist in seeking the revival of an abandoned application, or where the applicant deliberately chooses to delay seeking the revival of an abandoned application, the resulting delay in seeking revival of the abandoned application cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). *See* MPEP 711.03(c).

The language of both 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b) are clear and unambiguous, and, furthermore, without qualification. That is, the delay in filing the reply during prosecution, as well as in filing the petition seeking revival, must have been, without qualification, "unintentional" for the reply to now be accepted on petition. The Office requires that the entire delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. *See* H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner . . . could require applicants to act promptly after becoming aware of the abandonment"). The December 1997 change to 37 CFR 1.137 did not create any new right to overcome an intentional delay in seeking revival, or in renewing an attempt at seeking revival, of an abandoned application. *See* Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. 53131, 53160 (October 10, 1997), 1203 Off. Gaz. Pat. Office 63, 87 (October 21, 1997), which clearly stated that any protracted delay (over 2 years) could trigger, as here, a request for additional information. As the courts have since made clear, a protracted delay in seeking revival, as here, requires a petitioner's detailed explanation seeking to excuse the delay as opposed to USPTO acceptance of a general allegation of unintentional delay. *See* Lawman Armor v. Simon, 2005 U.S. Dist. LEXIS 10843, 74 USPQ2d 1633, at 1637-8 (DC EMich 2005); Field Hybrids, LLC v. Toyota Motor Corp., 2005 U.S. Dist. LEXIS 1159 (D. Minn Jan. 27, 2005) at *21-*23. Statements are required from any and all persons then at AT &T Corp. and the responsible person(s) having firsthand knowledge of the circumstances surrounding the protracted delay, after the abandonment date, in seeking revival.

As noted in MPEP 711.03(c)(II), subsection D, in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

> (A) the date that the applicant first became aware of the abandonment of the application; and
> (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application. *See also* New York University v. Autodesk, 2007 U.S. DIST LEXIS, U.S.District LEXIS 50832, *10 -*12 (S.D.N.Y. 2007)(protracted delay in seeking revival undercuts assertion of unintentional delay).

Any renewed petition may be addressed as follows:

By Mail: Mail Stop PETITION
Commissioner for Patents
P. O. Box 1450

Alexandria, VA 22313-1450

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

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

Correspondence regarding this decision may also be filed through the electronic filing system of the USPTO.

To expedite consideration, petitioner may wish to contact the undersigned regarding the filing of the renewed petition under 37 CFR 1.137(b).

Telephone inquiries concerning this decision should be directed to Denise Williams at (571) 272-8930.

Brian W. Brown
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

SAMUEL H. DWORETSKY
AT&T CORP.
P.O. BOX 4110
MIDDLETOWN NJ 07748-4110

MAILED

APR 14 2009

OFFICE OF PETITIONS

In re Application of	:	
Yihsiu Chen et al	:	
Application No. 09/910,987	:	DECISION ON PETITION
Filed: July 23, 2001	:	
Attorney Docket No. 2000-0183	:	

This is a decision on the renewed petition under the unintentional provisions of 37 CFR 1.137(b), filed March 30, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amendment/election; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the restriction requirement mailed August 31, 2006, is accepted as having been unintentionally delayed.

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

This application is being referred to Technology Center AU 2152 for appropriate action by the Examiner in the normal course of business on the reply received January 15, 2009.

Karen Creasy

Karen Creasy
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
DIW 11-01

Paper No. 3

CHARLES D. GUNTER, JR.
BRACEWELL & PATTERSON, LLP
SUITE 1600
201 MAIN STREET
FORT WORTH, TX 76102-3105

COPY MAILED

NOV 0 5 2001

OFFICE OF PETITIONS

In re Application of :
Rajan K. Vempati :
Application No. 09/911,021 : DECISION GRANTING PETITION
Filed: 20 July, 2001 :
Attorney Docket No. 0778CG.03557 :

This is a decision on the "Request for Correction of Filing Receipt" filed on 17 September, 2001, which is treated as a petition under 37 CFR 1.10(c) requesting that the above-identified application be accorded a filing date of 20 July, 2001, rather than the presently accorded filing date of 24 July, 2001.

Petitioner alleges that the application was deposited in Express Mail service on 20 July, 2001. Although petitioner has not provided a copy of the Express Mail label, a search of the USPTO USPS Express Mail database reveals that a mailing bearing Express Mail Label No. EL729730115US (the same Express Mail number found on the itemized transmittal sheet accompanying the original application papers located in the official file) was accepted by the USPS (i.e. given a "date-in" of) 20 July, 2001.

In view of the above, the petition is granted. No petition fee is required and none has been charged.

Petitioners should note that the requirement for a certificate of mailing by "Express Mail" has been waived by the Commissioner,[1]

The application is being forwarded to the Office of Initial Patent Examination for correction of the filing date to **20 July, 2001.**

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

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

Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

UNITED STATES PATENT AND TRADEMARK OFFICE

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

#4
5/30/02

MAY 30 2002

Paper No. 4

Mark Pohl
55 Madison Avenue
4th Floor
Morristown, New Jersey 07960

In re Application of: Stephen M. Reuning et al.	)	
Application No. 09/911,024	)	
Filed: July 24, 2001	)	**DECISION ON PETITION FOR**
For: AUTOMATED PROSPECTOR AND	)	**ACCELERATED EXAMINATION**
TARGETED ADVERTISEMENT	)	**UNDER M.P.E.P. §708.02(I)**
ASSEMBLY AND DELIVERY	)	
SYSTEM	)	

This is a decision on the petition, filed March 18, 2002 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(I): Manufacture, to make the above-identified application special.

M.P.E.P. §708.02, Section I which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. §1.102(d) states in relevant part:

> An application may be made special on the ground of prospective manufacture upon the filing of a petition accompanied by the fee under 37 CFR 1.17(h) and a statement by the applicant, assignee or an attorney/agent registered to practice before the Office alleging:
>
> > (A) The possession by the prospective manufacturer of sufficient presently available capital (stating approximately the amount) and facilities (stating briefly the nature thereof) to manufacture the invention in quantity or that sufficient capital and facilities will be made available if a patent is granted; If the prospective manufacturer is an individual, there must be a corroborating statement from some responsible party, as for example, an officer of a bank, showing that said individual has the required available capital to manufacture;
> >
> > (B) That the prospective manufacturer will not manufacture, or will not increase present manufacture, unless certain that the patent will be granted;
> >
> > (C) That the prospective manufacturer obligates himself, herself or itself, to manufacture the invention, in the United States or its possessions, in quantity immediately upon the allowance of claims or issuance of a patent which will protect the investment of capital and facilities; and

(D) That the applicant or assignee has made or caused to be made a careful and thorough search of the prior art, or has a good knowledge of the pertinent prior art.

Applicant must provide one copy of each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record.

Applicant's submission meets all the criteria set out above, accordingly, the Petition is **GRANTED**.

The application file is being forwarded to the Examiner of Record for accelerated examination according to the procedures set forth in M.P.E.P. §708.02, Section VIII.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JOSEPH B. KEJHA
1022 FREDERICK ROAD
MEADOWBROOK, PA 19046

COPY MAILED

DEC 2 2 2004

OFFICE OF PETITIONS

In re Application of :
Kejha et al. :
Application No. 09/911,036 :
Filed: July 23, 2001 :
Attorney Docket No. JBK-10 :

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed December 8, 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 final Office action mailed March 11, 2004. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on June 12, 2004.

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 submitted $685.00 towards payment of the petition fee. However, on December 8, 2004, the petition fee was increased to $750.00. **Accordingly, in order to revive the above-identified application, an additional $65.00 must be submitted.**

Further, papers filed in an 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 undividing 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.**

The instant petition submitted on December 8, 2004, was only signed by one of the three inventors. The signatures of the remaining two inventors must also be included if a renewed petition is filed.

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

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

By hand: Customer Window located at:

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

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

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

Liana Chase

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

JOSEPH B. KEJHA
1022 FREDERICK Rd.
MEADOWBROOK PA 19046

COPY MAILED

FEB 03 2005

OFFICE OF PETITIONS

In re Application of :
Kejha et al. :
Application No. 09/911,036 : ON PETITION
Filed: July 23, 2001 :
Title: Manufacturing Method And Structure Of Electrodes For Lithium Based Electrochemical Devices :

This is a decision on the renewed petition under 37 C.F.R. § 1.137(b), filed January 10, 2005, to revive the above-identified application.

The petition is **GRANTED.**

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 1700 for processing of the Request for Continued Examination under 37 CFR 1.114 filed December 8, 2004.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3282.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

Samuel H. Dworetsky
AT&T Corporation
P. O. Box 4110
Middletown, NJ 07748-4110

COPY MAILED

JUN 26 2003

OFFICE OF PETITIONS

In re Application of	:	
Yihsiu Chen, et al.	:	
Application No. 09/911,061	:	DECISION GRANTING PETITION
Filed: July 23, 2001	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. 2001-0056	:	

This is a decision on the petition filed May 19, 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 July 22, 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 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.

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 2152 for examination in due course.

Marianne E. Morgan

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BAKER & MCKENZIE
805 THIRD AVENUE
NEW YORK, NY 10022

COPY MAILED

AUG 1 6 2004

OFFICE OF PETITIONS

In re Application of :
Christina E. Colabella :
Application No. 09/911,123 : ON PETITION
Filed: July 23, 2001 :
Attorney Docket No. 56145473-17 :

This is a decision on the petition under 37 CFR 1.137(b), filed June 3, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely reply to the final Office action mailed November 19, 2003.

Extensions of time under 37 CFR 1.136 are available only if asked for "prior to or with the response." In no case, however, may an applicant respond later than the maximum time period set by statute. Accordingly, if the question of abandonment arises when the provisions of 37 CFR 1.136 can no longer be used, then the application is abandoned when the unextended time for response has expired. Therefore, no extension of time fees are due on a petition for revival. In view thereof, the $950 extension of time fee submitted with the petition is unnecessary and will be refunded to petitioner's deposit account.

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

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

The application file is being referred to Technology Center AU 3624, for further processing of the request for continued examination under 37 CFR 1.114 filed June 3, 2004.

Sherry D. Brinkley
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
www.uspto.gov

Paper No. 11

COOK, ALEX, MCFARRON, MANZO,
CUMMINGS & MEHLER, LTD.
SUITE 2850
200 WEST ADAMS STREET
CHICAGO IL 60606

COPY MAILED

DEC 1 0 2002

OFFICE OF PETITIONS

In re Application of :
Jun Koyama :
Application No. 09/911,156 : ON PETITION
Filed: July 23, 2001 :
Attorney Docket No. SEL 270 :

This is a decision on the petition, filed by facsimile transmission on December 9, 2002, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on November 13, 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 2821 for processing of the request for continued examination under 37 CFR 1.114.

Karen Creasy

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

---

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 20

COOK, ALEX, MCFARRON, MANZO,
CUMMINGS & MEHLER, LTD.
SUITE 2850
200 WEST ADAMS STREET
CHICAGO, IL 60606

COPY MAILED
DEC 15 2003
OFFICE OF PETITIONS

In re Application of
Jun Koyama
Application No. 09/911,156
Filed: July 23, 2001
Attorney Docket No. SEL 270

ON PETITION

This is a decision on the petition, filed December 12, 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 26, 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 2821 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).

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : May 9, 2007

TO SPE OF : ART UNIT **1614**

SUBJECT : Request for Certificate of Correction on Patent No.: **09/911195 – 7071230B2**

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

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

Thank You For Your Assistance

Elisha Evans
Certificates of Correction Branch
Tel. No. 703-308-9390 EXT 110

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

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

Comments:

_____

_____

_____

_____

_____

ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER

Ardin H. Marschel
SPE

1614
Art Unit

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

DALY, CROWLEY & MOFFORD, LLP
SUITE 101
275 TURNPIKE STREET
CANTON, MA 02021-2310

COPY MAILED

MAR 0 4 2003

OFFICE OF PETITIONS

In re Application of
Foulger, et al.
Application No. 09/911,216
Filed: July 23, 2001
Attorney Dkt. No. EMPIR-024AUS
For: METHOD OF BACKTRACING
NETWORK PERFORMANCE

DECISION REFUSING STATUS UNDER 37 CFR 1.47(b)

This is in response to the petition under 37 CFR 1.47(b), filed August 24, 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 July 23, 2001 without an executed oath or declaration and naming Davis Foulger, John Esposito, William Babcock, Robert McElhaney, and William Minckler as joint inventors. Accordingly, on August 24, 2001, a Notice to File Missing Parts of Application was mailed, requiring, among other items, an executed oath or declaration, and a surcharge for its late filing.

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), an oath or declaration for the patent application in compliance with 37 CFR 1.63 has not been presented. Please note that a declaration signed by one other than a named inventor should be executed by a corporate officer, such as the president, vice president, secretary, or treasurer on behalf of and as agent for the non-signing

inventors. The corporate officer's title and address 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. *See*, MPEP 409.03(b). Any renewed petition must be accompanied by a declaration in full compliance with 37 CFR 1.63.

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 an applicant, that the inventors have agreed in writing to assign the invention to an applicant, or that an applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application. Petitioner must submit a copies of employment agreements between the inventors and an applicant or a legal memorandum signed by an attorney familiar with the law of the jurisdiction stating that a court of competent jurisdiction would by weight of authority in that jurisdiction award title of the invention to a Rule 47 applicant.

As to item (6), petitioner has failed to present a showing that such action is required to preserve the rights of the parties or to prevent irreparable damages. Any renewed petition must be accompanied by a statement that status under Rule 47 is necessary to preserve the rights of the parties involved or to prevent irreparable damages to an applicant.

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 Assistant Commissioner
for Patent Policy and Projects

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

COPY MAILED

JUN 23 2003

OFFICE OF PETITIONS

DALY, CROWLEY & MOFFORD, LLP
SUITE 101
275 TURNPIKE STREET
CANTON, MA 02021-2310

In re Application of
Foulger, et al.
Application No. 09/911,216
Filed: July 23, 2001
Attorney Dkt. No. EMPIR-024AUS
For: METHOD OF BACKTRACING
NETWORK PERFORMANCE

DECISION REFUSING STATUS UNDER 37 CFR 1.47(b)

This decision is in response to the renewed petition under 37 CFR 1.47(b), filed May 14, 2003.

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 July 23, 2001 without an executed oath or declaration and naming Davis Foulger, John Esposito, William Babcock, Robert McElhaney, and William Minckler as joint inventors. Accordingly, on August 24, 2001, a Notice to File Missing Parts of Application was mailed, requiring, among other items, an executed oath or declaration, and a surcharge for its late filing. A petition under 37 CFR 1.47(b) was filed January 7, 2002 and dismissed March 4, 2003.

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. An oath or declaration for the patent application in compliance with 37 CFR 1.63 has not been presented. Please note that a declaration signed by one other than a named inventor should be executed by a corporate officer, such as the president, vice president, secretary, or treasurer on behalf of and as

agent for the non-signing inventors. The corporate officer's title and address 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. *See*, MPEP 409.03(b). Any renewed petition must be accompanied by a declaration in full compliance with 37 CFR 1.63.

While petitioner has provided a declaration, the declaration is not executed. David W. Rouille states he is "authorized to sign the present oath on behalf of Empirix, Inc.," however, a declaration rather than an oath has been presented. Moreover, Mr. Rouille has not executed the document. It is also worth noting that the inventor's are misnumbered on the document wherein John Esposito and William Babcock are both designated as the fourth joint inventor.

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 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 Assistant Commissioner
for Patent Policy and Projects

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

DALY, CROWLEY & MOFFORD, LLP
SUITE 101
275 TURNPIKE STREET
CANTON, MA 02021-2310

COPY MAILED

JUL 21 2003

OFFICE OF PETITIONS

In re Application of Foulger, et al. Application No. 09/911,216 Filed: July 23, 2001 Attorney Dkt. No. EMPIR-024AUS For: METHOD OF BACKTRACING NETWORK PERFORMANCE	DECISION GRANTING STATUS UNDER 37 CFR 1.47(b)

This decision is in response to the renewed petition under 37 CFR 1.47(b), filed July 11, 2003.

The petition is **GRANTED**.

Petitioner has shown that inventors Davis Foulger, John Esposito, William Babcock, Robert McElhaney, and William Minckler either cannot be reached or located or having been presented with a copy of the above-identified application papers refuse to join in the filing of the application.

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 regarding this decision should be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6,486,434	2002-11-26	09/911,237	2001-07-23	69012-51

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

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

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

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

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/W. Scott Harders/	Date (YYYY-MM-DD)	2007-05-17
Name	W. Scott Harders	Registration Number	42629

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

Privacy Act Statement

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

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

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

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

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

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

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

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

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

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

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

UNITED STATES 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. 6486434
Issue Date: November 26,2002
Application No. 09911237
Filed: July 23,2001
Attorney Docket No. LSP-43

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

This is a decision on the electronic petition, filed May 18,2007 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

The maintenance fee is accepted, and the above-identified patent reinstated as of May 18,2007 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in an Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

WK

Mailed: 5-17-06

In re application of	:	
Thomas Eckel et al.	:	DECISION ON
Serial No. 09/911,268	:	PETITION
Filed: July 23, 2001	:	
For: Flame-Resistant Polycarbonate Compositions	:	

This is a decision on PETITION TO EXPUNGE UNDER 37 C.F.R. 1.59(b), filed February 2, 2006, which has been accepted as a timely petition under 1.59(b) and MPEP 724.02 and is before the Group Director of Technology Center for consideration.

DECISION

Petitioner requests that the Appeal Brief dated January 10, 2006 be expunged. The Appeal Brief is neither related nor material to the present application. Each of the criteria for granting the request has been satisfied, see the MPEP 724.05.

The petition is **GRANTED.**

Section 1.59 has been amended to eliminate references to returning documents that have been expunged to recognize that, with electronic Official files, there will be nothing to return when a paper is expunged.

The Office is capturing electronic images of all documents that form the Official file. Where the image is generated from a physical source document, the originating document may be disposed of once the electronic image accuracy is verified. The paper source document will eventually be destroyed under a United States National Archives and Records Administration (NARA) approved schedule. Therefore, if a document is to be expunged from the record, the only operation that will be required will be removal of the image from the Official file.

Paragraph (a)(1) of §1.59 has been amended by deleting the phrase "and returned " from the first sentence, and deleting the second sentence. Paragraph (b) of §1.59 has been amended by deleting the phrase "and return " from each of the first and second sentences. The Office will continue to provide notice in the Official file that a paper has been expunged and the Office will send a decision to the applicant notifying the applicant that the paper has been expunged.

09/911,268

The image of the appeal brief will be removed from the Official file.

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

James R. Franks
Bayer Material Science LLC
100 Bayer Road
Pittsburgh, Pennsylvania 15205-9741

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALEXANDER ZINCHUK
ABELMAN FRAYNE & SCHWAB
666 THIRD AVENUE, 10TH FLOOR
NEW YORK, NY 10017-5621

COPY MAILED

MAR 2 2 2006

OFFICE OF PETITIONS

In re Patent No. 6,950,639 :
Issue Date: September 27, 2005 :
Application No. 09/911,272 : ON PETITION
Filed: July 23, 2001 :
Attorney Docket No. DT-3989 :

This is a decision on the petition under 37 CFR 1.183, filed December 7, 2005, which is being treated under 37 CFR 3.81(b), to add the second assignee on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **dismissed**.

Petitioner requests issuance of a certificate of correction to permit the addition of the second assignee **Jenoptik Laser, Optik, Systeme GmbH, Jena (DE)** on the front page of the Letters Patent. However, a copy of the assignment submitted with the instant petition indicates that the inventors assigned their rights to **Jenoptik Aktiengesellschaft, Jena, Germany.** Therefore, since the assignment do not reflect the second assignee's name sought by the Certificate of Correction herein, it would not be appropriate to issue a Certificate of Correction.

However, it would be appropriate to grant the instant petition of a certificate to reflect the second assignee data as Jenoptik Aktiengesellschaft, Jena, Germany, on the front page of the Letters Patent. Accordingly, if petitioner desires to have the assignee data corrected on the front page of the Letters Patent, petitioner should submit a request for reconsideration under 37 CFR 3.81, along with a request for a Certificate of Correction and USPTO Form 1050.

Petitioner may wish to submit a corrected cover sheet in accordance with 37 CFR 3.34 and MPEP 323.01, since the present assignment as recorded in the USPTO does not indicate Jenoptik Aktiengesellschaft as an assignee for this patent file.

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

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

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

By fax: (571) 273-8300

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

Wan Laymon

Wan Laymon
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

ALEXANDER ZINCHUK
ABELMAN FRAYNE & SCHWAB
666 THIRD AVENUE, 10TH FLOOR
NEW YORK, NY 10017-5621

COPY MAILED

AUG 31 2006

OFFICE OF PETITIONS

In re Patent No. 6,950,639	:	
Issue Date: September 27, 2005	:	
Application No. 09/911,272	:	ON PETITION
Filed: July 23, 2001	:	
Attorney Docket No. DT-3989	:	

This is a decision on the renewed petition filed April 6, 2006, under 37 CFR 3.81(b) to include a second assignee, Jenoptik Aktiengesellschaft, of Jena, Germany, on the front page of the above-identified patent by way of a Certificate of Correction.

The petition is **GRANTED**.

The patent file is being referred to the Certificates of Correction Branch for issuance of the requested Certificate of Correction.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3218. Inquiries regarding the issuance of a certificate of correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Frances Hicks
Petitions Examiner
Office of Petitions

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

Ronald L. Chichester
Baker Botts L.L.P.
One Shell Plaza
910 Louisiana Street
Houston, TX 77002-4995

MAILED

DEC 0 3 2002

Technology Center 2100

In re Application of: Sanghoon Sull, et al.)
Application No. 09/911,293)
Filed: July 23, 2001)
For: SYSTEM AND METHOD FOR INDEXING, SEARCHING, IDENTIFYING AND EDITING PORTIONS OF ELECTRONIC MULTIMEDIA FILES)

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed October 28, 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
For Special Programs Examiner
Technology Center 2100
Computer Architecture and Software
(703) 305-9750

cc: Mr. Gerald E. Linden, Esq.
12925 La Rochelle Circle
West Palm Beach, FL 33410-1406

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MR. GERALD E. LINDEN, ESQ.
12925 LA ROCHELLE CIRCLE
WEST PALM BEACH, FL 33410-1406

COPY MAILED
JUN 23 2006
OFFICE OF PETITIONS

In re Application of	:	
Sull et al.	:	DECISION ON PETITION
Application No. 09/911,293	:	TO WITHDRAW
Filed: July 23, 2001	:	FROM RECORD
Attorney Docket No. 069234.0109	:	

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 3, 2006 and May 10, 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 requests were signed by Gerald E. Linden and Dwight A. Stauffer. Gerald E. Linden and Dwight A. Stauffer have been withdrawn as attorneys of record. Applicants are 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 inventor; or (2) the assignee of the entire interest. All future communications from the Office will continue to be directed to the first named inventor or the assignee of the entire interest at the first below-listed address until otherwise properly notified by the applicant.

Telephone inquires concerning this decision should be directed to Petitions Examiner Liana Chase at (571) 272-3206. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

David Buczo
Petitions Examiner
Office of Petitions

Cc:

SANGHOON SULL
GAEPO 4-CHA WOOSUNG APT. 8-402
DOGOK-DONG, KANGMAN-KU
SEOUL, KOREA 135-370

EDWARD L. PENCOSKE
JONES DAY
500 GRANT STREET, SUITE 3100
PITTSBURGH, PA 15219-2502

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MARVIN FELDMAN
LACKENBACH SIEGEL, LLP
LACKENBACH SIEGEL BUILDING
1 CHASE ROAD
SCARSDALE NY 10583

COPY MAILED

NOV 2 2 2005

OFFICE OF PETITIONS

In re Application of
MITTS et al.
Application No. 09/911,320
Filed: July 23, 2001
Attorney Docket No. MEDIA.P-4 CIP

DECISION
ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed October 13, 2005, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to submit the issue and publication fees in a timely manner in reply to the Notice of Allowance and Fee(s) Due, mailed January 26, 2005, which set a statutory period for reply of three (3) months. Accordingly, the application became abandoned on April 27, 2005.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of the issue fee, the publication fee and the corrected drawings; (2) the petition fee of $750; and (3) the required statement of unintentional delay have been received. Accordingly, the issue and publication fee payments and the corrected drawings are accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-4787.

The application matter is being forwarded to the Office of Patent Publication.

Denise Pothier
Petitions Examiner
Office of Petitions

enc: PTO-948

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

November 5, 2002

Czeslaw Mazur
138 Monterey RD
Orange, CA 92866

In re application of:
Czeslaw Mazur DECISION ON PETITION
Serial No.: 09/911,347
Filed: July 27, 2001
For: INWENTOR

This is a decision on the petition received September 25, 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 of Incomplete Nonprovisional Application mailed September 4,2001. Which set a shortened statutory period for reply of two (2) months. Accordingly, this application became abandoned July 2, 2002. The notice of abandonment was mailed on September 9, 2002.

On September 25, 2002, the office received a communication from attorney Gerald L. Price who is not the attorney of record in the above application. All correspondence is designated to the inventor until a power of attorney is received. The inventor must send in a change of address to correct the inventor's address and correspondence.

The response of September 19, 2001, January 22, 2002 and July 8, 2002 did not complete the informalities in the above application. The notice of September 4, 2001, gave the applicant two months from the date of the notice to response. The response was due on or before November 4, 2001, with no extensions of time. The response of September 9, 2002, is untimely.

The petition is hereby DENIED.

The irradiated mail received the actual mail dates that were issued by the United States Postal Service.

Petitioner(s) may wish to consider filing a petition to the Commissioner under 37 CFR 1.37(a or (b) requesting that the application be revived.

Under 37 CFR 1.137(a), a petition requesting that the application be revived on the grounds of unavoidable delay must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a non provisional application abandoned for failure to prosecute (2) the $110 petition fee required by 37 CFR 1.17(l) ($55 if petitioner has established small entity status); (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; and (4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d) in a design application, a utility application filed before June 8, 1995, or a plant application filed before June 8, 1995.

Under 37 CFR 1.137(b), a petition requesting that the application be revived on the grounds of unintentional delay must be accompanied by: (1) the required reply (unless previously filed), which may met by the filing of a continuing application in a nonprovisional application abandoned for failure to prosecute; (2) the $1210 petition fee required by 37 CFR 1.17(l) ($605 if petitioner has established small entity status; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional; and (4) a terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)(in a design application, a utility application filed before June 8, 1995, or a plant application filed before June 8, 1995.

The filing of a petition under the unintentional standard 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).

The applicant may direct further correspondence regarding this application to:

Box DAC
Office of Petitions
Assistant Commissioner for Patents
Crystal Plaza 4 CP-3C23
South Clark Place
Arlington, VA 2202

This decision is addressed to a change shown on a returned letter.
Further, correspondence will be directed to the address in the application.

Doshie E. Day
Program Management Assistant
Office Initial Patent Examination
(703) 308-3640

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 17

GERALD L. PRICE
2161 ARGYLE AVENUE
HOLLYWOOD, CA 90068-2901

COPY MAILED

JUL 03 2003

OFFICE OF PETITIONS

ON PETITION

In re Application of	:	
Mazur	:	
Application No. 09/911,347	:	
Filed: To Be Determined	:	
Attorney Docket No. Price	:	

This is a decision on the petition under 37 CFR 1.181 (no fee) to withdraw the holding of abandonment.

The petition is **granted.**

An application which has not been assigned a filing date cannot become abandoned.

A failure to timely respond to a Notice of Incomplete Application *may* result in the termination of proceedings. The Office has exercised its discretion and the failure to timely reply will not be deemed to result in the termination of proceedings.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The file is being forwarded to the Office of Initial Patent Examination which will determine the filing date which should be assigned to the application and further process the application.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 17

GERALD L. PRICE
2161 ARGYLE AVENUE
HOLLYWOOD, CA 90068-2901

COPY MAILED

JUL 0 3 2003

OFFICE OF PETITIONS

In re Application of
Mazur
Application No. 09/911,347
Filed: To Be Determined
Attorney Docket No. Price

ON PETITION

This is a decision on the petition under 37 CFR 1.181 (no fee) to withdraw the holding of abandonment.

The petition is **granted.**

An application which has not been assigned a filing date cannot become abandoned.

A failure to timely respond to a Notice of Incomplete Application *may* result in the termination of proceedings. The Office has exercised its discretion and the failure to timely reply will not be deemed to result in the termination of proceedings.

The Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The file is being forwarded to the Office of Initial Patent Examination which will determine the filing date which should be assigned to the application and further process the application.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 21

VINCENT J. GNOFFO
BRINKS, HOFER, GILSON & LIONE
455 N. CITYFRONT
NBC TOWER, SUITE 3600
CHICAGO IL 60611

COPY MAILED

AUG 0 6 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of	:	
Ioannis Pallikaris et al	:	
Application No. 09/911,356	:	
Filed: July 23, 2001	:	
Attorney Docket No. 10781/9	:	

This is a decision on the petition, filed August 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 April 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]

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

---

[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).

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 3731 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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FOLEY & LARDNER LLP
150 EAST GILMAN ST
PO BOX 1497
MADISON WI 53701-1497

COPY MAILED

MAR 17 2006

OFFICE OF PETITIONS

In re Application	:	
Landis, et al.	:	
Application No. 09/911,367	:	DECISION ON APPLICATION
Filed: July 23, 2001	:	FOR PATENT TERM ADJUSTMENT
Atty Docket No. 032026-0594	:	

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 35 U.S.C. § 154(b)(3)(B)(ii)", filed February 23, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from two hundred eleven (211) days to three hundred seventy-two (372)days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **three hundred forty (340) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On February 10, 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 two hundred eleven (211) days. On February 23, 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 three hundred seventy-two (372) days.

---

[1] Applicants filed the application for patent term adjustment prior to payment of the issue fee.

Applicants assert entitlement to a patent term adjustment of three hundred seventy-two (372) days on the basis that the PTO improperly assessed Applicants a delay of one hundred forty-five (145) days for responding to a Notice to File Missing Parts mailed on September 26, 2001. Applicants assert that they filed a complete response on January 11, 2002, and as such should only have been assessed delay of sixteen (16) days.

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 two hundred eleven (211) days based on an adjustment for PTO delay of three hundred fifty-two (352) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1) and four (4) 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 forty-five (145) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. §1.704(b). The adjustment of fifty-six (56) days is at issue.

The adjustment of one hundred forty-five (145) 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 September 26, 2001. Applicants filed a complete response to this notice on January 10, 2002.[2] As this was not timely pursuant to 37 C.F.R. § 1.704(b), applicant delay of sixteen (16) days should have been assessed, not one hundred forty-five (145) days.

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 §

---

[2] It is noted that the Office mailed a Notice of Incomplete Reply on February 26, 2002, requiring a declaration with the signature of inventor Owen. However, a review of the declaration filed on January 11, 2002 reveals that the signature was present. Accordingly, it is concluded that the Notice of Incomplete Reply was mailed in error, and no 37 C.F.R. § 1.704(c)(7) reduction is warranted.

1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.[3]

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **three hundred forty (340) days** (356 days of PTO delay, reduced by 16 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. 50-2350, as authorized.

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

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

Nancy Johnson for

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

Enclosure: Copy of Revised PAIR Screen

---

[3] Applicants should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

Day : Thursday
Date: 3/16/2006

PALM INTRANET

Time: 13:39:01

PTA Calculations for Application: 09/911367			
Application Filing Date:	07/23/2001	PTO Delay (PTO):	356
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	145
Post-Issue Petitions:	0	Total PTA (days):	340
PTO Delay Adjustment:	129		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
45	03/16/2006	ADJUSTMENT OF PTA CALCULATION BY PTO		16	
44	03/16/2006	ADJUSTMENT OF PTA CALCULATION BY PTO	145		
28	02/10/2004	MAIL NOTICE OF ALLOWANCE	4		22
27	02/10/2004	MAIL EXAMINER'S AMENDMENT			
26	02/09/2004	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
25	02/09/2004	EXAMINER'S AMENDMENT COMMUNICATION			
24	02/09/2004	NOTICE OF ALLOWABILITY			
23	11/19/2003	DATE FORWARDED TO EXAMINER			
22	10/06/2003	RESPONSE TO ELECTION / RESTRICTION FILED			
21	09/10/2003	MAIL RESTRICTION REQUIREMENT	352		-1
20	09/08/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
19	07/09/2003	CASE DOCKETED TO EXAMINER IN GAU			
18	03/23/2003	CASE DOCKETED TO EXAMINER IN GAU			
17	03/07/2003	CASE DOCKETED TO EXAMINER IN GAU			
16	05/22/2002	APPLICATION DISPATCHED FROM OIPE			
15	05/20/2002	APPLICATION IS NOW COMPLETE			
13	05/20/2002	APPLICATION DISPATCHED FROM OIPE			
12	05/20/2002	APPLICATION IS NOW COMPLETE		145	5
10	03/14/2002	ADDITIONAL APPLICATION FILING FEES			
9	03/14/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
8	01/11/2002	PAYMENT OF ADDITIONAL FILING FEE/PREEXAM			
7	01/11/2002	AN ASSERTION THAT THE NATURE OF THE LEGAL ENTITIES HAVING PROPERTY RIGHTS TO THE PATENT AUTHORIZES T			

6	01/11/2002	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
5	09/26/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
3	09/25/2001	CORRESPONDENCE ADDRESS CHANGE			
2	07/31/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
1	07/23/2001	INITIAL EXAM TEAM NN			

Search Another: Application# [ ] Search

EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

To go back use Back button on your browser toolbar.

Back to PALM | ASSIGNMENT | OASIS | Home 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

FOLEY & LARDNER LLP
150 EAST GILMAN STREET
PO BOX 1497
MADISON WI 53701-1497

COPY MAILED
DEC 12 2006
OFFICE OF PETITIONS

In re	: DECISION ON APPLICATION
Landis, et al.	: FOR PATENT TERM ADJUSTMENT
Application No. 09/911,367	: AND NOTICE OF INTENT
Filed: July 23, 2001	: TO ISSUE
Patent No. 7,071,357	: CERTIFICATE OF CORRECTION
Issued: July 4, 2006	:

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT DETERMINATION UNDER 35 U.S.C. 154(b)(3)(B)(ii)", filed September 1, 2006. Patentees request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from eight hundred four (804) days to one thousand forty-one (1041) days.

The application for patent term adjustment is **GRANTED**.

The Patent Term Adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **one thousand forty-one (1041) days**.

On February 10, 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 two hundred eleven (211) days. On February 23, 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 three hundred seventy-two (372) days.

---

[1] Applicant filed the application for patent term adjustment prior to payment of the issue fee.

The petition was granted in part in a decision mailed on March 17, 2006. The patent issued with a patent term adjustment of eight hundred four (804) days.

Patentees timely filed the instant request for reconsideration on September 1, 2006.

Patentees point out that he was improperly assessed applicant delay of one hundred twenty (120) days for filing the application for patent term adjustment on February 23, 2004. In addition, Patentees argue that they were improperly assessed applicant delay of one hundred twenty (120) days for responding to a "Notice Under 37 CFR 1.251 - Patent", after the mailing of the Notice of Allowance. Lastly, Patentees point out that the Office was improperly assessed seven hundred four (704) days of delay in issuing the patent. According to Patentees, only seven hundred one (701) days should have been assessed.

With respect to the one hundred twenty (120) days of applicant delay assessed for filing the application for patent term adjustment, pursuant to 37 C.F.R. § 1.704(e), the submission of an application for patent term adjustment will not be considered a failure to engage in reasonable efforts to conclude prosecution of the application. Accordingly, zero (0) days should have been assessed for this filing.

In addition, applicants were assessed delay of one hundred twenty (120) days for the submission of a "REPLY TO NOTICE UNDER 37 CFR 1.251 TO RECONSTRUCT FILE" on September 26, 2005. A Reply to Notice under 37 CFR 1.251 is not identified as one of the papers the filing of which the Director has specifically deemed not to be a failure to engage in reasonable efforts under 37 C.F.R. §1.704(c)(10).[2] Nevertheless, under the circumstances of this case, it is concluded that the filing of applicants' "REPLY TO NOTICE UNDER 37 CFR 1.251 TO RECONSTRUCT FILE" is not a failure to engage under 37 C.F.R. §1.704(c)(10). Accordingly, the assessment of one hundred twenty (120) days of applicant delay with respect to this filing is not warranted.

Lastly, a review of the file confirms that the PTO was improperly assessed delay of seven hundred four (704) days for issuing the patent. Applicants paid the issue fee on April 2, 2004, not March 30, 2004 as indicated in PAIR. Accordingly, seven hundred

---

[2] See Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance has been Mailed, 1247 Off. Gaz. 111 (June 26, 2001).

one (701) days should have been assessed, not seven hundred four (704).

In view thereof, the correct determination of patent term adjustment is one thousand forty-one (1041) days.

The application file is being forwarded to the Certificate of Corrections Branch for issuance of a certificate of correction, indicating a Patent Term Adjustment **one thousand forty-one (1041) days**.

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

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

Enclosure: draft Certificate of Correction

UNITED STATES PATENT AND TRADEMARK OFFICE

DRAFT CERTIFICATE OF CORRECTION

PATENT : 7,071,357 B2

DATED : July 4, 2006

INVENTOR(S) : Landis, 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 (804) days

Delete the phrase "by 804 days" and insert – by 1041 days—

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)
6569308	2003-05-27	09/911,389	2001-07-25	80,090

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

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

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

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

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

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

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

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

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

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

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

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

○ A sole patentee

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

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

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/Stephen T. Hunnius/	Date (YYYY-MM-DD)	2008-07-24
Name	Stephen T. Hunnius	Registration Number	48304

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. 6569308
Issue Date: May 27,2003
Application No. 09911389
Filed: July 25,2001
Attorney Docket No. 80,090

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

This is a decision on the electronic petition, filed July 28,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is GRANTED.

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

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

UNITED STATES 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.

COPY MAILED

FEB 13 2004

OFFICE OF PETITIONS

ON PETITION

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

In re Application of
Toshiyuki Suzuki et al
Application No. 09/911,392
Filed: July 25, 2001
Attorney Docket No. 211952US2

This is a decision on the petition, filed February 11, 2004, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on November 4, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 2834 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

PAPER NO.

Oblon Spivak McClelland Maier & Neustadt
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

COPY MAILED

AUG 0 8 2003

OFFICE OF PETITIONS

In re Application of
Chiaki Matano
Application No. 09/911,399
Filed: July 25, 2001
Attorney Docket No. 211861US-3

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 7, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 30, 2003, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

After the application is received in the Office of Petition, the file will be forwarded to Technology Center AU 3677 for further processing of the request for continued examination under 37 CFR 1.114.

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

RECEIVED: 8-11-03
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 8-11-03
Type of Resp(s): _____
Due Date(s): _____

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

Received from < 7034132220 > at 9/5/03 4:13:08 PM [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

PAPER NO.

Oblon Spivak McClelland Maier & Neustadt
Fourth Floor
1755 Jefferson Davis Highway
Arlington, VA 22202

COPY MAILED

AUG 0 8 2003

OFFICE OF PETITIONS

In re Application of
Chiaki Matano
Application No. 09/911,399
Filed: July 25, 2001
Attorney Docket No. 211861US-3

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed August 7, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 30, 2003, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

After the application is received in the Office of Petition, the file will be forwarded to Technology Center AU 3677 for further processing of the request for continued examination under 37 CFR 1.114.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.8

JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
2 INDEPENDENCE WAY
P. O. BOX 5312
PRINCETON, NJ 08543-5312

COPY MAILED

AUG 1 9 2002

OFFICE OF PETITIONS

In re Application of
Peter Hoch
Application No. 09/911,437
Deposited: July 24, 2001
Attorney Docket No.:RCA
87,911/4417690

ON PETITION

This is a decision on the petition filed January 16, 2002 (certificate of mailing date December 7, 2001), requesting in effect, that a Notice of Incomplete Nonprovisional Application ("Notice") mailed September 7, 2001 be withdrawn. This petition will first be treated under 37 CFR 1.53 as a petition for a filing date and subsequently as a petition under 37 CFR 1.182.

The petition under 37 CFR 1.53 is **dismissed**.
The petition under 37 CFR 1.182 is **granted**.

The application was deposited on July 24, 2001. However, on September 7, 2001, the Office of Initial Patent Examination mailed the Notice requiring a declaration, the specification and at least one claim in the specification. The Notice further stated the filing date would be the date of the receipt of the specification and at least one claim.

In response, the present petition was filed. The petition contends a filing date for the above-identified application was incorrectly denied because a previously decided petition under 37 CFR 1.137(b) revived the parent application giving this application continuity with the parent application and as a consequence the filing date of the parent application.

Petitioner's argument has been considered but it is not persuasive. A review of the Official file confirms the specification and at least one claim were not amongst the items submitted on July 24, 2001.

Petitioner's interpretation of the decision on the petition to revive under 37 CFR 1.137(b) mailed on August 27, 2001 is incorrect. The decision does not indicate a filing date for the continuing application has been granted. The decision established continuity between the applications. "The term continuity is used to express the relationship of copendency of the same subject matter in two different applications of the same inventor." Establishing continuity is only one of the requirements in claiming benefit of an earlier filing date.

Pursuant to 35 U.S.C. 111(a)(2)(4) the filing date of an application shall be the date on which the specification and any required drawings are received in the Patent and Trademark Office.

Petitioner failed to submit the specification with at least one claim and as such petitioner was not entitled to a filing date. Establishing continuity does not overcome the requirements of what constitutes a complete application.

Thus, the petition to accord a filing date must be dismissed.

This petition was not necessitated by USPTO error so the petition fee will not be refunded.

Petition under 37 CFR 1.182

A review of the application transmittal form indicates petitioner intended to incorporate by reference prior application 08/443,518. Under circumstances where there has been an incorporation by reference, an inadvertent omission of application parts and no filing date has been granted petitioner is required to file a petition under 37 CFR 1.182. See MPEP 201.06.

A petition under 37 CFR 1.182 requires:

(1) required petition fee;
(2) an amendment submitting the omitted material, requesting that the necessary omitted material contained in the prior application and submitted in the amendment be included in the continuation or divisional application based on incorporation by reference statement.

Pursuant to petitioner's request a $130.00 petition fee has been charged to deposit account 07-0832.

The petition under 1.182 is **granted**.

The application is being returned to the Office of Initial Patent Examination for further processing with a filing date of July 24, 2001 using the application papers filed on July 24, 2001 and a copy of the specification, drawings and claims filed on January 16, 2002.

Telephone inquiries related to this decision may be directed to Petitions Attorney Charlema R. Grant at (703) 306-0251.

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
www.uspto.gov

Paper No.

Barbara A. Wrigley
OPPENHEIMER WOLFF & DONNELLY LLP
45 South Seventh Street
Suite 3300
MINNEAPOLIS MN 55402

COPY MAILED
AUG 24 2006
OFFICE OF PETITIONS

In re Application of :
Callister et al. : DECISION ON PETITION
Application No. 09/911,551 :
Filed: July 23, 2001 :
Attorney Docket No. 687-470 :

This is a decision on the PETITION TO WITHDRAW HOLDING OF ABANDONMENT filed January 13, 2006.

The above-identified application became abandoned for failure to file a timely and proper reply to the non-final Office action mailed February 22, 2005. This Office action set a shortened statutory period for reply of three (3) months, with extensions of time obtainable under § 1.136(a). No reply considered filed and no extension of time considered obtained, the application became abandoned effective May 23, 2005. A courtesy Notice of Abandonment was mailed on October 5, 2005.

Petitioner states that as shown in the record of this application available in PAIR applicants timely responded on March 14, 2005 with an IDS that met the requirements of 37 CFR §1.98(a)(1) as requested by the examiner.

A review of the record confirms that an IDS was timely received on March 14, 2005.

Accordingly, the Notice of Abandonment mailed October 3, 2005 is hereby **VACATED**, and the holding of abandonment is hereby **WITHDRAWN**.

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

No fee is required on petition under § 1.181.

Receipt of the revocation of power of attorney and change of correspondence address filed by the assignee (with an appropriate 3.73(b) statement and copy of assignment documents) is acknowledged and made of record.

Technology Center AU 3764 has been advised of this decision. The application file is, thereby, forwarded to the Technology Center's technical support staff to withdraw the holding of abandonment and for consideration by the examiner of the IDS shown to have been timely filed on March 14, 2005 (and for consideration of the supplemental IDS filed on April 13, 2006).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

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
09/911,551	07/23/2001	Jeffrey P. Callister	23267-1032

CONFIRMATION NO. 4767

OC000000020123471

COUDERT BROTHERS LLP
ONE MARKET PLAZA
SPEAR STREET TOWER, SUITE 2100
SAN FRANCISCO, CA 94105

Date Mailed: 08/21/2006

NOTICE REGARDING CHANGE OF POWER OF ATTORNEY

This is in response to the Power of Attorney filed 01/13/2006.

- The Power of Attorney to you in this application has been revoked by the assignee who has intervened as provided by 37 CFR 3.71. Future correspondence will be mailed to the new address of record(37 CFR 1.33).

Barbara A. Wrigley
OPPENHEIMER WOLFF & DONNELLY LLP
45 South Seventh Street
Suite 3300
Minneapolis MN 55402

NANCY E JOHNSON
OP (571) 272-3219

NEW ATTORNEY/AGENT COPY

#3

OIPE JC10
JAN 16 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
09/911,601	07/24/2001	Robert Albert Boie	19-9-7

CONFIRMATION NO. 3664

FORMALITIES LETTER

OC000000006561693

Docket Administrator
Lucent Technologies Inc.
101 Crawfords Corner Road (Room 3J-219)
Holmdel, NJ 07733-3030

Date Mailed: 09/17/2001

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 $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

01/22/2002 BARRAHA1 00000328 122325 09911601

01 FC:105 130.00 CH

#4

Serial No. 09/911,601

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

OIPE JC10 JAN 16 2002 PATENT & TRADEMARK OFFICE

Inventor(s)	Robert Albert Boie Jungsang Kim Hyongsok Soh		
Case	19-9-7		
Serial No.	09/911,601	Group Art Unit	2874
Filing Date	July 24, 2001	Examiner:	
Title	MEMS Driver Circuit Arrangement		

THE ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D. C. 20231

SIR:

PETITION FOR EXTENSION OF TIME

Applicant(s) petition(s) the Assistant Commissioner of Patents and Trademarks to extend the time for response to the Notice to File Missing Parts of Non-Provisional Application dated September 17, 2001 for one month from November 17, 2001 to December 17, 2001. Please charge **Lucent Technologies Inc. Deposit Account No. 12-2325** in the amount of $110.00 to cover the cost of the extension. Any deficiency or overpayment should be charged or credited to **Lucent Technologies Inc. Deposit Account No. 12-2325** as required to correct the error. Duplicate copies of this petition are enclosed.

01/22/2002 BABRAHA1 00000328 122325 09911601
02 FC:115 110.00 CH

Respectfully,
By Eugene J. Rosenthal
Eugene J. Rosenthal, Reg. No. 36658
Attorney for Applicant(s)
732-949-1857

Date: 11/30/01

Lucent Technologies Inc.
101 Crawfords Corner Road (Room 3J-219)
Holmdel, New Jersey 07733-3030

Certificate of Mailing

I hereby certify that this correspondence (and any paper referred to as being transmitted therewith) is being deposited with the United States Postal Service with sufficient postage as First Class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231 on the date indicated below:

11/30/01 Sharon Lobosco
SHARON LOBOSCO

COPY OF PAPERS ORIGINALLY FILED

Serial No. 09/911601

OIPE JC10 JAN 16 2002 PATENT & TRADEMARK OFFICE

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

Patent Application

Inventor(s):	**Robert Albert Boie** **Jungsang Kim** **Hyongsok Soh**
Case:	**19-9-7**
Serial No.:	**09/911601**
Filing Date:	**July 24, 2001**
Examiner:	Group Art Unit: **2874**
Title:	**MEMS Driver Circuit Arrangement**

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D. C. 20231

SIR:

Response to Notice to File Missing Parts of Non-Provisional Application

Enclosed is the Declaration and Power of Attorney relating to the above-identified application.

Please charge Lucent Technologies **Deposit Account No. 12-2325** the amount of **$130.00** to cover the filing fee surcharge. Duplicate copies of this letter are enclosed.

A copy of the Notice to File Missing Parts of Non-Provisional Application is also enclosed.

Respectfully,

By Eugene J. Rosenthal

Eugene J. Rosenthal, Attorney
Reg. No. 36658
908-582-4323

Date: 11/30/01

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 of Patents and Trademarks, Washington, D.C. 20231, on Nov. 30, 2001 (Date of Deposit)
[illegible] 11/30/01
Date

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

Kenneth F. Kozik
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110-2804

MAILED

JUL 17 2003

Technology Center 2100

In re Application of:	)	
John Edward Ciolfi	)	
Application No. 09/911,663	)	**DECISION ON REQUEST FOR**
Filed: July 24, 2001	)	**WITHDRAWAL AS ATTORNEY**
For: HANDLING PARAMETERS IN BLOCK DIAGRAM MODELING	)	

This is a decision on the Request To Withdraw from Representation filed June 12, 2003.

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

The request filed June 12, 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: Thomas V. Smurzynski, Esq.
LAHIVE & COCKFIELD LLP
28 State Street
Boston, MA 02109-1784

UNITED STATES PATENT AND TRADEMARK OFFICE

JUL 26 2006

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

DAVID L. FITZGERALD
SIDLEY AUSTIN LLP
1501 K STREET N.W.
WASHINGTON DC 20005

In re Application of
Anderson et al
Serial No. : 09/911,703
Filed : 25 July 2001
Attorney Dkt No. : 27693-01008

Decision on Petition

This decision is in response to the petition under 37 CFR 1.181 filed 28 April 2006, to regarding a requirement under 1.182 et al (sequence rules).

BACKGROUND AND DISCUSSION

This application contains nucleic acid and amino acid sequences. Applicants have submitted a computer readable form of the sequence listing, a paper copy of the sequence listing and a letter stating that the electronic copy and paper copy of the sequence listings are identical, in accordance with 37 CFR 1.812, *et seq*.

In addition to meeting the requirements of 37 CFR 1.182 *et seq*, the examiner has requested that an indication of antisense orientation be placed in field <223> of the sequence listing.

This request has been made in error. Applicants are not required to state that the sequence is antisense in section 223. The only mandatory use of <223> is for the use 'n' or 'Xaa' in the sequence or use of Artificial or Unknown for the organism. Any other information the applicant wants to include in a feature is optional.

DECISION

The petition to withdraw the restriction requirement is **GRANTED**. The letters mailed on November 2, 2005 and February 29, 2006 are hereby vacated and no response to them is required by applicants.

The application will be forwarded to the examiner to consider the amendment and response filed on 12 August 2005 and to prepare an action which is consistent with this petition decision.

Should there be any questions regarding this decision, please contact Special Program Examiner Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 571-273-8300.

John LeGuyader
Director, Technology Center 1600

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, NW
WASHINGTON DC 20005

COPY MAILED

JAN 04 2008

OFFICE OF PETITIONS

In re Application of	:
Anderson, et al.	:
Application No. 09/911,703	: DECISION ON PETITION
Filed: July 25, 2001	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 27693-01008	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed March 29, 2007, 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 August 12, 2005.

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 applications 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 applications. In order for this 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 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 applications, 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 Technology Center Art Unit 1644 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed applications.

Anthony Knight
Supervisor
Office of Petitions

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NUMBER	FILING or 371(c) DATE	GRP ART UNIT	FIL FEE REC'D	ATTY.DOCKET.NO	TOT CLAIMS	IND CLAIMS
09/911,703	07/25/2001	1644	1876	27693-01008	47	7

CONFIRMATION NO. 4927

CORRECTED FILING RECEIPT

47553
SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, NW
WASHINGTON, DC 20005

OC000000027557878

Date Mailed: 01/04/2008

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

Applicant(s)

Darrell R. Anderson, Escondido, CA;
Nabil hanna, Olivenhain, CA;
John E. Leonard, Encinitas, CA;
Roland A. Newman, San Diego, CA;
Mitchell E. Reff, San Diego, CA;
William H. Rastetter, Rancho Sante Fe, CA;

Assignment For Published Patent Application

IDEC Pharmaceuticals Corporation, San Diego, CA

Power of Attorney: The patent practitioners associated with Customer Number 47553

Domestic Priority data as claimed by applicant

This application is a CON of 08/475,813 06/07/1995 PAT 6,682,734
which is a DIV of 08/149,099 11/03/1993 PAT 5,736,137
which is a CIP of 07/978,891 11/13/1992 ABN

Foreign Applications

If Required, Foreign Filing License Granted: 01/15/2002

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is **US 09/911,703**

Projected Publication Date: Not Applicable

Non-Publication Request: No

Early Publication Request: No

Title

Therapeutic application of chimeric and radiolabelled antibodies to human B lymphocyte restricted differentiation antigen for treatment of B cell lymphoma

Preliminary Class

424

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

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

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

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

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

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

LICENSE FOR FOREIGN FILING UNDER

Title 35, United States Code, Section 184

Title 37, Code of Federal Regulations, 5.11 & 5.15

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where

the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

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

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

NOT GRANTED

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

UNITED STATES 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.

SIDLEY AUSTIN LLP
ATTN: DC PATENT DOCKETING
1501 K STREET, NW
WASHINGTON DC 20005

COPY MAILED
AUG 1 1 2008

In re Application of	:	
Anderson et al.	:	
Application No. 09/911,703	:	LETTER REGARDING
Filed: July 25, 2001	:	PATENT TERM ADJUSTMENT
Attorney Docket No. 27693-01008	:	
Title: ANTI-CD20 ANTIBODIES	:	

This is a decision on the "LETTER REGARDING PATENT TERM ADJUSTMENT," filed February 15, 2008. Applicant requests that the initial determination of patent term adjustment at the time of mailing of the notice of allowance be corrected from seven hundred and two (702) days to six hundred and three (603) days.

The request for reconsideration 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 five hundred twenty-two (522) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On January 29, 2008, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 702 days. The instant letter was timely filed[1] on or before payment of the issue fee. Applicant sets

[1] PALM records indicate that the issue fee was paid on February 15, 2008.

forth the following basis for recalculation of the patent term adjustment:

1. Applicant discloses that a period of reduction should be entered for the interval between three-months after the February 27, 2004 submission of a non-compliant sequence listing and the amendment filed on December 15, 2004 (e.g. May 27, 2004 to December 15, 2004 or 202 days).

2. Applicant discloses that given that the compliant sequence listing was not filed until December 15, 2004, the time for the Office to act on the response to the sequence letter under 1.703(a)(2) should run from December 15, 2004, and thus, entry of a period of adjustment of 21 days for Office delay is not warranted.

3. Applicant asserts that an interval between 4 months after the sequence listing of August 12, 2005 and the mailing of the December 29, 2006 Office action should constitute Office delay.

4. Applicant discloses that a period of reduction of 81 days should be entered for applicant delay for the IDS filed November 1, 2005.

Applicant states that any patent that issues from this application is subject to a terminal disclaimer.

Applicant's arguments have been considered and found persuasive to the extent indicated herein.

Applicant is correct that the incorrect periods were entered with respect to their delay in filing a compliant reply on December 15, 2004. Applicant is correct that a period of reduction for the entire interval and not separate periods of 58, 61 and 28 days should have been entered. However, applicant has not correctly calculated this period. The period is 266 days, not 202 days.

Pursuant to 37 C.F.R. § 1.704(c)(7), the submission of a reply having an omission (§1.135(c)) is a failure to engage in reasonable efforts to conclude prosecution, and the period of adjustment set forth in Rule 1.703 shall be reduced by the

number of days, if any, beginning[2] on the day after the date the reply having an omission was filed and ending on the date that the reply or other paper correcting the omission was filed. The period of reduction begins the day after the reply containing an omission was actually filed and not the day after the three month due date for the reply. In this instance, on February 27, 2004, the Office mailed a Notice to Comply with Sequence Requirements. On March 24, 2004, applicant filed a response. On March 30, 2004, applicant filed a further response to correct an omission in the response filed March 24, 2004. By Notice to Comply mailed June 17, 2004, applicant was advised that the response as filed March 30, 2004 contained an omission. A sequence listing was filed on November 17, 2004. However, it contained errors. It is undisputed that a sequence listing correcting the errors was not filed until December 15, 2004. Thus, the period of reduction pursuant to 37 CFR 1.704(c)(7) begins on March 25, 2004, the day after the first reply containing an omission was filed, and ends on December 15, 2004, the date the omission was corrected.

The response submitted on March 24, 2004 contained an omission that was later corrected via the submission of a response on December 15, 2004. This constitutes a delay of 266 days. Accordingly, the periods of reduction of 58, 61 and 28 days for applicant delay are being removed and a period of reduction of 266 days is being entered.

However, applicant is incorrect that entry of a period of adjustment of 21 days for Office delay in association with the mailing of the non-final Office action on April 7, 2005 is incorrect. Pursuant to 37 C.F.R. § 1.702(a)(2), the Office is required to respond to a reply under 35 U.S.C. 132 not later than four months after the date on which the reply was filed. The Office did not take action in response within four months (e.g. mail an action under 37 CFR 1.135(c)). A non-final Office action was mailed on April 7, 2005, four months and 21 days later. The period of adjustment of 21 days for Office delay is being retained.

However, applicant is correct that a period of adjustment pursuant to 37 C.F.R. § 1.702(a)(2) should be entered for Office delay in taking action in response to the amendment filed August

[2] When a period is indicated (in 37 CFR 1.703 or 1.704) as "beginning" on a particular day, that day is included in the period, in that such day is "day one" of the period and not "day zero." For example, a period beginning on April 1 and ending on April 10 is ten (and not nine) days in length. See MPEP 2731.

12, 2005. An Office communication was mailed on November 2, 2005, indicating that the submission filed August 12, 2005 contained an omission. A response was submitted on December 2, 2005, asserting that the November 2, 2005 Office communication was issued in error and should be vacated. In response, the Office mailed a communication on February 28, 2006, which indicated that this submission was not fully responsive. A petition was filed on April 28, 2006, directed towards the propriety of the assertion that the submission of August 12, 2005 contained an omission. This petition was granted via the mailing of a decision on July 26, 2006, which vacated the mailings of November 2, 2005 and February 28, 2006. A final Office action was next mailed on December 29, 2006.

The Office entered a period of adjustment of 271 days for Office delay in taking action in response to applicant's response filed December 2, 2005. Given the petition decision, for purposes of calculating patent term adjustment, the mailing of the Office action on December 29, 2006 is used as the date the Office took action in response to the reply filed August 12, 2005. The Office was required to respond to the August 12, 2005 submission no later than December 12, 2005, and the communication of December 29, 2006 is four months and 382 days after the receipt of the amendment. See 37 C.F.R. 1.703(a)(2). The period of adjustment of 271 days is being removed and a period of adjustment of 382 days is being entered.

Moreover, applicant is correct that a period of reduction of 81 days should be entered for the supplemental Information Disclosure Statement (IDS) filed on November 1, 2005. Pursuant to 37 C.F.R. § 1.704(c)(8), submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage. In which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed. In this instance, after the filing of a response on August 12, 2005, on November 1, 2005, applicant filed an IDS. The record supports a conclusion that the IDS was not expressly requested by the examiner and did not include a 1.704(d) statement. Accordingly, the patent term adjustment should have been reduced by 81 days, the number of days beginning on the day after the date the initial reply was

filed, August 13, 2005, and ending on the date that the IDS was filed, November 1, 2005.

Regarding the paper filed on February 16, 2007 and the subsequently submitted petition of March 29, 2007 that was accompanied by a complete response on the merits, it is noted that the Office properly did not assign a reduction based on either the request for reconsideration that was filed prior to the response or the petition that was filed with the response. No reduction is warranted for papers filed prior to or with the proper response to a final Office action. Further, the reply under 37 CFR 1.116 was in compliance with 1.113(c) and was filed within the three month period set forth in 37 CFR 1.704(b).

However, a review of the record reveals the basis for entry of a further period of reduction. After filing the response on March 29, 2007 on June 28, 2007, applicant filed a Notice of Appeal. The Notice of Appeal was not requested by the examiner. Pursuant to 37 CFR 1.704(c)(8), a period of reduction of <u>91 days</u> is being entered.

The other periods of delay are not at issue.

The proper period of adjustment for Office delay at the time of the mailing of the notice of allowance is 996 (366 + 21 + 382 + 227) days. The proper period of reduction at the time of mailing of the notice of allowance is 474 (266 + 36 + 81 + 91) days.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is 522 (996 - 474) days.

The application is being forwarded to the Office of Data Management 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 matter should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of Revised PTA calculation

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6/4/09

TO SPE OF : ART UNIT 1644 Shukla Ram Spe

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/911703 Patent No.: 7422739

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

FOR IFW FILES: Applicant is waiting for a responds. Thanks

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

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

FOR PAPER FILES:

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

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

Certificates of Correction Branch
703-308-9390 ext. _____

Thank You For Your Assistance

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

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

Comments: _____

RAM R. SHUKLA, PH.D.
SUPERVISORY PATENT EXAMINER
SPE

1644
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

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH VA 22040-0747

COPY MAILED

MAY 14 2009

OFFICE OF PETITIONS

In re Patent No. 6,933,378 :
Issue Date : August 23, 2005 :
Application No. 09/911,732 : NOTICE
Filed: July 25, 2001 :
Patentee(s): Joseph Atabekov, et al.

The above-identified patent has been referred to the Office of Petitions for consideration of a communication filed March 6, 2009 by Haynes and Boone, LLP. The communication is being treated as a request under 37 CFR 1.128(c), as it includes authorization to charge a maintenance fee deficiency and a letter indicating that applicants are no longer entitled to claim status as a small entity. It is noted that the request is not signed in accordance with 37 CFR 1.33(b).[1]

At present, the request is DISMISSED.

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 notice. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Request under 37 CFR 1.28(c)."

In addition, the renewed request to accept a deficiency in the fee payment under 37 CFR 1.28(c), must (1) be properly signed by a responsible party pursuant to 37 CFR 1.33(b); (2) identify when small entity status was lost and (3) explain why proper notification, as required by 37 CFR 1.27(g)(2), was not provided. See 37 CFR 1.28(c).

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

[1]37 CFR 1.33(b) states:

Amendments and other papers filed in the application must be signed by:

An attorney or agent of record appointed in compliance with §1.34(b);
A registered attorney or agent not of record who acts in a representative capacity under the provisions of §1.34(a);
The assignee of record of the entire interest, if there is an assignee of record of the entire interest;
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
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.

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-Web[2]

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

Sherry D. Brinkley
Petitions Examiner
Office of Petitions

cc: HAYNES AND BOONE, LLP
ATTORNEYS AND COUNSELORS
2505 N PLANO ROAD, SUITE 4000
RICHARDSON, TX 75082-4101

[2] www.uspto.gov/ebc/efs_help.html (for help using EFS-Web call the Patent Electronic Business Center at (866) 217-9197)

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: 0604

DATE : 6/29/04

TO SPE OF : ART UNIT 2827

SUBJECT : Request for Certificate of Correction on Patent No.: 6674649

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

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

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

Please see COCIN dated 2-5-04 in table of contents in IFW.

Diana T. Rose
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:

Approved because the proposed correction was, in fact, the Examiner's interpretation of the claim at the time the Notice of Allowance was issued (July 30, 2003).
— Exr John B. Vigushin
Primary Examiner in AU 2827

KAMAND CUNEO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800

SPE 6/29/04 **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

MAILED

APR 19 2006

TECHNOLOGY CENTER 2100

Hung Chang Lin
8 Schindler Court
Silver Spring, MD 20903

In re Application of: Apostolis PAPATHANASIOU Application No. 09/911,764 Attorney Docket No. HER-1 Filed: July 25, 2001 For: ADAPTIVE FILTER FOR COMMUNICATION SYSTEM	))))))	DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT UNDER 37 CFR §1.181

This is a decision on the request to withdraw the holding of abandonment, which is being treated as a petition to withdraw the holding of abandonment, under 37 CFR §1.181, filed on July 6, 2005.

The instant application became abandoned for failure to timely respond to the Office action (non-final) mailed April 23, 2004. A notice of abandonment was mailed on June 30, 2005. 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 is acceptable. No fee is required.

Petitioner has provided evidence in the petition that includes: a copy of the amendment and remarks bearing a certificate of mailing date of September 20, 2004; as well as a post card receipt identifying the that an amendment and check for $210.00 had been filed, bearing a USPTO receipt date of September 21, 2004. Note, the fee for a two months extension of time was charged on September 22, 2004, according to USPTO records.

In accordance with MPEP § 503, applicant is reminded it is important that the return postcard **itemize** all of the components of the [application] response. If the postcard does not itemize each of the components of the application, it may not serve as evidence that any component which was not itemized was received by the United States Patent and Trademark Office (USPTO).

Based upon the preponderance of evidence submitted, the petition is **GRANTED**. The Notice of Abandonment is hereby **WITHDRAWN**.

The application is being forwarded to the Supervisory Legal Instruments Examiner with instructions to **WITHDRAW** the abandonment and to **ENTER** the response filed September 21, 2004 (copy filed July 6, 2005). The application will then be forwarded to the examiner for prompt action on the merits. Note, as indicated above, the fee for the 2-months extension of time has previously been charged.

Brian L. Johnson
Special Programs Examiner
Technology Center 2100
Computer Architecture, Software, and Information Security
571-272-3595

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

M. David Galin
Renner, Otto, Boisselle & Sklar, LLP
Nineteenth Floor
1621 Euclid Avenue
Cleveland, OH 44115

Mail Date: 04/26/2010

Applicant	: Stephen Cutler	: DECISION ON REQUEST FOR
Patent Number	: 7664695	: RECALCULATION of PATENT
Issue Date	: 02/16/2010	: TERM ADJUSTMENT IN VIEW
Application No	: 09/911,772	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/24/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2165** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 12

Oinnegan Henderson Farabow
Garrett & Dunner
1300 I. Street, NW
Washington, DC 20005

COPY MAILED

JAN 3 1 2003

OFFICE OF PETITIONS

In re Application of
Browning et al.
Application No. 09/911,777
Filed: July 24, 2001
Attorney Docket No. 08201.0024-00000

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 10, 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 May 20, 2002, which set a period for reply of (1) One month from the mail date of the Notice. Extensions of time were filed on December 26, 2002 with a Certificate of Mailing dated December 20, 2002, which is after the expiration of the extendable period for reply. Accordingly, the application became abandoned on June 21, 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 1644 for further processing.

Latrice Bond

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

COPY MAILED

JUL 23 2002

OFFICE OF PETITIONS

SCHIFF HARDIN & WAITE
6600 SEARS TOWER
233 S WACKER DR
CHICAGO IL 60606-6473

In re Application of
Hetzer, Keunecke, Schlaaff & Gelfer
Application No.: 09/911,811
Filed: July 24, 2001
Attorney Docket No.: P01,0236
For: ARRANGEMENT AND METHOD FOR DATA FOLLOW-UP WARMUP CYCLES OF INK JET PRINT HEADS

DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed March 7, 2002 (certificate of mailing date February 27, 2002).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on July 24, 2001 without an executed oath or declaration. Accordingly, on September 4, 2001, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring an executed oath or declaration and a surcharge for its late filing.

In response, on March 7, 2002 (certificate of mailing date February 27, 2002), a petition for a four month extension of time and required fee, a declaration executed by 3 of 4 joint inventors, the surcharge, the petition fee, and the instant petition were filed. A declaration of facts of Wolfgang Thiel accompanied the petition. Mr. Thiel explains that non-signing joint inventor George Gelfer received numerous copies of the declaration and assignment for the above-identified application, but did not respond to the request that he sign the 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 item (1) above.

As to item (1), Applicants have failed to establish that the inventor has refused to sign the

declaration. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d). Mr. Thiel's statement of facts does not establish that a complete copy of the application was mailed to Mr. Gelfer's last known address.

Mr. Gelfer must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. Mr. Gelfer cannot make the required statements in the declaration without having the application in his possession -- (" I have reviewed and understand.." etc.). When petitioners can show that Mr. Hamilton was mailed or received the complete application and that he either refused to sign the declaration or would not respond to the request that he sign the declaration, petitioners will have satisfied this requirement.

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

By mail:	Commissioner for Patents Box DAC Washington, D.C. 20231
By facsimile:	(703) 308-6916 Attn: Office of Petitions
By hand:	Office of Petitions 2201 South Clark Place Crystal Plaza 4, Suite 3C23 Arlington, VA 22202

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

E. Shirene Willis

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 10

SCHIFF HARDIN & WAITE
6600 SEARS TOWER
233 S WACKER DR
CHICAGO IL 60606-6473

COPY MAILED

OCT 0 7 2002

OFFICE OF PETITIONS

In re Application of
Hetzer, Keunecke, Schlaaff & Gelfer
Application No.: 09/911,811
Filed: July 24, 2001
Attorney Docket No.: P01,0236
For: ARRANGEMENT AND METHOD FOR DATA FOLLOW-UP WARMUP CYCLES OF INK JET PRINT HEADS

DECISION GRANTING STATUS UNDER 37 CFR 1.47(a)

This is a decision on the reconsideration petition under 37 CFR 1.47(a), filed September 23, 2002 (certificate of mailing date September 18, 2002).

The petition is **GRANTED**.

Petitioners have shown that the non-signing inventor, Mr. George Gelfer, has constructively 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 Lieselotte Michel, patent prosecution administrator for the assignee of the invention, 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 within a reasonable amount of time.[1] Petitioners have 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 Technology Center 2800 for examination in due course.

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

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

[1] While the address for Mr. Gelfer listed on Ms. Michel's letter contains a typographical error --"Appelgate" rather than "Applegate"--, it is assumed that the US Postal Service would have been able to deliver the correspondence to the intended recipient.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

George G. Gelfer
135 Applegate Drive
West Chester, PA 19382

COPY MAILED

OCT 0 7 2002

OFFICE OF PETITIONS

In re Application of :
Hetzer, Keunecke, Schlaaff & Gelfer :
Application No.: 09/911,811 : LETTER
Filed: July 24, 2001 :
Attorney Docket No.: P01,0236 :
For: ARRANGEMENT AND METHOD FOR :
DATA FOLLOW-UP WARMUP CYCLES OF :
INK JET PRINT HEADS

Dear Mr. Gelfer.:

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
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTORNEY OF RECORD: SCHIFF HARDIN & WAITE
6600 SEARS TOWER
233 S WACKER DR
CHICAGO IL 60606-6473

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

JUL - 7 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 3

Kenneth F. Kozik
FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110-2804

In re Application of:
John T. Micco, et al.
Application No.: 09/911,819
Filed: July 24, 2001
For: FUNCTION CALL TRANSLATION

DECISION ON REQUEST TO
WITHDRAW AS ATTORNEY

This is a decision on the Request to Withdraw from Representation filed June 11, 2003.

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

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

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

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

James R. Matthews

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

#7

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

OCT 27 2003

TECHNOLOGY CENTER 2100

Paper No. 7

FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110-2804

In re Application of John t. MICCO, et al. Application No. 09/911,819 Filed: July 24, 2001 For: FUNCTION CALL TRANSLATION	DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Reprsentation filed July 28, 2003.

A Revocation And Substitution Of Power Of Attorney Under 37 CFR § 1. 36 was filed on July 14, 2003. The Power Of Attorney revoked all prior Powers Of Attorney and appointed Lahive & Cockfield LLP as the attorneys of record of the instant application. The Power Of Attorney of July 14, 2003 was accepted. Accordingly, all communications from the U.S. Patent and Trademark Office to applicant are to be conducted by Lahive & Cockfield LLP.

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

No further communication to you regarding this application will be made.

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

cc: Kevin J. Canning, Esq.
Lahive & Cockfield, LLP
28 State Street
Boston, MA 02109

UNITED STATES 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

BAKER BOTTS
44TH FLOOR
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-0228

COPY MAILED

SEP 0 9 2004

OFFICE OF PETITIONS

In re Application of :
Phillip S. Pang et al :
Application No. 09/911,821 : ON PETITION
Filed: July 24, 2001 :
Attorney Docket No. A33723/070050.1407 :

This is a decision on the petition under 37 CFR 1.137(b), filed July 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 Nonprovisional Application (Notice) mailed August 9, 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 October 10, 2001.

Telephone inquiries concerning this decision should be directed to Wan Laymon at (703) 306-5685.[1]

The application file is being forwarded to the Office of Initial Patent Examiantion.

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

[1] Effective September 27, 2004, the phone number will be 571-272-3220.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BROOKS, CAMERON & HUEBSCH , PLLC
1221 NICOLLET AVENUE , SUITE 500
MINNEAPOLIS, MN 55403

Mail Date: 04/21/2010

Applicant	: David Pierre Gendron	: DECISION ON REQUEST FOR
Patent Number	: 7640171	: RECALCULATION of PATENT
Issue Date	: 12/29/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/911,846	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/24/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2722** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

TOWNSEND AND TOWNSEND AND CREW
TWO EMBARCADERO CENTER, 8TH FLOOR
SAN FRANCISCO, CA 94111-3834

COPY MAILED

APR 0 8 2004

OFFICE OF PETITIONS

In re Application of	:	
Theodore W. Watler et al	:	
Application No. 09/911,868	:	NOTICE
Filed: July 23, 2001	:	
Attorney Docket No. 018684001310	:	

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 2686.

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
DIW 12-01

Paper No. 5

GREENBLUM & BERNSTEIN, P.L.C.
1941 ROLAND CLARKE PLACE
RESTON, VA 20191

COPY MAILED

JAN 0 8 2002

OFFICE OF PETITIONS

In re Application of :
Ikeda et al. :
Application No. 09/911,873 :
Filed: 25 July, 2001 :
Attorney's Docket No. P21290 :

ON PETITION

This is a decision on the petition filed on 30 October, 2001, requesting that the above-identified application be accorded a filing date of 25 July, 2001, with Pages 47 of the specification as a part of the original disclosure.

The petition is granted.

The application was filed on 25 July, 2001, with 78 pages of Japanese language specification as the original disclosure. However, on 30 August, 2001, Initial Patent Examination Division mailed a "Notice" stating, *inter alia*, that the application had been accorded a filing date but that Page 47 of the specification (description and claims) appeared to have been omitted.

In response, on 30 October, 2001, pages 47 of the specification, the present petition, and a petition fee were filed. Petitioners argue that Pages 47 were filed with the other application papers on 25 July, 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 30 October, 2001. The postcard receipt shows an Office date stamp of 25 July, 2001 and the above-identified application number, identifies the application by first named inventor's last name, docket number, and invention title, and acknowledges receipt of, *inter alia*, 78

pages of specification. Petitioners request that the application, including Pages 47 of the specification, be accorded a filing date of 25 July, 2001.

A review of the record reveals that no Page 47 of the specification has been located among the application papers received on 25 July, 2001. However, the evidence is convincing that the application papers deposited on 25 July, 2001,included Pages 47 of the specification, which was subsequently misplaced in the Office. Therefore, the application, including Page 47 of the specification, is entitled to a filing date of 25 July, 2001.

The "Notice" mailed on 25 July, 2001, is vacated to the extent that it stated that pages 47 of the specification appeared to have been omitted.

In view of the above, the petition is granted. The petition fee is unnecessary and will be credited to counsel's deposit account, No. 19-0089.

The application will be processed with the copy of Page 47 supplied on 30 October, 2001, as a part of the original disclosure. The copies of the other application papers supplied on 30 October, 2001, 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 25 July, 2001, using the application papers filed on 25 July, 2001, and the copy of Page 47 supplied on 30 October, 2001.

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

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
09/911,904	07/23/2001	Spencer B. Farr	400742000200

CONFIRMATION NO. 4189

FORMALITIES LETTER

OC000000008026428

Terri M. Shieh-Newton
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

OIPE JC125
JUN 0 6 2002
PATENT & TRADEMARK OFFICE

Date Mailed: 05/06/2002

NOTICE OF INCOMPLETE REPLY (NONPROVISIONAL)

Filing Date Granted

The U.S. Patent and Trademark Office has received your reply on 04/09/2002 to the Notice to File Missing Parts (Notice) mailed 11/06/2001 and it has been entered into the nonprovisional application. The reply, however, does not include the following items required in the Notice.

The period of reply remains as set forth in the Notice. You may, however, obtain EXTENSIONS OF TIME under the provisions of 37 CFR 1.136 (a) accompanied by the appropriate fee (37 CFR 1.17(a)).

A complete reply must be timely filed to prevent ABANDONMENT of the above-identified application.

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:

- 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

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

FEE TRANSMITTAL FOR FY 2002

OIPE JC125 JUN 0 6 2002 PATENT & TRADEMARK OFFICE

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT ($)780.00

Complete if Known	
Application Number	09/911,904
Filing Date	July 23, 2001
First Named Inventor	Spencer B. FARR
Examiner Name	To Be Assigned
Group Art Unit	1642
Attorney Docket No.	400742000200

METHOD OF PAYMENT

1. [x] The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number: 03-1952

Deposit Account Name: Morrison & Foerster LLP

[x] Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

[x] 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 Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	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	40	- 40 =	0	x	9	=	$0.00
Independent Claims	10	- 10 =	0	x	42	=	$0.00
Multiple Dependent					140	=	$0.00

Large Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	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 claims, 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 Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
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 of the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per properties (times number of properties)	
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) Adjusted five-month extension of time $980.00 - $200.00 paid 4/5/02 — 780

*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) ($)780.00

SUBMITTED BY

Complete *(if applicable)*

Name (Print/Type)	Terri M. Shieh-Newton	*Registration No. (Attorney/Agent)*	*47,081*	*Telephone*	(650) 813-5649
Signature				*Date*	June 6, 2002

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: Commissioner for Patents, Washington, DC 20231.

06-10-02 09911904.060602 03CO $

OIPE JC125 JUN 06 2002 PATENT & TRADEMARK OFFICE

PTO/SB/21 (08-00)
Approved for use through 10/31/02. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Please type a plus sign (+) inside this box → [+]

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	174

Application Number	09/911,904
Filing Date	July 23, 2001
First Named Inventor	Spencer B. FARR
Group Art Unit	1642
Examiner Name	To Be Assigned
Attorney Docket No.	400742000200

ENCLOSURES (check all that apply)

- [X] Fee Transmittal Form plus copy for fee processing (2 pages)
  - [ ] Fee Attached
- [ ] Amendment / Reply
  - [ ] After Final
  - [ ] Affidavits/declarations
- [X] Extension of Time Request (1 page)
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Response to Missing Parts/ Incomplete Application
  - [ ] Response to Missing Parts under 37 CFR 1.52 or 1.53
- [ ] Assignment Papers *(for an Application)*
- [ ] Drawing(s)
- [ ] Licensing-related Papers
- [ ] Petition
- [ ] 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)*:
  1. Copy of Notice of Incomplete Reply (Nonprovisional) (1 page)
  2. Response to Notice of Incomplete Reply (Nonprovisional) (2 pages)
  3. Substitute Specification in compliance with 37 C.F.R. 1.52 (167 pages)
  4. Return Receipt Postcard

Remarks

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or Individual Name	Morrison & Foerster LLP, 755 Page Mill Rd, Palo Alto, California 94304-1018 Terri M. Shieh-Newton, Reg. No. 47,081
Signature	
Date	June 6, 2002

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

Express Mail Label No.: EV 093227027 US Date of Deposit: June 6, 2002

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Tamara Alcaraz

Burden Hours 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, Box Patent Application, Washington, DC 20231.

pa-699317

09911904 .060602

OIPE JC125
JUN 0 6 2002
PATENT & TRADEMARK OFFICE

PATENT
Docket No. 400742000200

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

Express Mail Label No.: EV 093227027 US Date of Deposit: June 6, 2002

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated above and is addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

Tamara Alcaraz

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the application of:

Spencer B. FARR et al.

Serial No.: 09/911,904

Filing Date: July 23, 2001

For: CANINE TOXICITY GENES

Examiner: To Be Assigned

Group Art Unit: 1642

RESPONSE TO NOTICE OF INCOMPLETE REPLY (NONPROVISIONAL)

Box MISSING PARTS
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Enclosed please find the following:

1. Substitute Application with revisions from April 5, 2002 Preliminary Amendment.

During a conversation with Customer Service at the U.S. Patent & Trademark Office on May 14, 2002, permission was given to include the revisions from the Preliminary Amendment submitted April 5, 2002 to the U.S. Patent & Trademark Office to the Substitute Application that we are submitting.

Please note that Applicant is submitting a total of $780.00 of which $980.00 is for a 5 month extension of time to extend the date from May 6, 2002 to June 6, 2002 minus the $200.00

06/13/2002 MBERHE 00000109 031952 09911904
01 FC:228 780.00 CH

fee previously paid on April 5, 2002 that extended the date to file the Missing Parts from January 6, 2002 to March 6, 2002.

The Assistant Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this transmittal, or to credit any overpayment, to **Deposit Account No. 03-1952**.

Respectfully submitted,

Dated: June 6, 2002

By: _____

Terri M. Shieh-Newton
Registration No. 47,081

Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, California 94304-1018
Telephone: (650) 813-5649
Facsimile: (650) 494-0792

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
09/911,904	07/23/2001	Spencer B. Farr	400742000200

OIPE JC144
APR 0 9 2002
PATENT & TRADEMARK OFFICE

CONFIRMATION NO. 4189

FORMALITIES LETTER

OC000000007033061

Terri Shieh-Newton
Morrison & Foerster LLP
755 Page Mill Road
Palo Alto, CA 94304-1018

Date Mailed: 11/06/2001

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.**

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:

- A substitute specification in compliance with 37 CFR 1.52 because:
  - Papers contain improper margins. *Each sheet must have a left margin of at least 2.5 cm (1") and top, bottom and right margins of at least 2.0 cm (3/4")*
- This application 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

00000001 031952 09911904

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

PTO/SB/17 (09-00)
Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

OIPE JC
APR 0 9 2002
PATENT & TRADEMARK OFFICE

FEE TRANSMITTAL FOR FY 2002

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT ($)265.00

Complete if Known	
Application Number	09/911,904
Filing Date	July 23, 2001
First Named Inventor	Spencer B. FARR
Examiner Name	To Be Assigned
Group Art Unit	1642
Attorney Docket No.	400742000200

METHOD OF PAYMENT

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

Deposit Account Number: 03-1952

Deposit Account Name: Morrison & Foerster LLP

☒ 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 Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	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	40	- 40 =	0	x	9.00	=	$0.00
Independent Claims	10	- 10 =	0	x	42.00	=	$0.00
Multiple Dependent					140.00	=	$0.00

Large Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	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 claims, 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 Fee Code	Entity Fee ($)	Small Fee Code	Entity Fee ($)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	65
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	200
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 of the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	180	126	180	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per properties (times number of properties)	
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) ($)265.00

SUBMITTED BY				Complete *(if applicable)*	
Name (Print/Type)	Terri Shieh-Newton	*Registration No. (Attorney/Agent)*	*47.081*	*Telephone*	(650) 813-5649
Signature				*Date*	April 5, 2002

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: Commissioner for Patents, Washington, DC 20231.

pa-680860

09911904 .040902

Box Seq

mp

$

OIPE JC144
APR 0 9 2002
PATENT & TRADEMARK OFFICE

Please type a plus sign (+) inside this box → +

PTO/SB/21 (08-00)
Approved for use through 10/31/02. 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	257

Application Number	09/911,904
Filing Date	July 23, 2001
First Named Inventor	Spencer B. FARR
Group Art Unit	1642
Examiner Name	To Be Assigned
Attorney Docket No.	400742000200

ENCLOSURES (check all that apply)

- [x] Fee Transmittal Form plus copy for fee processing (2 pages)
  - [ ] Fee Attached
- [x] Amendment / Reply (152 pages)
  - [ ] After Final
  - [ ] Affidavits/declarations
- [x] Extension of Time Request (1 page)
- [ ] 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
- [ ] 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
- [ ] Other Enclosure(s) *(please identify below):*
  1. Copy of Notice to File Missing Parts of Nonprovisional Application (2 pages)
  2. Declaration for Utility Patent Application (signed in counterpart) (8 pages)
  3. Prosecution by Assignee and Power of Attorney Under 37 C.F.R. § 3.71 (3 pages)
  4. Certificate Under 37 C.F.R. § 3.73(b) and copy of Joint Assignment (signed in counterpart) (9 pages)
  5. Statement to Support Filing and Submission in Accordance with 37 C.F.R. §§ 1.821-1.825 (2 pages)
  6. Paper copy of the "Sequence Listing" (77 pages)
  7. Computer readable form (CRF) copy of the "Sequence Listing"
  8. Return Receipt Postcard

Remarks

SIGNATURE OF APPLICANT, ATTORNEY OR AGENT

Firm or Individual Name	Morrison & Foerster LLP, 755 Page Mill Rd, Palo Alto, California 94304-1018 Terri Shieh-Newton, Reg. No. 47,081
Signature	
Date	April 5, 2002

CERTIFICATE OF MAILING BY "FIRST CLASS MAIL"

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on April 5, 2002.

Hazel M. Raskowitz

Hazel M. Raskowitz

Burden Hours 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, Box Patent Application, Washington, DC 20231.

pa-680851

UNITED STATES 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

Kelly K. Kordzik
Winstead Sechrest & Minick, P.C.
5400 Renaissance Tower
1201 Elm Street
Dallas, TX 75270

COPY MAILED
NOV 03 2003
OFFICE OF PETITIONS

In re Application of	:	
Peter Chow	:	
Application No. 09/911,907	:	DECISION GRANTING PETITION
Filed: July 23, 2001	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. 2017P/F0994	:	

This is a decision on the petition, filed August 18, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the instant nonprovisional application for failure to timely notify the U.S. Patent and Trademark (USPTO) of the filing of an application in a foreign country, or under a multinational treaty that requires publication of applications eighteen months after filing. *See* 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application which was filed in an eighteen-month publication country on January 23, 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.

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 2143 for examination in due course.

Marianne E. Morgan

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

Mail Date: 04/23/2010

Applicant	: Takuma Miyazaki	: DECISION ON REQUEST FOR
Patent Number	: 7620965	: RECALCULATION of PATENT
Issue Date	: 11/17/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/911,911	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/24/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1631** 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 9/9/1913

Paper No.: —

DATE : 1/31/06

TO SPE OF : ART UNIT 1762

SUBJECT : Request for Certificate of Correction on Patent No.: 6900129 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.

Virginia Tolbert

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-308-9390 ext. 113

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

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

Comments:

TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER

SPE

1762
Art Unit

PTOL-306 (REV. 7/03)

U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

Thomas Louis Russo
7 Avenue D
Rutland VT 05701

COPY MAILED

JUN 14 2004

OFFICE OF PETITIONS

In re Application of :
Thomas Louis Russo :
Application No. 09/911,949 :
Filed: July 24, 2001 :
Title: Reusable Inflatable Zone :
Packing Pad :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed February 3, 2004, to revive the above-identified application on the basis of unavoidable delay.

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

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled, "Renewed Petition under 37 CFR 1.137(a)." In the alternative, applicant may wish to file petition under 37 CFR 1.137(b), to revive the application on the basis of unintentional delay.

The above-identified application became abandoned for failure to timely file a proper response to the final Office action mailed March 19, 2003, which set a shortened statutory period for reply of three (3) months. On June 17, 2003, applicant filed a timely amendment. However, by advisory action mailed July 1, 2003, applicant was advised that the amendment had been considered, but was not deemed to place the application in condition for allowance. The advisory action stated that the period for reply expires within three (3) months of the final Office action of March 19, 2003. The advisory action further indicated that applicant could obtain extensions of time to reply pursuant to 37 CFR 1.136(a).

On September 26, 2003 (certificate of mailing September 19, 2003), applicant filed a response. However, applicant did not purchase the required three-month extension of time under 37 CFR 1.136(a) in order to make the reply timely. Moreover, the Notice of Abandonment stated that the proposed reply received on September 26, 2003, did not constitute a proper reply under 37 CFR 1.113 to the final rejection. Accordingly, the above-identified application became abandoned on June 20, 2003. A Notice of Abandonment was mailed on December 19, 2003.

Consideration of petition under 1.137(a) (Unavoidable Delay):

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 does not satisfy requirements (1) and (3).

As to requirement (3), 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."[1]

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the MPEP, however, does not constitute "unavoidable" delay.[2]

37 CFR 1.135(b), the regulation relevant to the abandonment of this application, provides that (A) the admission of, or refusal to admit, any amendment after final rejection, or any related

---

[1] In re Mattulath, 38 App. D.C. 497, 514-15 (1912)(*quoting* Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

[2] See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

proceedings, will not operate to save the application from abandonment; and (B) the admission of, or refusal to admit, any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment. It is the applicant's responsibility to take the necessary action in an application under a final Office action to provide a complete reply under 37 CFR 1.113. "A delay is not 'unavoidable' when the applicant simply permits the maximum extendable statutory period for reply to a final Office action to expire while awaiting a notice of allowance or other action."[3]

Applicant should have ensured that the amendment had been entered or, in the alternative, filed a Request for Continued Examination (RCE), continuing application, or Notice of Appeal.

In order for the application to be revived, petitioner must submit a proper reply. **Any renewed petition should be accompanied by a proper reply in the form of either: (1) an amendment, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee); or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.**

Conclusion:

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, applicant is not precluded from obtaining relief by filing a request for reconsideration pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition under 37 CFR 1.137(b) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(m)[4]; (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). A Blank form for a petition under 37 CFR 1.137(b) is enclosed for petitioner's convenience.

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

---

[3] MPEP 711.03(c)(III)(C)(2).

[4] Currently $665.00 for a small entity

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: 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 decision should be directed to the undersigned at (703) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enc: PTO/SB/64 (2 pages)
P.L. 93-579

UNITED STATES 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:
MAR 1 8 2004

RPG

Paper No. 6

In re application of
Albert Ilya Yezrielev et al.
Serial No. 09/911,962
Filed: July 23, 2001
For: ENVIRONMENTALLY PREFERRED FLUIDS AND FLUID BLENDS

DECISION ON PETITION

This is a decision on the PETITION TO WITHDRAW HOLDING OF ABANDONMENT, filed October 31, 2003, for failure to timely reply to the Office Action dated January 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 27, 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 Office Action of January 30, 2002 will be remailed and time period for response will be restarted.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Exxon Mobile Chemical Company
P.O. Box 2149
Baytown, TX 77522

UNITED STATES PATENT AND TRADEMARK OFFICE

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

AUG 04 2005

KRAMER LEVIN NAFTALIS & FRANKEL LLP
INTELLECTUAL PROPERTY DEPARTMENT
1177 AVENUE OF THE AMERICAS
NEW YORK NY 10036

In re Application of	:	
Grayzel et al	:	
Serial No.: 09/912,008	:	DECISION ON PETITION
Filed: July 24, 2001	:	
For: Stiffened Balloon Catheter for Dilatation: And Stenting	:	

This is in response to applicants' petition filed April 18, 2005 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 Frederick Schmidt by letter addressed to the Director, Technology Center 3700, P.O. Box 1450 Alexandria, VA 22313-1450, or by telephone at (571) 272-2975 or by facsimile transmission at (571) 273-8300.

Frederick R. Schmidt

Frederick R. Schmidt, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JEFFREY FURR
253 N. MAIN STREET
JOHNSTOWN, OH 43031

COPY MAILED

NOV 23 2004

OFFICE OF PETITIONS

In re Application of
Frye and Huitt
Application No. 09/912,009
Filed: July 24, 2001
Attorney Docket No. 38, 146
For: RF Multiple Load Cell Scale

DECISION REFUSING TO ACCORD STATUS UNDER 37 CFR 1.47(a)

This is a decision on the petition under 37 CFR 1.47(a), filed January 8, 2002. The Office is also *sua sponte* treating the paper as a request under 37 CFR 1.181 to accord the application a filing date of July 24, 2001.

The petition under 37 CFR 1.47 is **dismissed**.

The petition for a filing date under 37 CFR 1.181 is **granted**.

The petition under 37 CFR 1.47:

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.**

It should first be noted that the inventors of record are:
(1) Craig Frye, and
(2) Bruce Huitt.

Since Kenneth Bauman cited in the petition is not listed on the declaration, he is not an inventor of record.

The petition is being treated as a request to accept the declaration without the signature of inventor Bruce Huitt.

A grantable petition under 37 CFR 1.47(a) requires

(1) proof that the non-signing inventor cannot be found or reached after diligent effort or that the inventor refuses to sign after having been presented with the application papers (specification, claims, and drawings),
(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).

In addition to the above requirements, the signing inventors must sign the declaration on behalf of the non-signing inventor. See MPEP 409.03(a).

The instant petition fails to satisfy (1) and (2).

As to (1), petitioner has failed to provide any evidence to establish that Huitt cannot be found or refuses to sign the declaration. The petition simply states Huitt is unavailable to sign the declaration.

As to (2), the changes were made to the information for Huitt on the declaration without any indication whether or not the changes were made before or after Frye signed the declaration. A new declaration signed by Frye on Huitt's behalf or by Huitt should be submitted.

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
Attn: Office of Petitions

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

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

The petition under 37 CFR 1.181:

The application was filed on July 24, 2001.

Upon submission of the petition under 37 CFR 1.47, the Office incorrectly changed the filing date to January 8, 2002. The reason for the change is unknown.

The filing date will be corrected to indicate a filing date of July 24, 2001.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JEFFREY FURR
253 N. MAIN STREET
JOHNSTOWN, OH 43031

COPY MAILED

JUN 0 3 2005

OFFICE OF PETITIONS

In re Application of
Frye and Huitt
Application No. 09/912,009
Filed: July 24, 2001
Attorney Docket No. 38, 146
For: RF Multiple Load Cell Scale

DECISION REFUSING TO ACCORD STATUS UNDER 37 CFR 1.47(a)

This is a decision on the renewed petition under 37 CFR 1.47(a), filed February 17, 2005.

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.**

It should first be noted that the inventors of record are:
(1) Craig Frye, and
(2) Bruce Huitt.

Since Kenneth Bauman cited in the petition is not listed on the declaration, he is not an inventor of record.

The original petition was treated as a request to accept the declaration without the signature of inventor Bruce Huitt.

Petitioner has now submitted a copy of a declaration signed by Huitt. The declaration states each inventor is listed on the declaration and only lists Huitt's name. In other words, the declaration states Huitt is the only inventor.

Unless a petition under 37 CFR 1.48 is filed, Huitt should sign a declaration listing his name and Frye's name.

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
Attn: Office of Petitions

If a request for reconsideration is filed, and a decision on the new petition is not received within three months, petitioner may wish to call the number below to check on the status of the renewed petition.

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

Charles Steven Brantley
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 7

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

In re the patent application of: Zyskind, J., et al. Application No.: 09/912,020 Filed: July 23, 2001 For: Genes Identified As Required For Proliferation In Escherichia Coli	DECISION ON PETITION

This is a decision under 37 C.F.R. 1.183, filed March 5, 2002 to waive the requirement of 37 C.F.R. 1.98(a)(2), for a copy of the sequence listing for European Publication No. 0 786 519 in an Information Disclosure Statement (IDS) filed in the above-identified application.

The petition under 37 C.F.R. 1.183 to waive the rules in the above noted application is **GRANTED**.

37 C.F.R. 1.98 requires applicants to submit as part of an IDS a legible copy of the portion of the reference that caused it to included in the IDS. The size and method of publication of the sequence listing in European Publication No. 0 786 519 makes it burdensome for applicant to submit, and for the Office to process if submitted, in the form it was published. Applicant and Michael Lewis of this office determined in earlier telephonic communications that the Office already has a copy of the sequence portion of the '519 document in a more usable form than applicant could submit.

Accordingly, it would be an unnecessary burden on both applicant and the Office to insist on a paper copy of the sequence portion of the '519 document.

The petition is granted to the extent that no paper copy of the sequence portion of the '519 reference needs be submitted with an IDS in this application.

After this decision is mailed, the application will be returned to the Technology Center 1600 for examination.

Telephone inquiries should be directed to Michael L. Lewis at (703) 306-5585.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 13

BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ, S.C.
250 E. WISCONSIN AVENUE
SUITE 1030
MILWAUKEE WI 53202

COPY MAILED

APR 0 7 2003

OFFICE OF PETITIONS

In re Application of	:
Thomas G. Rehberger et al	:
Application No. 09/912,049	: DECISION GRANTING PETITION
Filed: July 24, 2001	: UNDER 37 CFR 1.137(f)
Attorney Docket No. 362.003	:

This is a decision on the petition, filed February 20, 2003, to revive the instant nonprovisional application under the unintentional provisions of 37 CFR 1.137(f).

The petition is **GRANTED**.

Petitioner states that the instant nonprovisional application is the subject of an application filed in a foreign country on July 24, 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. It appears that a corrected Filing Receipt was previously mailed. Nevertheless, another corrected Filing Receipt which sets forth the projected publication date of July 10, 2003 accompanies this decision on petition.

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This application is being forwarded to Technology Center Art Unit 1651 to await a reply, if not already filed, to the January 3, 2003 nonfinal Office action.[1]

Frances Hicks

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

ATTACHMENT: Corrected Filing Receipt

---

[1] Petitioner is reminded that failure to timely reply to the January 3, 2003 nonfinal Office action will again result in the abandonment of this 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.go

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

MAIL

DEC 2 2 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

In re application of:
Song Zhang
Application No. 09/912,068
Filed: July 23, 2001
For: METHOD AND SYSTEM FOR TURBO ENCODING IN ADSL

DECISION ON REQUEST TO WITHDRAW FROM RECORD

This is a decision on the request for withdrawal as attorney/agent and change of correspondence address filed on September 27, 2004

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

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

All of the attorneys/agents associated with Customer Number 20350 have been withdrawn.

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

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

cc: Kris V. Kalidindi, Esq.
Potomac Patent Group, PLLC
2010 Corporate Ridge, Suite 700
McLean, VA 22102

UNITED STATES PATENT AND TRADEMARK OFFICE

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

KRISHNA KALIDINDI
POTOMAC PATENT GROUP, PLLC.
P.O. BOX 0855
McLEAN, VA 22101-0855

COPY MAILED

APR 11 2006

OFFICE OF PETITIONS

In re Application of	:	
SONG ZHANG, et al	:	
Application No. 09/912,068	:	DECISION ON PETITION
Filed: July 23, 2001	:	TO WITHDRAW
Attorney Docket No. 10.1017	:	FROM RECORD

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. §1.36(b), filed August 15, 2005.

The request is **NOT APPROVED as moot.**

A review of the file record indicates that the power of attorney to all attorneys of record has been revoked by the assignee of the patent application on September 2, 2005. Accordingly, the request to withdraw under 37 C.F.R. § 1.136(b) is moot.

Telephone inquiries concerning this decision should be directed to Amelia Au at 571.272.7414.

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

There is an outstanding Office action mailed March 21, 2006 that requires a reply from the applicant.

Amelia Au
Petitions Examiner
Office of Petitions

cc: MEREK, BLACKMON & VOORHEES, LLC
673 S. WASHINGTON ST.
ALEXANDRIA VA 22314

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

MAIL

MAR 1 0 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

SIEMENS SCHWEIZ
I-44, INTELLECTUAL PROPERTY
ALBISRIEDERSTRASSE 245
ZURICH CH-80-47 CH SWITZERLAND

In re Application of	:	
Ming-Yee Chiu et al	:	
Application No. 09/912,069	:	DECISION ON REQUEST TO
Filed: July 24, 2001	:	WITHDRAW AS ATTORNEY
For: **METHOD AND ARRANGEMENT FOR CAMERA CALIBRATION**	:	

This is a decision on the request to withdraw as attorney/agent of record filed on January 31, 2003.

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

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

All attorneys and agents of record associated with Customer No. 26461 are removed from record.

All future communications from the Office will be directed to the address listed below provided by the withdrawing attorney 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: Epping, Hermann & Fischer
Ridlerstrasse 55
Munich, D-80339
Germany

UNITED STATES 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
AUG 29 2006
OFFICE OF PETITIONS

LADAS & PARRY
26 WEST 61 STREET
NEW YORK NY 10023

In re Application of
Motoyuki Fujimori
Application No. 09/912,070
Filed: July 24, 2001
Attorney Docket No. U 013566-9

ON PETITION

COPY MAILED
AUG 30 2006
OFFICE OF PETITIONS

This is a decision on the petition filed May 6, 2003, to withdraw the holding of abandonment of the above-identified application, which is treated under 37 CFR 1.181.

The petition is DISMISSED.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181," or, as explained in more detail below, "...under 37 CFR 1.137(a)" or (b). This is not a final agency decision.

The above-referenced application was held abandoned on March 6, 2003, for failure to file drawing corrections required by a Final Office Action mailed December 5, 2002. The Office Action set a three (3)-month statutory period for reply. Accordingly, a Notice of Abandonment was mailed April 23, 2003.

Petitioner contends that 1) the period for response did not lapse until June 5, 2003 and 2) the Examiner was not clear in the Final Office Action regarding the drawings requirements to allow petitioner to therefore file a proper response.

In response to the Final Office Action, an amendment and a two month extension of time were filed on April 9, 2003. The extension of time however, only extended the time for response from March 6, 2003 to May 6, 2003, not to June 5, 2003 and as noted in the Notice of Abandonment, the response did not include proper drawing corrections. Thus, the amendment filed April 9, 2003 was not responsive to the Office Action and the application was appropriately abandoned.

With respect to the language or terminology used in the Office Action regarding the drawings, petitioner could have responded to the drawing requirements prior to the abandonment of the application and therefore could have avoided the abandonment. In view thereof, the holding of abandonment will not be withdrawn and the notice of abandonment will not be vacated.

Petitioner may wish to file a petition to revive under 37 CFR 1.137(a) or (b). Section 1.137(b) now provides that where the delay in reply was unintentional, a petition may be

filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

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

(2) the petition fee as set forth in 37 CFR 1.17(m) ($675.00);

(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 filing of a petition under the unintentional standard cannot be intentionally delayed and therefore should be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the delay from the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

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

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

By FAX: (571) 273-8300

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

LADAS & PARRY
26 WEST 61 STREET
NEW YORK NY 10023

COPY MAILED
DEC 0 4 2006
OFFICE OF PETITIONS

In re Application of Motoyuki Fujimori Application No. 09/912,070 Filed: July 24, 2001 Attorney Docket No. U 013566-9	: : : : :	ON PETITION

This is a decision on the petition under 37 CFR 1.137(b)[1], filed November 2, 2006, 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(b) 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-referenced application was held abandoned on March 6, 2003, for failure to file drawing corrections required by a Final Office Action mailed December 5, 2002. The Office Action set a three (3)-month statutory period for reply. In response to the Final Office Action, an amendment and a one month extension of time were filed on April 9, 2003 (certificate of mail date April 4, 2003). The extension of time extended the time for response from March 6, 2003 to April 6, 2003, however the response filed April 9, 2003 did not include proper drawing corrections. Thus, the amendment filed April 9, 2003 was not responsive to the Office Action and the application was appropriately abandoned. Accordingly, a Notice of Abandonment was mailed April 23, 2003.

The petition does not satisfy requirement (1) under 37 CFR 1.137(b).

---

[1]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

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

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

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

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

The application became abandoned for failure to file a response within the meaning of 37 CFR 1.113 to the final rejection of December 5, 2002, within the time period for response. The only proper reply to a final Office action is an amendment placing the application in *prima facie* condition for allowance, a Notice of Appeal accompanied by the requisite fee, a Request for Continued Examination (RCE) accompanied by a proper submission, or a continuing application. Since the amendment submitted April 9, 2003 has been referred to the examiner, who has indicated that the amendment does not prima facie place the application in condition for allowance, the response required for a renewed petition must be a Notice of Appeal and requisite fee, or the filing of a continuing application under the terms set forth in 1031 O.G. 11.

Petitioner must submit a proper reply to the final Office action mailed on December 5, 2002, with any renewed petition. **Petitioner should note that submission of any renewed petition without the required reply will be construed as intentional delay.**

A courtesy copy of an Advisory Action is included.

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

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

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

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/912,070	Applicant(s) FUJIMORI, MOTOYUKI	
	Examiner Andrew T. Sever	Art Unit 2851	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 April 2003 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 and 3-20*.
   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 argues that the amendment places the claims in a condition for allowance, however the amendment will not be entered since it requires further consideration and/or search (see above). Accordingly these arguments are moot. With regards to claim 9, specifically the 35 USC 112 rejection, applicant's arguments are found persuasive and the rejection will be withdrawn, however claim 9 remains rejected under 35 USC 102. With regards to the drawing corrections these arguments have been addressed elsewhere .
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

Continuation of 3. NOTE: Applicant has amended claim 1 to claim that that the inner case is covered with one of the outer cases instead of blocked by one of the outer cases. The terms covered and blocked are not necessarily synonyms and therefore the new term requires further search and/or consideration. .

Continuation of 13. Other: Applicant should note the US 6,742,900 claim 1 includes similar language to claim 1 of the present application and accordingly the present applicant potentially could be subjected to double patenting .

UNITED STATES 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

FEB 2 2 2007

OFFICE OF PETITIONS

LADAS & PARRY
26 WEST 61 STREET
NEW YORK NY 10023

In re Application of
Motoyuki Fujimori
Application No. 09/912,070
Filed: July 24, 2001
Attorney Docket No. U 013566-9

: ON PETITION

This is a decision on the renewed petition under 37 CFR 1.137(b)[1], filed January 9, 2007, to revive the above-identified application.

The petition is GRANTED.

The above-referenced application was held abandoned on March 6, 2003, for failure to file drawing corrections required by a Final Office Action mailed December 5, 2002. The Office Action set a three (3)-month statutory period for reply. In response to the Final Office Action, an amendment and a one month extension of time were filed on April 9, 2003 (certificate of mail date April 4, 2003). The extension of time extended the time for response from March 6, 2003 to April 6, 2003, however the response filed April 9, 2003 did not include proper drawing corrections. Thus, the amendment filed April 9, 2003 was not responsive to the Office Action and the application was appropriately abandoned. Accordingly, a Notice of Abandonment was mailed April 23, 2003. A petition filed November 2, 2006 was dismissed in a decision mailed December 4, 2006 because the petition did not satisfy requirement (1) under 37 CFR 1.137(b).

Comes now petitioner with the instant renewed petition, a Request for Continued Examination (RCE) and an amendment as the submission required under 37 CFR 1.114.

This matter is being referred to Technology Center 2851 for processing of the RCE.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

---

[1] Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH NC 27627

MAILED

FEB 17 2010

OFFICE OF PETITIONS

In re Application of	:	
MOYER et al.	:	LETTER REGARDING PATENT
Application No. 09/912,072	:	TERM ADJUSTMENT
Filed: July 24, 2001	:	
Attorney Docket No. 5051-445	:	

This letter is in response to the LETTER REGARDING PATENT TERM ADJUSTMENT filed December 2, 2009. Pursuant to applicants' duty of good faith and candor to the Office, applicants request 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 is **GRANTED to the extent indicate herein**.

The Office has updated the PALM and PAIR screen to reflect that the 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 is enclosed.

On October 6, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 551 days. On December 2, 2009, applicants submitted the instant comment.

Applicants request that the Office review the periods of adjustment for Office delay of 337 days and 215 days. Applicants do not state a specific basis for requesting these periods of adjustment be reviewed for accuracy.

A review of the application history confirms that the entry of the periods of adjustment for Office delay of 337 days and 215 days are incorrect.

As to the period of adjustment of 337 days, it is noted that the failure of the Office to respond to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken is a ground for adjustment of patent term due to examination delay under the Patent Term Guarantee Act of 1999. 37 CFR 1.702(a). The phrase the date on which "an appeal was taken" in 35 U.S.C. 154(b)(i)(A)(ii) means the date on which an appeal brief (and not a notice of appeal) was filed. The phrase "appeal brief in compliance with 37 CFR 1.192" requires that: (i) the appeal brief fee (37 CFR 1.17(c)) be paid (37 CFR 1.192(a)); and (2) the appeal brief complies with 37 CFR 1.192(c)(i) through (c)(9). Accordingly, 37 CFR 1.703(a)(4) pertains to the provisions of 35 U.S.C. 154(b)(i)(A)(ii) and specifies that the period of adjustment for Office delay includes the number of days, if any, in the period beginning on the day after the date that is four months after the date an appeal brief in compliance with § 1.192 was filed and ending on the date of mailing of any of an examiner's answer under § 1.193, an action under 35 U.S.C. 132, or a notice of allowance under 35 U.S.C. 151, whichever occurs first.

In this instance, an appeal brief was filed on January 29, 2007. On April 12, 2007, a notification of non-compliant appeal brief was mailed. On May 2, 2007, a second appeal brief was filed. On August 8, 2007, a notification of non-compliant appeal brief was mailed. On August 20, 2007, a third appeal brief was filed. On November 2, 2007, a notification of non-compliant appeal brief was mailed. On November 12, 2007, a fourth appeal brief was filed. On January 28, 2008, a notification of non-compliant appeal brief was mailed. On February 1, 2008, a corrected appeal brief was filed. On April 30, 2008, an examiner's answer under § 1.193 was mailed within four (4) months of February 1, 2008, the date the appeal brief in compliance with 37 CFR 1.192 was filed. Accordingly, there was no basis for entry of a period of adjustment for Office delay pursuant to 37 CFR 1.703(a)(4). The period of adjustment of 337 days is being removed.

As to the period of adjustment of 215 days, the record does not reveal any circumstances that constitute a failure by the Office to take certain action within a specified time frame. See 35 U.S.C. 154(b)(1)(A). Accordingly, the adjustment of 215 days of patent term was entered in error. The period of adjustment of 215 days will be removed as it is not warranted.

In view thereof, the correct patent term adjustment at the time of the mailing of the notice of allowance is **zero (0) days** (384 days of Office delay less 385 days of applicant delay).

As this letter was submitted as an advisement to the Office of an error in applicants' favor, the Office will not assess the $200.00 fee as set forth in 37 CFR 1.18(e). The Office thanks applicants for their good faith and candor in bringing this to the attention of the Office.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of updated PAIR screen

Day : Wednesday

PALM INTRANET

Date: 2/10/2010
Time: 19:06:55

PTA Calculations for Application: 09/912072			
Application Filing Date:	07/24/2001	PTO Delay (PTO):	936
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	385
Post-Issue Petitions:	0	Total PTA (days):	0
PTO Delay Adjustment:	-552		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
108	02/10/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		215	
107	02/10/2010	ADJUSTMENT OF PTA CALCULATION BY PTO		337	
98	10/06/2009	MAIL NOTICE OF ALLOWANCE	4		86
97	10/01/2009	DOCUMENT VERIFICATION			
96	10/01/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
95	09/28/2009	NOTICE OF ALLOWABILITY			
92	08/04/2009	DATE FORWARDED TO EXAMINER			
91	07/31/2009	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
90	08/04/2009	DATE FORWARDED TO EXAMINER			
89	07/31/2009	REQUEST FOR CONTINUED EXAMINATION (RCE)			
88	08/04/2009	DISPOSAL FOR A RCE / CPA / R129			
87	07/31/2009	WORKFLOW - REQUEST FOR RCE - BEGIN			
86	06/02/2009	MAIL BPAI DECISION ON APPEAL - AFFIRMED	215		77
85	06/02/2009	BPAI DECISION - EXAMINER AFFIRMED			
83	10/24/2008	DOCKETING NOTICE MAILED TO APPELLANT			
82	10/24/2008	ASSIGNMENT OF APPEAL NUMBER			
81	08/14/2008	APPEAL AWAITING BPAI DOCKETING			
80	07/11/2008	MAIL REPLY BRIEF NOTED BY EXAMINER			
79	07/09/2008	REPLY BRIEF NOTED BY EXAMINER			
78	06/30/2008	DATE FORWARDED TO EXAMINER			
77	06/30/2008	REPLY BRIEF FILED			
76	05/05/2008	EXAM. ANS. REVIEW COMPLETE			
75	04/30/2008	MAIL EXAMINER'S ANSWER	337		53
74	04/28/2008	EXAMINER'S ANSWER TO APPEAL BRIEF			

73	02/14/2008	APPEAL BRIEF REVIEW COMPLETE			
72	02/14/2008	DATE FORWARDED TO EXAMINER			
71	02/01/2008	APPEAL BRIEF FILED			
70	01/28/2008	NOTICE -- DEFECTIVE APPEAL BRIEF			
69	11/19/2007	APPEAL BRIEF REVIEW COMPLETE			
68	11/19/2007	DATE FORWARDED TO EXAMINER			
67.1	11/12/2007	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
67	11/12/2007	APPEAL BRIEF FILED			
66	11/19/2007	DATE FORWARDED TO EXAMINER			
65	11/12/2007	AMENDMENT/ARGUMENT AFTER NOTICE OF APPEAL			
64	11/02/2007	NOTICE -- DEFECTIVE APPEAL BRIEF			
63	09/10/2007	APPEAL BRIEF REVIEW COMPLETE			
62	09/10/2007	DATE FORWARDED TO EXAMINER			
61.1	08/20/2007	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
61	08/20/2007	APPEAL BRIEF FILED			
60	08/08/2007	NOTICE -- DEFECTIVE APPEAL BRIEF			
59	06/07/2007	APPEAL BRIEF REVIEW COMPLETE			
58	06/07/2007	DATE FORWARDED TO EXAMINER			
57.1	05/02/2007	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
57	05/02/2007	APPEAL BRIEF FILED			
56	04/12/2007	NOTICE -- DEFECTIVE APPEAL BRIEF			
55	04/10/2007	APPEAL BRIEF REVIEW COMPLETE			
54	04/10/2007	DATE FORWARDED TO EXAMINER			
53.1	01/29/2007	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
53	01/29/2007	APPEAL BRIEF FILED			
52	11/27/2006	NOTICE OF APPEAL FILED		25	50
51	11/27/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
50	08/02/2006	MAIL FINAL REJECTION (PTOL - 326)			
49	07/24/2006	FINAL REJECTION			
48	05/12/2006	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
47	05/18/2006	DATE FORWARDED TO EXAMINER			
46	05/12/2006	RESPONSE AFTER NON-FINAL ACTION		94	42

45	05/04/2006	MAIL NOTICE OF INFORMAL OR NON-RESPONSIVE AMENDMENT			
44	02/07/2006	AFFIDAVIT(S) (RULE 131 OR 132) OR EXHIBIT(S) RECEIVED			
43	02/16/2006	DATE FORWARDED TO EXAMINER			
42.1	02/07/2006	INFORMAL OR NON-RESPONSIVE AMENDMENT AFTER EXAMINER ACTION			
42	02/07/2006	RESPONSE AFTER NON-FINAL ACTION		89	38
41	02/07/2006	REQUEST FOR EXTENSION OF TIME - GRANTED			
40	12/21/2005	MAIL EXAMINER INTERVIEW SUMMARY (PTOL - 413)			
39	12/02/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
38	08/10/2005	MAIL NON-FINAL REJECTION			
37	08/08/2005	NON-FINAL REJECTION			
36	06/02/2005	DATE FORWARDED TO EXAMINER			
35	05/23/2005	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			
34	06/02/2005	DATE FORWARDED TO EXAMINER			
33	05/23/2005	REQUEST FOR CONTINUED EXAMINATION (RCE)		86	29
32	06/02/2005	DISPOSAL FOR A RCE / CPA / R129			
31	05/23/2005	REQUEST FOR EXTENSION OF TIME - GRANTED			
30	05/23/2005	WORKFLOW - REQUEST FOR RCE - BEGIN			
29	11/26/2004	MAIL FINAL REJECTION (PTOL - 326)			
28	11/24/2004	FINAL REJECTION			
27.7	09/09/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
27	09/09/2004	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
26	09/09/2004	NEW OR ADDITIONAL DRAWING FILED			
25	09/21/2004	DATE FORWARDED TO EXAMINER			
24	09/09/2004	RESPONSE AFTER NON-FINAL ACTION		91	20
23	09/09/2004	REQUEST FOR EXTENSION OF TIME - GRANTED			
22	09/09/2004	WORKFLOW INCOMING AMENDMENT IFW			
21	05/13/2004	CASE DOCKETED TO EXAMINER IN GAU			
20	03/10/2004	MAIL NON-FINAL REJECTION	30		17

19	03/08/2004	NON-FINAL REJECTION			
18	11/01/2003	DATE FORWARDED TO EXAMINER			
17	10/09/2003	RESPONSE TO ELECTION / RESTRICTION FILED			
16	09/09/2003	MAIL RESTRICTION REQUIREMENT	350		-1
15	09/08/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
14	06/24/2003	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
13	04/18/2003	CASE DOCKETED TO EXAMINER IN GAU			
12	05/11/2002	X-PRE-LEGAL COMPLETE NEW CASE			
11.7	12/10/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
11	12/10/2001	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
10	05/11/2002	CASE DOCKETED TO EXAMINER IN GAU			
9	03/28/2002	APPLICATION DISPATCHED FROM OIPE			
8	03/27/2002	APPLICATION IS NOW COMPLETE			
7	11/07/2001	A STATEMENT BY ONE OR MORE INVENTORS SATISFYING THE REQUIREMENT UNDER 35 USC 115, OATH OF THE APPLIC			
6	09/27/2001	NOTICE MAILED--APPLICATION INCOMPLETE--FILING DATE ASSIGNED			
5	09/27/2001	CORRESPONDENCE ADDRESS CHANGE			
4	09/12/2001	CRF IS GOOD TECHNICALLY / ENTERED INTO DATABASE			
3	07/31/2001	IFW SCAN & PACR AUTO SECURITY REVIEW			
2	07/24/2001	CRF DISK HAS BEEN RECEIVED BY PREEXAM / GROUP / PCT			
1	07/24/2001	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.

Back to OASIS | Home 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

MAILED

APR 15 2010

OFFICE OF PETITIONS

MYERS BIGEL SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH NC 27627

In re Patent No. 7,695,901	:	
Moyer et al.	:	LETTER REGARDING
Issue Date: April 13, 2010	:	PATENT TERM ADJUSTMENT
Application No. 09/912,072	:	and
Filed: July 24, 2001	:	NOTICE OF INTENT TO ISSUE
Attorney Docket No.5051-445	:	CERTIFICATE OF CORRECTION

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT filed April 13, 2010. Patentees request that the patent term adjustment for the above-identified patent be corrected from eighty-seven (87) days to three hundred two (302) days due to an administrative error on the part of the USPTO.

The request for reconsideration of the patent term adjustment indicated in the patent is **GRANTED**.

The Office has determined that the patent term adjustment requires correction. 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 two (302) days.**

On April 13, 2010, the above-identified application matured into U.S. Patent No. 7,695,901 with a revised Patent Term Adjustment of 87 days. It has been determined that due to clerical error an incorrect Patent Term Adjustment was indicated on the patent. This Office error has been corrected and the period of reduction of 215 days has been removed.

No fee is required and no fee has been charged for this correction.

This matter 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 two (302) days.**

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3211.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of DRAFT Certificate of Correction

DRAFT COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT : 7,695,901 B2

DATED : Apr. 13, 2010

INVENTOR(S) : Moyer 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 (87) days

Delete the phrase "by 87 days" and insert – by 302 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

LOUIS PAUL HERZBERG
3 CLOVERDALE LANE
MONSEY, NY 10952

COPY MAILED

MAR 1 7 2006

OFFICE OF PETITIONS

In re Application of

Sakamoto, et al. :

Application No. 09/912,109

: DECISION ON PETITION

Filed: July 24, 2001

:

Attorney Docket No. **JP920000036US1**

This is a decision on the petition under 37 CFR 1.137(b), filed March 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 July 28, 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 October 29, 2005. A Notice of Abandonment had not been mailed at the time of this decision.

The amendment filed March 9, 2006, is noted.

The request for a change in the correspondence address, filed March 9, 2006, is noted and made of record.

The application is being forwarded to Technology Center 2600, GAU 2614 for further processing.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3222.

Kenya A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 UNOCAL PLACE
SANTA ROSA, CA 95403

Mail Date: 04/21/2010

Applicant	: Joshua Makower	: DECISION ON REQUEST FOR
Patent Number	: 7648517	: RECALCULATION of PATENT
Issue Date	: 01/19/2010	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/912,122	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/24/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **253** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

DEC 1 2 2005

OFFICE OF PETITIONS

In re Application of	:	
Felts et al.	:	
Application No. 09/912,130	:	
Filed: July 24, 2001	:	ON PETITION
Attorney Docket Number:	:	
PHFR 000076	:	

This is a decision on the Request for Withdrawal of Erroneously Issued Notice of Abandonment, filed August 22, 2005. The petition is properly treated under 37 CFR 1.181. The delay in treating this petition is regretted.

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 12, 2005. 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 April 13, 2005. A Notice of Abandonment was mailed on August 9, 2005.

Applicant's Assertion

Applicant responds with the instant petition wherein Applicant asserts that a timely reply was filed on February 12, 2005.

A review of Office records reveal that the Examiner issued new grounds for rejection in the January 12, 2005 non-final Office action. In response thereto, Applicant timely filed a request to reinstate the appeal and Supplemental Appeal Brief on February 17, 2005 (Certificate of Mailing dated February 12, 2005).

Accordingly, the petition is granted.

In view of the foregoing, the holding of abandonment is hereby withdrawn.

No fee has been charged for the petition and none is due.

The application file is being referred to Technology Center Art Unit 2613 for continued processing in due course.

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

Derek L. Woods
Attorney
Office of Petitions
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

CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
540 WHITE PLAINS RD
P O BOX 2005
TARRYTOWN, NY 10591-9005

COPY MAILED

JAN 24 2005

OFFICE OF PETITIONS

In re Application of	:	
David George Leppard, et al.	:	
Application No. 09/912,139	:	ON PETITION
Filed: July 24, 2001	:	
Attorney Docket No. 1-2228/A	:	

This is a decision on the petition, filed January 10, 2005, to withdraw the above-identified application from issue after payment of the issue fee.

Petitioners request, in effect, that the application be withdrawn from issue in accordance with the Letter of Express Abandonment filed December 14, 2004. Accordingly, the petition is being treated under 37 CFR 1.313(c)(3).

The petition is **GRANTED**.

The above-identified application has been withdrawn from issue and is expressly abandoned in favor of continuing application No. 10/894,773 filed July 20, 2004.

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

Sherry D. Brinkley

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 6

ZymoGenetics, Inc.
1201 Eastlake Avenue East
Seattle WA 98102

COPY MAILED

JUL 19 2002

OFFICE OF PETITIONS

In re Application of :
Presnell, et al. :
Application No.09/912,157 : DECISION GRANTING PETITION
Filed: July 24, 2001 :
Attorney Docket No. 00-49 :

This is a decision on the petition filed May 28, 2002, under 37 CFR 1.10(c) requesting that the above-cited application be accorded a filing date of July 24, 2001, rather than the presently accorded filing date of July 23, 2001.

Petitioner alleges that the application was deposited with the Express Mail Service on July 24, 2001. In support of the allegation, the petition is accompanied by a copy of the "Pickup Service Statement for Express Mail, Priority Mail, or Parcel Post" showing the package sent by Express Mail label No. EL623622906US (the same Express Mail label number was placed on the original application papers located in the official file) was received by the postal employee on July 24, 2001.

In view of the above, the petition is granted. A corrected filing receipt is enclosed showing the filing date for the application as July 24, 2001.

The application file is being returned to Technology Center 1600 with a filing date of July 24, 2001.

Any inquiries related to this decision should be directed to the undersigned at (703)305-0010.

K. A. McLaughlin

Kenya A. McLaughlin
Petitions Attorney
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
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

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

COPY MAILED
MAY 19 2004
OFFICE OF PETITIONS

In re Application of
Dominick H. Salvato et al
Application No. 09/912,162
Filed: July 24, 2001
Attorney Docket No. 1219

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed May 11, 2004, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure submit the issue fee in a timely manner in reply to the Notice of Allowance mailed November 28, 2003, which set a statutory period for reply of three (3) months. Accordingly, the above-identified application became abandoned on February 29, 2004.

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

The application file is being forwarded to the Publishing Division.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

BOULDER PATENT SERVICES INC
1021 GAPTER ROAD
BOULDER, CO 80303

COPY MAILED

OCT 29 2001

OFFICE OF PETITIONS

In re Application of	:	
Alvin Kershman et al	:	DECISION DISMISSING
Application No. 09/912,219	:	PETITION
Filed: July 25, 2001	:	
Attorney Docket No. SK-3	:	

This is a decision on the petition filed September 10, 2001, requesting that the above-identified application be accorded a filing date of July 24, 2001.

Petitioners allege that the application was deposited in Express Mail service on July 24, 2001, under 37 CFR 1.10, and should be accorded that date as the filing date instead of the presently accorded filing date of July 25, 2001. In support of the allegation, the petition is accompanied by a copy of the original transmittal letter submitted with the present application which includes a statement of express mailing under 37 CFR 1.10 dated July 24, 2001.

37 CFR 1.10(a) 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).

37 CFR 1.10(c) states that:

> (c) Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that there is a discrepancy between the filing date accorded by the Office to the correspondence and the date of

deposit as shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation, may petition the Commissioner to accord the correspondence a filing date as of the "date-in" on the "Express Mail" mailing label or other official USPS notation, provided that:

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

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

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

As clearly stated in 37 CFR 1.10(a), the date of deposit with the United States Postal Service (USPS) is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. Thus, any petition alleging that the PTO did not accord a paper the date of deposit in Express Mail service as the filing date must be accompanied by "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." 37 CFR 1.10(c)(3).

The present petition is not accompanied by the evidence required by 37 CFR 1.10.

Accordingly, the petition is dismissed.

No petition fee is required and none has been charged.

Any request for reconsideration of this decision should be filed within **TWO MONTHS** of the date of this decision in order to be considered timely (see 37 CFR 1.181(f)) and 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 Technology Center AU 1761 with the presently accorded filing date of July 25, 2001.

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

UNITED STATES 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.

PRITZKAU PATENT GROUP, LLC
993 GAPTER ROAD
BOULDER CO 80303

MAILED

SEP 14 2009

OFFICE OF PETITIONS

In re Application of	:	
Kershman et al.	:	
Application No. 09/912,219	:	
Patent No. 6,858,241	:	DECISION ON PETITION
Filed: July 25, 2001	:	PURSUANT TO 37 C.F.R.
Issue Date: February 22, 2005	:	§ 1.378(B)
Attorney Docket Number: SK-3	:	
Title: FARINACEOUS SURFACE	:	
PRODUCT THAT IS TOASTER	:	
REHEATABLE AND METHOD	:	

This is a decision on the petition filed on July 27, 2009,[1] pursuant to 37 C.F.R. § 1.378(b) to revive the above-identified application.

This petition pursuant to 37 C.F.R. § 1.378(b) is **DISMISSED**.

Background

The patent issued on February 22, 2005. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on February 22, 2009, with no payment received. Accordingly, the patent expired on February 22, 2009 at midnight.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

1 Petitioner has indicated that a copy of this petition was first filed on March 11, 2009. The electronic record has been reviewed, and this indication is confirmed to be correct. It is noted that this prior submission contains a certificate of mailing dated March 3, 2009.

(1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);

(2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

With this petition, Petitioner has submitted the surcharge associated with a petition to accept the late payment of a maintenance fee as unavoidable, along with the 3½-year maintenance fee and a statement of facts.

Petitioner has met the first and second requirements of Rule 1.378(b). The third requirement of Rule 1.378(b) will be discussed below.

The standard

35 U.S.C. § 41(c)(1) states, *in pertinent part*:

> The Director may accept the payment of any maintenance fee… after the six-month grace period if the delay[2] is shown to the satisfaction of the Director to have been unavoidable.

37 C.F.R. § 1.378(b)(3) is at issue in this case. Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 37 C.F.R. § 1.137(a). This is a very stringent standard. 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

2 This delay includes the entire period between the due date for the fee and the filing of a grantable petition pursuant to 37 C.F.R. § 1.378(b).

> is generally used and observed by prudent and careful men in relation to their most important business.[3]

In addition, decisions are made on a "case-by-case basis, taking all the facts and circumstances into account." Nonetheless, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable."[4]

The burden of showing the cause of the delay is on the person seeking to revive the application.[5]

Application of the standard to the current facts and circumstances

Petitioner's explanation of the delay has been considered, and it has been determined that it fails to meet the standard for acceptance of a late payment of the maintenance fee and surcharge.

The period for paying the 3½-year maintenance fee without the surcharge extended from February 22, 2008 to August 22, 2008 and for paying with the surcharge from August 23, 2008 to February 22, 2009. Thus, the delay in paying the 3½-year maintenance fee extended from February 22, 2009 at midnight to the prior filing of this petition on March 3, 2009.

With this petition, the Patentee has asserted that he submitted the maintenance fee and the $65 surcharge for the late submission of the same on February 17, 2009, which was prior to the expiration of this patent. However, this submission was sent to an incorrect address, and returned to the sender on an unspecified date.

It follows that this patent became expired due to Petitioner's failure to submit the maintenance fee payment to the proper address. However, it is noted that the form contains the outdated address in the pre-printed certificate of mailing section, and that the form further indicates that it is

---

3 In re Mattullath, 38 App. D.C. 497, 514-15 (1912)(*quoting* Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).
4 Haines, 673 F. Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32.
5 Id.

"[a]pproved for use through 04/30/2009." As the submission was made prior to that date, it was reasonable for Petitioner to have addressed the mailing to the outdated address.

However, this petition cannot be granted at this time, for **the record does not contain a showing that Petitioner had steps in place to ensure the timely submission of the maintenance fee.** An adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fees for this patent. Where the record fails to disclose that the patentee took reasonable steps to ensure timely payment of the maintenance fee, 35 U.S.C. § 41(c) and 37 C.F.R. § 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR § 1.378(b).

Conclusion

Any request for reconsideration of this decision **must** be filed within **TWO MONTHS** of the mailing date of this decision. Any such petition for reconsideration must be accompanied by the $400 petition fee set forth in §1.17(h). After decision on the petition for reconsideration, no further reconsideration or review of the matter will be undertaken by the Commissioner. Accordingly, on request for reconsideration, it is extremely important that petitioner supply **any** and **all** relevant information and documentation in order to meet his burden of showing unavoidable delay. This includes statements by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Petitioner must provide documentation and address the deficiency noted above.
If on request for reconsideration, the delayed payment of the maintenance fee is not accepted, then the maintenance fee is subject to refund following the decision on the petition for reconsideration, or after the expiration of the time for filing such a petition for reconsideration, if none is filed.

The reply should include a cover letter entitled "Renewed Petition pursuant to 37 C.F.R. § 1.378(e)". This is not a final agency action within the meaning of 5 U.S.C § 704.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski,

and may be submitted by mail,[6] hand-delivery,[7] or facsimile.[8] Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web.[9]

The general phone number for the Office of Petitions which should be used for status requests is (571) 272-3282. Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225. Inquiries pertaining to the submission of maintenance fees should be directed to the Maintenance Fee branch at 571-272-6500.

Paul Shanoski
Senior Attorney
Office of Petitions

6 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.
7 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.
8 (571) 273-8300- please note this is a central facsimile number.
9 https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html

APPENDIX

Portion of the MPEP relevant to the expiration of this patent

MPEP § 2510(II) sets forth, *in pertinent part*:

> Maintenance fee payments not electronically submitted over the Internet, and correspondence related to maintenance fees may be addressed to:
>
> Director of the United States Patent and Trademark Office
> Attn: Maintenance Fee
> 2051 Jamieson Avenue, Suite 300
> Alexandria, Virginia 22314

UNITED STATES 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.

PRITZKAU PATENT GROUP, LLC
993 GAPTER ROAD
BOULDER CO 80303

COPY MAILED

NOV 30 2009

OFFICE OF PETITIONS

In re Application of :
Kershman et al. :
Application No. 09/912,219 :
Patent No. 6,858,241 :
Filed: July 25, 2001 :
Issue Date: February 22, 2005 :
Attorney Docket Number: SK-3 :
Title: FARINACEOUS SURFACE :
PRODUCT THAT IS TOASTER :
REHEATABLE AND METHOD :

DECISION ON RENEWED PETITION PURSUANT TO 37 C.F.R. § 1.378(E)

This is a decision on the renewed petition pursuant to 37 C.F.R. § 1.378(e), filed on September 21, 2009, and supplemented on October 8, 2009. Petitioner has requested reconsideration of a prior decision pursuant to 37 C.F.R. § 1.378(b), which refused to accept the delayed payment of a maintenance fee for the above-referenced patent.

The patent issued on February 22, 2005. The grace period for paying the 3½-year maintenance fee provided in 37 C.F.R. § 1.362(e) expired at midnight on February 22, 2009, with no payment received. Accordingly, the patent expired on February 22, 2009 at midnight.

Any petition to accept an unavoidably delayed payment of a maintenance fee filed under 37 C.F.R. § 1.378(b) must include:

(1) the required maintenance fee set forth in 37 C.F.R. § 1.20 (e) through (g);

(2) the surcharge set forth in 37 C.F.R. § 1.20(i)(1), and;

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after

> the patentee was notified of, or otherwise became aware of, the expiration of the patent - the showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

An original petition was filed on July 27, 2009 along with evidence which established that the petition had been previously submitted on March 3, 2009. The original petition was dismissed via the mailing of a decision on September 14, 2009, for failure to meet the third requirement of Rule 1.378(b).

This renewed petition pursuant to 37 C.F.R. § 1.378(e) was filed on September 21, 2009, along with the $400 petition fee. A supplement to this renewed petition was received on October 8, 2009.

With the supplement to the renewed petition, the third requirement of Rule 1.378(b) has been satisfied. It follows that each of the three requirements of 37 C.F.R. § 1.378(b) has been met, and Petitioner has demonstrated to the satisfaction of the Director that the delay in timely paying the maintenance fee was unavoidable. Consequently, this renewed petition is **GRANTED.**

The above-identified patent is hereby reinstated as of the mail date of this decision.

This file is being sent to Files Repository.

Telephone inquiries regarding this decision should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.[1]

Anthony Knight
Supervisor
Office of Petitions

---

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

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

MAIL

MAY 15 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Troutman Sanders LLP
Bank of America Plaza, Suite 5200
600 Peachtree Street, NE
Atlanta, GA 30308-2216

In re Application of Melia et al.
Application No. 09/912,220
Filed: July 24, 2001
Attorney Docket No. MELIA1
Title: CONTENT MANAGEMENT AND TRANSFORMATION SYSTEM FOR DIGITAL CONTENT

DECISION ON PETITION TO MAKE SPECIAL UNDER 37 CFR 1.102(d)

This is a decision on the petition, filed April 14, 2003 under 37 C.F.R. §1.102(d) and M.P.E.P. §708.02(II): Infringement, to make the above-identified application special.

M.P.E.P. §708.02, Section (II) sets out the prerequisites for a grantable petition under 37 C.F.R. §1.102(d) states in relevant part:

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

The petition meets the criteria of Section (II) by the applicant stating (A) "there is an infringing product on the market"; (B) "in my opinion, ... after a rigid comparison of said product with the claims of the above-mentioned application, some of the claims of the application are unquestionably infringed"; and (C) "I have knowledge of the pertinent art and have made a careful and thorough search of the prior art".

The Petition is **GRANTED**.

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

RDD

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SMITH FROHWEIN TEMPEL GREENLEE BLAHA, LLC
Two Ravinia Drive
Suite 700
ATLANTA GA 30346

COPY MAILED

MAR 0 5 2007

OFFICE OF PETITIONS

In re Patent No. 7,016,963 :
Issued: March 21, 2006 :
Application No. 09/912,220 : ON PETITION
Filed: July 24, 2001 :
Attorney Docket No. 12002.1001 :

This is a decision on the petition, filed November 14, 2006, 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 requests issuance of a certificate of correction in the name of "Melia Technologies, Ltd."

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

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

---

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

U.S. Patent and Trademark Office assignment records disclose that an assignment from the named inventors to Melia Technologies, Ltd. was recorded on July 24, 2001. Accordingly, a certificate of correction is indeed a proper course of action. However, the instant request lacks the required processing fee of $130.00. Thus, the instant request is subject to dismissal at the current time.

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.

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 decision on petition should be directed to the undersigned at (571) 272-3205.

Alesia M. Brown
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700

Mailed: 1-18-06

MEB
Paper Number:

In re application of
Ting He
Serial No. 09/912,223
Filed: July 24, 2002
For: Substrates With Small Particle Size Metal Oxide and Noble Metal Catalyst Coatings And Thermal Spraying Methods For Producing The Same

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW ABANDONMENT, filed September 1, 2005. The petition requests that the abandonment, as set forth in the Notice of Abandonment of August 22, 2005, for failure to timely reply to the Notice of Allowance of March 11, 2005 be withdrawn. The petitioner asserts that a proper reply was timely filed by facsimile with the Office on March 18, 2005, with the appropriate fees. A copy of the reply is also provided as evidence.

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) Petition To Withdraw Holding of Abandonment Based on Evidence That a Reply Was Timely Mailed or Filed:
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 that the reply to the Notice of Allowance was submitted by facsimile, as evidenced by the signed and dated certificate of transmission on March 18, 2005, is sufficient. The application will be forwarded to the issue branch for processing and consideration of the issue fee payment filed March 18, 2005, and a copy of which is provided as an attachment to the instant petition.

The Petition is **Granted**.

UNITED STATES PATENT AND TRADEMARK OFFICE

Technology Center 1700

Jacqueline M. Stone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

Edwin M. Baranowski
Porter, Wright, Morris & Arthur LLP
41 South High Street
Columbus, Ohio 43215

UNITED STATES 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
AUG 30 2006
OFFICE OF PETITIONS

COPY MAILED
AUG 29 2006
OFFICE OF PETITIONS

CANCELLED

HEWLETT-PACKARD COMPANY
INTELLECTUAL PROPERTY ADMINISTRATION
P.O. BOX 272400
FORT COLLINS CO 80527-2400

In re Application of	:	
Amir Said	:	DECISION ON PETITION TO
Application No. 09/912,278	:	WITHDRAW HOLDING OF
Filed: 24 July, 2001	:	ABANDONMENT
Attorney Docket No. PDNO	:	
10006298-1	:	

This is a decision on the "PETITION TO WITHDRAW HOLDING OF ABANDONMENT" filed on 21 June, 2006.

The petition is **GRANTED**.

The application was held abandoned for failure to timely respond to the Notification of Non-Compliant Appeal Brief mailed on 25 July, 2005. Notice of Abandonment was mailed on 2 June, 2006.

Petitioner asserts that a response to the Office communication was timely filed on 3 August, 2005. In support, petitioner has supplied a copy of an "Response to Notification of Non-Complaint Appeal Brief" and transmittal letter which contains a Certificate Under 37 CFR 1.8 dated 3 August, 2005, signed by registered patent attorney Hugh P. Gortler. Petitioner has also supplied a copy of the USPTO's Auto-Reply Facsimile Transmission showing five (5) pages, including the first page of the reply, were received at the USPTO on 3 August, 2005.

Any petition to withdraw the holding of abandonment based on a Certificate of Transmission by facsimile must include the following requirements:

(1) A copy of the original response bearing a signed Certificate of Transmission which includes the date of signing; and

(2) A statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of transmitting the ***original*** response on the date indicated on the Certificate of Transmission (*see* 37 CFR 1.8 and MPEP 512).

As the present petition is signed by attorney Gortler and states that the reply was filed on 3 August, 2005, this paper will be construed as constituting the statement required by item (2) above.

As petitioner has provided convincing evidence that a reply to the Office communication was transmitted to the USPTO on 3 August, 2005, 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 application is being referred to Technology Center Art Unit 2624 for further processing.

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

DWood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SAMUEL A. KASSATLY LAW OFFICE
20690 VIEW OAKS WAY
SAN JOSE, CA 95120

COPY MAILED

APR 2 0 2007

OFFICE OF PETITIONS

In re Application of	:	
Li Jia Hao	:	
Application No.: 09/912345	:	DECISION ON
Filing or 371(c) Date: 07/26/2001	:	PETITION
Title of Invention:	:	
BUBBLE CYCLING HEAT EXCHANGER	:	

This is a decision in response to the Petition to Withdraw Holding of Abandonment Under 37 CFR 1.181, filed August 1, 2006. The delay in treating this petition is regretted.

This Petition is hereby **granted**.

Background

The above-identified application became abandoned for failure to timely and properly reply to the Notice of Allowance and Issue Fee Due, mailed November 10, 2005. The Notice set a non-extendable three (3) month period for reply. No reply having been received, the application became abandoned on February 11, 2006. A Notice of Abandonment was mailed March 28, 2006.

The present petition

Applicant files the present petition and asserts that timely payment of the issue fee was tendered to this Office on November 29, 2005. Applicant states that, according to the monthly statement of Applicant's deposit account, after the $300 was withdrawn from the deposit account, there remained enough money to pay the $700.00. In support of this assertion, Applicant submits a copy of his "Monthly Statement of Deposit Account" from this Office which indicates that a balance of $5985.26 was in the account on November 30, 2005.

A review of Office records

A review of Office records reveals that Applicant is correct. Applicant's deposit account contained a balance of $5985.26 on November 30, 2005.

In view of the foregoing, the petition is granted. The holding of abandonment is hereby withdrawn.

No petition fee has been charged and none is due.

The issue fee has been charged to Applicant's deposit account.

The application will be referred to Publishing Division for processing into a patent.

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

Derek L. Woods
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

BACON & THOMAS PLLC
4TH FLOOR
625 SLATERS LANE
ALEXANDRIA, VA 22314-1176

COPY MAILED

JUN 28 2005

OFFICE OF PETITIONS

In re Application of	:
Chang Hee Lee et al	:
Application No. 09/912,358	: DECISION GRANTING PETITION
Filed: July 26, 2001	: UNDER 37 CFR 1.137(b)
Attorney Docket No. EM/BEU/LEE3048	:

This is a decision on the petition under 37 CFR 1.137(b), filed March 11, 2005, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned for failure to timely pay the issue and publication fees on or before January 6, 2004, as required by the Notice of Allowance and Fee(s) Due, mailed October 6, 2003. A Notice of Abandonment was mailed on February 23, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of payment of the issue fee of $700 and the publication fee of $300; (2) the petition fee of $750; and (3) the required statement of unintentional delay have been received. Accordingly, the issue and publication fees are accepted as having been unintentionally delayed.

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

This matter is being forwarded to Publishing Division.

Frances Hicks
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Morgan, Lewis & Bockius LLP
1111 Pennsylvania Avenue, NW
Washington, DC 20004

MAILED

JUL 0 2 2004

Technology Center 2100

In re Application of:
Michael J. NOE
Application No. 09/912,383
Filed: July 26, 2001
For: METHOD AND SYSTEM FOR ADAPTIVELY DOWNLOADING DATA FROM A NETWORK DATA

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed May 3, 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.

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

cc: Mr. James Hao
Wagner, Murabito & Ho
2 North Market Street, 3rd Floor
San Jose, CA 95113

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

MYERS BIGLEY SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

COPY MAILED

OCT 3 1 2003

OFFICE OF PETITIONS

In re Application of :
Terrence Edward Rogers :
Application No. 09/912,411 :
Filed: April 19, 2001 :
Attorney Docket Number: :
P12614

Decision on Petitions

This is a decision on two petitions. The first petition is a Petition and Fee for Filing Date of Patent Application Under 37 CFR 1.53, requesting the above-identified application be accorded the filing date of April 19, 2001. The second petition is a petition to withdraw the holding of abandonment, filed September 5, 2003[1].

The petition under 37 CFR 1.53 is granted.

The petition under 37 CFR 1.181 is dismissed.

Background

Application papers in the above-identified application were filed on April 19, 2001. On September 4, 2001, the Office of Initial Patent Examination mailed a Notice of Incomplete Nonprovisional Application, stating that a filing date had NOT been accorded the application because the specification did not include at least one claim. The Notice also required the basic filing fee. The Notice set a two-month period for reply, with extensions of time available under 37 CFR §1.136(a).

On November 2, 2001, Applicant timely filed a Petition and Fee for Filing Date of Patent Application Under 37 CFR 1.53, wherein Applicant averred that the application as filed was a complete application. In support of this assertion, Applicant submitted copies of Express Mail Label No. EL034577565US purporting to

[1] The petition was originally filed on July 28, 2003, as evidenced by a copy of Applicant's return-receipt postcard filed via facsimile on September 5, 2003.

evince filing of a complete application[2]. Applicant also submitted the basic filing fee on November 2, 2001.

On November 1, 2001, the Office of Initial Patent Examination mailed a Notice to File Corrected Application Papers, requiring a substitute specification in compliance with 37 CFR 1.52 because the line spacing on the abstract is not properly spaced. The Notice was properly mailed to the correspondence address of record on November 1, 2001.

On January 4, 2002, Applicant filed an Associate Power of Attorney, requesting all future communications be directed to Myers, Bigley, Sibley & Sajovec, P.A., at their correspondence address. On February 27, 2002, Applicant properly filed, as a separate paper, a Change of Correspondence Address to customer number 20792. *Accord* 37 CFR 1.4.

A Notice of Abandonment was incorrectly mailed to the former correspondence address of record on July 15, 2003. The Notice of Abandonment indicated as the reason for abandonment, Applicant's failure to respond to the Notice to File Corrected Application Papers, mailed November 1, 2001.

Applicant files the instant petition via facsimile, requesting the Office withdraw the holding of abandonment on the basis that Applicant timely filed a response to the September 4, 2001 Notice of Incomplete Nonprovisional Application. The instant petition is accompanied by a copy of a return-receipt postcard evincing receipt of a petition by this Office on July 28, 2003.

<u>The Petition and Fee for Filing Date of Patent Application Under 37 CFR 1.53</u>

A review of the application file reveals that the Petition and Fee for Filing Date of Patent Application Under 37 CFR 1.53 was timely filed and received in the Office on November 2, 2001.

---

[2] The best evidence of what was filed on April 19, 2001, is a return-receipt postcard. "A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all items listed thereon by the PTO." MPEP § 503.

A further review of the file reveals that the specification as filed on April 19, 2001, contained 4 pages of claims, numbering 1 - 20.

Accordingly, the September 4, 2001 Notice of Incomplete Nonprovisional Application was mailed in error and is hereby withdrawn.

The Instant Petition to Withdraw Holding of Abandonment.

A review of the file reveals that the application became abandoned for failing to timely and properly reply the the Notice to File Corrected Application Papers, mailed November 1, 2001. A further review of the file reveals that the Notice to File Corrected Application Papers was properly mailed to the correspondence address of record.

Accordingly, the petition to withdraw the holding of abandonment is dismissed.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.181." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

Applicant is urged to file a petition stating that the delay was unintentional. A grantable petition under 37 CFR 1.137(b)[3] must be accompanied by: (1) the required reply,[4] 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).

---

[3] 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).

[4] 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.

Applicant must reply to the Notice to File Corrected Application Papers, requiring a substitute specification in compliance with 37 CFR 1.52 because the line spacing on the abstract is not properly spaced. A copy of the Notice to File Corrected Application Papers is enclosed.

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 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 matter should be directed to the undersigned at (703) 305-0014.

Derek L. Woods
Petitions Attorney
Office of Petitions

Enclosure: Notice to File Corrected Application Papers

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 9

MYERS BIGLEY SIBLEY & SAJOVEC
PO BOX 37428
RALEIGH, NC 27627

COPY MAILED

DEC 0 8 2003

OFFICE OF PETITIONS

In re Application of :
Terrence Edward Rogers :
Application No. 09/912,411 :
Filed: April 19, 2001 : Decision on Petitions
Attorney Docket Number: :
P12614

This is a decision on a Renewed Petition under 37 CFR 1.[1]81, filed November 24, 2003, which is properly treated as a petition under 37 CFR 1.137(b), to revive the above-identified application.

The petition is **granted**.

Application papers in the above-identified application were filed on April 19, 2001. On November 1, 2001, the Office of Initial Patent Examination mailed a Notice to File Corrected Application Papers, requiring a substitute specification in compliance with 37 CFR 1.52 because the line spacing on the abstract is not properly spaced. The Notice set a two-month period for reply, with extensions of time available under 37 CFR §1.136(a). No response having been received, the application became abandoned on January 2, 2003.

With the instant petition, Petitioner has satisfied the requirements of a grantable petition under 37 CFR 1.137(b). The reply to the November 1, 2001 Notice is filed with the instant petition. Accordingly, the petition is granted.

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

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

Sharmini N. Green
c/o BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 Wilshire Boulevard
Seventh Floor
Los Angeles CA 90025

COPY MAILED

AUG 2 5 2004

OFFICE OF PETITIONS

In re Application of :
Needham et al. : DECISION ON PETITION
Application No. 09/912,427 :
Filed: July 26, 2001 :
Attorney Docket No. 042390.P11167 :

This is a decision on the petition filed April 6, 2004, requesting that the above-identified application be accorded a filing date of July 26, 2001.

On July 26, 2001, applicants filed the above-identified application. However, on October 3, 2001, the Office of Initial Patent Examination mailed a "Notice to File Missing Parts in a Nonprovisional Application," stating, inter alia, that the application had been accorded a filing date of July 26, 2001, and advising applicants that Figure 3 described in the specification appeared to have been omitted.

In response, on October 23, 2001, applicants submitted, inter alia, a Request for Approval of Drawing Corrections, which included a copy of omitted Figure 3. Applicants explained that no new matter was added to the application by introducing Figure 3. However, applicants did not submit a petition and petition fee to accept the later filing date or file an amendment with Figure 3. After receipt of Figure 3, the Office of Initial Patent Examination changed the filing date of the present application to October 23, 2001, the date of receipt of omitted Figure 3.

On April 6, 2004, applicants submitted the present petition, the petition fee, and a preliminary amendment canceling Figure 3 and related text in the specification. Applicants request that

Figure 3 be withdrawn and the application be accorded the original filing date of July 26, 2001.

The petition is granted. The drawing sheet containing Figure 3, filed on October 23, 2001, is withdrawn and will not be entered.

The Office of Initial Patent Examination is directed to process the application with a filing date of **July 26, 2001**, using only the drawing sheets (Figures 1, 2(A) and 2(B)) submitted on that date. Figure 3 will NOT be entered. The Office is further directed to mail a corrected filing receipt and indicate in the 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) 306-5589.

Christina Tartera Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SHARMINI N. GREEN
c/o BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD
SEVENTH FLOOR
LOS ANGELES, CA 90025

COPY MAILED

DEC 10 2007

OFFICE OF PETITIONS

In re Application of :
Bradford H. Needham, et al. :
Application No. 09/912,427 : ON PETITION
Filed: July 26, 2001 :
Attorney Docket No. P 279172 P11167 :

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

The petition is **granted**.

This application became abandoned as a result of petitioner's failure to file a complete and proper appeal brief within the time period provided in 37 CFR 41.37(a)(1). As a complete and proper appeal brief was not filed within one (1) month of the Notification of Non-Compliance with 37 CFR 41.37(c)(1), mailed December 4, 2006, and no extensions of time under the provisions of 37 CFR 1.136(a) were obtained, the appeal was dismissed and the proceedings as to the rejected claims were terminated. *See* 37 CFR 1.197(b). As no claim was allowed, the application became abandoned on January 5, 2007. *See* MPEP 1215.04. A Notice of Abandonment was mailed on July 13, 2007. In response, on July 25, 2007, the present petition was filed.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137(b) in that (1) the reply in the form of an amended Appeal Brief; (2) the petition fee of $1,500; and (3) an adequate statement of unintentional delay.

It is noted that the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in 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 is being referred to Technology Center AU 2143.

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

cc: FARZAD F. AMINI
BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

UNITED STATES PATENT AND TRADEMARK OFFICE

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

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

COPY MAILED

MAY 26 2009

OFFICE OF PETITIONS

In re Application of	:	
Neuberger	:	
Application No. 09/912,446	:	DECISION
Filed/Deposited: 26 July, 2001	:	
Attorney Docket No. 782.1102	:	

This is a decision on the petition filed on 6 May, 2009, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application

The petition as considered under 37 C.F.R. §1.181 is **DISMISSED**.

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181 to Withdraw the Holding of Abandonment." *In the alternative, Petitioner may properly file a petition to the Commissioner under 37 C.F.R. §1.137(b) requesting revival of an application abandoned due to unintentional delay.*

As to the Request to Withdraw
the Holding of Abandonment

Petitioners always are directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness and showing requirements for relief under 37 C.F.R. §1.181.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the final Office action mailed on 9 July, 2008, with reply due absent extension of time on or before 9 October, 2008.

On 9 January, 2009, Petitioner filed an a request and fee for extension of time and after-final amendment, which the Examiner refused to enter and Petitioner–as one registered to practice before the Office—knew was not as of right and not a proper reply[1] if it did not *prima facie* place the application in condition for allowance, and on 24 February, 2009, the Examiner mailed an Advisory Action.

The application went abandoned by operation of law after midnight 9 January, 2009.

The Office mailed the Notice of Abandonment on 14 April, 2009.

On 6 May, 2009, Petitioner filed a petition pursuant to 37 C.F.R. §1.181 and averred timely filing of a request for continued examination (RCE) and fee and a submission under the provisions of 37 C.F.R. §1.114 in the form of an amendment on 9 January, 2009. However, Petitioner provided neither evidence of submission *via* Express Mail evidence, nor evidence of a date stamped receipt card or Electronic Acknowledgement Receipt for receipt by the Office of anything other than an "Amendment/Request for Reconsideration" and fee for an extension of time to make timely the after-final amendment. Moreover, Petitioner's copy of the RCE is not supported by the required evidence, as set forth in the excerpt from with the guidance in the Commentary at MPEP 711.03(c)(I), below.

Petitioner's burden is to make a showing pursuant to 37 C.F.R. §1.181 (with narrative and documentary support) consistent with the guidance in the Commentary at MPEP 711.03(c)(I), which provides in pertinent part:

***

> 37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), (e), or (g) (see MPEP §513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.
>
> Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP §503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have

[1] A proper reply is an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission under 37 C.F.R. §1.114). (See: MPEP §711.03(c).)

> been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.
>
> Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP §512. As stated in 37 C.F.R. §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).
>
> 37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. §1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP §512. [2]
>
> ***

As indicated above, Petitioner clearly failed to satisfy this burden.

Moreover, the documents of record clearly evidence that <u>while Petitioner may have intended to file an RCE with his amendment on 9 January, 2009, he simply failed to do so</u>. And Petitioner makes no such showing otherwise.

The statutory requirement of a timely reply is not satisfied by an intended action, but, rather, only by a completed action.

Petitioner failed to satisfy the requirements set forth in the guidance in the Commentary at MPEP §711.03(c)(I), which is the requirement for relief pursuant to 37 C.F.R. §1.181.

Petitioner's only alternative is to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay pursuant to 37 C.F.R. §1.137(b).

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

---

[2] *See*: MPEP §711.03(c) (I)(B).

complained of (*see*: 37 C.F.R. §1.181(f)), and those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation– since all owe to the Office the continuing duty to disclose.[3]

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.

STATUTES, REGULATIONS

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). And 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.[4],[5]

Moreover, the Office has set forth in the Commentary at MPEP §711.03(c)(I) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

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

---

[3] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

[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] 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. (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. 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) And the Petitioner must be diligent in attending to the matter. 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.))

> and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.[6]

Allegations as to the Request to
Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how and when it is to be made and supported.

Petitioner appears not to have made the showing required.

CONCLUSION

Accordingly, the petition as considered under 37 C.F.R. §1.181 is **dismissed**.

ALTERNATIVE VENUE

Should Petitioner wish to revive the application, Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (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 petition fee, 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), and a terminal disclaimer and fee where appropriate.

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

[6] 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).

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

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

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[7]) 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./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[7] 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

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

COPY MAILED

SEP 1 1 2009

OFFICE OF PETITIONS

In re Application of :
Neuberger :
Application No. 09/912,446 : DECISION
Filed/Deposited: 26 July, 2001 :
Attorney Docket No. 782.1102 :

This is a decision on the petition filed on 26 June, 2009, considered as a petition under 37 C.F.R. §1.181 (no fee) requesting withdrawal of the holding of abandonment in the above-identified application.

The petition as considered under 37 C.F.R. §1.181 is **DISMISSED**.

This is **not** a final agency action within the meaning of 5 U.S.C. §704.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 C.F.R. §1.181 to Withdraw the Holding of Abandonment." *In the alternative, Petitioner may properly file a petition to the Commissioner under 37 C.F.R. §1.137(b) requesting revival of an application abandoned due to unintentional delay.*

As to the Request to Withdraw
the Holding of Abandonment

Petitioners always are directed to the Commentary at MPEP §711.03(c)(I) for guidance as to the proper showing and timeliness and showing requirements for relief under 37 C.F.R. §1.181.

BACKGROUND

The record reflects as follows:

Petitioner failed to reply timely and properly to the final Office action mailed on 9 July, 2008, with reply due absent extension of time on or before 9 October, 2008.

On 9 January, 2009, Petitioner filed an a request and fee for extension of time and after-final amendment, which the Examiner refused to enter and Petitioner–as one registered to practice before the Office—knew was not as of right and not a proper reply[1] if it did not *prima facie* place the application in condition for allowance, and on 24 February, 2009, the Examiner mailed an Advisory Action.

The application went abandoned by operation of law after midnight 9 January, 2009.

The Office mailed the Notice of Abandonment on 14 April, 2009.

On 6 May, 2009, Petitioner filed a petition pursuant to 37 C.F.R. §1.181 and averred timely filing of a request for continued examination (RCE) and fee and a submission under the provisions of 37 C.F.R. §1.114 in the form of an amendment on 9 January, 2009. However, Petitioner provided neither evidence of submission *via* Express Mail evidence, nor evidence of a date stamped receipt card or Electronic Acknowledgement Receipt for receipt by the Office of anything other than an "Amendment/Request for Reconsideration" and fee for an extension of time to make timely the after-final amendment. Moreover, Petitioner's copy of the RCE was not supported by the required evidence, as set forth in the excerpt from with the guidance in the Commentary at MPEP 711.03(c)(I), below. The petition was dismissed on 26 May, 2009.

On 26 June, 2009, Petitioner re-advanced the petition, this time with a statement by the person averred to have signed and dated the certificate of mailing stamped on the face of the RCE—Nova Johns (Ms. Johns)—which RCE was averred to have been submitted only *via* U.S. Postal Service (USPS) first class mail pursuant to 37 C.F.R. §1.8 and <u>not</u> with the electronically filed amendment after final (alternatively, the submission under the provisions of 37 C.F.R. §1.114). This averment by Ms. Johns was not set forth previously. Petitioner erroneously claimed the decision of 26 May, 2009, concluded that the petition "did not provide any supporting evidence"—what the decision stated was:

> ... Petitioner provided neither evidence of submission *via* Express Mail evidence, nor evidence of a date stamped receipt card or Electronic Acknowledgement Receipt for receipt by the Office of anything other than an "Amendment/Request for Reconsideration" and fee for an extension of time to make timely the after-final amendment. Moreover, Petitioner's copy of the RCE was not supported by the required evidence, as set forth in the excerpt from with the guidance in the Commentary at MPEP 711.03(c)(I) ... .

[1] A proper reply is an amendment *prima facie* placing the application in condition for allowance, a Notice of Appeal, or an RCE (with fee and submission under 37 C.F.R. §1.114). (<u>See</u>: MPEP §711.03(c).)

There is a difference between a lack of evidence and a lack of the proper and supporting evidence—and Petitioner's election to confuse or otherwise mischaracterize the statement of the Office is unfortunate. With regard to the averment of Ms. Johns submitted by Petitioner, not only did Petitioner delay in its presentation, but Ms. Johns did not indicate therein that the item was placed into the USPS mailbox prior to the last collection of the day, which assertion is required to satisfy the mandate of the rule that "The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated." (*See*: 37 C.F.R. §1.8(1)(ii).) If the deposit was not made before the last collection of the day on 9 January, 2009, the person signing the certificate had no reasonable basis to expect that the correspondence would in fact be mailed or transmitted on that day.

(Petitioner averred in the petition of 6 May, 2009, that "the Amendment filed on January 9, 2009, and received by the USPTO indicated on the first page that that a Request for Continued Examination (RCE) is submitted." In fact, there was no evidence supporting that statement submitted with the Amendment when it was filed electronically on 9 January, 2009, because, as Petitioner acknowledged, the papers were submitted separately and by different forms of transmission—and Ms. Johns details in her statement submitted on 26 June, 2009, that such "is a practice that Ms. Afework uses on regular bases (sic)."

Rather than place all of the information into her petition at the outset and make a proper showing as set forth in the guidance in the Commentary at MPEP 711.03(c)(I), Petitioner instead seems to have chosen to release details piecemeal. As a result, questions remain as to whether the RCE and fee were in fact timely submitted—Petitioner's documentation clearly evidences that they were not timely filed with the amendment after final. And the showing by Petitioner is that such is her express and consistent "practice use[d] on [a] regular bas[i]s."

Petitioner's burden is to make a showing pursuant to 37 C.F.R. §1.181 (with narrative and documentary support) consistent with the guidance in the Commentary at MPEP 711.03(c)(I), which provides in pertinent part:

***

> 37 C.F.R. §1.10(c) through §1.10(e) and §1.10(g) set forth procedures for petitioning the Director of the USPTO to accord a filing date to correspondence as of the date of deposit of the correspondence as "Express Mail." A petition to withdraw the holding of abandonment relying upon a timely reply placed in "Express Mail" must include an appropriate petition under 37 C.F.R. §1.10(c), (d), (e), or (g) (see MPEP §513). When a paper is shown to have been mailed to the Office using the "Express Mail" procedures, the paper must be entered in PALM with the "Express Mail" date.
>
> Similarly, applicants may establish that a reply was filed with a postcard receipt that properly identifies the reply and provides *prima facie* evidence that the reply was timely filed. See MPEP §503. For example, if the application has been held abandoned for failure to file a reply to a first Office action, and applicant has a postcard receipt showing that an amendment was timely filed in response to the Office action, then the holding of

abandonment should be withdrawn upon the filing of a petition to withdraw the holding of abandonment. When the reply is shown to have been timely filed based on a postcard receipt, the reply must be entered into PALM using the date of receipt of the reply as shown on the post card receipt.

Where a certificate of mailing under 37 C.F.R. §1.8, but not a postcard receipt, is relied upon in a petition to withdraw the holding of abandonment, see 37 C.F.R. §1.8(b) and MPEP §512. As stated in 37 C.F.R. §1.8(b)(3) the statement that attests to the previous timely mailing or transmission of the correspondence must be on a personal knowledge basis, or to the satisfaction of the Director of the USPTO. If the statement attesting to the previous timely mailing is not made by the person who signed the Certificate of Mailing (i.e., there is no personal knowledge basis), then the statement attesting to the previous timely mailing should include evidence that supports the conclusion that the correspondence was actually mailed (e.g., copies of a mailing log establishing that correspondence was mailed for that application). When the correspondence is shown to have been timely filed based on a certificate of mailing, the correspondence is entered into PALM with the actual date of receipt (i.e., the date that the duplicate copy of the papers was filed with the statement under 37 C.F.R. §1.8).

37 C.F.R. §1.8(b) also permits applicant to notify the Office of a previous mailing or transmission of correspondence and submit a statement under 37 C.F.R. §1.8(b)(3) accompanied by a duplicate copy of the correspondence when a reasonable amount of time (e.g., more than one month) has elapsed from the time of mailing or transmitting of the correspondence. Applicant does not have to wait until the application becomes abandoned before notifying the Office of the previous mailing or transmission of the correspondence. Applicant should check the private Patent Application Information Retrieval (PAIR) system for the status of the correspondence before notifying the Office. See MPEP §512. [2]

***

As indicated above, Petitioner clearly failed to satisfy this burden.

Moreover, the showing of record continue to indicate that while Petitioner may have intended to file an RCE with her amendment on 9 January, 2009, she simply failed to do so. The statutory requirement of a timely reply is not satisfied by an intended action, but, rather, only by a completed action.

Petitioner failed to satisfy the requirements set forth in the guidance in the Commentary at MPEP §711.03(c)(I), which is the requirement for relief pursuant to 37 C.F.R. §1.181.

Petitioner's alternative is to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay pursuant to 37 C.F.R. §1.137(b).

---

[2] *See*: MPEP §711.03(c) (I)(B).

Out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (*see*: 37 C.F.R. §1.181(f)), and those registered to practice and all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation– since all owe to the Office the continuing duty to disclose.[3]

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.

STATUTES, REGULATIONS

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). And 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.[4],[5]

Moreover, the Office has set forth in the Commentary at MPEP §711.03(c)(I) the showing and timeliness requirements for a proper showing for relief under 37 C.F.R. §1.181 in these matters.

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

---

[3] See supplement of 17 June, 1999. The Patent and Trademark Office is relying on Petitioner's duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

[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] 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. (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. 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) And the Petitioner must be diligent in attending to the matter. 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.))

> 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.[6]

Allegations as to the Request to
Withdraw the Holding of Abandonment

The guidance in the Commentary at MPEP §711.03(c)(I) specifies the showing required and how and when it is to be made and supported.

Petitioner appears not to have made the showing required.

CONCLUSION

Accordingly, the petition as considered under 37 C.F.R. §1.181 is **dismissed**.

ALTERNATIVE VENUE

Should Petitioner wish to revive the application, Petitioner may wish to properly file a petition to the Commissioner requesting revival of an application abandoned due to unintentional delay under 37 C.F.R. §1.137(b). (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 petition fee, 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), and a terminal disclaimer and fee where appropriate.

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

---

[6] 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).

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

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

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3214—it is noted, however, that all practice before the Office is in writing (see: 37 C.F.R. §1.2[7]) 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./
John J. Gillon, Jr.
Senior Attorney
Office of Petitions

[7] 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

NXP, B.V.
NXP INTELLECTUAL PROPERTY & LICENSING
M/S41-SJ
1109 MCKAY DRIVE
SAN JOSE CA 95131

MAILED

JAN 15 2010

OFFICE OF PETITIONS

In re Application of
Boyle et al.
Application No. 09/912,470
Filed: 07/25/2001
Attorney Docket No. GB 010056

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed July 8, 2009, to revive the above-identified application.

The petition is **GRANTED**.

The application became abandoned for failure to timely and proper reply within the meaning of 37 CFR 1.113 to the final Office action, mailed July 30, 2008, which set a shortened statutory period for reply of three (3) months. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on October 31, 2008. A Notice of Abandonment was mailed on April 3, 2009.

The petition satisfies the requirements of 37 CFR 1.137(b) in that applicant has supplied (1) the reply in the form of a RCE, the RCE fee, and the submission required by 37 CFR 1.114; (2) the petition fee; and (3) a proper statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3211.

This application is being referred to Technology Center AU 2618 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.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

032005

Dreiss, Fuhlendorf, Steimle & Becker
Postfach 10 37 62
Stuttgart D-700-32 DE
GERMANY

MAR 16 2005

In re Application of:
Peter Kofink et al.
Serial No.: 09/912,477
Filed: July 26, 2001
For: STEERING COLUMN MODULE

DECISION ON PETITION

This is a decision on the petition, filed December 12, 2003, to withdraw the holding of abandonment of the above-identified application.

The petition is GRANTED.

This application was held abandoned for failing to file a proper reply to the final Office action of February 27, 2003. A Notice of Abandonment was mailed on November 10, 2003.

Petitioner states that a response including a Request for Continued Examination (RCE) was in fact timely filed on July 28, 2003. To support this assertion, petitioner has submitted a copy of the response that includes a request for RCE, a petition for extension of time with the fee to be charged to petitioner's Deposit Account. It is also indicated in petition that a copy of a fax confirmation sheet indicating error-free transmission on July 28, 2003 was enclosed.

The request for RCE and the petition for extension of time each bears a certificate of transmission under 37 CFR 1.8(a) with a transmission date of July 28, 2003.

The originally transmitted Request for RCE and petition for extension of time are not in the file record. However, the finance record shows that the RCE and petition for an extension of time was received on July 28, 2003 and the fees of $430 and $750, respectively, were collected on August 11, 2003. The RCE fee of $750 was credited back to petitioner's account on August 14, 2003, reasons unclear. The RCE requests that the amendment filed May 8, 2003 (received in the Office May 9, 2003) be entered as the required submission. It is apparent from the file record that an RCE was timely filed and the application is not abandoned in fact.

In view of the above stated reasons, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn. Inconvenience to petitioner is regretted.

The copy of the RCE submitted with the petition is hereby accepted since the originally filed RCE is apparently lost.

The RCE will be processed and an Office action will be issued in due course.

Inquiries regarding this decision should be directed to Hien H. Phan, Special Programs Examiner, at (571) 272-1606.

Howard N. Goldberg, Group Director
Technology Center 2800
Semiconductors, Electrical and Optical
Systems and Components

OIPE JC184
JUN 1 2 2003
PATENT & TRADEMARK OFFICE

06-13-03

DAC
office of Petitions

#12

"EXPRESS MAIL CERTIFICATE"
"EXPRESS MAIL" MAILING LABEL NUMBER EV104962585US
DATE OF DEPOSIT: June 12, 2003
I hereby certify that this paper or fee and the papers indicated as being transmitted herewith are being deposited with the United States Postal Service"Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date and with the Mailing Label Number indicated above and addressed to:
COMMISSIONER FOR PATENTS, MAIL STOP: PETITIONS
P.O. BOX 1450, ALEXANDRIA, VA 22313-1450.
STEVEN OLSZEWSKI
NAME OF PERSON MAILING PAPER OR FEE (TYPE OR PRINT)
SIGNATURE Steven Olszewski

Attorney Docket No.: P51160

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Erskine, *et al.*

For: Compounds and Methods for the Treatment of Neoplastic Disease

Serial No.: 09/912,483 Group Art Unit: 1614

Filed: July 25, 2001 Examiner: James H. Reamer

Due Date of Mailing "Notice of Allowance and Base Issue Fee Due": May 27, 2003

PETITION TO WITHDRAW FROM ISSUE --ISSUE FEE PAID UNDER 37 C.F.R.§1.313(c)(2)

In this application, the issue fee was paid on May 20, 2003, in response to a Notice of Allowance mailed February 26, 2003. Applicants now petition to withdraw this application from issue under the provisions of 37 C.F.R. §1.313(c)(2) and respectfully request consideration of the enclosed Request for Continued Examination made in compliance with 37 C.F.R. §1.114.

Applicants hereby submit a Information Disclosure Statement and PTO form 1449 disclosing U.S. Application Serial No. 10/912,610 (Attorney Docket No. P51113) and its related continuation-in-part application, U.S. Application Serial No. 10/199,933 (Attorney Docket No. P51113-1), along with additional references submitted with these applications for the Examiner's consideration. Applicants also enclose herein a copy of the official Office Action for Serial No. 09/912,610 (Paper No. 12).

06/16/2003 SLUANG1 00000003 192570 09912483
01 FC:1460 130.00 DA

RECEIVED
JUN 1 7 2003
OFFICE OF PETITIONS

REMARKS

In view of the foregoing, Applicants respectfully request the grant of this Petition for Withdrawal of Issue and Request for Continued Examination.

PETITION FEES

The Commissioner is hereby authorized to charge the requisite fee of $130.00 or any additional fees under 37 C.F.R §1.17(h) to Deposit Account No. 19-2570.

Respectfully submitted,

Andrea V. Lockenour
Attorney for Applicants
Registration No. 51,962

GLAXOSMITHKLINE
Corporate Intellectual Property - UW2220
709 Swedeland Road
P.O. Box 1539
King of Prussia, PA 19406-0939
Phone (610) 270-7568
Facsimile (610) 270-5090

RECEIVED
JUN 1 7 2003
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

GLAXOSMITHKLINE
CORPORATE INTELLECTUAL PROPERTY-US,
UW2220
P.O. BOX 1539
KING OF PRUSSIA PA 19406-0939

COPY MAILED

JUN 1 8 2003

OFFICE OF PETITIONS

In re Application of
Symon G. Erskine et al
Application No. 09/912,483
Filed: July 25, 2001
Attorney Docket No. P51160

ON PETITION

This is a decision on the petition, filed June 12, 2003, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on May 22, 2003 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

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

After receipt of the file in the Office of Petitions, the application will be forwarded to Technology Center AU 1614 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

Paper No. 23

Richard B. Taylor
Protein Technologies International, Inc.
P.O. Box 88940
St. Louis, MO 63188

COPY MAILED

JUN 2 3 2004

OFFICE OF PETITIONS

In re Application of :
Wong, et al. : DECISION ON PETITION
Application No. 09/912,494 :
Filed: July 24, 2001 :
Atty. Dkt. No.: SP-1093.2 :

This is a decision on the petition under 37 CFR 1.137(b), filed March 26, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned October 2, 2003 for failure to timely file a proper response to the final Office action mailed July 1, 2003. A response was submitted August 7, 2003, however it failed to place the application in condition for allowance. Thereafter, an Advisory Action was mailed October 14, 2003. This decision precedes Notice of Abandonment.

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 submit a proper reply to the final Office action is accepted as having been unintentionally delayed.

This application will be forwarded to Technology Center 1600 for processing of the Notice of Appeal and Appeal Brief submitted with the instant petition.
Telephone inquiries concerning this matter may be directed to the undersigned at (703) 305-0310.

Application No. 09/912,494

Telephone inquiries concerning this matter may 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

CYTYC CORPORATION
250 CAMPUS DRIVE
MARLBOROUGH MA 01752

COPY MAILED

SEP 28 2007

OFFICE OF PETITIONS

In re Application of	:	
David Hung	:	
Application No. 09/912,499	:	ON PETITION
Filed: July 26, 2001	:	
Attorney Docket No. 12.018011	:	

This is a decision on the petition to withdraw the holding of abandonment under 37 CFR 1.181, filed September 11, 2007.

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

This application was held abandoned for failure to timely file a reply to the Office letter mailed on June 15, 2006. The Office mailed a Notice of Abandonment on June 8, 2007.

A review of the Office letter mailed on June 15, 2006 reveals that it was an Examiner's Answer, mailed in response to Applicant's Appeal Brief filed on February 15, 2006. Further review of the Examiner's Answer indicates that it did not contain any new ground(s) of rejection. As such, the application should have been forwarded to the Board of Patent Appeals and Interferences for consideration.

In view thereof, **THE HOLDING OF ABANDONMENT IS WITHDRAWN.**

The Notice of Abandonment is **VACATED**.

The matter is being forwarded to the Board of Patent Appeals and Interferences for consideration of the Appeal Brief and Examiner's Answer.

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED

JUN 17 2005

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

McGuire Woods LLP
1750 Tysons Boulevard
Suite 1800
McLean VA 22102

In re Application of:
KIM, HAENG-SEON
Application Serial No.: 09/912,500
Filed: July 26, 2001
For: **FLAT PANEL DISPLAY**

DECISION
ON PETITION

This is a decision on the Petition to Withdraw Holding of Abandonment filed on May 18, 2005 pursuant to 37 C.F.R. §1.181. No fee is required.

The petition is **GRANTED**.

This application was held abandoned for failure to timely file new formal drawings as required in the Notice of Allowability mailed December 14, 2004. A Notice of Abandonment was mailed May 6, 2005.

Petitioner states that a second Notice of Allowability received, did not require the submission of formal drawings. As evidence thereof, a copy of the second Notice of Allowability with facsimile transmission date of December 20, 2004 did not require submission of drawings. The first Notice of Allowability mailed December 14, 2004 did require corrected drawings

A review of the file reveals that there is a Draft's person notice of informal drawing (PTO-948) of record. This notice is dated August 11, 2003. However, the cover sheet (PTO-326) of the Office action of September 10, 2003 (The next Office communication to applicant) does not indicate that a PTO-948 is included. Consequently, it is concluded the PTO-948 was not sent to applicant. The second Notice of Allowability does not indicate that corrected drawings are required.

Accordingly, the Notice of Abandonment is hereby vacated and the holding of abandonment is withdrawn. The requirement for corrected drawings is vacated. The application file is being forwarded to publications for further processing. If corrected drawings are necessary, notice to that effect will be sent to applicant.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.

FITZPATRICK, CELLA, HARPER &
SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112-3801

COPY MAILED

AUG 3 1 2006

OFFICE OF PETITIONS

In re Patent No. 7,031,001	:	
Nakagiri et al.	:	
Issue Date: April 18, 2006	:	LETTER REGARDING
Application No. 09/912,553	:	PATENT TERM ADJUSTMENT
Filed: July 26, 2001	:	
Attorney Docket No. 862.C2310	:	

This is in response to the paper styled SUBMISSION OF PAPER MISSING FROM IMAGE FILE WRAPPER AND COMMENTS ON DETERMINATION OF PATENT TERM ADJUSTMENT filed June 2, 2006. Pursuant to patentees' duty of good faith and candor, patentees note that the Patent Term Adjustment may need to be recalculated.

The request for correction of the patent term adjustment indicated in the patent is **DISMISSED**.

On April 18, 2006, the above-identified application matured into U.S. Patent No. 7,031,001, with a revised Patent Term Adjustment of 800 days. Patentees disclose that a "Request for Corrected Notice of Allowance" was filed on October 28, 2005 but is missing from the image file wrapper. Further, patentees state given the entry of this paper the Patent Term Adjustment may need to be recalculated.

The filing of the "Request for Corrected Notice of Allowance" on October 28, 2005 after the mailing of the Notice of Allowance on October 11, 2005 has been considered. 37 CFR 1.704(c)(10) generally establishes the filing of a paper after the mailing of the notice of allowance as a circumstance that constitutes a

"failure to engage in reasonable efforts to conclude prosecution," warranting entry of a period of reduction of patent term adjustment. However, the Office has determined that the filing of a response to the examiner's reasons for allowance or a request to correct an error or omission in the "Notice of Allowance" or "Notice of Allowability" will not be considered a failure to engage in reasonable efforts to conclude processing or examination of an application. See MPEP 2732. As the paper filed October 28, 2005 was a request to correct an error in the Notice of Allowability, no reduction for its filing is warranted. Thus, the entry of this paper in the image file wrapper for this application has no impact on the Patent Term Adjustment indicated in the patent.

In view thereof, the patent properly issued with a revised patent term adjustment of 800 days.

As this letter was submitted as an advisement to the Office of an error in Patentees' favor, the Office will not assess the $200.00 fee under 37 CFR 1.18(e). The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

The application is being forwarded to the Certificates of Correction Branch for consideration of the request for certificate of correction filed August 8, 2006.

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

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

SANTIAGO RIVERA
3350 KURTZ STREET
SAN DIEGO, CA 92110

MAILED

JUL 17 2003

Director's Office
Group 3700

Paper No. 13

In re Application of
RIVERA ET AL.
Application No.: 09/912,560
Filed: July 26, 2001

DECISION ON PETITION

This is a decision on petitioner's request filed April 8, 2003 to review the holding of abandonment, mailed March 25, 2003 for failure to respond to the Office action of July 8, 2002.

In support of the request, petitioner has submitted a copy of a request for a two (2) month extension of time and a response with a certificate of mailing dated December 9, 2002. Petitioner has also submitted a statement attesting to the timely mailing as required by 37 CFR 1.8(b).

In view of the above, the Notice of Abandonment mailed March 25, 2003 is in error and is hereby vacated. The holding of abandonment is withdrawn. This application is being forwarded to the examiner for appropriate action.

Summary: Holding of Abandonment Withdrawn.

Richard A. Bertsch, Director
Technology Center 3700

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
PO Box 1450
Arlington, VA 22313-1450
www.uspto.gov

Paper No. 8

Schwabe, Williamson, & Wyatt
Pacwest Center, Suites 1600-1900
1211 SW Fifth Avenue
Portland, OR 97204

COPY MAILED

JUL 0 1 2003

OFFICE OF PETITIONS

In re Application of
Pugh et al.
Application No. 09/912,571
Filed: July 24, 2001
Attorney Docket No. 109870-130115

ON PETITION

This is a decision on the petition under 37 CFR 1.137(f), filed June 10, 2003, which is being treated as a petition under 37 CFR 1.137(b) to revive the above-identified application.

The petition is Granted.

Petitioner states that the instant non-provisional application is the subject of a counterpart application filed in a foreign country 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 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(b) 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(b). Accordingly, the failure to timely notify the Office of a foreign or international filing within 45 days after the date of filing of such foreign or international application as provided by 35 U.S.C. 122(b)(2)(B)(iii) and 37 CFR 1.213(c) is accepted as having been unintentionally delayed.

The previous Request and Certification under 35 U.S.C. § 122 (b) (2) (B) (i) has been rescinded. A Notice Regarding Rescission of Non-publication Request which sets forth the projected publication date of October 2, 2003 was mailed on June 30 2003.

The application file is being forwarded to Technology Center AU 2124 for examination in due course.

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

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

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

UNITED STATES 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

REED & EBERLE LLP
800 MENLO AVENUE, SUITE 210
MENLO PARK CA 94025

COPY MAILED

MAR 2 5 2004

OFFICE OF PETITIONS

In re Application of
Evan C. Unger et al
Application No. 09/912,609
Filed: July 25, 2001
Attorney Docket No. UNGR-1599

: 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 July 3, 2003, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/703,484, filed October 31, 2000, 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(s), 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 reference to the above-noted, prior-filed application 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).

A reference to add the above-noted, prior-filed application on page one following the first sentence of the specification has been included in an amendment filed on July 3, 2003. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew 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 applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See* In re de Seversky, *supra*. *Note also* MPEP 201.06(c).

Accordingly, before the petition under 37 CFR 1.78(a)(3) can be granted, a substitute amendment [2] deleting the incorporation by reference statement to Application No. 09/703,484, along with a renewed petition under 37 CFR 1.78(a)(3), is required.

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

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

---

[2]Note 37 CFR 1.121

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

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

Karen Creasy

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No.13

REED & EBERLE LLP
800 MENLO AVENUE, SUITE 210
MENLO PARK, CA 94025

COPY MAILED

JUN 2 3 2004

OFFICE OF PETITIONS

In re Application of
Evan C. Unger et al
Application No. 09/912,609
Filed: July 25, 2001
Attorney Docket No. UNGR-1599

: DECISION ON PETITION
: UNDER 37 CFR 1.78(a)(3)

This is a decision on the renewed petition under 37 CFR 1.78(a)(3), filed May 26, 2004, 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 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 July 25, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

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

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

This application is being forwarded to Technology Center Art Unit 1617 for consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to prior-filed nonprovisional Application No. 09/703,484, filed October 31, 2000.

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
WWW.USPTO.GOV

PAPER NO. 15

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

COPY MAILED

JUL 28 2003

OFFICE OF PETITIONS

In re Application of
Tetsuya Kawagishi, et al.
Application No. 09/912,632
Filed: July 26, 2001
Attorney Docket No. 212052US-2

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed July 25, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on March 26, 2003, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

After the application is received in the Office of Petition, the file will be forwarded to Technology Center AU 3737 for further processing of the request for continued examination under 37 CFR 1.114.

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OIPE
FEB 07 2005
PATENT & TRADEMARK OFFICE

PAPER NO.

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

COPY MAILED
JUL 28 2003
OFFICE OF PETITIONS

In re Application of
Tetsuya Kawagishi, et al.
Application No. 09/912,632
Filed: July 26, 2001
Attorney Docket No. 212052US-2

ON PETITION

This is a decision on the petition under 37 CFR 1.313(c)(2), filed July 25, 2003, to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

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

Petitioner is advised that the issue fee paid on March 26, 2003, in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance. [1]

After the application is received in the Office of Petition, the file will be forwarded to Technology Center AU 3737 for further processing of the request for continued examination under 37 CFR 1.114.

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

RECEIVED: 7-30-03
OBLON, SPIVAK, McCLELLAND
MAIER & NEUSTADT, P.C.
DOCKETING DEPT.
Initials/Date Docketed: 7-23-03
Type of Resp(s): _____
Due Date(s): _____

[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

COPY MAILED

JUL 3 0 2004

OFFICE OF PETITIONS

LEWIS F. GOULD, JR.
DUANE MORRIS & HECKSCHER, LLP
ONE LIBERTY PLACE
PHILADELPHIA PA 19103

In re Application of	:	
Jean Marc Gilson	:	
Application No. 09/912,635	:	ON PETITION
Filed: July 25, 2001	:	
Attorney Docket No. 3610-16	:	

This is a decision on the petition, filed July 29, 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 June 7, 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 1725 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
Washington, D.C. 20231
www.uspto.gov

Paper No. 6

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
12400 WILSHIRE BOULEVARD, SEVENTH FLOOR
LOS ANGELES CA 90025-1026

COPY MAILED

FEB 26 2002

OFFICE OF PETITIONS

In re Application of	:	
Elliott Schwartz	:	
Application No. 09/912,636	:	DECISION GRANTING
Filed: July 24, 2001	:	PETITION
Attorney Docket No. 05168.P002	:	

This is a decision on the petition October 1, 2001, requesting that the above-identified application be accorded a filing date of July 24, 2001, rather than the presently accorded date of July 25, 2001. The petition is properly treated as a petition under 37 CFR 1.10(c).

Applicant requests the earlier filing date on the basis that the application was purportedly deposited with the U.S. Postal Service (USPS) as Express Mail on July 24, 2001 pursuant to 37 CFR 1.10. In support, applicant has submitted a copy of Express Mail label No. EL627465605US showing an illegible handwritten "date-in" as well as a "SAN JOSE CA WINDOW NO 15 JULY 24 2001 USPS" receipt stamp. The same Express Mail receipt number appears on the original "Transmittal for Patent Application," which includes the Express Mail label number. Additionally, the Express Mail label number appears on the Certificate of Mailing by "Express Mail" and includes a statement of express mailing dated July 24, 2001 on the cover page for the application papers.

In view of the USPS receipt stamp of July 24, 2001 appearing on the same Express Mail label, it is concluded that the application was deposited as "Express Mail" with the USPS on July 24, 2001.

The petition is **granted**.

In further reviewing the application file, it is noted that, on December 4, 2001, a request to rescind a previous nonpublication request under 35 USC 122(b)(2)(B)(ii) was submitted. Accordingly, as requested, the nonpublication request has been rescinded.

A corrected filing receipt showing the filing date of the instant application and the projected publication date accompany this decision.

This application is being forwarded to the Office of Initial Patent Examination Division for further **processing with a filing date of July 24, 2001.** Thereafter, the application will be forwarded to Technology Center AU 2153 for examination in due course.

Telephone inquiries concerning this matter may be directed to Frances Hicks at (703) 305-8680.

Brian Hearn

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

ATTACHMENT: Corrected Filing Receipt

DORSEY
DORSEY & WHITNEY LLP

FAX COVER SHEET

The information contained in this facsimile message, if a client of this firm is a named addressee, or the message is otherwise intended for a client, is presumptively legally privileged and confidential information. If you are not a named addressee, or if there is any reason to believe that you may have received this message in error, (1) do not read the message below; (2) do not distribute or copy this facsimile; and (3) please immediately call us collect at the number of the sender below.

DATE:	**February 27, 2007**	TOTAL # OF PAGES: (INCLUDING THIS COVER SHEET)	**23**
TO:	**Ms. Mary Diggs, Certificate of Corrections**	FAX #:	**(571) 270-9882**
FIRM NAME:	**United States Patent and Trademark Office**	PHONE #:	**(703) 308-9390 ext. 125**
FROM:	**Ginny Sawatzke, Senior Intellectual Property Paralegal**	FAX #:	**(303) 629-3450**
PHONE #:	**(303) 352-1105**	EMAIL:	**sawatzke.ginny@dorsey.com**

COMMENTS:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket No.: 33526/US

Inventors: Hai Pin Kuo et al.
Patent No.: 6,461,279
Issue Date: October 8, 2002
Title: TREADMILL HAVING DUAL TREADS FOR STEPPING EXERCISES

CERTIFICATE OF TRANSMISSION

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING FACSIMILE TRANSMITTED TO THE UNITED STATES PATENT AND TRADEMARK OFFICE FAX NO. 571-270-9882, ON FEBRUARY 27, 2007.

G. Sawatzke
(PERSON MAKING THE TRANSMISSION OR ATTORNEY OF RECORD)

ATTACHED CORRESPONDENCE: In furtherance of our recent telephone conversation, attached please find photocopies of the Petition to Correct Inventorship (35 U.S.C. § 256 and 37 C.F.R. § 1.324) and related documents filed with the U.S. Patent and Trademark Office via Express Mail on October 7, 2004 and not reflected in PAIR:

1. Certificate of Mailing by Express Mail (Express Mail No. EV 156 969 439 US) (2 pages);

ORIGINAL WILL BE SENT VIA:	MAIL	E-MAIL	MESSENGER	AIR COURIER	X	WILL NOT BE SENT

PLEASE CONTACT GINNY SAWATZKE AT (303) 352-1105 IF THIS TRANSMISSION IS INCOMPLETE OR CANNOT BE READ.

REFERENCE # 3057/461066-1075; 33526/US

DORSEY & WHITNEY LLP · WWW.DORSEY.COM · T 303.629.3400 · F 303.629.3450
REPUBLIC PLAZA BUILDING · SUITE 4700 · 370 SEVENTEENTH STREET · DENVER, COLORADO 80202-5647
USA CANADA EUROPE ASIA

DORSEY

Continuation of attached documents previously filed with the Office relating to the Petition to Correct Inventorship dated October 7, 2004 in connection with U.S. patent No. 6,461,279:

2. Petition to Correct Inventorship (35 U.S.C. § 256 and 37 C.F.R. § 1.324) (2 pages);
3. Statement by Gary D. Piaget Under 37 C.F.R. § 1.324(b)(1) (executed) (1 page);
4. Statement by Hai Pin Kuo Under 37 C.F.R. § 1.324(b)(2) (executed) (1 page);
5. Combined Declaration and Power of Attorney for Patent Application (executed) (3 pages);
6. Consent of Assignee to Change Inventorship Under 37 C.F.R. § 1.324(b)(3) (executed) (1 page);
7. Combined Power of Attorney by Assignee and Submission Under 37 C.F.R. §§ 3.71 and 3.73(b) (executed) and copy of the Assignment from Hai Pin Kuo to The Nautilus Group, Inc. (5 pages);
8. Two (2) Certificates of Correction (Form PTO-1050);
9. "Fee Address" Indication Form (1 page);
10. Check No. 500409 for $130.00;
11. Express Mail Label No. EV 156 969 439 US dated October 7, 2004 (1 page); and
12. Return postcard itemizing the above-mentioned enclosures and date stamped by the U.S. Patent and Trademark Office October 7, 2004 (1 page).

Please acknowledge receipt of this correspondence by calling me at (303) 352-1105.

Thank you in advance for your kind attention concerning this matter.

Best regards,

Ginny Sawatzke

c. New Declaration and Power of Attorney executed by both inventors;

d. Pursuant to 37 C.F.R. § 1.324(b)(3), Consent of Assignee to Change Inventorship, with the Assignee The Nautilus Group, Inc. agreeing to the change of inventorship;

e. Combined Power of Attorney by Assignee and Submission Under 37 C.F.R. §§ 3.71 and 3.73(b), and copy of the Assignment from Hai Pin Kuo to The Nautilus Group, Inc.;

f. Pursuant to 37 C.F.R. § 1.324(b)(4), the petition fee of $130.00 under 37 C.F.R. § 1.20(b);

g. Two (2) copies of completed Form PTO-1050 with at least one copy being suitable for printing.

3. Please send the Certificate of Correction to:

Name: Lee R. Osman, Esq.
Address: Dorsey & Whitney LLP
370 Seventeenth Street, Suite 4700
Denver, CO 80202-5647

It is believed that no additional fees are due; however, this Petition is submitted with a check in the amount of $130 to cover the Petition fee.

Signed at Denver, Colorado, this 7TH day of OCTOBER, 2004.

Respectfully submitted,

Gregory P. Durbin, Reg. No. 42,503
DORSEY & WHITNEY LLP
370 Seventeenth Street, Suite 4700
Denver, CO 80202-5647
Tel: (303) 629-3400
Fax: (303) 629-3450

USPTO Customer No. 20686

Express Mail No. EV 156 969 439 US
Attorney Docket No. 33526/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

Patent No:	6,461,279
Issue Date:	08 October 2002
Appl. No.:	09/912,664
Filed:	25 July 2001
Title:	TREADMILL HAVING DUAL TREADS FOR STEPPING EXERCISES

Commissioner for Patents
Attn: Decision and Certificate of Correction
Branch of the Patent Issue Division
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT BY GARY D. PIAGET UNDER 37 C.F.R. § 1.324(b)(1)

Dear Sir:

I, Gary D. Piaget, hereby state that the inventorship error of omitting myself as an inventor of the above-referenced patent occurred without any deceptive intention on the part of myself.

Dated this 27 day of SEPTEMBER 2004.

Respectfully submitted,

By: _____
Gary D. Piaget

4837-7771-9296\1

Express Mail No. EV 156 969 439 US
Attorney Docket No. 33526/US

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:

Patent No:	6,461,279
Issue Date:	08 October 2002
Appl. No.:	09/912,664
Filed:	25 July 2001
Title:	TREADMILL HAVING DUAL TREADS FOR STEPPING EXERCISES

Commissioner for Patents
Attn: Decision and Certificate of Correction
Branch of the Patent Issue Division
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION TO CORRECT INVENTORSHIP
(35 U.S.C. § 256 and 37 C.F.R. § 1.324)

Dear Sir:

1. Pursuant to 35 U.S.C. § 256 and to 37 C.F.R. § 1.324, correction of the above-referenced patent to add Gary D. Piaget hereinafter ("Mr. Piaget") as an inventor is hereby requested. Mr. Piaget was erroneously, and without deceptive intent on his part, omitted as an inventor on the above-referenced patent. The correct inventors for the claimed subject matter of the above-referenced patent are:

   Hai Pin KUO, Tainan City, Taiwan; and

   Gary D. PIAGET, Deer Harbor, Washington.

2. Attached are the following documents:

   a. Pursuant to 37 C.F.R. § 1.324(b)(1), a statement from Gary D. Piaget that the error of omitting him as an inventor in the above-referenced patent occurred without deceptive intent on his part;

   b. Pursuant to 37 C.F.R. § 1.324(b)(2), a statement from Hai Pin Kuo, agreeing to the change of inventorship;

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : 6,461,279

DATED : October 8, 2002

INVENTOR(S) : Hai Pin Kuo

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

Title page, Item (76), after subheading "Inventor", insert additional inventor –Gary D. Piaget, 141 Deep Meadow Lane, Deer Harbor, Washington 98243.

MAILING ADDRESS OF SENDER:

Lee R. Osman, Esq.
DORSEY & WHITNEY LLP
370 Seventeenth Street, Suite 4700
Denver, CO 80202-5647

PATENT NO. 6,461,279

PAGE 18/23 * RCVD AT 2/27/2007 11:50:33 AM [Eastern Standard Time] * SVR:USPTO-EFXRF-2/9 * DNIS:2709882 * CSID:3036293450 * DURATION (mm-ss):06-06

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : **6,461,279**

DATED : **October 8, 2002**

INVENTOR(S) : **Hai Pin Kuo**

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

Title page, Item (76), after subheading "Inventor", insert additional inventor --Gary D. Piaget, 141 Deep Meadow Lane, Deer Harbor, Washington 98243.

MAILING ADDRESS OF SENDER:

Lee R. Osman, Esq.
DORSEY & WHITNEY LLP
370 Seventeenth Street, Suite 4700
Denver, CO 80202-5647

PATENT NO. **6,461,279**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 8-20-07

Paper No.: _____

TO SPE OF : ART UNIT 3764

SUBJECT : Request for Certificate of Correction for Appl. No. 6461279B1 (09/912664)

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

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

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

(Please do not send to warehouse) Applicant & attorney want to know the status. Thank you, Kindly

Esta James

Certificates of Correction Branch

703-308-9390 ext. 116

124

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**

3763 **Art Unit**

UNITED STATES PATENT AND TRADEMARK OFFICE

CERTIFICATE OF CORRECTION

PATENT NO. : **6,461,279**

DATED : **October 8, 2002**

INVENTOR(S) : **Hai Pin Kuo**

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

Title page, Item (76), after subheading "Inventor", insert additional inventor --Gary D. Piaget, 141 Deep Meadow Lane, Deer Harbor, Washington 98243.

MAILING ADDRESS OF SENDER:

Lee R. Osman, Esq.
DORSEY & WHITNEY LLP
370 Seventeenth Street, Suite 4700
Denver, CO 80202-5647

PATENT NO. **6,461,279**

Copyright 1994 Legalsoft P15/REV01

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

PATREA L. PABST
HOLLAND & KNIGHT LLP
SUITE 2000, ONE ATLANTIC
CENTER
1201 WEST PEACHTREE STREET,
N.E.
ATLANTA, GA 30309-3400

COPY MAILED

APR 19 2002

OFFICE OF PETITIONS

In re Application of	:	
Ye Bangce	:	
Application No. 09/912,673	:	DECISION ON PETITION
Filed: July 23, 2001	:	
Attorney Docket No. JNB 100	:	

This is a decision on the petition filed January 14, 2002, requesting that the above-identified application be accorded a filing date of July 23, 2001.

The application was filed on July 23, 2001. However, on September 13, 2001, the Initial Patent Examination Division mailed a Notice of Incomplete Nonprovisional Application (hereinafter "Notice"), requiring drawings and stating that the filing date of the application would be the date of receipt of the omitted drawings.

Petitioner argues, *inter alia*, that two (2) sheets of drawings were received by this Office as evidenced by the return-receipt postcard. In support, Petitioner provides a copy of a return receipt postcard acknowledging receipt of the application and two (2) sheets of drawings by this Office.

A review of the return receipt postcard reveals that Petitioner is correct. The postcard acknowledges receipt of two (2) sheets of drawings by this Office. Petitioner also re-submitted the drawings with the instant petition. The Notice was mailed in error and is vacated.

The petition is granted.

No petition fee is required.

The application will be returned to the Initial Patent Examination Division for further processing as a nonprovisional application with a filing date of July 23, 2001 and an indication that two (2)sheets of drawings were present on filing using the two (2) sheets filed January 14, 2002, with the instant petition.

Telephone inquiries concerning this matter should be directed to Petitions Attorney Derek L. Woods at (703) 305-0014.

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

DEC 1 9 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Seed Intellectual Property Law Group
701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092

In re Application of KARANEWSKY, Donald, et al. U.S. Application No.: 09/912,674 Filing Date: 20 July 2001 Attorney's Docket No.: 480140.444 For: (SUBSTITUTED) ACYL DIPEPTIDYL INHIBITORS ...	DECISION ON PETITION FOR REVIVAL (37 CFR 1.137(b))

This is in response to applicant's petition under 37 CFR 1.137(b) filed 20 July 2001 to revive international application PCT/US99/24756 abandoned under 35 U.S.C. 371(d).

All of the requirements of 37 CFR 1.137(b) for revival have been submitted. Applicant's statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirements of 37 CFR 1.137(b)(3).

International application PCT/US99/24756 became abandoned as to the United States of America after midnight on 22 June 2000 for failure to pay the basic national fee. The filing of the present continuing application under 35 U.S.C. 111 is accepted as the appropriate response under 37 CFR 1.137(b). See MPEP § 711.03(c). International application PCT/US99/24756 is being revived for purposes of continuity only and since continuity has been established by this decision reviving the international application, the international application is again abandoned in favor of the present continuing application number 09/912,674.

This application is being forwarded to the Office of Initial Patent Examination for treatment as a filing under 35 U.S.C. 111(a) with a filing date of 20 July 2001.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

RMR/RC:rmr

UNITED STATES PATENT AND TRADEMARK OFFICE

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

a

TIMOTHY W. LOHSE
PATENT DEPARTMENT - EM
GRAY CARY WARE & FREIDENRICH
1755 EMBARCADERO ROAD
PALO ALTO, CA 94303

COPY MAILED

JUL 0 2 2002

OFFICE OF PETITIONS

In re Application of Janet Wasowicz et al Application No. 09/912,681 Filed: July 24, 2001 For: DIAGNOSTIC SYSTEM AND METHOD FOR PHONOLOGICAL AWARENESS, PHONOLOGICAL PROCESSING, AND READING SKILL TESTING	DECISION REFUSING STATUS UNDER 37 CFR 1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed March 4, 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(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

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

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

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

(3) the petition fee; and

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

Applicant lacks item (2) as set forth above.

In regards to requirement (2), petitioner has not submitted an oath or declaration in compliance with 37 CFR 1.63 and 1.64. The declaration submitted does not set forth the citizenship, residence, and mailing address of nonsigning Wasowicz. Accordingly, a new oath or declaration signed by all the nonsigning inventors on behalf of themselves and on behalf of the nonsigning inventor in compliance with 37 CFR 1.63 and 1.64 is required.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to consider submitting the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Karen Creasy.

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 related to this decision should 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
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 12.

TIMOTHY W. LOHSE
GRAY CARY WARE & FREIDENRICH
ATTN: PATENT GROUP
1755 EMBARCADERO RD.
PALO ALTO, CA 94303

COPY MAILED

JUL 29 2002

OFFICE OF PETITIONS

In re Application of Janet Wasowicz, Feng-Qi Lai & Andrew Morrison Application No. 09/912,681 Filed: July 24, 2001 For: DIAGNOSTIC SYSTEM AND METHOD FOR PHONOLOGICAL AWARENESS, PHONOLOGICAL PROCESSING, AND READING SKILL TESTING	DECISION NOTING JOINDER OF INVENTOR AND PETITION UNDER 37 CFR 1.47(a) MOOT

This is in response to the paper filed on July 25, 2002 under 37 CFR 1.47(a) and in response to the Supplemental Declaration filed July 25, 2002, signed by previously nonsigning inventor Janet Wasowicz in compliance with 37 CFR 1.63.

In view of the joinder of the inventor, further consideration under 37 CFR 1.47(a) is 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 any further consideration under 37 CFR 1.47(a).

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

Inquiries related to this decision may be addressed 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

Paper No. 16

TIMOTHY W. LOHSE
GRAY CARY WARE & FREIDENCRICH
PATENT DEPARTMENT - EM
1755 EMBARCADERO ROAD
PALO ALTO CA 94303

COPY MAILED

JUL 23 2003

OFFICE OF PETITIONS

In re Application of
Feng-Qi Lai, Janet Wasowicz, and Andrew Morrison
Application No. 09/912,681
Filed: July 24, 2001
Attorney Docket No. 2100632-991121
Title: DIAGNOSTIC SYSTEM AND METHOD FOR PHONOLOGICAL AWARENESS, PHONOLOGICAL PROCESSING, AND READING SKILL TESTING

DECISION ON PETITION

This is a decision on the petition under 37 C.F.R. §1.182, filed June 9, 2003, to change the order of the names of the inventors.

The petition is **GRANTED**.

The order of the names of the inventors has been changed as follows:

Feng-Qi Lai
Janet Wasowicz
Andrew Morrison

A filing receipt reflecting this change is enclosed.

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

Telephone inquiries related to this decision should be directed to the undersigned at (703) 305-0011.

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

Encl. 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

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

COPY MAILED
AUG 1 0 2006
OFFICE OF PETITIONS

In re Application of	:	
Michael A. Epstein	:	
Application No. 09/912,685	:	ON PETITION
Filed: July 25, 2001	:	
Attorney Docket No. US010339	:	

This is a decision on the petition under 37 CFR 1.137(b), filed by facsimile transmission on May 26, 2006, 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 January 3, 2006. A Notice of Abandonment was mailed on May 12, 2006.

Since $1,500 is needed for treatment of the instant petition, that fee has been charged to petitioner's deposit account, as authorized.

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

This application file is being referred to the Office of Publications 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

cc: Michael J. Ure
Philips Electronics North America Corp.
1109 McKay Drive MS41-SJ
San Jose, CA 95131

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

COPY MAILED

FEB 19 2003

OFFICE OF PETITIONS

Scott & Yallery – Arthur
7306 Georgia Avenue, NW
Washington, DC 20012

In re Application of
E. T. Buford III.
Application No. 09/912,692
Filed: July 26, 2001
Attorney Docket No. 27.385

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed January 29, 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 August 15, 2001. The Notice set a period for reply of two (2) months from the mail date of the Notice. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on October 16, 2001.

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

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

Latrice Bond

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

#5

Corrected Application

Application as originally filed

July 26, 2001

UNITED STATES 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

Nigel L. Scott
SCOTT & YALLERY-ARTHUR
7306 Georgia Avenue, N.W.
Washington, DC 20012

COPY MAILED

FEB 23 2004

OFFICE OF PETITIONS

In re Application of
Edward T. BUFORD, III
Application No. 09/912,692
Filed: July 26, 2001
Attorney Docket No. 27.385

ON PETITION

This is a decision on the substitute petition under 37 CFR 1.137(b), filed September 25, 2003, to revive the above-identified application.

The petition is **GRANTED**.

The decision on petition, mailed February 19, 2003, is vacated in favor of the instant decision on petition as the prior decision was issued in error.

Inasmuch as the requirements for a grantable petition pursuant to 37 CFR 1.137(b) have now been met, the instant application file is being forwarded to Technology Center 1700 for further examination on the merits.

Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-3865.

BethAnne Davoan
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

NIGEL L. SCOTT, ESQUIRE
SCOTT & YALLERY-ARTHUR
7306 GEORGIA AVENUE, N.W.
WASHINGTON, DC 20012

COPY MAILED

SEP 06 2005

OFFICE OF PETITIONS

In re Application of :
Edward T. Buford III :
Application No. 09/912,692 :
Filed: July 26, 2001 :
Attorney Docket No. 27.385 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed May 12, 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(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) two (2).

Petitioner is advised that as of December 8, 2004, the Petition fee for revival of an application for patent abandoned unintentionally under 37 CFR 1.137(b) is $750 for a small entity. Petitioner remitted $685 for the petition fee on May 12, 2005; therefore, the fee deficiency of $65 is due upon the filing of the "renewed petition."

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

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

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

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

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

Retta Williams

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

NIGEL L. SCOTT, ESQUIRE
SCOTT & YALLERY-ARTHUR
7306 GEORGIA AVENUE, N.W.
WASHINGTON, DC 20012

COPY MAILED

JAN 17 2006

OFFICE OF PETITIONS

In re Application of :
Edward T. Buford III :
Application No. 09/912,692 : ON PETITION
Filed: July 26, 2001 :
Attorney Docket No. 27.385 :

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

The petition is **GRANTED.**

A Notice of Non-Compliance was mailed on November 22, 2004. The Notice indicated that the Amendment filed April 29, 2004 was considered non-compliant because it has failed to meet the requirements of 37 CFR 1.121, as amended on June 30, 2003 (see 68 Fed. Reg. 38611, June 30, 2003). Petitioner was given a time period of one (1) month or thirty (30) days from the mailing date of the notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment of the application. Accordingly, the application became abandoned on December 23, 2004.

The petition satisfies the conditions for revival pursuant to the provisions of 37 CFR 1.137 (b) in that (1) the reply in the form of an Amendment (filed May 12, 2005); (2) the petition fee; (3) the required statement of unintentional delay have been received. Accordingly, the petition filed November 28, 2005 is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being referred to Technology Center 1700, Art Unit 1744 for further processing.

Retta Williams

Retta Williams
Petitions Examiner
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAIL

AUG 4 - 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Paper No. 9

FISH & RICHARDSON P.C.
225 Franklin Street
Boston, MA 02110-2804

In re Application of:
David A. Foti
Application No.: 09/912,720
Filed: July 24, 2001
For: DESIGNATING AN OBJECT FOR DESTRUCTION

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY

This is a decision on the Request to Withdraw from Representation filed July 11, 2003.

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

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

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

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

for James R. Matthews

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 11

MAIL

OCT 2 8 2003

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

Lawrence K. Kolodney
FISH & RICHARDSON
225 Franklin Street
Boston, MA 02110-2804

In re Application of:
David A. Foti
Application No. 09/912,720
Filed: July 24, 2001
For: DESIGNATING AN OBJECT FOR DESTRUCTION

DECISION ON REQUEST FOR WITHDRAWAL AS ATTORNEY

This is a decision on the Request To Withdraw from Representation filed August 11, 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 11, 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.

For James R. Matthews

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

cc: Thomas V. Smurzynski, Esq.
Lahive & Cockfield LLP
28 State Street
Boston, MA 02109-1784

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

DICKSTEIN SHAPIRO LLP
1633 Broadway
NEW YORK, NY 10019

Mail Date: 04/21/2010

Applicant	: Song Chen	: DECISION ON REQUEST FOR
Patent Number	: 7606576	: RECALCULATION of PATENT
Issue Date	: 10/20/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/912,721	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/24/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **2339** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MAILED Paper No. 7

JUL 2 1 2003

DIRECTOR'S OFFICE
TECHNOLOGY CENTER 2600

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS MI 48303

In re Application of:
HUNZINGER, JASON F.
Application No. 09/912,795
Filed: July 24, 2001
For: HANDOFF ADAPTATION FOR CDMA SYSTEMS

DECISION ON PETITION TO MAKE SPECIAL

This is a decision on the petition received by June 27, 2003 under Manual of Patent Examination Procedure §708.02, VIII requesting accelerated examination.

The petition under Manual of Patent Examination Procedure §708.02, VIII, must:
(1) be filed prior to receiving any examination by the examiner,
(2) be accompanied by the required fee- $130,
(3) the claims should be directed to a single invention (if it is determined that the claims pertain to more than one invention, then applicant will have to make an election without traverse or forfeit accelerated examination status),
(4) state that a pre-examination search was made, and fully discuss the search method employed, such as classes and subclasses searched, publications, Chemical abstracts, patents, etc. A search made by a foreign patent office satisfies this requirement,
(5) be accompanied by a copy of each of the references most closely related to the subject matter encompassed by the claims if said references are not already of record,
(6) fully discuss the references, pointing out with the particularity required by 37 C.F.R. §1.111(b) and (c), how the claimed subject matter is patentable over the references.

The petition does not meet requirement (5) listed above. Specifically, Petitioner has only submitted a copy of the table of contents and one other page of the ANSI/TIA/EIA-95-B reference.

Accordingly, the petition is **DENIED**.

Any request for reconsideration must be filed within **TWO MONTHS** of the date of this decision. No further petition fee is required.

The application is being forwarded to the group Central Files and will await action in its regular turn.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DARBY & DARBY P.C.
P.O. BOX 770
CHURCH STREET STATION
NEW YORK, NY 10008-0770

COPY MAILED

SEP 03 2009

OFFICE OF PETITIONS

In re Application of	:	
Haumonte et al.	:	DECISION ON PETITION
Application No. 09/912,814	:	TO WITHDRAW
Filed: July 24, 2001	:	FROM RECORD
Attorney Docket No. 043395-0378020	:	

This is a decision on the Request to Withdraw as attorney or agent of record under 37 C.F.R. § 1.36(b), filed July 10, 2009.

The request is **NOT APPROVED** because it is moot.

A review of the file record indicates that on July 15, 2009 the power of attorney to Darby & Darby P.C. was revoked by the assignee of the patent application. Accordingly, the request to withdraw under 37 C.F.R. § 1.36(b) is moot.

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

Telephone inquires concerning this decision should be directed to the undersigned at 571-272- 7751. All other inquires concerning either the examination or status of the application should be directed to the Technology Center.

Joan Olszewski
Petitions Examiner
Office of Petitions

cc: Pillsbury Winthrop Shaw Pittman LLP
P.O. Box 10500
McLean VA 22102

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

Pillsbury Winthrop Shaw Pittman LLP
(INTEL)
P.O. Box 10500
McLean, VA 22102

Mail Date: 04/20/2010

Applicant	: Luc Haumonte	: DECISION ON REQUEST FOR
Patent Number	: 7577118	: RECALCULATION of PATENT
Issue Date	: 08/18/2009	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/912,814	: OF WYETH AND NOTICE OF INTENT TO
Filed	: 07/24/2001	: ISSUE CERTIFICATE OF CORRECTION
		:

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

The patent term adjustment has been determined to be **1146** days. The USPTO will *sua sponte* issue a certificate of correction reflecting the amount of PTA days determined by the recalculation.

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

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

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

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

QUINE INTELLECTUAL PROPERTY LAW GROUP
P.O. BOX 458
ALAMEDA, CA 94501

COPY MAILED

APR 19 2004

OFFICE OF PETITIONS

In re Application of
Daniel Pinkel et al
Application No. 09/912,818
Filed: July 24, 2001
Attorney Docket No. 407E-914026US

: 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 April 13, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 07/969,948, filed October 30, 1992, 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 July 24, 2001, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. *See* 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed application. In order for the instant application to be entitled to the benefit of the prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed 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 corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

Any inquiries concerning this decision may be directed to Karen Creasy at (703) 305-8859.

The examiner of Technology Center Art Unit 1637 will consider applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to prior-filed nonprovisional Application No. 07/969,948, filed October 30, 1992.

Karen Creasy

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

ATTACHMENT: Corrected Filing Receipt

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

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

Patent Number	Issue Date (YYYY-MM-DD)	Application Number	Filing Date (YYYY-MM-DD)	Docket Number (if applicable)
6,587,304	2003-07-01	09/912,822	2001-07-25	4389.81928

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	/Jusitn R. Gaudio/	Date (YYYY-MM-DD)	2008-10-02
Name	Justin R. Gaudio	Registration Number	60178

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. 6587304
Issue Date: July 1,2003
Application No. 09912822
Filed: July 25,2001
Attorney Docket No. IOM-0277

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

This is a decision on the electronic petition, filed October 3,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 3,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 5

GLENN M. SEAGER
CROMPTON, SEAGER & TUFTE, LLC
SUITE 895
331 SECOND AVENUE SOUTH
MINNEAPOLIS, MN 55401-2246

COPY MAILED
JUL 2 2 2002
OFFICE OF PETITIONS

In re Application of	:
Jeffrey Krolik et al	: DECISION GRANTING
Application No. 09/912,862	: PETITION
Filed: July 24, 2001	:
Attorney Docket No. 1001.1507101	:

This is a decision on the petition filed by facsimile transmission on June 27, 2002, to accord the above-identified application a filing date of July 24, 2001, instead of July 25, 2001.

The petition is **granted**.

37 CFR 1.10(d) 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 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 the "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.

All of the above requirements have been met. Therefore, the application will be accorded a filing date of July 24, 2001.

A corrected filing receipt showing the filing date of July 24, 2001 accompanies this decision.

This application is being forwarded to the Office of Initial Patent Examination Division for further processing with a filing date of July 24, 2001. Afterwards, the application file will be forwarded to Technology Center Art Unit 3731 for examination in due course.

Telephone inquiries concerning this matter may be directed to Karen Creasy at (703) 305-8859.

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

ATTACHMENT: Corrected Filing Receipt

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 4

COPY MAILED

OCT 31 2001

OFFICE OF PETITIONS

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

In re Application of
Ray Burkhardt, et al
Application No. 09/912,864
Filed: July 24, 2001
Attorney Docket No. MS#155706.1 (4931)

DECISION GRANTING PETITION

This is a decision on the communication filed September 24, 2001, which is being treated as a petition under 37 CFR 1.10(c), requesting that the above-identified application be accorded a filing date of July 24, 2001, instead of the presently accorded date of July 25, 2001.

Petitioner alleges that the application was deposited in "Express Mail" service with the U. S. Postal Service, on July 24, 2001. In support, petitioners provide a copy of the Express Mail label, receipt no. E18527744018US. The same Express Mail receipt number was referred to in the copy of the original transmittal letter submitted with the instant petition. It is noted that while the "date in" on the copy of the Express Mail label is not legible, it includes a "JEFFERSON MEM STA ST LOUIS MO USPS" receipt stamp dated July 24, 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. The evidence is convincing that the application was deposited as "Express Mail" with the US Postal Service on July 24, 2001.

The petition is granted.

The application is being returned to Initial Patent Examination Division for correction of the filing date to **July 24, 2001**, and to await the response to the Notice to File Corrected Application Papers mailed September 4, 2001.

Telephone inquires related to this decision should be directed to the undersigned at (703) 305-9220. Telephone inquiries related to OIPE processing should be directed to their hotline at (703) 308-1202.

Sherry D. Brinkley
Petitions Examiner
Office of Petitions
Office of the Deputy Assistant Commissioner
for Patent Policy and Projects

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

COPY MAILED

APR 2 9 2002

OFFICE OF PETITIONS

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
SUITE 3400
FOUR EMBARCADERO CENTER
SAN FRANCISCO, CA 94111-4187

In re Application of
Wenocur et al.
Application No. 09/912,905
Filed: July 25, 2001
Attorney Docket No. A-70555/RMA

: DECISION GRANTING
: PETITION;
: NOTICE TO FILE
: CORRECTED APPLICATION
: PAPERS

This is a decision on the petition filed on January 22, 2002, in effect requesting that a Notice of Omitted Item(s) in a Nonprovisional Application, mailed on October 9, 2001 for the above-identified application ("10/9/01 Notice"), be withdrawn.

The petition is GRANTED.

The application was filed on July 25, 2001. However, the Office of Initial Patent Examination (OIPE) mailed the 10/9/01 Notice stating that pages 39-41 of the specification were missing from the filed application.

In response, the instant petition was filed. Petitioners contend that 222 pages of specification including 5 pages of claims were filed on July 25, 2001 with the other application papers. In support, the petition is accompanied by a copy of Applicants' postcard receipt which acknowledges receipt in the Office on July 25, 2001 of, *inter alia*, 222 pages of specification. The application is identified on the postcard receipt as "A-70555/RMA," which is the attorney docket number for this application. In addition, the petition encloses "copies" of pages 39-41 allegedly filed on that date.

The Office file for this application includes only pages 1-38 and 42-222, but not 39-41. Based on the information contained in Applicants' postcard receipt, the Office concludes that pages 39-41 had been received in the Office on July 25, 2001 and were later misplaced. The petition is thus granted. The 10/9/01 Notice is hereby withdrawn.

No petition fee is owed. The $130 petition fee has been credited to Deposit Account No. 06-1300 as authorized in the instant petition.

In addition, the substitute drawings enclosed with the instant petition do not comply with the margins requirements of 37 CFR 1.84. A courtesy copy of the April 23, 2002 Notice of Draftsperson's Patent Drawing Review is attached.

To avoid abandonment of this application,[1] Applicants must submit substitute drawings that are in full compliance with 37 CFR 1.84 within **TWO (2) MONTHS** from the mailing date of this

---

[1] See 37 CFR 1.85(a) (A utility/plant application will not be placed on the files for examination until objections to the drawings have been corrected); and MPEP section 608.02(a) (Aug. 2001) (OIPE will not release applications to the Technology Centers [for examination] until acceptable drawings are filed . . . If a drawing is not timely received [by the PTO] in reply to a notice . . . , the application becomes abandoned for failure to reply.).

decision unless proper extension(s) of time under 37 CFR 1.136(a) is (are) obtained.[2]

The application is being returned to OIPE for further processing, using the originally filed specification supplemented with pages 39-41 supplied with the petition; and to await submission of corrected drawings.

Telephone inquiries concerning this decision should 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

Attachment: Courtesy copy of "Notice of Draftsperson's Patent Drawing Review" (4/23/02)

---

[2] The 2-month period for reply to a Notice to File Corrected Application Papers, similar to that in 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 are permitted. See MPEP 710.02(d) (Aug. 2001).

Substitute drawings with proper margins should be sent directly to OIPE along with a copy of this decision.

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

Gardner Groff & Mehrman, P.C.
Paper Mill Village, Building 23
600 Village Trace
Suite 300
Marietta, Georgia 30067

MAIL

JUL 15 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of:	)	
Newton Howard	)	
Application No. 09/912,918	)	
Filed: July 25, 2001	)	**DECISION ON REQUEST FOR**
For: INTENTION-BASED AUTOMATED	)	**WITHDRAWAL AS ATTORNEY**
CONFLICT PREDICTION AND	)	
NOTIFICATION SYSTEM	)	

This is a decision on the Request To Withdraw from Representation filed June 14, 2002.

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

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.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Paper No. 8

Gardner Groff & Mehrman, P.C.
Paper Mill Village, Building 23
600 Village Trace
Suite 300
Marietta, Georgia 30067

MAIL

AUG 1 9 2002

DIRECTOR OFFICE
TECHNOLOGY CENTER 2100

In re Application of: Newton Howard.)
Application No. 09/912,918)
Filed: July 25, 2001) **DECISION ON REQUEST FOR**
For: INTENTION-BASED AUTOMATED) **WITHDRAWAL AS ATTORNEY**
CONFLICT PREDICTION AND)
NOTIFICATION SYSTEM)

This is a decision on the Request To Withdraw from Representation filed July 30, 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: Dr. Newton Howard
7872 Seafarer Way
Lorton, VA 22079

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. 7

CONLEY ROSE & TAYON PC
P O BOX 3267
HOUSTON, TX 77253-3267

COPY MAILED

FEB 0 4 2002

OFFICE OF PETITIONS

In re Application of	:
James M. Tour et al	:
Application No. 09/912,923	: DECISION ON PETITION
Filed: July 25, 2001	: UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 1789-05303	:

This is a decision on the petition under 37 CFR 1.78(a)(3), filed January 23, 2002, to accept an unintentionally delayed claim under 35 USC § 120 of one or more prior filed copending nonprovisional applications, namely, Application No. 09/488,339, filed January 20, 2000, and Application No. 09/551,716, filed April 18, 2000.

The petition is **granted**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2). In addition, the petition must be accompanied by:

(1) the surcharge of $1280 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)(2) and the date the claim was filed was unintentional; and

(3) the specification must contain or be amended to contain a reference to each prior filed copending nonprovisional application or be included in an application data sheet (ADS) (37 CFR 1.76). The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on July 25, 2001 and was copending with Application Nos. 09/488,339, filed January 20, 2000 and 09/551,716, filed March 20, 2000, at the time of filing, for which priority is claimed. A reference to the prior nonprovisional applications has been included in an application data sheet (ADS), which was filed concurrently with the instant petition under 37 CFR 1.78(a)(3).

The reference to the prior filed nonprovisional applications was not included in the manner specified in 37 CFR 1.78(a)(2) (i.e., in an ADS or in the first sentence following the title of the specification) or filed within the period specified in 37 CFR 1.78(a)(2). Therefore, since the claim for priority herein is submitted after expiration of the period specified in 37 CFR 1.78(a)(2), and since the instant petition satisfies the conditions of 37 CFR 1.78(a)(3) for acceptance of an unintentionally delayed claim for priority under 35 USC § 120, the petition to accept an unintentionally delayed claim for priority of prior filed nonprovisional Application Nos. 09/488,339, filed January 20, 2000, and 09/551,716, filed April 18, 2000, is granted as of the date of filing of the petition.

Any inquiries concerning this decision may be directed to the undersigned at 703-305-8680.

This application is being forwarded to the Office of Initial Patent Examination Division (OIPE) to await a reply to the Notice to File Missing Parts mailed September 17, 2001, or, if filed, to associate the reply with the file. After association of the reply to the Notice of September 17, 2001 with the file, OIPE will mail out a corrected filing receipt with the corrected continuity data and a projected publication date. Thereafter, the application will be forwarded to Technology Center AU 2818 for processing the ADS filed January 23, 2002 and for consideration by the examiner of the claim under 35 U.S.C. §120 and 37 CFR 1.78(a)(3) for the benefit of prior filed nonprovisional Application Nos. 09/488,339 and 09,551,716, filed January 20, 2000 and April 18, 2000, respectively.

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

ROSS SPENCER GARSSON
WINSTEAD SECHREST & MINICK P.C.
P. O. BOX 50784
DALLAS, TX 75201

COPY MAILED

NOV 29 2006

OFFICE OF PETITIONS

In re Application of :
James M. Tour, et al. :
Application No. 09/912,923 :
Filed: July 25, 2001 :
Attorney Docket No. 1789-05303 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(b), filed June 7, 2006, to revive the above-identified application.

The application became abandoned for failure to timely reply to a final Office action mailed November 17, 2004. A Notice of Abandonment was mailed on May 18, 2006. In response, on June 7, 2006, the present petition was filed.

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

The petition is **GRANTED**.

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

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

The application file is being forwarded to Technology Center AU 1631 for further processing of the request for continued examination under 37 CFR 1.114 filed June 7, 2006.

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
www.uspto.gov

Paper No.

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
Suite 3400
Four Embarcadero Center
San Francisco, CA 94111-4187

MAILED

APR 0 4 2005

Technology Center 2100

In re Application of:
Michael L. Wenocur
Application No. 09/912,936
Filed: July 25, 2001
For: SYSTEM AND METHOD FOR AUTHORIZATION OF ACCESS TO A RESOURCE

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request To Withdraw from Representation filed January 24, 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 signer of the petition, R. Michael Ananian is not appointed as an attorney or agent of record. Therefor he is not authorized to act on behalf of the attorneys or record, nor can he effect a change of address.

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

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

James R. Matthews

for Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

2 2 AUG 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thomas M. Risso
E I Du Pont De Nemours and Company
Legal Patent Records Center
1007 Market Street
Wilmington, DE 19898

In re Application of	:	
FAMODU, Omolayo O. et al.	:	
Application No.: 09/913,060	:	DECISION ON
PCT Application No.: PCT/US00/03513	:	
International Filing Date: 09 February 2000	:	PETITION
Priority Date: 10 February 1999	:	
Attorney Docket No.: BB-1321	:	UNDER 37 CFR 1.137(b)
For: UDP- GLUCOSE MODIFIERS	:	

This is a decision on applicants' "Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR §1.137(b)," filed in the United States Patent and Trademark Office on 21 May 2002.

BACKGROUND

On 09 February 2000, applicants filed international application PCT/US00/03513. A Demand for international preliminary examination was filed 30 August 2000. The thirty month period for entering the national stage in the United States expired at midnight on 10 August 2001.

On 08 August 2000, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the basic national fee.

On 20 September 2001, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that the surcharge for late filing of the oath or declaration and a computer readable format (CRF) of the sequence listing were required and a Notification To Comply With Requirements For Patent Application Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures (Form PCT/DO/EO/920) indicating that a CRF was required. The notification set a two month extendable period for reply.

On 04 January 2002, applicants submitted a response to the Notification of Missing Requirements including a CRF. The certificate of mailing under 37 CFR 1.8 listed the date of deposit as 15 November 2001.

On 18 March 2002, the Office mailed a Notification of a Defective Response (Form PCT/DO/EO/916) indicating that the CRF could not be read. The CRF Problem Report indicated that the CRF was damaged and indicated proper methods of delivering a substitute CRF. The Notification set a one month non-extendable time period for reply or the time remaining to respond to the Notification of Missing Requirements, whichever was longer.

On 21 May 2002, applicants submitted the instant petition to revive accompanied by a substitute CRF. This submission was directed to the 20231 ZIP code.

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) 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, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicants statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," satisfies 37 CFR 1.137(b)(3). The appropriate petition fee has been paid. A terminal disclaimer is not required as application was filed on or after 08 June 1995.

As to item (2), a proper reply is a substitute CRF. The CRF submitted with the instant petition was directed to the 20231 address. It is damaged. Applicants' attention is directed to the CRF Problem Report indicating proper methods for submitting a CRF so that it is not subjected to the treatment given to incoming mail. Kindly address the response to this petition to the address provided in the conclusion.

It is noted that both the Notification of Missing Requirements and the Notification of a Defective Response indicated that the surcharge for late filing of the oath or declaration was due. The declaration was submitted prior to thirty months, no surcharge is due.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **DISMISSED** without prejudice

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)."

The application remains **ABANDONED**.

Any further correspondence with respect to this matter should be addressed to the **U.S. Patent and Trademark Office; Box PCT; P.O. Box 2327; Arlington, VA 22202**, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459

2.2 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Thomas M. Risso
E I Du Pont De Nemours and Company
Legal Patent Records Center
1007 Market Street
Wilmington, DE 19898

In re Application of	:	
FAMODU, Omolayo O. et al.	:	
Application No.: 09/913,060	:	DECISION ON
PCT Application No.: PCT/US00/03513	:	
International Filing Date: 09 February 2000	:	PETITION
Priority Date: 10 February 1999	:	
Attorney Docket No.: BB-1321	:	UNDER 37 CFR 1.137(b)
For: UDP- GLUCOSE MODIFIERS	:	

This is a decision on applicants' "Reply to Decision on Petition For Revival of an Application For Patent Abandoned Unintentionally Under 37 CFR §1.137(b)," filed in the United States Patent and Trademark Office on 17 September 2002.

Applicants state that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as required by 37 CFR 1.137(b)(3). The proper reply, a substitute computer readable format, has been submitted. The appropriate petition fee has been paid. A terminal disclaimer is not required as application was filed on or after 08 June 1995.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continued processing in accordance with this decision. The application has a date of 09 February 2000 under 35 U.S.C. §363 and a date of 08 August 2001 under 35 U.S.C. §371.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

SPE: VU

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 09/913,062

Paper No.: _____

DATE : 11/1/05

TO SPE OF : ART UNIT 2612

SUBJECT : Request for Certificate of Correction on Patent No.: 6906747

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

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

Lamonte M. Newsome

Thank You For Your Assistance

Certificates of Correction Branch
Tel. No. 703-305-8309

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

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

Comments:

C. of C approved.

DAVID OMETZ
SUPERVISORY PATENT EXAMINER

SPE

2622

Art Unit

PTOL-306 (REV. 7/03) U.S. DEPARTMENT OF COMMERCE Patent and Trademark Office

SPE: VU

SPE RESPONSE FOR CERTIFICATE OF CORRECTION 09/913,062

Paper No.: _____

DATE : 11/1/05

TO SPE OF : ART UNIT 2612

SUBJECT : Request for Certificate of Correction on Patent No.: 6906747

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

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

Thank You For Your Assistance

Lamonte M. Newsome
Certificates of Correction Branch
Tel. No. 703-305-8309

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

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

Comments:

SPE

2622
Art Unit

DAVID OMETZ
SUPERVISORY PATENT EXAMINER

21 JUN 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

#5

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

Fish & Richardson PC
45 Rockefeller Plaza, Suite 2800
New York, NY 10111

In re Application of	:	
HAMMOND, Geoffrey Robert, et al.	:	
Application No.: 09/913,130	:	DECISION ON
PCT No.: PCT/GB00/00466	:	
Int. Filing Date: 14 February 2000	:	PETITION UNDER
Priority Date: 16 February 1999	:	
Attorney Docket No.: 08291-7060001	:	37 CFR 1.47(a)
For: TOILET BOWL DISPENSER	:	
APPARATUS	:	

This is a decision on applicants' "Petition Under 37 C.F.R. §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 19 December 2001.

BACKGROUND

On 14 February 2000, applicants filed international application PCT/GB00/00466, which claimed a priority date of 16 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 24 August 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 07 September 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 August 2001.

On 09 August 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 11 September 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 24 April 2002, applicants submitted the instant petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a petition for a four-month extension of time; the fee for a four-month extension of time; a declaration of inventorship executed by Geoffrey Robert Hammond; a statement of facts from Amanda J. Wilde; and copies of letters, emails and file notes.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the

application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1), (3) and (4) have been met. (1) The petition fee of $130 has been paid. (3) The last known address of non-signing inventor Yannic Hermouet is 3, Allée des Enables; 78480 Verneuil sur Seine; France. (4) The declaration complies with 37 CFR 1.47(a). However, it is noted that the second page of the declaration indicates it is page 2 of 3. This indication notwithstanding, it is presumed that the two page declaration is the entire declaration. If this understanding is incorrect, applicants must notify the office immediately and supply either the missing page of the declaration or a new oath or declaration in compliance with 37 CFR 1.47 and 37 CFR 1.497.

Item (2) has not been met. Applicants are asserting that the nonsigning inventor cannot be reached after diligent effort.

Under 37 CFR 1.47(a), the petition must supply proof of pertinent facts. The statement should outline what steps, *e.g.*, internet searches, postal inquiries, *etc.*, were taken to locate the inventor beyond contacting the human resources department. MPEP §409.03(d)

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

2 0 FEB 2003

#2

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Fish & Richardson PC
45 Rockefeller Plaza, Suite 2800
New York, NY 10111

In re Application of	:	
HAMMOND, Geoffrey Robert, et al.	:	
Application No.: 09/913,130	:	DECISION ON
PCT No.: PCT/GB00/00466	:	
Int. Filing Date: 14 February 2000	:	PETITION UNDER
Priority Date: 16 February 1999	:	
Attorney Docket No.: 08291-7060001	:	37 CFR 1.47(a)
For: TOILET BOWL DISPENSER	:	
APPARATUS	:	

This is a decision on applicants' "Renewed Petition Under 37 C.F.R. §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 26 December 2002.

BACKGROUND

On 14 February 2000, applicants filed international application PCT/GB00/00466, which claimed a priority date of 16 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 24 August 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 07 September 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 August 2001.

On 09 August 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 11 September 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 24 April 2002, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a petition for a four-month extension of time; the fee for a four-month extension of time; a declaration of inventorship executed by Geoffrey Robert Hammond; a statement of facts from Amanda J. Wilde; and copies of letters, emails and file notes.

On 21 June 2002, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 26 December 2002, applicants submitted Renewed Petition Under 37 CFR §1.47(a), accompanied by a petition for a four month extension of time and the fee for a four month extension of time.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1), (3) and (4) were previously met. The last known address of non-signing inventor Yannic Hermouet is now 34 rue Aydes; 45770 Saran; France. Additionally, applicants have indicated that notwithstanding the numbering of the second page of the declaration, the two page declaration is the entire declaration.

Item (2) has not been met. The petition must supply proof that applicant refused to sign after being presented with the application papers (specification, including claims, drawings, and oath or declaration). MPEP §409.03(d). Applicants supplied only the declaration and assignment to the nonsigning inventor. Documentary evidence of the presentation with a full copy of the application papers and subsequent refusal must be furnished.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

14 MAY 2004

#9

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Fish & Richardson PC
45 Rockefeller Plaza, Suite 2800
New York, NY 10111

In re Application of	:	
HAMMOND, Geoffrey Robert, et al.	:	
Application No.: 09/913,130	:	DECISION ON
PCT No.: PCT/GB00/00466	:	
Int. Filing Date: 14 February 2000	:	PETITION UNDER
Priority Date: 16 February 1999	:	
Attorney Docket No.: 08291-7060001	:	37 CFR 1.47(a)
For: TOILET BOWL DISPENSER	:	
APPARATUS	:	

This is a decision on applicants' "Renewed Petition Under 37 CFR §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 05 May 2003.

BACKGROUND

On 14 February 2000, applicants filed international application PCT/GB00/00466, which claimed a priority date of 16 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 24 August 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 07 September 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 August 2001.

On 09 August 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 11 September 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 24 April 2002, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a petition for a four-month extension of time; the fee for a four-month extension of time; a declaration of inventorship executed by Geoffrey Robert Hammond; a statement of facts from Amanda J. Wilde; and copies of letters, emails and file notes.

On 21 June 2002, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 26 December 2002, applicants submitted Renewed Petition Under 37 CFR §1.47(a), accompanied by a petition for a four month extension of time and the fee for a four month extension of time.

On 20 February 2003, the Office mailed Decision on Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 05 May 2003, applicants submitted a second renewed petition, accompanied by the fee for a one month extension of time.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1), (3) and (4) were previously met.

Item (2) has not been met. The petition must supply proof that applicant refused to sign after being presented with the application papers (specification, including claims, drawings, and oath or declaration). MPEP §409.03(d). Applicants sent the application papers to the last known address of the nonsigning inventor. However, the papers were signed for by someone named "Fauvet". Applicant must explain why applicant believes that the last known address of the nonsigning inventor remains his current address. Documentary evidence should be submitted.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

23 SEP 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

Fish & Richardson PC
225 Franklin Street
Boston, MA 02110

In re Application of HAMMOND, Geoffrey Robert, et al. Application No.: 09/913,130 PCT No.: PCT/GB00/00466 Int. Filing Date: 14 February 2000 Priority Date: 16 February 1999 Attorney Docket No.: 08291-706001 For: TOILET BOWL DISPENSER APPARATUS	DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Renewed Petition Under 37 CFR §1.47(a)" filed in the United States Patent and Trademark Office (USPTO) on 11 June 2004.

BACKGROUND

On 14 February 2000, applicants filed international application PCT/GB00/00466, which claimed a priority date of 16 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 24 August 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 07 September 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 August 2001.

On 09 August 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 11 September 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of the oath or declaration were required.

On 24 April 2002, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a petition for a four-month extension of time; the fee for a four-month extension of time; a declaration of inventorship executed by Geoffrey Robert Hammond; a statement of facts from Amanda J. Wilde; and copies of letters, emails and file notes.

On 21 June 2002, the Office mailed Decision On Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 26 December 2002, applicants submitted Renewed Petition Under 37 CFR §1.47(a), accompanied by a petition for a four month extension of time and the fee for a four month extension of time.

On 20 February 2003, the Office mailed Decision on Petition Under 37 CFR 1.47(a), dismissing applicants' petition without prejudice.

On 05 May 2003, applicants submitted a second renewed petition, accompanied by the fee for a one month extension of time.

On 14 May 2004, the Office mailed Decision On Petition Under 37 CFR 1.47(a) dismissing applicants' petition without prejudice.

On 11 June 2004, applicants submitted this instant renewed petition.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1), (3) and (4) were previously met.

Item (2) has now been satisfied. Mr. Rabin declares that he spoke with Mr. Hermouet and that he acknowledged receiving the application papers and declaration, but was unwilling to sign them.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including accordation of a 35 U.S.C. §§371(c)(1), (c)(2) and (c)(4) date of **24 April 2002**.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

23 SEP 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

Yannic Hermouet
34 rue Aydes
45770 Saran
France

In re Application of
HAMMOND, Geoffrey Robert, et al.
Application No.: 09/913,130
PCT No.: PCT/GB00/00466
Int. Filing Date: 14 February 2000
Priority Date: 16 February 1999
Attorney Docket No.: 08291-706001
For: TOILET BOWL DISPENSER APPARATUS

Dear Mr. Hermouet:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

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

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

Fish & Richardson PC
225 Franklin Street
Boston, MA 02110

SPE: G. Benzion

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9/1/06

TO SPE OF : ART UNIT 1637

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/913,171 Patent No.: 7008768

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: _____

SPE 1637 Art Unit

NOV 0 8 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

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

BOYLE FREDRICKSON NEWHOLM STEIN & GRATZ
250 PLAZA, SUITE 1030
250 E. WISCONSIN AVENUE
MILWAUKEE, WI 53202

In re Application of Peter JORDAN, Franz BEIERLEIN, and Johann SCHINDLBECK Application No. 09/913,216 PCT No.: PCT/EP00/03138 Int. Filing Date: 07 April 2000 Priority Date: 12 April 1999 Attorney Docket No.: 72.050 For: INTERNAL VIBRATION DEVICE WITH VARIABLE VIBRATION AMPLITUDE	DECISION REGARDING SUBMISSION UNDER 37 CFR 1.42

This decision is in response to applicants' submission of a declaration with the signature of an administratortrix on behalf of a deceased inventor.

BACKGROUND

On 07 April 2000, applicants filed international application PCT/EP00/03138, which claimed a priority date of 12 April 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 19 October 2000. A Demand electing the United States was filed 07 July 2000. Accordingly, the thirty-month period for complying with the requirements for entry into the national stage expired at midnight on 12 October 2001.

On 10 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, an express request pursuant to 35 U.S.C. 371(f) to begin the national stage examination procedures at any time rather than delay; the basic national fee as required by 35 U.S.C. 371(c)(1); an English translation of the international application as required by 35 U.S.C. 371(c)(2); and an executed declaration as required by 35 U.S.C. 371(c)(4).

The declaration submitted states that joint inventor Peter Jordan is deceased, and is executed by joint inventors Beierlein and Schindlbeck, as well as, by Christina Jordan on behalf of inventor Jordan as administratortrix. Accompanying this declaration is a Certificate from the Federal Republic of Germany District Court offered to show the administratortrix's authority to sign on behalf of the deceased inventor. Acceptance of this declaration is being considered under §§1.42 and 1.497.

DISCUSSION

37 C.F.R. §1.42, provides that:

> In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, ... obtain the patent.

37 C.F.R. §1.497(b)(2), as amended effective September 8, 2000, provides that:

> If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§1.42, 1.43, or §1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative.

Former §1.44 required that proof of the authority of legal representative be submitted. Effective September 8, 2000[1], §1.44 was removed and reserved. The requirement to submit proof of legal authority was thereby, eliminated. Thus, the signature and accompanying identification of Christina Jordan as administratortrix is sufficient to establish that she may make application on behalf of the deceased inventor. Moreover, the declaration includes the citizenship, residence and mailing address of Ms. Jordan as required.

However, the declaration fails to recite the citizenship, residence and mailing address information for inventor Jordan. These are facts which the inventor would have been required to state. Accordingly, the declaration is not in compliance with §1.497. A declaration including this information as inventor Jordan would have stated it is required.

CONCLUSION

In view thereof, the declaration is not accepted under 37 CFR §§1.42 and 1.497. The request to accept this submission is **DISMISSED** without prejudice.

---

[1] *Changes to Implement Patent Business Goals: Final Rule,* 65 FR 54604, 54618 (September 8, 2000).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C., 20231, with the contents of this letter marked to the attention of the PCT Legal Office.

Nancy Johnson
Petitions Attorney
PCT Legal Office

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 305-0309
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

02 OCT 2002

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

Boyle Frederickson Newholm
Stein & Gratz
250 Plaza, Suite 1030
250 E. Wisconsin Avenue
Milwaukee, WI 53202

In re Application of Jordan et al. Application No. 09/913,216 PCT No.: PCT/EP00/03138 Priority Date: 07 April 2000 Int. Filing Date: 12 April 1999 Atty. Docket No.: 72.050 For: Internal Vibration Device With Variable Vibration Amplitude	DECISION ON PAPERS UNDER 37 CFR 1.42

This is a decision on the "Request For Reconsideration Of Decision Dismissing Petition" filed on 28 January 2002.

DISCUSSION

Review of the declaration filed on 28 January 2002 reveals that it was properly executed on behalf deceased joint inventor Peter Jordan by Christina Jordan, acting in the capacity of legal representative for Peter Jordan in accordance with 37 CFR 1.42. As such, the declaration is proper.

DECISION

The request under 37 CFR 1.42 is **GRANTED**.

This application is being forwarded to the National Stage Processing Branch for further processing. The date of this application under 35 U.S.C. 371 is **28 January 2002**.

Leonard E. Smith
for Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

02 OCT 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Davis J. Levy
GlaxoSmithKline Corp. Intellectual Prop. Dept.
Five Moore Drive
PO Box 13398
Research Triangle Park, NC 27709

RECEIVED
APR 26 2004
TECH CENTER 1600/2900

In re Application of
DALUGE et al
U.S. App. No.: 09/913,226
PCT No.: PCT/EP00/01045
Int. Filing Date: 10 Feb. 2000
Priority Date: 12 Feb. 1999
Attorney's Docket No.: PU3579 USW
For: PHOSPHORAMIDATE, AND MONO-DI...

DECISION ON PETITION UNDER 37 CFR 1.181

This is in response to the communication filed 18 August 2003 requesting that the copy of the "PCT Response to Notification of Missing Requirements" attached thereto be treated as filed on 26 October 2001. The communication has been treated as a petition under 37 CFR 1.181.

BACKGROUND

On 10 August 2001, applicants filed in the United States Patent and Trademark Office (USPTO), *inter alia,* a Transmittal Letter (Form PTO-1390) requesting entry of the above-identified application into the national stage and the full U.S. basic national fee.

On 15 October 2001, a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905) was mailed to applicant requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b), surcharge fee under 1.492(e), and a sequence listing in computer readable form.

On 18 August 2003, applicants filed the petition considered herein. The petition is accompanied by a postcard receipt and a copy of a purported response filed 26 October 2001.

DISCUSSION

MPEP 503 provides:

> A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

The copy of the postcard receipt accompanying the present petition has been stamped by the USPTO with a 26 October 2001 receipt date. However, only a portion of the postcard has been submitted. It is not clear that the postcard relates to the present application, or if it has been annoted by the USPTO to indicate that any item was missing. Applicants are required to submit a copy of the complete post in response to this decision.

Application no. 09/913226

CONCLUSION

For reasons above, the petition under 1.181 is **DISMISSED**, without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.181." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Boris Milef
Legal Examiner
PCT Legal Office

Telephone: (703) 308-3659
Facsimile: (703) 308-6459

25 FEB 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

Davis J. Levy
GlaxoSmithKline Corp. Intellectual Prop. Dept.
Five Moore Drive
PO Box 13398
Research Triangle Park, NC 27709

In re Application of DALUGE et al U.S. App. No.: 09/913,226 PCT No.: PCT/EP00/01045 Int. Filing Date: 10 Feb. 2000 Priority Date: 12 Feb. 1999 Attorney's Docket No.: PU3579 USW For: PHOSPHORAMIDATE, AND MONO-DI...	DECISION ON RENEWED PETITION UNDER 37 CFR 1.181

This is in response to the "Renewed Petition Under 37 CFR 1.181" filed 12 December 2003.

BACKGROUND

On 10 August 2001, applicants filed in the United States Patent and Trademark Office (USPTO), *inter alia,* a Transmittal Letter (Form PTO-1390) requesting entry of the above-identified application into the national stage and the full U.S. basic national fee.

On 15 October 2001, a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905) was mailed to applicant requiring an oath or declaration in compliance with 37 CFR 1.497(a)-(b), surcharge fee under 1.492(e), and a sequence listing in computer readable form.

On 18 August 2003, applicants filed a petition alleging that a timely reply to the Notification of Missing Requirments was filed on 26 October 2001. The petition was accompanied by a copy of a stamped postcard receipt.

On 02 October 2003, the petition was dismissed on the basis that a copy of the complete postcard receipt was not provided.

DISCUSSION

MPEP 503 provides:

> A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

The copy of the postcard receipt accompanying the present petition has been stamped by the USPTO with a 26 October 2001 receipt date. For reasons stated in the renewed petition, the postcard sufficiently identifies the instant application, and, on the basis of the totallity of the evidence submitted, indicates receipt of the executed declaration on that date. Petitioners have submitted a "copy of the declaration" previously filed. This is construed to mean that the copy of the declarations executed by the two named inventors that accompany the instant petition are true copies of the declarations filed 26 October 2001. If this is incorrect,

Application no. 09/913226

petitioners **must immediately notify this office**.

CONCLUSION

For reasons above, the renewed petition under 1.181 is **GRANTED**. The holding of abandonment is **VACATED**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing, including according the application a 35 U.S.C. 371(c)(1), (2) and (4) date of **26 October 2001.**

Boris Milef
Legal Examiner
PCT Legal Office

Telephone: (703) 308-3659
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MATTHEWS COLLINS SHEPARD & MCKAY PA
100 THANET CIRCLE
SUITE 306
PRINCETON NJ 08540

COPY MAILED

MAR 1 0 2005

OFFICE OF PETITIONS

In re Application of		
Daluge, et al.	:	
Application No. 09/913,226	:	DECISION ON
Filed: October 26, 2001	:	PETITION
Attorney Docket No. 1493-139 US	:	

This is in response to the petition to revive under 37 CFR 1.137(a), filed February 25, 2005.

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

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)". Extensions of time under 37 CFR 1.136(a) are permitted.

The above-identified application became abandoned for failure to timely file a reply to the non-final Office action mailed May 4, 2004. This Office action set a shortened statutory period for reply of three months. No extensions of time under 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 4, 2004. A Notice of Abandonment was mailed on December 27, 2004.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the reply required to the outstanding Office action or notice, unless previously filed; (2) the petition fee set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable

petition pursuant to this paragraph was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(d). The instant petition lacks item (3).

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."[1]

Moreover, delay resulting from the lack of knowledge or improper application of the patent statutes, rules of practice or the Manual of Patent Examining Procedure, however, does not constitute "unavoidable" delay.[2]

Where an application becomes abandoned as a consequence of a change of correspondence address (the Office action being mailed to the old, uncorrected address and failing to reach the applicant in sufficient time to permit a timely reply), an adequate showing of "unavoidable" delay will require a showing that due care was taken to adhere to the requirement for prompt notification in each concerned application of the change of address, and must include an adequate showing that a **timely notification of the change of address was filed** in the application concerned, and in a manner reasonably calculated to call attention to the fact that it was a notification of change of address.[3]

A proper power of attorney was not filed until **August 16, 2004.** This power of attorney was accepted in a paper mailed on September 1, 2004.

A review of the non-final Office action mailed May 4, 2004 reveals that it was properly mailed to the correspondence address of record at that time. Petitioner has not submitted evidence showing that he timely filed a change of correspondence address or power of attorney with the Office. Nor has petitioner demonstrated that the non-final Office action was not received by the prior attorneys of record. Petitioner merely states that the newly appointed attorneys were not supplied with the Office action "for reasons unknown".

---

[1] In re Mattulath, 38 App. D.C. 497, 514-15 (1912)(*quoting* Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 U.S.P.Q. 666, 167-68 (D.D.C. 1963), aff'd, 143 U.S.P.Q. 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913).

[2] See Haines, 673 F. Supp. at 317, 5 U.S.P.Q. 2d at 1132; Vincent v. Mossinghoff, 230 U.S.P.Q. 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 U.S.P.Q. 1091 (D.D.C. 1981); Potter v. Dann, 201 U.S.P.Q. 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

[3] See MPEP 601.01; See also Ray. v. Lehman, 55 F.3d 606, 34 U.S.P.Q. 2d 1786 (CAFC 1995).

Accordingly, the entire period of delay in the above-identified application can not be characterized as "unavoidable".

While the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable, petitioner is **not** precluded from obtaining relief by filing a request for reconsideration pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in 37 CFR 1.17(m); (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and (4) Any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to paragraph (d) of this section.

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

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

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

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

Cliff Congo
Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

MATTHEWS COLLINS SHEPARD & MCKAY PA
100 THANET CIRCLE
SUITE 306
PRINCETON NJ 08540

COPY MAILED

APR 18 2005

OFFICE OF PETITIONS

In re Application of		
Daluge, et al.	:	
Application No. 09/913,226	:	DECISION ON
Filed: October 26, 2001	:	PETITION
Attorney Docket No. 1493-139 US	:	

This is in response to the petition to revive under 37 CFR 1.137(b), filed April 7, 2005.

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

The above-identified application became abandoned for failure to timely file a reply to the non-final Office action mailed May 4, 2004. This Office action set a shortened statutory period for reply of three months. No extensions of time under 37 CFR 1.136(a) were obtained. Accordingly, the above-identified application became abandoned on August 4, 2004. A Notice of Abandonment was mailed on December 27, 2004. Applicants filed a petition to revive under 37 CFR 1.137(a) on February 25, 2005. However, the petition was dismissed in a decision mailed on March 10, 2005.

With the instant petition, applicants paid the petition fee and made the proper statement of unintentional delay. The required reply in the form of an amendment was previously filed on February 25, 2005.

The application file is being forwarded to Group Art Unit 1624 for consideration of the amendment filed February 25, 2005.

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

Cliff Congo
Petitions Attorney
Office of Petitions

MAR 2 8 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Robin W. Asher
Clark Hill
500 Woodward Avenue
Suite 3500
Detroit, MI 48226-3435

In re Application of FOLINO et al.	:
Application No.: 09/913,233	:
PCT No.: PCT/CA00/00128	:
Int. Filing: 10 February 2000	:
Priority Date: 10 February 1999	: DECISION ON PETITION
Attorney Docket No.: 19345-087835	: UNDER 37 CFR 1.47(a)
For: GASKET INSTALLATION APPARATUS	:
	:

This is a decision on applicant's petition under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 27 November 2001.

BACKGROUND

On 10 February 2000, applicant filed international application No. PCT//CA00/00128 which claimed priority of an earlier U.S. application filed 10 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 17 August 2000.

On 31 August 2000, a Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 10 August 2001.

On 10 August 2001, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 27 September 2001, a Notification of Missing Requirements (FORM

PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration along with a surcharge for filing the oath or declaration after the thirty month period was required.

On 27 November 2001, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Salvatore J. Folino, on the grounds that the nonsigning inventor refused to execute the declaration. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicant, Peter Vert and Cecil Beauman on behalf of Salvatore J. Folino and a statement of facts under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Item (1) is satisfied with the payment of the $130 petition fee. Item (3) is satisfied with the statement of the last known address of non-signing inventor, Salvatore J. Folino. With regard to item (4), the declaration was executed by the available joint inventors on their behalf and on behalf of the non-signing inventor and satisfies the requirements of 37 CFR 1.47(a).

With respect to item (2), applicant must demonstrate that Salvatore J. Folino has refused to sign the declaration by conduct constituting a refusal to sign the declaration for the above referenced application..

Inventor's Refusal to Sign

Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal, states, in part:....

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney....
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the

> person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Here, Petitioner submitted a statement of facts in the form of a petition under 37 CFR 1.47(a) signed by U.S. patent agent, David J. Simonelli, dated 27 November 2001. The statement indicates that a letter was mailed to Mr. Folino on September 25, 2001 at his last known residence, with no response. A copy of the letter, which was attached to the petition, indicated that the "U.S. declaration and Power of Attorney document together with a copy of the application as filed" was sent to Mr. Folino's home address by Jeffrey T. Imai, Chief Patent Counsel at Magna International Inc. (parent corporation to applicant Tesma International, Inc.). A first hand statement from Mr. Imai was not provided. Accordingly, such allegation constitutes hearsay. Moreover, evidence that such letter was received by Mr. Folino has not been provided. For these reasons, petitioner has presented insufficient evidence to conclude that applicant/inventor Salvatore J. Folino has refused to sign the application.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Boris Milef
Legal Examiner
PCT Legal Office

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK/BM:cmk

Telephone: (703) 306-5467

29 JUL 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Robin W. Asher
Clark Hill
500 Woodward Avenue
Suite 3500
Detroit, MI 48226-3435

In re Application of FOLINO et al.	:
Application No.: 09/913,233	: DECISION ON
PCT No.: PCT/CA00/00128	:
Int. Filing: 10 February 2000	: RENEWED PETITION
Priority Date: 10 February 1999	:
Attorney Docket No.: 19345-087835	: UNDER 37 CFR 1.47(a)
For: GASKET INSTALLATION APPARATUS	:

This is a decision on applicant's Renewed Petition Under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 31 March 2003.

BACKGROUND

On 27 September 2001, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration along with a surcharge for filing the oath or declaration after the thirty month period was required.

On 27 November 2001, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Salvatore J. Folino, on the grounds that the nonsigning inventor refused to execute the declaration. Subsequently on 28 March 2002, a decision was mailed to applicants dismissing the petition on the grounds that petitioner had not presented sufficient evidence to conclude that applicant/inventor Salvatore J. Folino refused to sign the application.

On 28 August 2002, applicant filed a request for reconsideration of the petition, which was dismissed on the grounds that ample time had not passed to allow Mr. Folino to respond to the request for his signature or to imply his refusal to sign.

On 31 March 2003, applicant filed the instant renewed petition under 37 CFR 1.47(a) along with a declaration executed by the previously non-signing inventor Folino. A review of the declaration reveals that it is in compliance with37 CFR 1.497 and is accepted. With the submission of the executed declaration, applicant's renewed petition under 37 CFR 1.47(a) is moot.

CONCLUSION

The renewed petition under 37 CFR §1.47(a) is **MOOT**. The declaration submitted on

31 March 2003 meets the requirements of 37 CFR 1.497 and is acceptable.

This application will be forwarded to the United States Designated/Elected Office for further processing. The 35 U.S.C. 371 date is **31 March 2003.**

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

30 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Robin W. Asher
Clark Hill
500 Woodward Avenue
Suite 3500
Detroit, MI 48226-3435

In re Application of FOLINO et al.	:
Application No.: 09/913,233	: DECISION ON PETITION
PCT No.: PCT/CA00/00128	:
Int. Filing: 10 February 2000	: FOR RECONSIDERATION
Priority Date: 10 February 1999	:
Attorney Docket No.: 19345-087835	: UNDER 37 CFR 1.47(a)
For: GASKET INSTALLATION APPARATUS	:
	:

This is a decision on applicant's petition for reconsideration under 37 CFR 1.47(a) filed in the United States Patent and Trademark Office (USPTO) on 28 August 2002. Petitioner's request for a three month extension of time is granted.

BACKGROUND

On 27 September 2001, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating that an oath or declaration along with a surcharge for filing the oath or declaration after the thirty month period was required.

On 27 November 2001, in response to the Notification of Missing Requirements, applicant filed a petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4). The petition requested the acceptance of the application without the signature of inventor, Salvatore J. Folino, on the grounds that the nonsigning inventor refused to execute the declaration. The petition included the requisite petition fee, a declaration signed by the 37 CFR 1.47(a) applicant, Peter Vert and Cecil Beauman on behalf of Salvatore J. Folino and a statement of facts under 37 CFR 1.47(a).

On 28 March 2002, a decision was mailed to applicants dismissing the petition on the grounds that petitioner had not presented sufficient evidence to conclude that applicant/inventor Salvatore J. Folino refused to sign the application.

On 28 August 2002, applicant filed the instant request for reconsideration of the petition accompanied by the declarations of Jeffrey T. Imai, Chief Patent Counsel for Magna International (parent company of Tesma International, Inc.) and Jo-Ann Percy, assistant to Mr. Imai.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

Applicants have previously satisfied Items (1), (3) and (4) above.

With respect to item (2), applicant must demonstrate that Salvatore J. Folino has refused to sign the declaration by conduct constituting a refusal to sign the declaration for the above referenced application. Petitioner previously provided a copy of a letter mailed to Mr. Folino on September 25, 2001 at his last known residence, to which Mr. Folino did not respond. The letter indicated that the "U.S. declaration and Power of Attorney document together with a copy of the application as filed" were sent to Mr. Folino's home address by Jeffrey T. Imai.

Petitioner now submitted declarations of Mr. Imai and Ms. Percy having first-hand knowledge of Mr. Folino's refusal to sign the declaration. Mr. Imai attested to the mailing of the 25 September 2001 letter to Mr. Folino's home address and Mr. Folino's lack of response to the letter or return of the executed Declaration/Power of Attorney.

Further evidence is provided by Ms. Percy's declaration which states that Mr. Folino did not respond to the 25 September 2001 letter or execute and return the Declaration/Power of Attorney. Ms. Percy states that she periodically contacted Mr. Folino via telephone requesting that he execute the Declaration/Power of Attorney, however, Ms. Percy does not detail these attempts.

On 27 August 2002 Ms. Percy again sent Mr. Folino a copy of the application and Declaration/Power of Attorney via e-mail. Ms. Percy states that she has "talked with Mr. Folino on several occasions. Mr. Folino initially stated that he had signed the Declaration/Power of Attorney and faxed a copy" to Magna. However, Ms. Percy states that there is no record of such transmission or receipt of the executed Declaration.

On the same day as her e-mail, 27 August 2002, Ms. Percy again spoke directly to Mr. Folino, "wherein he stated that he would not sign the Declaration/Power of Attorney until he had his lawyer review the Assignment." Ms. Percy concluded that Mr. Folino has refused to sign the Declaration/Power of Attorney. Petitioner filed his request for reconsideration on 28 August 2002.

In light of Mr. Folino's response that "he would not sign the Declaration/Power of Attorney until he had his lawyer review the Assignment", and that sufficient time had not passed (from the telephone contact on 27 August 2002 to the filing of this petition on 28 August 2002) to allow Mr. Folino to consult with his lawyer, Petitioner has not allowed ample time for Mr. Folino to respond to the request for his signature or to imply his refusal to sign. Thus, Petitioner has not presented insufficient evidence to conclude that applicant/inventor Salvatore J. Folino has refused to sign the application. Petitioner's request for reconsideration is dismissed.

CONCLUSION

The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT Legal, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (703) 306-5467

CMK:cmk

1 8 MAR 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Richard L. Mayer
KENYON & KENYON
One Broadway
New York, New York 10004-1050

In re Application of	:	
Markus KLAUSNER	:	
Application No.: 09/913,239	:	DECISION ON
PCT No.: PCT/DE00/03778	:	PETITION
Int. Filing Date: 26 October 2000	:	UNDER 37 CFR 1.181
Priority Date: 09 December 1999	:	
Attorney Docket No.: 10191/1956	:	
For: A METHOD FOR DETECTING ERRORS	:	
IN A MOTOR VEHICLE	:	

The "PETITION TO WITHDRAW HOLDING OF ABANDONMENT" filed 29 July 2002 is being treated as a petition under 37 C.F.R. 1.181 to withdraw the Notification of Abandonment (Form PCT/DO/EO/909) mailed 02 July 2002 and is **GRANTED** as follows:

On 09 May 2002, applicant timely completed all the requirements of 35 U.S.C. 371 for entry into the national stage with the submission of the declaration of the inventor in compliance with 37 CFR 1.497. Accordingly, the Notification of Abandonment of 02 July 2002 was mailed in error and is hereby VACATED.

Applicant's claim for priority is acknowledged. This application has an international filing date of **26 October 2000** under 35 U.S.C. 363 and a date of **09 May 2002** under 35 U.S.C. 371(c).

The application is being returned to the United States Designated/Elected Office for issuance of a Notification of Acceptance (Form PCT/DO/EO/903) and for preparation and mailing of a filing receipt.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

NNH/LES:hn

Tel: (703) 308-6508

UNITED STATES PATENT AND TRADEMARK OFFICE

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

JAN 03 2002

Benoît Castel
Young & Thompson
745 South 23rd Street
2nd Floor
Arlington, VA 22202

In re Application of ZEITSCH, Karl J. Application No.: 09/913,280 PCT No.: PCT/ZA00/00024 Int. Filing Date: 11 February 2000 Priority Date: 11 February 1999 Attorney's Docket No.: 251713 For: PROCESS FOR THE MANUFACTURE OF FURFURAL	DECISION ON PAPERS UNDER 37 CFR 1.42

This is a decision on the declaration submitted on 27 November 2001. A review of the Declaration reveals an indication that the sole inventor Karl J. Zeitsch is deceased. Applicant's submission taken together with the indication that sole inventor Zeitsch is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 11 February 2000, applicant filed international application PCT/ZA00/00024, which claimed a priority date of 11 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 August 2000.

On 13 August 2001, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 11 October 2001, the Office mailed a "Notification of Missing Requirements Under 35 U.S.C. 371 In the United States Designated/Elected Office," (Form PCT/DO/EO/905) noting, *inter alia*, that an oath or declaration of the inventors complying with 37 CFR 1.497(a)-(b) was required.

On 27 November 2001, applicant filed a declaration executed by Mr. Philipp D.P. Steiner, who was "authorized by Hanna TEPOHL, the executor of deceased inventor Karl J. Zeitsch, to execute the declaration."

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions

applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

In this case, applicant has provided a power of attorney stating that the executor is appointing a "legal representative" to act on behalf of the executor in matters regarding German Patent Application No. 199 05 655.2. The declaration of inventorship must be signed by the legal representative of the deceased inventor, in this case the executor, Mrs. Tepohl. It may not be signed by another appointed as agent for the legal representative on behalf of the legal representative. See MPEP 605.04(a). In the present case, Mr. Philipp D.P. Steiner is not the legal representative of the deceased inventor, but rather an agent for the heir. As such, execution of the declaration by Mr. Philipp D.P. Steiner is improper. The declaration must be executed by the executor of the estate, Mrs. Hanna Tepohl.

Further, under 37 CFR 1.497(b)(2), the declaration must include the residence, mailing address and citizenship of the person(s) signing on behalf of the deceased inventor and the information that the inventor would be required to state. It is noted that under the name of Karl J. Zeitsch, the residence is listed as Kwa Zulu Natal, South Africa, the postal address is Durban and the citizenship is listed as South Africa. However, the PCT application lists Mr. Zeitsch as a citizen of Germany with a residence and postal address in Köln (Cologne). Again, the declaration must provide the information for the legal representative (executor) and for the deceased inventor.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

APR 16 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Benoît Castel
Young & Thompson
745 South 23rd Street
2nd Floor
Arlington, VA 22202

In re Application of ZEITSCH, Karl J. Application No.: 09/913,280 PCT No.: PCT/ZA00/00024 Int. Filing Date: 11 February 2000 Priority Date: 11 February 1999 Attorney's Docket No.: 251713 For: PROCESS FOR THE MANUFACTURE OF FURFURAL	DECISION ON PAPERS UNDER 37 CFR 1.42

This is a decision on "Renewed Submission Under 37 CFR 1.42," filed on 04 March 2002.

BACKGROUND

On 11 February 2000, applicant filed international application PCT/ZA00/00024, which claimed a priority date of 11 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 17 August 2000.

On 13 August 2001, applicant filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 11 October 2001, the Office mailed a "Notification of Missing Requirements Under 35 U.S.C. 371 In the United States Designated/Elected Office," (Form PCT/DO/EO/905) noting, *inter alia*, that an oath or declaration of the inventors complying with 37 CFR 1.497(a)-(b) was required.

On 27 November 2001, applicant filed a declaration executed by Mr. Philipp D.P. Steiner, who was "authorized by Hanna TEPOHL, the executor of deceased inventor Karl J. Zeitsch, to execute the declaration."

On 03 January 2002, the Office mailed Decision On Papers Under 37 CFR 1.42, refusing the request for status under 37 CFR 1.42.

On 04 March 2002, applicant filed "Renewed Submission Under 37 CFR 1.42," accompanied by a new declaration.

DISCUSSION

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 CFR 1.42.

In this case, Hanna Tepohl signed the declaration as the legal representative of the deceased inventor, Karl J. Zeitsch. The Declaration lists the deceased inventor's citizenship, residence and postal address, and the legal representative's citizenship, residence and mailing address.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **GRANTED**.

This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing consistent with this decision. The application has an international filing date of 11 February 2000 under 35 U.S.C. §363 and a date of 04 March 2002 under 35 U.S.C. §371.

Richard Cole
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Date Mailed : 9-22-06

Patent No.: 6,711,594
Patent Issued : March 23, 2004
Inventor(s) : Yoshihiro Yano, et. al.
Title: DISTRIBUTED DATA ARCHIVE DEVICE AND 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 1.322.

The request for the printing of the PTA on front of the patent has been denied again. (See attached page.)

Eva James
For Cecelia B. Newman
Certificate of Correction Branch
(703) 308-9390 ext. 124 or ext. 102

William R. Evans
Larry & Parry LLP
26 West 61st Street
New York, New York 10023

ej

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Marina Larson & Associates, LLC
P.O. BOX 4928
DILLON CO 80435

COPY MAILED
NOV 25 2008

In re Application of	:
Gleave et al.	:
Application No. ~~09/613,325~~ **09/913,325**	: Decision on Petition for
International Filing Date: February 25, 2000	: Patent Term Adjustment
Attorney Docket No. UBC.P-020	:
For: TRPM-2 ANTISENSE THERAPY	:
	:

The above-identified application has been forwarded to the undersigned for consideration on a petition entitled "Petition For Correction To Patent Term Adjustment," received on April 24, 2008. In the alternative, the petition is being treated as a petition for corrected patent term extension under 37 CFR 1.701 and 37 CFR 1.181. See 35 U.S.C. § 154(b)[1] and 37 CFR § 1.701.

The petition under 37 CFR 1.705 is dismissed.

The petition under 37 CFR 1.181 is dismissed.

Petitioner notes that Notice of Allowance mailed was mailed on March 21, 2008, for the above-identified application and that the Determination of Patent Term Extension failed to properly calculate an extension. Petitioner states that it appears from the entries PAIR, it appears the calculation function failed to run because neither PTO delays (750 days), nor applicant delays (243 days) were calculated. Petitioner asserts that that the application is entitled to a patent term adjustment of 507 days under 35 U.S.C. § 154(b)(1)(B).

35 U.S.C. § 154(b)(as amended by the "Uruguay Round Agreements Act," enacted December 8, 1994, as part of Public Law 103-465) provides for patent term extension for appellate review, interference and secrecy order delays in applications filed on or after June 8, 1995 and before May 29, 2000.

[1] 35 U.S.C. § 154 was amended by the "American Inventors Protection Act of 1999," which was enacted on November 29, 1999 as part of Public Law 106-113 (Consolidated Appropriations Act for Fiscal Year 2000). Since this amendment is effective May 29, 2000 and applies to applications filed on or after that date, the prior patent term adjustment provisions of 35 U.S.C. § 154 continue to apply to the above-identified application.

35 U.S.C. § 154(b) (as amended by the "American Inventors Protection Act of 1999," enacted November 29, 1999, as part of Public Law 106-113) provides for patent term adjustment for these administrative delays and others in applications filed on or after May 29, 2000.

The above-identified application was filed on February 25, 2000, as the international filing date is the filing date of the application and August 10, 2001, is the date of national stage entry and completion of 35 U.S.C. 371(c)(1), (c)(2) an d(c)(4) requirements. See MPEP 1893.03(b) and Notice of Acceptance of Application under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495. Accordingly the application is entitled to patent term extension based upon the conditions in 35 U.S.C. § 154(b), in effect on June 8, 1995. The provisions of 35 U.S.C. § 154(b) in effect on May 29, 2000 do not apply, because the amended version of 35 U.S.C. § 154(b) only applies to applications filed on or after May 29, 2000, thus the petition under 37 CFR 1.705 is dismissed.

In the alternative, the application has been reviewed for patent term extension pursuant to 35 U.S.C. § 154(b), in effect on June 8, 1995. The application is not entitled to patent term extension under 37 CFR 1.701, as there was not a successful appeal, interference or a secrecy order. The Office has no authority to grant an extension of the term due to administrative delays except as authorized by 35 U.S.C. § 154. The petition is dismissed.

The rules and statutory provisions governing the operations of the U.S. Patent and Trademark Office require payment of a fee on filing each petition. *See* 35 U.S.C. § 41(a)(7). The required $200 fee for the request under 37 CFR 1.705(b) has been paid.

Telephone inquiries with regard to this communication should be directed to Mark O. Polutta at (571) 272-7709.

Mark O. Polutta
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

DATE : 82206 **Paper No.:** _____

TO SPE OF : ART UNIT 2851 - NGUYEN

SUBJECT : Request for Certificate of Correction on Patent No.: 6707529

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

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

Thank You For Your Assistance

ROCHAUN JOHNSON
Certificates of Correction Branch
Tel. No. 703-308-9390 EXT 119

REQUEST FOR CORRECTED PATENT

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:

HENRY HUNG NGUYEN
PRIMARY EXAMINER

~~SPE~~

2851
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

NIXON & VANDERHYE MPC
1100 NORTH GLEBE ROAD, 8TH FLOOR
ARLINGTON VA 22201-4714

COPY MAILED
MAY 25 2004
OFFICE OF PETITIONS

In re Application of :
Heikkila et al. :
Application No. 09/913,331 : ON PETITION
Filed: August 13, 2001 :
Attorney Docket No. 3952-36

This is a decision on the petition filed March 18, 2002, requesting under 37 CFR 1.59 that the USPTO expunge and correct assignment records, which is being treated as a petition under 37 CFR 1.183 that the USPTO waive the rules. The delay in treating the petition is sincerely regretted.

The petition is **dismissed.**

Petitioners seek extraordinary relief in that through error, an assignment intended for another unrelated application was submitted and recorded at the USPTO on October 11, 2001 at reel/frame 12259/659 against this application. Petitioners note that another assignment that was intended for this application was likewise submitted and recorded by the USPTO on October 11, 2001, at reel/frame 12368/669 against this application. As such, petitioners seek expungement of the incorrect assignment.

Initially, while petitioners seek an extraordinary remedy under 37 CFR 1.182 or 1.183, it is pointed out that the USPTO will not normally resort to an extraordinary remedy under 37 CFR 1.182 or 1.183 if the rules of practice and the procedures before the USPTO already provide an avenue for the requested relief. See Cantello v. Rasmussen, 220 USPQ 664, 664 (Comm'r Pats. 1982).

As background, the USPTO simply acts in a ministerial capacity in recording documents that have been submitted for recordation. See 35 U.S.C. § 261 and 37 CFR 3.11. However, the recording of a document pursuant to 37 CFR 3.11 is **not** a determination by the USPTO of the validity of the document *per se* or the effect that document has on the title to a patent or application. See 37 CFR 3.54. As such, it is not necessary, or desirable, for the USPTO to "void" or "expunge" the assignment of which petitioner complains. For example, an error(s) in a recorded assignment document is not corrected by "voiding" the previous document, but simply by recording a corrected document. See MPEP 323. Rather, as noted in MPEP 323, it is USPTO policy to maintain a complete history of claimed interests in a given property, and, as such, a recorded assignment

document will not be expunged, even if it is subsequently found to be invalid. In re Raney, 24 USPQ2d 1713 (Comm'r Pat. 1992).

Since, as here, applicants have recorded a correct assignment against this application, all that the records of the USPTO need show is that the assignment recorded against this application at reel/frame 12259/659 is a document submitted for recordation in error. Such alleged error may be corrected under the rules currently in effect by simply supplying a copy of this petition (or other document setting forth the same relevant facts) along with a recordation cover sheet and the $40 fee, and asking that Assignment Branch record the clarifying document against the above-identified application as an "other document" within the meaning of 37 CFR 3.11(a).

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

Brian Hearn

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

12 FEB 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

James W. Bailey
Birch, Stewart, Kolasch & Birch, LLP
P.O. Box 747
Falls Church, VA 22040-0747

In re Application of		
SUZUKI et al.	:	
Application No.: 09/913,332	:	
PCT No.: PCT/JP00/01742	:	
Int. Filing Date: 22 March 2000	:	NOTIFICATION
Priority Date: 21 December 1999	:	
Atty. Docket No.: 4777-12	:	
For: THERMOPLASTIC RESIN COMPOSITION	:	

This is a response to applicants' "Petition Accompanying New Translation of PCT/JP00/01742" filed 13 November 2003.

BACKGROUND

On 22 March 2000, applicants filed international application PCT/JP00/01742 which claimed a priority date of 21 December 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 28 June 2001. A Demand was not filed with for International Preliminary Examination before the 19th month from the earliest claimed priority date. Accordingly, the twenty-month time period for submitting the requisite basic national fee in the United States of America expired at midnight on 21 June 2002.

On 13 August 2001, applicant filed a Transmittal Letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. 371. Filed with the Transmittal Letter were, *among others*, the requisite basic national fee of $890; translation of the international application; and an executed declaration.

On 02 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF ACCEPTANCE OF APPLICATION UNDER 35 U.S.C. 371 AND 37 CFR 1.494 OR 1.495" (Form PCT/DO/EO/903) which set forth a 35 U.S.C. 371 completion date of 13 August 2001.

On 13 November 2003, applicants filed "Petition Accompanying New Translation of PCT/JP00/01742."

DISCUSSION

A review of the application file and other Patent and Trademark Office records reveal that the requirements of 35 U.S.C. 371(c) for entry into the national stage in the United States of America have not been completed as indicated in the Notification of Acceptance mailed by the DO/EO/US on 02 October 2001. Applicant states, "[e]nclosed with the present petition is a new translation of International PCT application PCT/JP00/01742 filed on March 22, 2000. . .Table 3 has been revised to reflect amendments requested by Applicants on February 10, 2003. . .The errors ware editorial one which occurred in the course of preparing an English translation of the original PCT application. . ." Since the translation of the international application filed 13 August 2001 was not an identical translation in accordance with 35 U.S.C. 371(c)(1), the Notification of Acceptance of Application mailed 02 October 2001 is vacated.

With the filing of the new translation of International PCT application PCT/JP00/01742 on 13 November 2003, the above-identified application will be given an international filing date of 22 March 2000 under 35 U.S.C. 363, and a date of **13 November 2003** under 35 U.S.C. 371(c)(1), (c)(2), and(c)(4).

CONCLUSION

Applicant's request to accept the translation of the international application under 35 U.S.C. 371, filed 13 November 2003, is **GRANTED**.

The Notification of Acceptance of Application Under 35 U.S.C. 371 and 37 CFR 1.494 or 1.495 (Form PCT/DO/EO/903) mailed on 17 October 2001 is hereby **VACATED**.

The application will be given an international filing date of 22 March 2000 under 35 U.S.C. 363, and a date of **13 November 2003** under 35 U.S.C. 371 371(c)(1), (c)(2), and(c)(4).

This application will be forwarded to the United States Designated/Elected Office (DO/EO/US) for mailing of a NOTIFICATION OF ACCEPTANCE OF APPLICATION (Form PCT/DO/EO/903) which identifies a date of **13 November 2003** under U.S.C. 371 371(c)(1), (c)(2), and(c)(4).

Art Unit 1711 will be notified of this decision.

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel.: 703-308-6314
Fax: 703-308-6459

OIPE JC174
NOV 13 2003
PATENT & TRADEMARK OFFICE

MS AF
EXPEDITED PROCEDURE
EXAMINING GROUP 1711

PATENT
0649-0800P

IN THE U.S. PATENT AND TRADEMARK OFFICE

Applicant:	SUZUKI et al.	Conf.:	8577
Appl. No.:	09/913,332	Group:	1711
Filed:	August 13, 2001	Examiner:	J. C. MULLIS
For:	THERMOPLASTIC RESIN COMPOSITION		

PETITION ACCOMPANYING NEW TRANSLATION OF PCT/JP00/01742

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

November 13, 2003

Sir:

Enclosed with the present petition is a new translation of International PCT Application PCT/JP00/01742 filed on March 22, 2000. The accompanying new English translation is identical to that earlier submitted to the USPTO, with the exception of Table 3 at page 23 thereof. Table 3 has been revised to reflect amendments requested by Applicants on February 10, 2003 in the matter of the instant case.

Regarding the corrections to Table 3, at page 23 of the International Application, the undersigned notes as follows.

11/14/2003 HDEBESS1 00000004 09913332
03 FC:1460 130.00 OP

The errors are editorial ones which occurred in the course of preparing an English translation of the original PCT application as set forth below in more detail.

Basically, Table 3 was prepared based on the electronic data of Table 2 (i.e., copying and pasting, followed by making necessary modifications). However, some data originated from Table 2 (i.e., the portions marked as (A), (B) and (C) shown in the attached uncorrected Table 3) that should have been deleted were erroneously allowed to remain therein. Please note that the 1st column is the same as Table 2, the portion (B) shows the same values as "b-PP" in Examples 1 to 4, and that the portion (C) shows the same values as "heat deformation temperature" in Examples 1 to 4. In other words, the corrected Table 3 can be obtained by deleting these portions (cells) from Table 3 as filed.

The necessary petition fee under 37 C.F.R. § 1.17(h) of $130.00 is enclosed.

Favorable consideration of the instant petition is earnestly solicited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH & BIRCH, LLP

By _____
John W. Bailey, #32,881

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000

JWB/enm
0649-0800P

Attachment(s)

OIPE JC174
NOV 13 2003
PATENT & TRADEMARK OFFICE

Table 2

	Ex. 1	Ex. 2	Ex. 3	Ex. 4	Ex. 5	Ex. 6	Ex. 7	Ex. 8
Structure of hydrogenated block copolymer	I	I	I	I	II	III	IV	I
Hydrogenated block copolymer (parts)	6	15	6	10	6	6	6	15
HIPS (wt.%)	70	70	50		70	70	70	
GPPS (wt.%)				70				
ABS (wt.%)								70
b-PP (wt.%)	30	30	50	30	30	30	30	30
Elongation at break (%)	120	180	300	100	240	100	130	100
Heat deformation temperature (°C)	107	107	112	107	109	106	107	105
Flexural modulus (kgf/cm²)	17800	16400	15600	22000	17200	16600	17300	15400
Oil resistance (°C)	105	103	115	105	109	102	108	110
Phase separation structure	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation
Existing ratio (%) of block copolymer on interface	85	70	95	83	90	70	87	67

Table 3

	Comp. Ex. 1	Comp. Ex. 2	Comp. Ex. 3	Comp. Ex. 4
Structure of hydrogenated block copolymer	-	V	VI	VII
Hydrogenated block copolymer (parts)	0	6	6	6
HIPS (wt.%)	70	70	70	70
GPPS (wt.%)	30	30	30	30
ABS (wt.%)	3	15	30	21
b-PP (wt.%)	30	30	50	30
Elongation at break (%)	106	106	107	108
Heat deformation temperature (°C)	107	107	112	107
Flexural modulus (kgf/cm²)	19000	15800	16500	14000
Oil resistance (°C)	70	81	86	83
Phase separation structure	sea-island	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation
Existing ratio (%) of block copolymer on interface	-	30	45	40

(A) (B) (C)

Phase separation structure of each of the thermoplastic resin compositions of Example 1 and

OIPE JC174
NOV 13 2003
PATENT & TRADEMARK OFFICE

DESCRIPTION

THERMOPLASTIC RESIN COMPOSITION

TECHNICAL FIELD

The present invention relates to a thermoplastic resin composition rich in heat resistance and oil resistance and excellent in tensile elongation properties.

BACKGROUND ART

Styrene resins are used widely as an injection molding material or sheet forming material because of its rigidity, good stability and low cost. They however have stress cracks under the influence of a fatty oil or organic solvent and undergo a drastic deterioration in physical properties. In addition, since they are amorphous and have a glass transition point of about 90°C, they easily change in shape at a relatively low temperature not greater than 90°C. These drawbacks prevent free use of them.

There has accordingly been an attempt to prepare a resin composition having improved oil resistance and chemical resistance by adding, to a styrene resin, a propylene resin having excellent oil resistance.

Proposed in JP-A-54-53159 (The term "JP-A" as used herein means an "unexamined published Japanese patent application") and JP-A-54-13354 are compositions obtained by adding a compatibilizer to a composition of a styrene resin and a propylene resin, which have inherently difficulty in mixing, in order to improve their compatibility. For example, in JP-A-54-53159, proposed is a thermoplastic composition obtained from a polystyrene resin and a polyethylene or poly-α-olefin resin by using, as a compatibilizer, a selectively hydrogenated linear, sequential or radial teleblock copolymer which comprises a polymerized aromatic vinyl compound A and an olefin elastomer B and has a structure of A-B-A, $A-(B-A-B)_n-A$, $A(BA)_nB$, $B(A)_4$ or $B[(AB)_nB]_4$ (wherein, n stands for an integer of 1 to 10). In the block copolymer serving as a compatibilizer, a block of the polymerized aromatic vinyl compound preferably accounts for 15 to 40 wt.% of all the block polymers, the olefin elastomer B is preferably a hydrogenated saturated polybutadiene, and 30 to 50% of butadiene carbon atoms are vinyl side chains. As its specific example, an SEBS block copolymer having a 30 wt.% of a bound styrene content is disclosed. However, owing to a low content of the aromatic vinyl compound block, this block copolymer lacks affinity with a styrene resin. An amount of the

block copolymer which can exist on the interface as a compatibilizer for the styrene resin and propylene resin is not sufficient so that the resulting composition is poor in tensile elongation properties. In JP-A-56-38338, on the other hand, proposed is a thermoplastic resin composition formed of a polyolefin resin and a polystyrene resin by using, as a compatibilizer, a hydrogenated block copolymer available by hydrogenating a block copolymer having at least one aromatic vinyl compound polymer block A and at least one conjugated diene polymer block B and containing 15 to 85 wt.% of a bound vinyl-substituted aromatic compound, thereby saturating at least 70% of double bonds in the block copolymer. In Examples, disclosed as a compatibilizer for a composition of a styrene resin and a propylene resin is A-B-A-B tapered 4 type hydrogenated block copolymers having a bound styrene content of 40 wt.% and a vinyl content, before hydrogenation, of 13%. These hydrogenated block copolymers involve drawbacks such as complex structure and cumbersome preparation process. There is accordingly a demand for a hydrogenated block copolymer which has a simple structure and can be prepared easily. In JP-A-5-186660 and JP-A-6-184366, proposed are resin compositions having excellent heat resistance, chemical resistance and oil resistance and

formed from a rubber-modified styrene resin and a polyolefin resin by using, as a compatibilizer, a hydrogenated triblock copolymer which comprises a styrene block, isoprene block, and a styrene block, with these styrene blocks accounting for 40 to 70 wt.% of these blocks. The hydrogenated triblock copolymer having an isoprene block is however inferior in weather resistance and heat resistance and has a problem in recycling properties. In addition, these resin compositions are not always satisfactory in tensile elongation properties, because adhesion of the styrene resin phase and propylene resin phase on the interface therebetween is insufficient.

An object of the invention is to provide a thermoplastic resin composition rich in heat resistance and oil resistance and having excellent tensile elongation properties by adding, to a styrene resin and a propylene resin, a hydrogenated block copolymer having a specific structure.

DISCLOSURE OF THE INVENTION

The object of the invention has been achieved by a thermoplastic resin composition comprising (A) a styrene resin, (B) a propylene resin and (C) a hydrogenated block copolymer comprising at least two polystyrene blocks Xs

and at least one polybutadiene block Y, with at least 70 % of the double bonds of the polybutadiene of the polybutadiene block Y having been hydrogenated, wherein a styrene content of the hydrogenated block copolymer (C) is 40 to 80 wt.%, a 1,2-bound content of the polybutadiene block is 30 to 80 wt.%, a weight ratio of the component (A) to the component (B) is 95:5 to 5:95, a content of the component (C) is 2 to 30 parts by weight based on 100 parts by weight of the components (A) and (B), and at least 50% of the component (C) exists on the interface between the phase of the component (A) and the phase of the component (B).

BRIEF DESCRIPTION OF THE DRAWINGS

FIG. 1 illustrates a phase separation structure of a thermoplastic resin composition of Example 1 of the invention observed through a transmission electron microscope; and FIG. 2 illustrates a phase separation structure of a thermoplastic resin composition of Comparative Example 2 observed through a transmission electron microscope.

BEST MODE FOR CARRYING OUT THE INVENTION

In the invention, examples of the styrene resin (A) include homopolymers or copolymers obtained using, as a

monomer component, styrene, methylstyrene, ethylstyrene, isopropylstyrene, dimethylstyrene, paramethylstyrene, chlorostyrene, bromostyrene, vinyltoluene or vinylxylene, styrene-maleic anhydride copolymer, styrene-acrylic acid copolymer, styrene-acrylate copolymer, styrene-methacrylic acid copolymer, styrene-acrylonitrile copolymer and acrylonitrile-butadiene-styrene copolymer. In addition, an impact-resistant polystyrene resin obtained by mixing the above-described polystyrene resin with at least one of a butadiene rubber, ethylene-propylene rubber and a styrene butadiene rubber or graft polymerizing the latter on the former can also be used. The styrene resin of the invention has preferably a melt index (MI: at 200°C under a load of 5 Kg) of 0.5 to 20 g/10 min, more preferably 1 to 10 g/10 min.

In the invention, no particular limitation is imposed on the propylene resin (B) insofar as it is a polymer obtained by polymerizing a propylene monomer as a main component. A propylene resin obtained by copolymerizing with up to about 20 wt.% of another α-olefin such as ethylene, butene or 4-methylpentene-1 may be used. Either a random copolymer or block copolymer may be used. Moreover, a propylene resin may contain up to about 40 wt.% of an olefin thermoplastic elastomer such as a copolymer rubber with at least 2 α-olefins

selected from ethylene, propylene, 1-butene, 1-hexene, 4-methyl-pentene and 1-octene or a copolymer rubber comprising an α-olefin and various monomers. Typical examples of the copolymer rubber with the at least 2 α-olefins include ethylene-propylene copolymer rubber (EPR), ethylene-butene copolymer rubber (EBR) and ethylene-propylene-diene copolymer rubber (EPDM). In the invention, preferred as the propylene resin (B) is a syndiotactic polypropylene homopolymer or a propylene-ethylene block resin having a crystal-melting peak temperature by DSC of 155°C or greater. Use of it heightens the heat deformation temperature of the resulting composition.

The propylene resin of the invention has preferably a melt flow rate (MFR, at 230°C under a load of 2.16 Kg) of 0.5 to 60 g/10 min, more preferably 1 to 20 g/10 min. Melt flow rates less than 0.5 g/10 min deteriorate the moldability or formability of the resulting thermoplastic resin composition, while melt flow rates exceeding 60 g/min deteriorate impact resistance. Melt flow rates outside the above-described range are therefore not preferred.

In the invention, the hydrogenated block copolymer (C) comprises at least two polystyrene blocks Xs and at least one polybutadiene block Y, and has at least 70% of

the double bonds of the polybutadiene of the polybutadiene block Y has been hydrogenated. The polystyrene block X may be a styrene homoblock or a block comprising styrene as a main component and 40 wt.% or less of another aromatic vinyl compound copolymerizable with styrene. Examples of the another aromatic vinyl compound include α-methylstyrene, 4-methylstyrene, 1,1-diphenylethylene and divinylbenzene. The polybutadiene block Y may be a butadiene homoblock or a block comprising butadiene as a main component and a 40 wt.% or less of another conjugated diene compound or aromatic vinyl compound copolymerizable with butadiene. Examples of the another conjugated diene compound copolymerizable with butadiene include isoprene, 2,3-dimethyl-1,3-butadiene, 1,3-pentadiene, 2-methyl-1,3-butadiene, 1,3-hexadiene, 4,5-diethyl-1,3-octadiene, 3-butyl-1,3-octadiene, myrcene and ocimene, while those of the aromatic vinyl compound include styrene, α-methylstyrene, 4-methylstyrene, 1,1-diphenylethylene and divinylbenzene.

The styrene content of the hydrogenated block copolymer (C) is 40 to 80 wt.%, preferably 45 to 80 wt.%. When the styrene content is less than 40 wt.%, the hydrogenated block copolymer (C) and the styrene resin lack affinity therebetween and the amount of the hydrogenated block copolymer existing on the interface

between the styrene resin phase and the propylene resin phase becomes insufficient, resulting in unsatisfactory compatibilizing effects. When the styrene content exceeds 80 wt.%, on the other hand, the affinity with the styrene resin phase becomes excessive and the hydrogenated block copolymer is inevitably incorporated in the styrene resin phase, resulting also in unsatisfactory compatibilizing effects. When the hydrogenated block copolymer (C) contains another aromatic vinyl compound in addition to styrene, the styrene content means wt.% of all the aromatic vinyl compounds.

The 1,2-bound content of the butadiene unit of the polybutadiene block Y of the hydrogenated block copolymer (C) is 30 to 80 wt.%, preferably 40 to 80 wt.%. When the 1,2-bound content is less than 30 wt.%, the polybutadiene block and propylene resin after hydrogenation lack affinity therebetween, preventing the hydrogenated block copolymer from bringing about sufficient compatibilizing effects. When it exceeds 80 wt.%, on the other hand, the affinity with the propylene resin becomes excessive and the hydrogenated block copolymer is inevitably incorporated in the propylene resin phase, resulting in insufficient compatibilizing effects.

In the hydrogenated block copolymer (C), at least 70% of the double bonds of the polybutadiene of the polybutadiene block have been hydrogenated. Hydrogenation ratios less than 70% tend to lower elongation properties and heat resistance of the resulting composition.

It is preferred that the polystyrene block X of the hydrogenated block copolymer (C) has a weight-average molecular weight of 5000 to 50000, while the polybutadiene block Y has a weight-average molecular weight of 5000 to 70000. Weight-average molecular weights of the polystyrene block X not greater than 5000 lower the affinity with the styrene resin of the polystyrene block X, while weight-average molecular weights of the polybutadiene block Y not greater than 5000 lower the affinity with the propylene resin of the hydrogenated polybutadiene block Y, leading to inferior compatibilizing effects. When the weight-average molecular weight of the polystyrene block X is 50000 or greater or the weight-average molecular weight of the polybutadiene block Y is 70000 or greater, on the other hand, the molecular weight which becomes too large as the hydrogenated block copolymer causes an rise in the melt viscosity. Then, dispersion in the resin composition comprising a styrene resin and a propylene resin becomes

insufficient, resulting in inferior compatibilizing effects.

The hydrogenated block copolymer (C) has preferably a melt flow rate (MFR, at 230°C under a load of 2.16 Kg) of 0.1 to 50 g/10 min, more preferably 0.5 to 20 g/10 min, still more preferably 1 to 10 g/10 min. At a melt flow rate less than 0.1 g/10 min, the melt viscosity becomes too high, which makes it impossible to obtain sufficient compatibilizing effects. Melt flow rates exceeding 50 g/min, on the other hand, make it impossible to obtain reinforcing effects on the interface between the styrene resin and propylene resin.

In the invention, it is necessary that at least 50%, more preferably at least 60%, of the hydrogenated block copolymer (C) exists on the interface between the styrene resin (A) and the propylene resin (B). At an existing ratio less than 50%, even if the styrene resin and propylene resin form a mutually-impregnation phase separation structure, the resulting composition does not exhibit excellent tensile elongation properties because of inferior adhesion strength on their interface.

In the invention, the styrene resin (A) and propylene resin (B) are mixed at a weight ratio of 95:5 to 5:95. It is possible to adjust this composition ratio, for example, to increase the ratio of the styrene

resin (A) when heightening of rigidity is intended, or to increase the ratio of the propylene resin when heat resistance and oil resistance are important. From the viewpoint of the balance between rigidity and heat resistance or oil resistance, a preferred weight ratio of the styrene resin (A) to the propylene resin (B) is 80:20 to 40:60.

The amount of the hydrogenated block copolymer (C) is 2 to 30 parts by weight, preferably 5 to 15 parts by weight, based on 100 parts by weight of the styrene resin (A) and propylene resin (B). Amounts less than 2 parts by weight cannot bring about sufficient compatibilizing effects. Amounts exceeding 30 parts by weight lower rigidity and in addition, are not economical.

In the invention, as the hydrogenated block copolymer (c), a triblock copolymer having an X-Y-X structure is preferably employed. In this case, the styrene content of the hydrogenated block copolymer (C) preferably exceeds 50 wt.% but not greater than 80 wt.%. The 1,2-bound content of the polybutadiene block Y of the hydrogenated block copolymer (C) is preferably 45 to 75 wt.%, more preferably 55 to 70 wt.%.

As one of preferred modes in the invention, the hydrogenated block copolymer (C) has an Y-X-Y-X or Y-X-Y-X-Y structure. In this case, the styrene content of the

hydrogenated block copolymer (C) preferably exceeds 50 wt.% but not greater than 80 wt.%. The 1,2-bound content of the polybutadiene block Y of the hydrogenated block copolymer (C) is preferably 30 wt.% or greater but less than 60 wt.%.

No particular limitation is imposed on the preparation process of the hydrogenated block copolymer (C) and a known process is adopted. For example, a block copolymer comprising a polystyrene block X and a polybutadiene block Y can be prepared in an inert solvent by using a technique of living anionic polymerization in the presence of an organic lithium catalyst, which technique has been described in JP-B-36-19286. Described specifically, it can be prepared, for example, by successively forming blocks in the order of X, Y and X in the presence of, as an organolithium catalyst, a monolithium compound such as n-butyl lithium, sec-butyl lithium or tert-butyl lithium, by forming an X-Y two-type living block copolymer in the order of X and Y and then forming a triblock copolymer of an X-Y-X structure by using a bifunctional coupling agent, or by forming a triblock copolymer of an X-Y-X structure in the order of Y and X by using a dilithium compound.

The styrene content of the hydrogenated block copolymer (C) of the invention is adjusted by a feed

monomer composition of styrene and butadiene. Upon polymerization, a polar compound or randomizing agent can be used for the purpose of adjusting a polymerization rate or changing the microstructure (cis, trans or 1,2-bound ratio) of the polymerized butadiene block.

Examples of the polar solvent or randomizing agent include amines such as N,N,N',N'-tetramethylethylenediamine, trimethylamine, triethylamine and diazobicyclo[2,2,2]octane, ethers such as tetrahydrofuran, diethylene glycol dimethyl ether and diethylene glycol dibutyl ether, thioethers, phosphines, phosphoramides, alkylbenzene sulfonates and alkoxides of potassium or sodium.

A hydrogenated block copolymer with at least 70% of the double bonds of the butadiene block having been selectively hydrogenated can be obtained by subjecting a solution of the block copolymer obtained above in a hydrocarbon solvent or a solution obtained by dissolving the block copolymer in a hydrocarbon solvent to hydrogenation reaction (which will hereinafter be called "hydrogenation"). The hydrogenation of the block copolymer solution may be conducted while the terminal is active or after inactivating the active terminal by a polymerization terminator.

As the catalyst to be used for hydrogenation, known are (1) a supported-type heterogeneous catalyst system and (2) a homogeneous catalyst using a Ziegler catalyst or a titanocene compound. In accordance with a process as described in JP-B-42-8704 or JP-B-43-6636, preferably a process as described in JP-B-63-441 or JP-B-63-5401, hydrogenation is conducted in the presence of a hydrogenation catalyst in an inert solvent, whereby a solution of a hydrogenated block copolymer is available.

By removing the solvent from the solution of a hydrogenated block copolymer thus obtained in a conventional manner, the hydrogenated block copolymer can be obtained. A step for deashing a metal can be adopted if necessary. A reaction terminator, antioxidant, neutralizing agent or surfactant may be used as needed.

To the thermoplastic resin composition of the invention, any additive can be added as needed. No particular limitation is imposed on the nature of the additive insofar as it is ordinarily employed for reparation of a resin. Examples include inorganic fillers such as silica, calcium carbonate, magnesium carbonate, calcium sulfate and talc, organic fibers, pigments such as titanium oxide, carbon black and iron oxide, lubricants or mold releasing agents such as stearic acid, behenic acid, zinc stearate, calcium

stearate, magnesium stearate and styrene-bis-stearamide, plasticizers such as organopolysiloxane and mineral oils, antioxidants such as hindered phenol and phosphor antioxidants, flame retardants, ultraviolet absorbers, antistatic agents, and reinforcing agents such as glass fibers, carbon fibers and metal whisker; the other additives; and mixtures thereof.

No particular limitation is imposed on the preparation method of the resin composition of the invention insofar as it permits existence of at least 50% of the hydrogenated block copolymer (C) on the interface between the styrene resin (A) phase and propylene resin (B) phase. A known method can be utilized. Examples include a method of kneading components under a molten state in an ordinarily employed mixer such as Banbury mixer, single screw extruder, twin screw extruder, co-kneader or a multi screw extruder: or a method of dissolving or dispersing components in a solvent and then removing the solvent by heating. Preferred is a method of kneading under conditions permitting a shear rate of at least 100 sec^{-1} at 180°C or greater, preferably 200°C or greater, under which the styrene resin (A) phase, propylene resin (B) phase and the hydrogenated block copolymer (C) can be mixed and melted sufficiently and the hydrogenated block copolymer (C) moves to the

interface between the styrene resin (A) phase and the propylene resin (B) phase. Use of a twin screw extruder is preferred. The components are preferably kneaded once by the above-described method to form master pellets, followed by molding or forming and, if necessary, expansion molding.

Next, Examples in order to illustrate the present invention in greater detail are shown below, but the invention should not be construed as being limited thereto. The values shown in these Examples were measured by the methods described below. In Examples, the "part" and "%" is in terms of weight unless otherwise particularly indicated. Measurements in Examples were conducted in accordance with the following methods.

(1) Styrene content: measured by infrared spectroscopy based on the absorption of a phenyl group at 679 cm^{-1}.

(2) 1,2-Bound content of the polybutadiene block: by measured by infrared spectroscopy and calculated from Hampton method.

(3) Hydrogenation ratio: calculated from 100-MHz 1H-NMR spectrum by using ethylene tetrachloride as a solvent.

(4) Weight-average molecular weight: measured using gel permeation chromatography (GPC) at 40°C in a THF solvent.

(5) Tensile elongation properties: A tensile elongation at break of injection-molded test piece of a resin composition was measured in accordance with ASTM D638 and it was used as an index.

(6) Rigidity: Flexural modulus of an injection molded test piece of a resin composition was measured by a three-point bending test in accordance with ASTM D790 and it was used as an index.

(7) Heat resistance: A vicat softening point of an injection molded test piece of a resin composition was measured under a load of 1 kgf in accordance with ASTM D5125 and it was used as an index.

(8) Oil resistance: A resin composition was formed into a sheet of 1 mm thick by a sheet extruder. By using the sheet, a container of 2 cm in height x 10 cm in length x 10 cm in width was formed. After application of a synthetic coconut oil to the inside surface of the container, it was heated in an oven for 1 hour. A heating temperature at which a changing ratio of the internal volume of the container by the above-described heating became 10% or greater was used as an index.

(8) Phase separation structure: From an injection molded piece of a resin composition, an ultra-thin section was cut out along a face parallel with a flow direction, upon molding or forming, of the resin by an ultra-microtome and it was stained with ruthenium tetraoxide. From the observation of the image at 25000× magnification under a transmission electron microscope, the phase separation structure of the styrene resin phase and propylene resin phase was observed.

(10) Existing ratio of block copolymer on the interface (a ratio of the hydrogenated block copolymer existing on the interface between the styrene resin phase and the propylene resin phase was measured and calculated based on the total amount of the hydrogenated block copolymer by the below-described method and it was used as an index): An image obtained by the above-described observation (9) of the phase separation structure under a transmission electron microscope was photographed. Based on the analysis of this photographed image, an area of the hydrogenated block copolymer existing in the styrene resin phase or propylene resin phase was measured and its ratio (a) to the whole area subjected to image analysis was calculated. Supposing that a weight ratio of the hydrogenated block copolymer calculated from the mixing ratio of the resin composition was (b), a ratio (c) of

the hydrogenated block copolymer existing on the interface between the styrene resin phase and propylene resin phase was ((b)-(a)))/(b) x 100%. This ratio was used as an index.

Examples 1 to 8 and Comparative Examples 1 to 4

At a temperature maintained at 50°C, an autoclave having a content volume of 5 liter and equipped with a stirrer and a jacket was fed with 250 g of styrene and 1250 g of cyclohexane which had been purified in advance. Polymerization was initiated by adding thereto 0.5 g, in terms of butyl lithium, of a hexane solution of butyl lithium. One hour after the addition of the catalyst, 250 g of butadiene and 1250 g of cyclohexane, which had been purified and dried in advance, were added and they were polymerized at 50°C. After one hour, 250 g of styrene and 1250 g of cyclohexane were added and polymerization was conducted for 1 hour. Upon polymerization, tetramethylethylene diamine was added to regulate the 1,2-bound content of the polybutadiene block moiety.

The resulting block copolymer solution was diluted with cyclohexane to a concentration of 5 wt.%. To the diluted block copolymer solution, 1.175 g, in terms of nickel, of a hexane solution of nickel octenoate and 6.85 g, in terms of triethyl aluminum, of a hexane solution of

triethyl aluminum were added as a catalyst. The resulting mixture was reacted at 50°C for about 6 hours under hydrogen pressure. The resulting hydrogenated block copolymer solution was washed three times with an aqueous hydrochloric acid solution. From the thus-washed hydrogenated copolymer solution, the hydrogenated copolymer was precipitated using excess methanol. The precipitate was dried under reduced pressure. The resulting hydrogenated block copolymer (I) was found to have a styrene content of 67%, a 1,2-bound content of the polybutadiene block of 41%, and a hydrogenation ratio of 97%.

In a similar manner, hydrogenated block copolymers (I) to (VII) having a structure as described in Table 1 were prepared.

Table 1

Structure of hydrogenated copolymer	I	II	III	IV	V	VI	VII
Block structure	X-Y-X	X-Y-X	X-Y-X	X-Y-X-Y	X-Y-X	X-Y-X	X-Y-X
Styrene content	67%	70%	50%	67%	35%	68%	67%
Molecular weight of polystyrene block X	15000	15000	16000	15000	10000	15400	15000
1,2-bound content of polybutadiene block Y	40%	65%	40%	40%	41%	20%	40%
Molecular weight of polybutadiene block Y	15000	13000	32000	75000	37000	14500	15000
Hydrogenation ratio of polybutadiene block Y	97%	98%	97%	97%	96%	96%	20%

Seven hydrogenated block copolymers thus obtained were each mixed with a commercially available impact-resistance styrene resin (HIPS, "SR500", product of Dainippon Ink & Chemicals, Inc.), styrene resin (GPPS, "G9305", product of A & M styrene Co., Ltd.) or acrylonitrile-butadiene-styrene resin (ABS, "A4130", product of Asahi Kasei Corporation) and a block propylene resin (b-PP, "K7019", product of Chisso Corporation) at a ratio as shown in Table 2 or 3, followed by mixing for about 10 minutes in a super mixer. The resulting mixture was kneaded under a molten state at 210 to 230°C in a 30-mmØ twin screw extruder, whereby a composition was obtained in the form of pellets. These pellets were measured for various properties. Composition ratios and measuring results are shown in Tables 2 and 3.

Table 2

	Ex. 1	Ex. 2	Ex.3	Ex. 4	Ex. 5	Ex. 6	Ex. 7	Ex. 8
Structure of hydrogenated block copolymer	I	I	I	I	II	III	IV	I
Hydrogenated block copolymer (parts)	6	15	6	10	6	6	6	15
HIPS (wt.%)	70	70	50		70	70	70	
GPPS (wt. %)				70				
ABS (wt. %)								70
b-PP (wt.%)	30	30	50	30	30	30	30	30
Elongation at break (%)	120	180	300	100	240	100	130	100
Heat deformation temperature (°C)	107	107	112	107	109	106	107	105
Flexural modulus (kgf/cm^2)	17800	16400	15600	22000	17200	16600	17300	15400
Oil resistance (°C)	105	103	115	105	109	102	108	110
Phase separation structure	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation	Mutual impreg-nation
Existing ratio (%) of block copolymer on interface	85	70	95	83	90	70	87	67

Table 3

	Comp. Ex. 1	Comp. Ex. 2	Comp. Ex. 3	Comp. Ex. 4
Structure of hydrogenated block copolymer	-	V	VI	VII
Hydrogenated block copolymer (parts)	0	6	6	6
HIPS (wt.%)	70	70	70	70
b-PP (wt.%)	30	30	30	30
Elongation at break (%)	3	15	30	21
Heat deformation temperature (°C)	106	106	107	108
Flexural modulus (kgf/cm^2)	19000	15800	16500	14000
Oil resistance (°C)	70	81	86	83
Phase separation structure	sea-island	Mutual impregnation	Mutual impregnation	Mutual impregnation
Existing ratio (%) of block copolymer on interface	-	30	45	40

Phase separation structure of each of the thermoplastic resin compositions of Example 1 and

Comparative Example 2 observed under a transmission electron microscope are shown in FIGS. 1 and 2, respectively. In FIG. 2, a number of hydrogenated block copolymers are dispersed in the propylene resin phase (the unstained light phase), while hydrogenated block copolymers scarcely exist on the interface between the styrene resin phase (the stained dark phase) and the propylene resin phase.

Compositions obtained in Examples of the invention all exhibited satisfactory results in any item.

In Comparative Example 1 free of a hydrogenated block copolymer, tensile elongation properties are inferior and oil resistance is insufficient. In Comparative Example 2 wherein the styrene content in the hydrogenated block copolymer is too small, the hydrogenated block copolymer has excessive affinity with the propylene resin, increasing the existing ratio of the hydrogenated block copolymer in the propylene resin phase. This means that the amount of the hydrogenated block copolymer is not enough for reinforcing the adhesion on the interface between the styrene resin phase and propylene resin phase, resulting in inferior tensile elongation properties and oil resistance. In Comparative Example 3, since the 1,2-bound content of the polybutadiene block of the hydrogenated block copolymer

is too small, the affinity with the propylene resin lowers, leading to an increase in the existing ratio of the hydrogenated block copolymer in the styrene resin phase. This makes the adhesion on the interface insufficient, whereby tensile elongation properties and oil resistance become inferior. In Comparative Example 4, a hydrogenation ratio of the hydrogenated block copolymer becomes too small and affinity with the propylene resin lowers, so that the existing ratio of the hydrogenated block copolymer on the interface becomes insufficient, resulting in inferior tensile elongation properties and oil resistance.

INDUSTRIAL APPLICABILITY

The hydrogenated block copolymer (C) to be used in the invention exists on the interface between a styrene resin phase and a propylene resin phase and reinforces this interface, which makes it possible to provide a thermoplastic resin composition having excellent heat resistance and oil resistance and having incomparable tensile elongation properties.

CLAIMS

1. A thermoplastic resin composition comprising:

(A) a styrene resin;

(B) a propylene resin; and

(C) a hydrogenated block copolymer comprising at least two polystyrene blocks X and at least one polybutadiene block Y, with at least 70 % of the double bonds of the polybutadiene of the polybutadiene block Y having been hydrogenated,

wherein the hydrogenated block copolymer (C) has a styrene content of 40 to 80 wt.%, a 1,2-bound content of the polybutadiene block Y is 30 to 80 wt.%, a weight ratio of the component (A) to the component (B) is 95:5 to 5:95, a content of the component (C) is 2 to 30 parts by weight based on 100 parts by weight of the components (A) and (B), and at least 50% of the component (C) exists at the interface between a phase of the component (A) and a phase of the component (B).

2. The thermoplastic resin composition according to claim 1, wherein in the component (C), the polystyrene block X has a molecular weight of 5000 to 50000, and the polybutadiene block Y has a molecular weight of 5000 to 70000.

3. The thermoplastic resin composition according to claim 1, wherein a weight ratio of the component (A) to the component (B) is 80:20 to 40:60.

4. The thermoplastic resin composition according to claim 2, wherein a weight ratio of the component (A) to the component (B) is 80:20 to 40:60.

5. The thermoplastic resin composition according to claim 1, wherein the component (C) is a triblock copolymer having an X-Y-X structure.

6. The thermoplastic resin composition according to claim 5, wherein the styrene content of the component (C) is exceeding 50 wt.% but not greater than 80 wt.%.

7. The thermoplastic resin composition according to claim 1, wherein the component (C) is a block copolymer having an X-Y-X-Y structure or Y-X-Y-X-Y structure.

8. The thermoplastic resin composition according to claim 7, wherein the 1,2-bound content of the polybutadiene block Y of the component (C) is at least 30 wt.% but less than 60 wt.%, and the styrene content of

the component (C) is exceeding 50 wt.% but not greater than 80 wt.%.

ABSTRACT

Provided is a thermoplastic resin composition comprising (A) a styrene resin, (B) a propylene resin and (C) a hydrogenated block copolymer comprising at least two polystyrene blocks Xs and at least one polybutadiene block Y, with at least 70 wt.% of the double bonds of the polybutadiene of the polybutadiene block Y having been hydrogenated, wherein the hydrogenated block copolymer (C) has a styrene content of 40 to 80 wt.%; a 1,2-bound amount of the polybutadiene block Y is 30 to 80 wt.%; a weight ratio of the component (A) to the component (B) is 95:5 to 5:95; the component (C) is contained in an amount of 2 to 30 parts by weight based on 100 parts by weight of the components (A) and (B); and at least 50% of the component (C) exists at the interface between a phase of the component (A) and a phase of the component (B). Existence of this component (C) makes it possible to yield a thermoplastic resin composition having excellent heat resistance and oil resistance and having comparable tensile elongation properties.

UNITED STATES PATENT AND TRADEMARK OFFICE

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

DEC 14 2004

MICHAEL R. WARD
MORRISON & FOERSTER, LLP
425 MARKET STREET
SAN FRANCISCO, CA 94105

In re Application of	:
Gregory N. Beatch et al	:
Serial No.: 09/913,373	: PETITION DECISION
Filed: January 28, 2002	:
Attorney Docket No.: 554792000500	:

This is in response to the petition under 37 CFR 1.144, filed August 6, 2004, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and accepted on January 28, 2002, and contained claims 1-85, as filed. In a first Office action, mailed February 12, 2003, the examiner set forth a Lack of Unity requirement under 35 U.S.C. 121 and 372, as follows:

Group I – Claims 1-85, drawn claims where variables n, A, Q, X and Y were defined and R1-R4 were defined as non-cyclic groups;

Group II – Claims 1-85, drawn to claims where n, A, Q, X and Y were defined and R1-R2 were defined as cyclic or heterocyclic groups and R3-R4 are non-cyclic groups;

Group III – Claims 1-85, drawn to claims where variables n, A, Q, X and Y are defined and R1-R2 are non-cyclic groups and R3-R4 form a spiro-heterocyclic ring.

Group IV – Claims 1-85, drawn to claims where n, A, Q, X and Y are defined and R1-R4 are non-cyclic groups.

The examiner argued that the various groups did not make a contribution over the prior art. Also that the number of groups listed was not exhaustive and to examine all groups would impose an undue burden on the examiner. The examiner also gave applicant the option of identifying a single species from which a group would be defined and examination proceed.

Applicants replied on April 12, 2003, electing a species with traverse, but failing to give reasons for traverse.

The examiner mailed a non-Final Office action to applicants on May 7, 2003, acknowledging applicants' election of a species and drafting a group from the elected species, defining n as 1,3 or 4, Q as oxygen, X as CRRY where Y is C1-C4, R1 and R2 form a morpholinyl ring with the nitrogen to which they are attached and R3 and R4 are Hydrogen or C1-C6 alkyl or alkoxy. The examiner held all other compounds withdrawn from consideration. The examiner rejected claims 4-7 under 35 U.S.C. 101 as improper method of use claims. Claims 5, 8-71 and 74-83 were rejected under 35 U.S.C. 112, first paragraph, as lacking support in the specification and proceeded with a Wands analysis. Claims 2 and 4-7 were rejected under 35 U.S.C. 112, second paragraph, as indefinite for various reasons. No art rejection was made.

Applicants replied on November 7, 2003, with an amendment which amended claims 1-3 and 5-85, canceling claim 4. Applicants presented a traverse of the Lack of Unity requirement by the examiner as not being under the correct standard and suggested what the common special technical feature should be. Applicants further responded to the rejections under 35 U.S.C. 101 and 112, first and second paragraphs.

The examiner mailed a Final Office action to applicants on February 6, 2004, maintaining the rejection under 35 U.S.C. 112, first paragraph, for claims 6-7 and 68-69 and providing a Wands analysis supporting the rejection. The examiner objected to all other claims as containing non-elected subject matter. The examiner answered applicants' traverse of t he Lack of Unity requirement with various arguments.

Applicants replied with an amendment on August 6, 2004, in which claims 1-3 and 5-85 were amended and new claims 86-89 were presented. Applicants requested withdrawal of the Lack of Unity requirement and concurrently filed this petition. Applicants further argued the rejections and objections made by the examiner. This amendment has not been acted on, but will be acted on subsequent to the mailing of this petition decision.

DISCUSSION

It is noted first that although applicants made an election with traverse in response to the initial Office action setting forth a Lack of Unity requirement, no arguments for traverse were presented thus compromising applicants' rights to later traverse the requirement or file this petition. However the petition will be treated on the merits

A thorough review of the claims, as filed, and the prosecution has been made. It is clear that this application is subject to Unity of Invention review at each stage of prosecution. Initially the examiner divided the claimed Markush group of compounds/compositions contained in claims 1-85 into four groups, but did not identify any special technical feature for any of the groups; they were defined only by the values of certain substituents. It is not clear that these values serve to define a special technical feature. The examiner also invited applicants to identify a species if none of the groups included the species desired by applicants. In effect this was a request for an election of species from which examination could begin.

A review of the claims shows that independent Claim 1 is directed to a large number of compounds defined by a Markush group. Independent Claim 2 claims two individual species,

salts and solvates thereof. Claim 3, dependent from claims 1 and 2, adds a pharmaceutical carrier. Claim 4 claims a use of the compounds of claims 1 and 2. Claims 5-7 claim compounds of claims 1-3 (and are improperly multiply dependent) used for arrhythmia and ion channel modulation. Even numbered claims 8-84 depend on claims 1 and 2 and claim pharmaceutical compositions of claims 1 and 2 for treating various conditions and odd numbered claims 9-85 depend from their immediately preceding claim and are to a method of treating the condition identified.

Applicants' petition cites M.P.E.P. 1850, part D, which relates to Unity of Invention in Markush groups. The requirements are that (a) all alternatives have a common property or activity; and (b) that there be a common structure present shared by all alternatives or that they belong to a recognized class of chemical compounds.

Applicants' argument that all compounds possess a common utility or activity is severely questioned. Applicants suggest one common utility is treatment of arrhythmia However applicants also claim more than 35 other conditions for which the compounds/compositions may be used. It is unlikely (and unsupported in the specification) that the same common structural feature provides activity or utility for all conditions claimed. It appears more likely that the values for variable A and other variables provide different utilities for different conditions.

Applicants suggest that the common structural element is an unsaturated carbocyclic ring structure of 5, 7 or 8 carbons having on adjacent carbons an amino group and an ether or ester group. Applicants are essentially correct that the 2-amino cycloalkyl esters or ethers form the only common structure present. In the absence of any prior art cited by the examiner it is not known whether this structure is known or not, although its simplicity suggests that it is known. If known, the structure cannot be a special technical feature which defines over the art and would thus establish that Unity is lacking. However, the examiner has failed to provide any prior art to substantiate such a holding.

Further, the examiner in the first Office action appears to have merely picked and chosen some variables in order to set forth a non-exhaustive restriction requirement, rather than a Lack of Unity requirement, under 35 U.S.C. 121. Such was improper. The examiner's statement of not setting forth all possible combinations of the variables and inviting applicants to, in essence, create their own group by electing a species from which to start examination and on which the examiner would build a subgenus was not proper. The examiner should have determined what the basic common structure is and then determined whether it defines over the art or not. If it does define over the art then all compounds/compositions having this structure would be patentable. If it does not define over the art then the differing values of one or more variables should have been used to establish one or more structures which do define over the art and thus establish a Lack of Unity between the different structures, but Unity within the structures.

The examiner, however, in effect, set forth an election of species requirement inviting applicants to identify a species from which examination should begin. However, election of species is not specifically provided for under Lack of Unity guidelines. This does not prevent an examiner from inviting applicants to assist by identifying a starting point for examination as has herein been done. However, having made such invitation and accepted such identification of a single

species to then limit applicants to an examiner created subgroup or subgenus of compounds/compositions is improper. Based on the identified species the examiner should have determined the differences between it and the structure common to all compounds and proceeded to determine patentability based on the minimum number of differences therebetween. In other words the examiner should have determined patentability of the species initially and then expanded patentability considerations by eliminating one or more structural differences until a compound is found which is not patentable over the prior art and based Lack of Unity thereon. If no prior art is found for the structure common to all, then all compounds should be deemed patentable.

DECISION

The petition is **GRANTED.**

The application will be forwarded to the examiner for consideration of the amendment filed August 6, 2004, and further action not inconsistent with this decision.

No fee is required for this petition and the petition fee paid of $130.00 will be credited to applicants' Deposit Account No. 03-1952, as directed.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 703-308-3824 or by facsimile sent to the general Office facsimile number, 703-872-9306.

Bruce M. Kisliuk
Director, Technology Center 1600

MAY 1 3 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

James P. Zeller
Marshall, Gerstein & Borun
233 S. Wacker Drive
6300 Sears Tower
Chicago, IL 60606

In re Application of	:	DECISION
BURROUGHES et al	:	
Application No.: 09/913,381	:	
PCT No.: PCT/GB00/00476	:	ON PETITION
Int. Filing Date: 14 February 2000	:	
Priority Date: 12 February 1999	:	
Attorney's Docket No.: 29610/CDT087A	:	UNDER 37 CFR 1.47(a)
For: OPTO-ELECTRICAL DEVICES	:	

This decision is in response to applicant's "PETITION UNDER 37 CFR §1.47(a) INVENTORS REFUSE TO SIGN" filed on 29 January 2002 to accept the above-captioned application without the signature of the non-signing joint inventor- Ian S. Millard. Petitioner has submitted the requisite $130 petition fee.

BACKGROUND

On 14 February 2000, applicant filed international application PCT/GB00/00476, which claimed an earliest priority date of 12 February 1999. A copy of the international application was transmitted to the United States from the International Bureau on 17 August 2000. A Demand electing the US was filed within 19 months from the priority date.

On 13 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). No oath or declaration was submitted at such time.

On 22 October 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance 37 CFR 1.497(a) and (b) is required. The notification set two months time limit or 32 months from the priority date for the application, whichever is later to respond.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Applicants have satisfied requirements (1), (3), and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

> "...Where a refusal of the inventor to sign the application paper is alleged, the circumstances of the refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings and oath or declaration) to the nonsigning inventor for signature.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration."

In this case, it has not been sufficiently demonstrated that a copy of the application papers were presented to the nonsigning inventor. Petitioner asserts that the documents were mailed to Mr. Millard's last known residential address. However, no documentary evidence to support this assertion has been provided (e.g. certified mail return receipt). Moreover, it appears unlikely that Mr. Millard resides at the UK address given petitioner assertion that Mr. Millard works in California. With regard to mailing of the application papers to Osram Opto Semiconductors, Inc, petitioner has not established that Mr. Millard was employed at Osram's San Jose site during the relevant period.

Mr. Millard's failure to respond given that it is unclear if he actually received the documents can not be construed as a refusal at this time. It could be that in this situation that Mr. Millard has moved both from his last known address and from his job, and the reason for no replies. If such is case, then the petition should address that there was an inability to find or reach the nonsigning inventor, Mr. Millard, after diligent effort.

Consequently, the petition does not include sufficient factual proof that Mr. Millard refused to sign the required documents.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a).

A proper reply to this decision must include : 1) sufficient proof of refusal or unavailability required under 37 CFR 1.47(a) as indicated above (or an oath/declaration in compliance with 1.497(a)-(b)), and 2) failure to timely submitted the proper reply will result in abandonment of the application.

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

200

UNITED STATES PATENT AND TRADEMARK OFFICE

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

James P. Zeller
Marshall, Gerstein & Borun
233 S. Wacker Drive
6300 Sears Tower
Chicago, IL 60606

In re Application of	:	DECISION
BURROUGHES et al	:	
Application No.: 09/913,381	:	
PCT No.: PCT/GB00/00476	:	ON PETITION
Int. Filing Date: 14 February 2000	:	
Priority Date: 12 February 1999	:	
Attorney's Docket No.: 29610/CDT087A	:	UNDER 37 CFR 1.47(a)
For: OPTO-ELECTRICAL DEVICES	:	

This decision is in response to applicant's "REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 CFR §1.47(a)" filed on 21 June 2002 to accept the above-captioned application without the signature of the non-signing joint inventor- Ian S. Millard.

BACKGROUND

In a decision by this Office on 13 May 2002, the petition filed on 29 January 2002 was dismissed. The decision stated that Mr. Millard's failure to respond given that it was unclear if he had actually received the documents could not be construed as a refusal at that time. It could have been that in this situation that Mr. Millard had moved both from his last known address and from his job, and the reason for no replies.

On 13 May 2002, applicants filed the present renewed petition accompanied by an electronic mail message sent by Ann Brown to Mr. David Lacey and a message sent by Mr. Lacey in response to Ms. Brown's e-mail of October 31, 2001.

DISCUSSION

With respect to the petition, the application together with supplemental renewed petition under 37 CFR 1.47(a) have been reviewed and have been found to be in compliance with 37 CFR 1.47(a). Petition asserts that the renewed petition corroborates that the nonsigning inventor was employed at Osram's San Jose site during the relevant period and that a refusal to execute the declaration can be inferred from the nonsigning inventor's conduct. Petitioner supports this assertion by stating that an electronic message was sent by Ann Brown to Mr. David Lacey requesting an alternative contact information for Mr. Millard. And that in a response to Ms. Brown electronic mail, Mr. Lacey alluded to the possible reasons for Mr. Millard's refusal to execute the declaration (i.e., "given the way CDT treated Ian around the time he left, I am not

surprised he is reticent in returning signatures."). The evidence of record is sufficient to establish that Mr. Ian Millard has refused to sign the declaration.

Applicants has satisfied requirements (1), (2), (3), and (4) of 37 CFR 1.47(a).

CONCLUSION

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

A review of the application reveals that the requirements under 35 U.S.C. 371 for entry into the national stage in the US have been satisfied. The application will be given a 35 U.S.C. 371(c) date of **29 January 2002.**

The Application Division and the International Division are authorized to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

20 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

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

Mr. Ian Millard
69a Histon Road
Cambridge CB4 3JD
United Kingdom

In re Application of
BURROUGHES et al
Application No.: 09/913,381
PCT No.: PCT/GB00/00476
Int. Filing Date: 14 February 2000
Priority Date: 12 February 1999
Attorney's Docket No.: 29610/CDT087A
For: OPTO-ELECTRICAL DEVICES

Dear Mr. Millard:

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

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

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Telephone: (703) 308-6461
Facsimile: (703) 308-6312

Boris Milef
PCT Legal Examiner
PCT Legal Office

James P. Zeller
Marshall, Gerstein & Borun
233 S. Wacker Drive
6300 Sears Tower
Chicago, IL 60606

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OFFICIAL GAZETTE NOTICE

37 CFR 1.47 Notice by Publication

Notice is hereby given of the filing of an application with a petition under 37 CFR 1.47 requesting acceptance of the application without the signature of all inventors. The petition has been granted. A notice has been sent to the last known address of the non-signing inventor. The inventor whose signature is missing (Mr. Ian Millard) may join in the application by promptly filing an appropriate oath or declaration complying with 37 CFR 1.63. The international application number is PCT/GB00/00476 and was filed on 14 February 2000 in the names of Jemery H. BURROUGHES; Julian C. CARTER; Alec G. GUNNER; Stephen K. HEEKS and Ian S. MILLARD for the invention entitled OPTO-ELECTRICAL DEVICES. The national stage application number is 09/913,381 and has a 35 U.S.C. 371 date of 29 JANUARY 2002.

UNITED STATES 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 17 2006

OFFICE OF PETITIONS

ARNOLD & PORTER LLP (18528)
555 TWELFTH ST, NW
WASHINGTON, DC 20004

In re Application of	:
Covezzi, et al.	: DECISION ON APPLICATION
Application No. 09/913,385	: FOR PATENT TERM ADJUSTMENT
Filed: August 13, 2001	:
Atty. Dkt. No.: US 18021	:

This is a decision on the "PETITION UNDER 37 CFR 1.703 TO CORRECT PATENT TERM ADJUSTMENT" filed September 26, 2005. This matter is being treated under 37 CFR 1.705(b) as an application patent term adjustment.

The application for patent term adjustment ("PTA") under 37 CFR 1.705(b) is hereby **DISMISSED**.

Applicants request that the Determination of Patent Term Adjustment be corrected from 772 days, as indicated on the Determination of Patent Term Adjustment mailed September 15, 2005, to an adjustment of 799 days.

A review of the application history reveals that as of the time of allowance, an adjustment of 799 days can be attributed to the Office. In accordance with 37 CFR 1.702(a)(1), an adjustment of 621 days can be attributed to the Office for failure to mail at least one of a notification under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151 not later than fourteen months after the date on which the application was filed. The adjustment began October 14, 2002, the day after the date that is 14 months after the date that the application was filed, and ended June 25, 2004, the date the non-final Office action was mailed. See 37 CFR 1.703(a)(1).

A further adjustment of 178 days can be attributed to the Office in accordance with 37 CFR 1.702(a)(2) in accordance with 37 CFR 1.702(a)(2) for failure to respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken. The adjustment began February 23, 2005, the day after the date that is four months after the date that a reply to the non-final Office action was filed, and ended August 19, 2005, the date the Notice of Allowance was mailed.

The adjustment of 799 days was properly reduced 27 days in accordance with 37 CFR 1.704(b) for applicants' failure to engage

in reasonable efforts to conclude prosecution. The reduction began September 26, 2004, the day after the date that is three months after the date that the non-final Office action was mailed, and ended October 22, 2004, the date the response to the non-final Office action was filed.

Applicants argue that the application is entitled to an additional adjustment of 27 days because a Corrected Notice of Allowance was mailed 27 days after the mailing of the Notice of Allowance.

Applicants' arguments have been carefully considered but are not found convincing. An adjustment of 178 days was attributed to the Office in accordance with 37 CFR 1.702(a)(2) for failure to mail the Notice of Allowance within four months of applicants' response to the non-final Office action. The fact that a Corrected Notice of Allowance was subsequently mailed does not negate the fact that the Notice of Allowance mailed August 19, 2005 was properly mailed within the meaning of 35 USC 151 and 37 CFR 1.311. Accordingly, applicants are not entitled to an additional adjustment relative to the mailing of a corrected Notice of Allowance.

Accordingly, at the time of allowance, the application is entitled to an adjustment of 772 days, as indicated in the Notice of Allowance.

The fee required in connection with an application for patent term adjustment under 37 CFR 1.705 is currently $200.00. Accordingly, applicants' request for a refund is hereby dismissed. Moreover, at the time of submission of the instant petition, applicants submitted $130.00. The remaining $70.00 has been charged to applicants' deposit account as authorized.

The application file is being forwarded to the Publications Division for issuance of a patent.

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

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

NOV 3 0 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

#3

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

Jacob Eisenberg
EPPING, HERMANN & FISCHER
Ridlerstrasse 55
D-80339 Munchen, Deutschland (Germany)

In re Application of: HARLE, Volker, et al. U.S. Application No.: 09/913,394 PCT No.: PCT/DE00/04089 International Filing Date: 20 November 2000 Priority Date: 19 November 1999 Attorney's Docket No.: P1999,0003USN For: OPTICAL SEMICONDUCTOR DEVICE COMPRISING A MULTIPLE QUANTUM WELL STRUCTURE	DECISION ON PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 13 August 2001 in the above-captioned application is hereby **GRANTED** as follows:

Applicants' statement that the "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

Applicants have now submitted the basic national fee (a copy of the international application had previously been communicated by the International Bureau) and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application is granted as to the national stage in the United States of America.

This application is being returned to the National Stage Processing Division of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an executed declaration in compliance with 37 CFR 1.497.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

United States Patent and Trademark Office

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

Paper No. 12

Siemens Schweiz
I-44, Intellectual Property
Albisriederstrasse 245
Zurich Ch-80-47
Switzerland

AIR MAIL

MAR 10 2003

In re Application of	)	
HARLE et al.	)	
Application No. 09/913,394	)	DECISION ON REQUEST TO
Filed: February 5, 2002	)	WITHDRAW FROM RECORD
For: Optical Semiconductor Device Comprising a	)	
Multiple Quantum Well Structure	)	

This is a decision on the request filed by Jacob Eisenberg on January 31, 2003, to withdraw the attorneys/agents associated with Customer Number 26461 as attorneys/agents of record.

A 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/agent is signing on behalf the 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 meets the above listed requirements. Accordingly, the request is **APPROVED**.

All future communications from the Office will be directed to the correspondence address indicated in the request.

Edward Westin

Edward Westin, Special Program Examiner
Technology Center 2800 - Semiconductors, Electrical
and Optical Systems and Components

cc: Epping, Hermann & Fischer
Ridlerstrasse 55
Munich D-80339
Germany

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FEB 2 0 2002

James F. Kamp
RADER FISHMAN & GRAUER
39533 Woodward Avenue, Suite 140
Bloomfield Hills, MI 48304

In re Application of RYAN, Paul T. *et al* U.S. Application No.: 09/913,425 PCT No.: PCT/GB00/00573 Int. Filing Date: 17 February 2000 Priority Date: 17 February 1999 Attorney Docket No.: 65446-0082 For: AN AUTOMATED SYSTEM FOR EXCISING PROTEINS . . .	DECISION UNDER 37 CFR 1.47(a)

This decision is in response to applicants' "Petition Pursuant to 37 CFR 1.47(a) Involving the Refusal of a Co-Inventor to Execute the Power of Attorney/Declaration" filed on 17 January 2002.

BACKGROUND

On 13 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States under 35 U.S.C. 371 which was accompanied by, *inter alia*, a check to pay the basic national fee for a small entity.

On 17 October 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that an oath/declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $65.00 pursuant to 37 CFR 1.492(e) must be provided. Applicants were given two months to respond.

On 17 January 2002, applicants submitted the instant petition which was accompanied by, *inter alia*, a one-month extension request and extension fee of $55.00; a declaration signed by two of the three co-inventors; the $65.00 surcharge fee; a declaration by Mr. David Byatt ("Byatt Decl."); copies of two letters mailed to the nonsigning co-inventor; and authorization to charge any additional fees to counsel's Deposit Account No. 18-0013.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the required petition fee; (2) factual proof that the missing joint inventor refuses to execute the application; (3) a statement of the last known address of the missing joint inventor; (4)

and an oath or declaration executed by the signing joint inventor on his behalf and on behalf of the non-signing joint inventor. ~~Applicants failed to satisfy item (2).~~

Concerning item (1), the $130.00 petition fee has been charged to Deposit Account No. 18-0013 as authorized.

Concerning item (2), section 409.03(d) of the Eighth Edition of the MPEP explains what is required to prove a refusal by an inventor and states, in part:

> A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . .
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. . . . Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. . . .
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition.

Here, applicants submitted a declaration by Mr. David Byatt, the Managing Director of Genomic Solutions Limited and a co-inventor who detailed the steps taken that led the 37 CFR 1.47(a) applicant to conclude that Mr. Auton refuses to sign the above-captioned application. Mr. Byatt states that he has "personal knowledge" of the facts and declares that "[o]n December 11, 2001, a second letter, including a copy of the above identified application and a Power of Attorney, was sent to Dr. Auton's last known home address." Byatt Decl. ¶ 1, 6. However, after contacting the

"ascertain that Dr. Auton has taken delivery of the December 11, 2001 letter and Power of Attorney" it was found that "Dr. Auton has taken delivery on December 17." Id. at ¶ 11. Finally, Mr. Byatt contacted the nonsigning inventor on 18 December 2001 and "Dr. Auton indicated that he would not sign the Power of Attorney." Id. at ¶ 12. Petitioners included copies of the 22 October 2001 and 11 December 2001 letters sent to the nonsigning inventor.

This is sufficient to satisfy item (2).

With regard to item (3), applicants satisfy this requirement by listing the last known address of the nonsigning co-inventor, Kevin Auton as:

42 Croftfield Road
Godmanchester, Huntingdon,
Cambridge, PE 29 2ED
United Kingdom

Regarding item (4), applicants included a Declaration signed by two of the three co-inventors. All the inventors' names, residences, post office addresses and citizenship are typed on the declaration. This declaration satisfies the requirements of section 409.03(a) of the Manual of Patent Examining Procedure (MPEP) and is in compliance with 37 CFR 1.497(a) and (b). Thus, item (4) has been satisfied.

Accordingly, all the requirements of 37 CFR 1.47(a) have been satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **GRANTED**.

Applicants have completed the requirements for acceptance under 35 U.S.C. § 371(c). The application has an international filing date of 17 February 2000 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **17 January 2002**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record and will be published in the Official Gazette.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

UNITED STATES PATENT AND TRADEMARK OFFICE

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

FEB 20 2002

Kevin Auton
42 Croftfield Road
Godmanchester, Huntingdon,
Cambridge, PE 29 2ED
United Kingdom

In re Application of
RYAN, Paul T. *et al*
U.S. Application No.: 09/913,425
PCT No.: PCT/GB00/00573
Int. Filing Date: 17 February 2000
Priority Date: 17 February 1999
Attorney Docket No.: 65446-0082
For: AN AUTOMATED SYSTEM FOR EXCISING PROTEINS . . .

Dear Mr. Auton:

You are named as an inventor in the above identified United States patent application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. § 116. Should a patent be granted, you will be designated as an inventor.

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

Leonard Smith
PCT Legal Examiner
PCT Legal Office

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

James F. Kamp
RADER FISHMAN & GRAUER
39533 Woodward Avenue, Suite 140
Bloomfield Hills, MI 48304

UNITED STATES 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: MAR 1 8 2004

spg
Paper Number 10

In re application of
Marek Weltrowski et al.
Serial No. 09/913,448
Filed: August 14, 2001
For: FIBRE WITH IMPROVED COMPLEXATION QUALITIES AND CATION-EXCHANGE PROPERTIES

DECISION ON PETITION

This is a response to the PETITION TO WITHDRAW ABANDONMENT filed November 24, 2003. The petition requests that the abandonment, as set forth in the Notice of Abandonment of October 21, 2003, for failure to timely file a proper reply to the Office letter of March 13, 2003, be withdrawn since the applicants did timely file a response thereto on June 6, 2003 by facsimile transmission to the USPTO. (A copy of the papers filed June 6, 2003 and a copy of the Facsimile Transmission Report indicating receipt of the facsimile transmission at the USPTO is attached to the instant petition.)

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 response was properly filed on June 6, 2003 by facsimile transmission as evidenced by the properly completed Certification of Facsimile Transmission attached to applicant's response and by the copy of the facsimile transmission report provided with the instant petition which indicates the successful transmission, to a USPTO facsimile telephone number (703-305-5408), of sixteen pages. Therefore, the application was never in-fact abandoned and any holding of abandonment for failure to timely file a proper response to the Office letter mailed on March 13, 2003 is hereby vacated, and the application is returned to pending status.

The application shall be forwarded to the examiner for processing and consideration of the papers originally filed June 6, 2003 by facsimile transmission and a copy of which is provided as an attachment to the instant petition.

The Petition is **GRANTED**.

JMStone

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

WEINGARTEN, SCHURGIN, GAGNEBIN & LEBOVICI LLP
TEN POST OFFICE SQUARE
BOSTON MA 02109

UNITED STATES PATENT AND TRADEMARK OFFICE

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

SMITH & HOPEN PA
15950 BAY VISTA DRIVE
SUITE 220
CLEARWATER, FL 33760

COPY MAILED

JUL 2 5 2005

OFFICE OF PETITIONS

In re Application of :
Emmanuel Lazaridis :
Application No. 09/913,498 :
Filed: August 16, 2001 :
Attorney Docket No. 114205.204 :

ON PETITION

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

The petition is **GRANTED.**

The above-identified application became abandoned for failure to reply in a timely manner to the final Office action mailed August 11, 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. An Advisory action was mailed February 9, 2005 indicating that the reply filed on November 12, 2004 failed to place the application in condition for allowance. Accordingly, the application became abandoned on November 12, 2004.

In view of the submission of the petition fee in the small entity amount of $750, status as a small entity remains. If the application is, in fact, entitled to large entity status, petitioner should promptly file a petition under 37 CFR 1.28.

The petition satisfies the requirements of 37 CFR 1.137(b) in that petitioner has supplied (1) the reply in the form of an Amendment and a Request for Continued Examination (RCE); (2) the petition fee of $750; and (3) an adequate statement of unintentional delay.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3229.

The application matter is being forwarded to Technology Center 1600, Art Unit 1631 for processing the Request for Continued Examination under 37 CFR 1.114 filed with the instant petition.

Retta Williams

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

UNITED STATES PATENT AND TRADEMARK OFFICE

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

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,577	01/25/2002	Toshihiro Morita	275734US6PCT	4188

22850 7590 02/04/2008
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER
POND, ROBERT M

ART UNIT	PAPER NUMBER
3625	

NOTIFICATION DATE	DELIVERY MODE
02/04/2008	ELECTRONIC

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

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

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

UNITED STATES 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
FROM DIRECTOR'S OFFICE

FEB 01 2008

TECHNOLOGY CENTER 3600

Bradley D. Lytle
OBLON, SPIVAK, MCCLELLAND MAIER
& NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

Inventor: TOSHIHIRO MORITA, et al.	PETITION FOR CONSIDERATION OF IDS FILED AUGUST 15, 2001 UNDER 37 C.F.R. 1.181
Application No. 09/913,577	
Attorney Docket No.: 275734US6PCT	
Filed: January 25,2002	
For: METHOD AND APPARATUS FOR INFORMATION PROCESSING, AND MEDIUM FOR STORING PROGRAM	

This is in response to Applicant's petition filed on December 14, 2007 to have the Examiner consider references "AK"-"AN" and "AS"-"AT" filed with the IDS of August 15, 2001.

The petition is **GRANTED**.

In citing MPEP 609.04(a)(III), Petitioner implies that the Examiner refused consideration of these references for failure to satisfy 37 CFR 1.98(a)(3)(i). Inasmuch as the Examiner has not provided a specific reason that such references were not considered, this decision will address compliance with both 37 CFR 1.97 and 1.98.

37 CFR 1.97(a) states:
"In order for an applicant for a patent or for a reissue of a patent to have an information disclosure statement in compliance with § 1.98 considered by the Office during the pendency of the application, the information disclosure statement must satisfy one of paragraphs (b), (c), or (d) of this section."

37 CFR 1.97(b) states:
"An information disclosure statement shall be considered by the Office if filed by the applicant within any one of the following time periods:

(1) Within three months of the filing date of a national application other than a continued prosecution application under § 1.53(d);
(2) Within three months of the date of entry of the national stage as set forth in 1.491 in an international application;
(3) Before the mailing of a first Office action on the merits; or
(4) Before the mailing of a first Office action after the filing of a request for continued examination under § 1.114."

A review of the file reveals that the IDS was filed August 15, 2001. A first Office action on the merits was not mailed until October 18, 2005. Accordingly, the IDS is in compliance with at least 37 CFR 1.97(b)(3).

37 CFR 1.98(3)(i) requires:
"A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from applicant's specification or incorporated therein."

MPEP 609.04(a)(III) states:
"Where the information listed is not in the English language, but was cited in a search report or other action by a foreign patent office in a counterpart foreign application, the requirement for a concise explanation of relevance can be satisfied by submitting an English-language version of the search report or action which indicates the degree of relevance found by the foreign office. This may be an explanation of which portion of the reference is particularly relevant, to which claims it applies, or merely an "X", "Y", or "A" indication on a search report."

A review of the file reveals that the IDS filed August 15, 2001 included an English-language version of International Search Report (ISR) for International application No. PCT/JP00/08914 (the International application from which this National Stage application takes priority). Such ISR listed all of the references identified as "AK"-"AN" and "AS"-"AT" in the IDS filed August 15, 2001 and included at least an "X", "Y", or "A" indication associated with each. The IDS further included legible copies of each of these references and a statement that "[The enclosed copies of the cited publications were] cited in the International Search Report of International Application No.

PCT/JP00/08914". Accordingly, the IDS is also in compliance with at least 37 CFR 1.98(a)(3)(i).

It is also noted upon a thorough review of the file that the IDS filed August 15, 2001 additionally fully complies with all of the requirements regarding the content of the Information Disclosure Statement under 37 CFR 1.98.

Summary:

The IDS filed August 15, 2001 satisfied the requirements of both 37 CFR 1.97 and 1.98.

The petition is **GRANTED**.

The file has been forwarded to the Examiner for consideration of references "AK"-"AN" and "AS"-"AT" filed with the IDS of August 15, 2001 and for any further action consistent with this decision.

Any questions dealing with this decision should be directed to Jeffrey A. Smith at (571) 272-6763.

Wynn Coggins, Director
Patent Technology Center 3600
(571)-272-5350

WC/jas:12/16/07
SM

UNITED STATES PATENT AND TRADEMARK OFFICE

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

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA VA 22314

MAILED

OCT 01 2007

Technology Center 2100

In re Application of:
MORITA, Toshihiro et al.
Application No. 09/913,586
Filed: August 15, 2001
For: **INFORMATION PROCESSING APPARATUS AND ASSOCIATED METHOD OF TRANSFERRING GROUPED CONTENT**

DECISION ON PETITION TO WITHDRAW THE 37 CFR 1.105 REQUIREMENT FOR INFORMATION

This is a decision on the petition, filed on August 16, 2006, under 37 CFR 1.181 to withdraw the requirement for information under 37 CFR 1.105.

The petition is **GRANTED**.

Applicant states that the requests for items (A) and (F) of the 1.105 requirement is improper. Items (A) and (F) from the examiner's action dated July 7, 2006 stated the following:

(A) Stipulate whether each and every individually cited reference listed on the IDS(s) submitted on 05/17/2006, 2/15/2006, 02/01/2006, 12/23/2005, 08/23/2005, 08/11/2003 and 08/15/2001 is material to the patentability of the instant application; the applicant may either agree or disagree for each cited reference.

(F) In order to constitute a complete response Applicant is required to include stipulations for each and every reference cited in the IDS submission(s) dated 5/17/2006, 2/15/2006, 2/1/2006, 12/23/2005, 8/23/2005, 8/11/2003 and 8/15/2001 as well as each and every IDS submission thereafter, as delineated in requirement A.

Applicant's basis for the improper 1.105 requirement is that under 37 CFR 1.97(h) the filing of information disclosure statement is not considered to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 CFR 1.56. Information relative to the materiality of each reference is either unknown or not readily available to Applicants. The Examiner determines what is material, not Applicants, and thus the Rule 105 improperly requests Applicants to express their opinion. Moreover, Applicants respectfully submit that they are not required to formulate such an opinion as noted above. Accordingly, Applicants respectfully submit that this request for information is improper.

REGULATION AND PROCEDURES

MPEP 704.11 states that:

There must be a reasonable basis for the information required that would aid in the examination of an application or treatment of some matter. A requirement for information under 37 CFR 1.105 places a substantial burden on the applicant that is to be minimized by clearly focusing the reason for the requirement and the scope of the expected response. Thus, the scope of the requirement should be narrowly defined, and a requirement under 37 CFR 1.105 may only be made when the examiner has a reasonable basis for requiring information.

The terms "factual" and "facts" are included in 37 CFR 1.105 to make it clear that it is facts and factual information, that are known to applicant, or readily obtained after reasonable inquiry by applicant, that are sought, and that requirements under 37 CFR 1.105 are not requesting opinions that may be held or would be required to be formulated by applicant. Where the factual information requested related to the subject application, and details thereof, applicant would be expected to make a reasonable inquiry under the circumstances to find the factual information requested (37 CFR 10.18(b)(2)). Applicant need not, however, derive or independently discover a fact, such as by experimentation, in response to a requirement for information. The purpose of 37 CFR 1.105 is to improve patent quality, and render better decisions, and not to put applicants in jeopardy of meeting their duties of candor and good faith in their replies to a requirement for information.

Decision

The Applicant's remarks are persuasive and the petition is **GRANTED**. The suspension and shortened statutory period established in the paper mailed July 24, 2006 are withdrawn. The application is restored to amended status and the file forwarded to the examiner to act promptly on the amendments filed December 23, 2005 and April 10, 2006.

Any question concerning this decision should be directed to John Follansbee whose telephone number is 571-272-3964.

The application is being forwarded to the examiner for appropriate action.

Paul Sewell, Director
Technology Center 2100

2855

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov
dlw 02-04

DORSEY & WHITNEY LLP
INTELLECTUAL PROPERTY DEPARTMENT
4 EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO CA 94111

COPY MAILED

FEB 0 9 2004

OFFICE OF PETITIONS

In re Application of	:	
Lazarev et al.	:	
Application No. 09/913,591	:	ON PETITION
Filed: 16 August, 2001	:	
Attorney Docket No. 033054-008	:	

This is a decision on the petition under 37 CFR 1.137(b),[1] filed on 16 January, 2004, to revive the above-identified application.

The petition is **GRANTED**.

This application became abandoned on 19 July, 2003, for failure to reply to the non-final Office action mailed on 18 April, 2003, which set a three (3) month shortened statutory period for reply.

---

[1]Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional 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)).

No extensions of the time for reply in accordance with 37 CFR 1.136(a) were obtained. The filing of the present petition precedes the mailing of Notice of Abandonment.

The petition fee of $665.00 will be charged to counsel's deposit account, No. 50-2319, as authorized in the present petition.

The application is being forwarded to Technology Center 2800 for further processing.

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

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

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

POLYONE CORPORATION
33587 WALKER ROAD
AVON LAKE, OH 44012

Mail Date: 04/21/2010

Applicant	: Jorg Vortkort	: DECISION ON REQUEST FOR
Patent Number	: 6774162	: RECALCULATION of PATENT
Issue Date	: 08/10/2004	: TERM ADJUSTMENT IN VIEW
Appliction No	: 09/913,613	: OF WYETH
Filed	: 08/15/2001	:
		:

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

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

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

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

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

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

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

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

or

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

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

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

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

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

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)
6668949	2003-12-30	09913626	2001-08-17	RIV-02

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

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

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

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

SURCHARGE
The surcharge required by 37 CFR 1.20(i)(2) (Fee Code 1558) must be paid as a condition of accepting unintentionally delayed payment of the maintenance fee.

MAINTENANCE FEE (37 CFR 1.20(e)-(g))
The appropriate maintenance fee must be submitted with this petition.

STATEMENT
THE UNDERSIGNED CERTIFIES THAT THE DELAY IN PAYMENT OF THE MAINTENANCE FEE TO THIS PATENT WAS UNINTENTIONAL

PETITIONER(S) REQUEST THAT THE DELAYED PAYMENT OF THE MAINTENANCE FEE BE ACCEPTED AND THE PATENT REINSTATED

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

37 CFR 1.378(d) states: "Any petition under this section must be signed by an attorney or agent registered to practice before the Patent and Trademark Office, or by the patentee, the assignee, or other party in interest."

I certify, in accordance with 37 CFR 1.4(d)(4) that I am

◉ An attorney or agent registered to practice before the Patent and Trademark Office

○ A sole patentee

○ A joint patentee; I certify that I am authorized to sign this submission on behalf of all the other patentees.

○ A joint patentee; all of whom are signing this e-petition

○ The assignee of record of the entire interest

Patent Practitioner			
A signature of the applicant or representative is required in accordance with 37 CFR 1.33 and 10.18. Please see 37 CFR 1.4(d) for the form of the signature			
Signature	/David B. Dickinson/	Date (YYYY-MM-DD)	2008-10-22
Name	David B. Dickinson	Registration Number	47525

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. 6668949
Issue Date: December 30,2003
Application No. 09913626
Filed: August 17,2001
Attorney Docket No. A-3990/RIV-02

:DECISION GRANTING PETITION
:UNDER 37 CFR 1.378(c)

This is a decision on the electronic petition, filed October 22,2008 ,under 37 CFR 1.378(c) to accept the unintentionally delayed payment of the 3.5 year maintenance fee for the above-identified patent.

The petition is **GRANTED**.

The maintenance fee is accepted, and the above-identified patent reinstated as of October 22,2008 . This decision also constitutes notice that the fee has been accepted. An electronic copy of the petition and this decision has been created as an entry in the Image File Wrapper. Nevertheless, petitioner should print and retain an independent copy.

Telephone inquiries related to this electronic decision should be directed to the Electronic Business Center at 1-866-217-9197.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

JUL 12 2004

Yankwich and Associates
201 Broadway
Cambridge, Massachusetts.
02139

In re Application of:
Denise L. Faustman
Serial No.: 09/913,664
Filed: August 17, 2001
Attorney Docket No.: DLF-002.1P US

DECISION ON PETITION TO ENTER APPLICANT'S 37 C.F.R. § 1.132 DECLARATION AFTER FINAL REJECTION

This is in response to the petition under 37 C.F.R. § 1.181(a)(1), filed on June7, 2004, requesting entry of a 37 C.F.R. § 1.132 declaration after final rejection.

BACKROUND

In response to the final Office Action issued September 24, 2003, Applicant submitted a Notice of Appeal and a response including a declaration of the inventor pursuant to 37 C.F.R. § 1.132 in order to address and dispute the Examiner's interpretation of the primary references relied on in rejecting Applicant's claims under 35 U.S.C. § 102(b) and 35 U.S.C. § 103. This declaration was refused entry on the Advisory Action that was issued on May 7, 2004 on the grounds that good and sufficient reasons were not provided why the declaration was not presented earlier.

DISCUSSION

Applicant's state that the declaration was included in the Response to the final Office Action of September 24, 2003 in order to address and dispute the Examiner's interpretation of the primary references raised for the first time.

A review of the application file record reveals that the Examiner in the final Office action disputed the biological effect of the donor tissue pretreatments taught by Oliver et al. for the first time, thus making the biological effects of the procedures taught by Oliver et al. a contested fact between the Office and Applicant. In response to this interpretation of the references adopted by the Examiner in the final Office Action, Applicant conducted a series of experiments to demonstrate that the methods taught and claimed in the Oliver et al. patents could not anticipate or render obvious Applicant's claimed methods. Accordingly, it is concluded that the declaration was deemed necessary in order to provide the Examiner with documented evidence of Applicant's position.

DECISION

The petition is **GRANTED**.

The application will be forwarded to the examiner for further consideration not inconsistent with this decision.

Should there be any questions about this decision, please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile at 703-872-9306.

Bruce Kisliuk
Director, Technology Center 1600

MAR 2 9 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

#6

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Patton Boggs
P.O. Box 270930
Louisville, CO 80027

In re Application of:	:	
Rump et al.	:	
Application No.: 09/913,686	:	DECISION
PCT No.: PCT/EP99/09981	:	
Int. Filing Date: 15 December 1999	:	UNDER
Priority Date: 16 February 1999	:	
Atty. Docket No.: 13189.137	:	37 CFR 1.47
For: Method And Device For Producing An	:	
Encrypted Payload Data Stream And	:	
Method And Device For Decrypting...	:	

This is in response to the papers filed under 37 CFR 1.47(a) on 24 January 2002.

BACKGROUND

This international application was filed on 15 December 1999, and claimed an earliest priority date of 16 February 1999. The International Bureau transmitted a copy of the published international application to the United States Patent and Trademark Office on 24 August 2000. A Demand electing the United States was filed on 13 September 2000, which was prior to the elapse of 19 months from the priority date. Accordingly, the thirty month period for paying the basic national fee in the United States expired as of midnight on 16 August 2001.

On 16 August 2001, applicant filed the basic national fee accompanied by, *inter alia*, a Transmittal Letter.

On 18 October 2001, a Notification of Missing Requirements was transmitted to applicants, requiring the submission of an oath or declaration of the inventors and a surcharge under 37 CFR 1.492(e).

Applicants filed the instant papers on 24 January 2002.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own

behalf and on behalf of the non-signing joint inventor. Petitioner has satisfied requirements (1), (3) and (4).

Regarding requirement (1), the petition fee is being charged to Counsel's Deposit Account No. 50-1848, as authorized by the Transmittal Letter filed on 16 August 2001.

Regarding requirement (2), the evidence now of record establishes that the missing joint inventor, Niels Rump, cannot be reached after diligent effort.

With respect to requirement (3), the petition includes a statement of the last known address of the missing inventor.

With respect to requirement (4), the petition is accompanied by an appropriate declaration.

For the reasons discussed above, it would be appropriate to grant the requested relief on the basis of the present record.

CONCLUSION

The petition is **GRANTED**.

The Application Division and the International Division are authorized to accept the application as a 37 CFR 1.47(a) application and to mail a filing receipt. The application will be given an international filing date of 15 December 1999 under 35 U.S.C. 363, and a 35 U.S.C. 371 date of **24 January 2002**.

As provided by 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of this application under 37 CFR 1.47(a) will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

APR 0 8 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Carl Forest
Patton Boggs
P.O. Box 270930
Louisville, CO 80027

In re Application of RUMP, Niels, et al. Application No.: 09/913,690 PCT No.: PCT/EP99/09980 Int. Filing Date: 15 December 1999 Priority Date: 16 February 1999 Attorney Docket No.: 13189.138 For: METHOD AND APPARATUS FOR GENERATING A DATA STREAM AND METHOD AND DEVICE FOR PLAYING A DATA STREAM	DECISION ON PETITION UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Statement of Facts In Support of Filing On Behalf of Nonsigning Inventor (37 C.F.R. Section 1.47)," filed in the United States Patent and Trademark Office (USPTO) on 24 January 2002.

BACKGROUND

On 15 December 1999, applicants filed international application PCT/EP99/09980, which claimed a priority date of 16 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 24 August 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 13 September 2000, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 16 August 2001.

On 16 August 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 19 October 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge for late filing of oath or declaration were required.

On 24 January 2002, applicants submitted the instant petition under 37 CFR 1.47, which was accompanied by, *inter alia*, a combined declaration and power of attorney executed by inventors Juergen Koller and Karlheinz Brandenburg.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign or cannot be reached after diligent effort,

(3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant.

Items (1) and (4) have been met. (1) The petition fee of $130 has been paid. (4) The declaration submitted is accepted as complying with 37 CFR 1.47(a).

Item (2) has not been met. Applicants are asserting that the nonsigning inventor cannot be reached after diligent effort. It is noted that had this petition been based on the refusal of inventors to sign the declaration, applicants would have had to demonstrate that *bona fide* attempt was made to present a copy of the application papers to the inventors. MPEP 409.03(d).

Under 37 CFR 1.47(a), the petition must supply proof of pertinent facts. It is noted that "copies of documentary evidence, such as a internet searches, certified return mail receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached" should be included. MPEP §409.03(d).

In this case, Mr. Schoppe states a request was submitted to the residence registration office in Erlangen and the telephone inquiry office. These are not documented. Further, a statement should outline what steps, *e.g.*, internet searches, were taken to locate Mr. Rump beyond searching in Erlangen.

Item (3) has not been met. Applicants list the last known address of Niels Rump as Brueckenstrasse 13, Erlagen D-91056, Germany. This is also the address listed on the declaration. However, the inquiry at the residence registration office was in Erlangen and the letters were directed to an address in Erlangen.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the Office of PCT Legal Administration.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: 703-305-0455
Facsimile: 703-308-6459

FEB 2 8 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#4

Marc D. Machtinger
Law Offices of Marc D. Machtinger
750 W. Lake Cook Road Suite 350
Buffalo Grove, IL 60089

In re Application of
SALINAS
Application No.: 09/913,702
PCT No.: PCT/ES00/00490
Int. Filing Date: 27 December 2000
Priority Date: 31 December 1999
Attorney Docket No.: 279 P002
For: MACHINE FOR APPLYING FIBERGLASS REINFORCEMENTS IN DISPOSABLE COLUMN FORMS

DECISION ON PETITION
UNDER 37 CFR 1.137(b)

The petition to revive under 37 CFR 1.137(b) filed 23 January 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has submitted the basic national fee of $500 and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision. The 35 U.S.C. 371(c) date is **23 January 2002**.

Anthony Smith

Anthony Smith
Attorney-Advisor
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

08 JUN 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Marc D. Machtinger
Law Offices of Marc D. Machtinger
750 W. Lake Cook Road Suite 350
Buffalo Grove, IL 60089

In re Application of	:	
SALINAS	:	
Application No.: 09/913,703	:	DECISION ON PETITION
PCT No.: PCT/ES00/00496	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 28 December 2000	:	
Priority Date: 04 January 2000	:	
Attorney Docket No.: 279 P003	:	
For: FORMWORK FOR CYLINDRICAL COLUMNS		

The petition to revive under 37 CFR 1.137(b) filed 23 January 2002 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements of 37 CFR 1.137(b)(3).

A review of the application file reveals that applicant has submitted the basic national fee of $520 and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being returned to the United States Designated/Elected Office for processing in accordance with this decision. The 35 U.S.C. 371(c) date is **23 January 2002**.

Anthony Smith

Anthony Smith
Attorney-Advisor
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

JAN 3 1 2002

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Arthur R. Crawford
Nixon & Vanderhye, P.C.
1100 North Glebe, 8th Floor
Arlington, VA 22201-4714

In re Application of	:	
ISHIYAMA et al.	:	DECISION ON
Application No.: 09/913,722	:	PAPERS UNDER 37 CFR 1.42
PCT No.: PCT/US00/04001	:	
Int. Filing Date: 17 February 2000	:	
Priority Date: 18 February 1999	:	
Attorney Docket No.: 2554-9	:	
For: NOVEL AMIDE DERIVATIVES AS GROWTH HORMONE		

This a response to "Submission of Proof of Legal Representative under 37 CFR 1.42" filed 17 December 2001 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 17 February 2000, applicants filed international application PCT/US00/04001, which claimed a priority date of 18 February 1999. A proper Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 18 August 2001.

On 17 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and a preliminary amendment.

On 15 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 17 December 2001, applicant filed "Submission of Proof of Legal Representative under 37 CFR 1.42" which included a declaration and power of attorney executed by nine joint inventors and Linda Joyce Maki on behalf of deceased inventor Gilda H. Loew.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

> In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declaration submitted on 17 December 2001 was executed by Linda Joyce Maki as "legal representative" to the deceased inventor Gilda H. Loew. Counsel avers that, "[i]nventor Gilda H. Loew is deceased. The inventors' declaration under Rule 63 is executed by her legal representative Linda Joyce Maki . . . " Therefore, the declaration submitted on 17 December 2001 appears to have been executed by the proper party under 37 CFR 1.42. However, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

> (2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to revised 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(b)(2), the declaration must also provide residence, citizenship, and post office address for the legal representative. The declaration filed on 17 December 2001 provides this information with respect to the deceased inventor, but <u>not</u> the legal representative. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is <u>REFUSED</u>.

Applicant is required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTH** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Anthony Smith
Attorney-Advisor
PCT Legal Office
Tel: (703) 308-6314
Fax: (703) 308-6459

28 JUN 2002

#6

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Arthur R. Crawford
Nixon & Vanderhye, P.C.
1100 North Glebe, 8th Floor
Arlington, VA 22201-4714

In re Application of	:	DECISION ON
ISHIYAMA et al.	:	PAPERS UNDER 37 CFR 1.42
Application No.: 09/913,722	:	
PCT No.: PCT/US00/04001	:	
Int. Filing Date: 17 February 2000	:	
Priority Date: 18 February 1999	:	
Attorney Docket No.: 2554-9	:	
For: NOVEL AMIDE DERIVATIVES AS GROWTH HORMONE		

This is a response to "Renewed Submission under 37 CFR 1.42" filed 12 March 2002. No petition fee is required.

BACKGROUND

On 17 February 2000, applicants filed international application PCT/US00/04001, which claimed a priority date of 18 February 1999. A proper Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire on 18 August 2001.

On 17 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee and a preliminary amendment.

On 15 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.497 and the surcharge fee required under 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 17 December 2001, applicant filed "Submission of Proof of Legal Representative under 37 CFR 1.42" which included a declaration and power of attorney executed by nine joint inventors and Linda Joyce Maki on behalf of deceased inventor Gilda H. Loew.

In a decision dated 31 January 2002, applicant's request under 37 CFR 1.42 was dismissed because the declaration and power of attorney was not in compliance with 37 CFR 1.497.

On 12 March 2002, applicant filed the present request and declaration and power of attorney.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration filed 12 March 2002 is executed by Linda J. Maki as the "'legal representative" of the deceased inventor, Gilda H. Loew. The declaration submitted on 12 March 2002 appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration provided sets forth only the information (citizenship, residence, and mailing address) for the legal representative. Since the previously submitted declaration included the information (citizenship, residence, and mailing address) for the deceased inventor, the present declaration taken in combination with the previously submitted declaration fulfills the requirements of 37 CFR 1.497.

Accordingly, the requirements for entry into national stage under 35 U.S.C. 371(c) were completed as of 05 March 2001.

CONCLUSION

The papers filed under 37 CFR 1.42 are **ACCEPTED**.

The application has an international filing date of 17 February 2000, under 35 U.S.C. 363, and a 35 U.S.C. 371(c) date of **12 March 2002**.

This application is being forwarded to the National Stage Processing Branch of the International Division for continued national stage processing.

Richard Cole
PCT Legal Examiner
Office of PCT Legal Administration

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BAKER & BOTTS
30 ROCKEFELLER PLAZA
44TH FLOOR
NEW YORK NY 10112-4498

COPY MAILED
DEC 12 2006
OFFICE OF PETITIONS

In re Application of	:	
Kathleen R. McKeown et al	:	
Application No. 09/913,745	:	DECISION GRANTING PETITION
Filed: December 10, 2001	:	UNDER 37 CFR 1.137(b)
Attorney Docket No. A32313-PCT	:	

This is a decision on the petition under 37 CFR 1.137(b), filed July 31, 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 RCE and previously filed amendment on June 22, 2006; (2) the petition fee; and (3) the required statement of unintentional delay have been received. Accordingly, the reply to the Final Rejection of December 27, 2005, is accepted as having been unintentionally delayed.

Telephone inquiries concerning this decision should be directed to the undersigned at (571) 272-3208.

This matter is being referred to Technology Center AU 2162.

Karen Creasy

Karen Creasy
Petitions Examiner
Office of Petitions

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : November 22, 2005

TO SPE OF : ART UNIT 1654

SUBJECT : Request for Certificate of Correction on Patent No.: 6,773,912

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:

BRUCE R. CAMPELL, PH.D
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Bruce Campell — **SPE**

1654 — **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

FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE
NEW YORK, NY 10151

COPY MAILED

SEP 1 9 2008

OFFICE OF PETITIONS

In re Patent No. 6,773,912	:	
Application No. 09/913,763	:	
Filed: December 21, 2001	:	ON PETITION
Issued: August 10, 2004	:	
Attorney Docket No. 512585-2001	:	

This is a decision on the petition filed June 18, 2008, which is being treated as a request under 37 CFR 3.81(b)[1] to correct the front page of the above-identified patent by way of a Certificate of Correction.

The request is **GRANTED**.

A Certificate of Correction was issued on August 5, 2008.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3206. Inquiries regarding the Certificate of Correction should be directed to the Certificate of Correction Branch at (571) 272-4200.

Liana Walsh
Petitions Examiner
Office of Petitions

[1] *See* MPEP 1309, subsection II; and 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
www.uspto.gov
AMB

Paper No. 8

HEAD, JOHNSON & KACHIGIAN
228 W 17TH PLACE
TULSA, OK 74119

COPY MAILED
SEP 02 2003
OFFICE OF PETITIONS

In re Application of
Wideman, et al.
Application No. 09/913,774
Filed: August 13, 2001
Atty. Dkt No.:00038

: ON PETITION

This is a decision on the petition filed August 4, 2003 under 37 CFR 1.182 to change the order of inventors in the above-identified application.

The current Office procedure for changing the order of inventors named in an application involves submitting a petition under 37 CFR 1.182 signed by either the attorney or agent of record or all of the applicants designating the desired changed.

The instant petition has met the criteria for changing the order of named inventors. Accordingly, the petition is **GRANTED**.

The order of inventors will be changed as follows:

1. ROBERT F. WIDEMAN, JR.
2. GISELA F. ERF
3. HOWARD L. FRENCH

This application is being forwarded to the Office of Initial Patent Examination for correction of the file wrapper label and the PALM database regarding the order of inventorship.

Telephone inquiries pertaining to this decision should be directed to the undersigned at (703) 305-0310.

Alesia M. Brown
Senior Petitions Attorney
Office of Petitions

APR 3 0 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Dennis E. Stenzel
CHERNOFF, VILHAUER, McCLUNG &
STENZEL
1600 ODS Tower
601 S.W. Second Avenue
Portland, Oregon 97204-3157

In re Application of	:	
Vincenzo VASSAROTTI (deceased)	:	
Application No.: 09/913,781	:	DECISION ON
PCT No.: PCT/EP00/00976	:	PAPERS FILED
Int. Filing Date: 08 February 2000	:	UNDER 37 CFR 1.42
Priority Date: 15 February 1999	:	
Attorney Docket No.: 3568.069	:	
For: DEVICE FOR CONCENTRATING AND	:	
PURIFYING MACROMOLECULES	:	

This is a decision on the papers filed 16 January 2002.

On 08 February 2000, applicant filed international application PCT/EP00/00976, which claimed priority of an earlier Swedish application filed 15 February 1999. A copy of the international application was received by the United States Patent and Trademark Office from the International Bureau on 24 August 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 06 September 2000. Accordingly, the thirty month period for paying the basic national fee in the United States expired at midnight on 15 August 2001. Applicant paid the basic national fee of $860.00 on 14 August 2001.

In order to satisfy the requirement of 35 U.S.C. 371(c) and 37 CFR 1.495 that an oath or declaration of the inventor be submitted, applicant submitted the following papers on 16 January 2002:

1. a declaration under 37 CFR 1.497 signed by Salvatore Aversano as executor of the estate of deceased inventor Vincenzo VASSAROTTI.

2. a certified copy of the original Certificate of Appointment of Executor issued by

the District Court of Gilly and translation thereof reflecting that Salvatore Aversano is the appointed executor of the estate of deceased inventor Vincenzo VASSAROTTI.

A review of the application file reveals that a translation of the international application has not been submitted. The substitute specification filed 14 August 2001 is not a true and accurate translation of the application as filed. Here are a few examples:

- The title is incomplete.
- The first paragraph of the international application has been deleted. The following paragraphs have been rewritten.
- The description of Figure 15 is not a true translation of the original description of Figure 15 as published.
- No translation of the list of special features represented in the drawings has been provided.
- Claim 1 has been amended to add sub-paragraphs (a), (b), etc, and claims 8-9 have been added.

CONCLUSION

The above application and papers have been reviewed and found to be in compliance with 37 CFR 1.42.

The papers filed under 37 CFR 1.42 are ACCEPTED.

The application is being returned to the United States Designated/Elected Office for further processing, including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) to inform applicant that a true and accurate translation of the application as filed along with the $130.00 surcharge fee for submitting the translation after 30 months from the priority date must be submitted in order to avoid abandonment of the application as to the national stage in the United States. The declaration is acceptable under 37 CFR 1.497.

Boris Milef
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

NNH/BM:hn

Tel: (703) 308-6508

NOV 2 0 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Chad S. Hilyard
Two Embarcadero Center
Eighth Floor
San Francisco, California 94111-3834

In re Application of	:	
Simon ARMOUR, et al.	:	
Application No.: 09/913,840	:	DECISION ON
PCT No.: PCT/GB00/00174	:	PETITION
Int. Filing Date: 24 January 2000	:	UNDER 37 CFR 1.137(b)
Priority Date: 22 January 1999	:	
Attorney Docket No.: None	:	
For: OFDM RECEIVER WITH ADAPTIVE EQUALISER	:	

The petition to revive under 37 CFR 1.137(b) filed 16 August 2001 in the above-captioned application is hereby **GRANTED** as follows:

The appropriate petition fee as required by 37 CFR 1.17(m) has been submitted.

All of the requirements of 37 CFR 1.137(b) for revival have been submitted. Applicants' statement that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" meets the requirements under 37 CFR 1.137(b)(3) at the time of filing this petition.

A review of the application file reveals that an oath or declaration of the inventors in compliance with 37 CFR 1.497 has not been filed.

Applicants' claim for priority is acknowledged. The application has an international filing date of **24 January 2000** under 35 U.S.C. 363.

The request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

The application is being forwarded to the United States Designated/Elected Office for further processing including the issuance of a Notification of Missing Requirements under 35

U.S.C. 371(c) and 37 CFR 1.494 (Form PCT/DO/ EO/905) to inform applicants that an oath or declaration of the inventors must be filed in order to avoid abandonment of the application as to the national stage in the United States.

Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

Nguyên Ngoc-Hô
Paralegal Specialist
PCT Legal Office

NNH/LES:hn

Tel: (703) 308-6508

DO NOT SEND TO WAREHOUSE

NOTICE RE: CERTIFICATES OF CORRECTION

DATE : 8/15/03 **Paper No.:** 6

TO : **Supervisor, Art Unit** 1626

SUBJECT : Certificate of Correction Request in Patent No.: 6,500,966

A response to the following question is requested with respect to the accompanying request for a certificate of correction.

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

PLEASE COMPLETE THIS FORM AND RETURN WITH FILE, WITHIN 7 DAYS, TO CERTIFICATES OF CORRECTION BRANCH - PK 3-915/922
PALM LOCATION 7580 - TEL. N0. 305-8309

THANK YOU FOR YOUR ASSISTANCE!

Note your decision by placing a check mark in the appropriate box below, indicating whether all **changes requested in the Request for Certificate of Correction should be applied. Please specify which changes should not be applied and indicate the reason(s) for denial, in the "Comments" section below.**

☒ **YES** ☐ **NO**

☐ **Comments:** All changes OK.

JOSEPH K. McKANE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Supervisor **Art Unit** 1626

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

JAN 20 2006

OFFICE OF PETITIONS

GARVEY SMITH NEHRBASS & NORTH
LAKEWAY 3, SUITE 3290
3838 NORTH CAUSEWAY BLVD.
METAIRIE LA 70002

In re Application of	:	
Colin Ramshaw et al	:	
Application No. 09/913,905	:	ON PETITION
Filed: January 23, 2002	:	
Attorney Docket No. A01205US	:	

This is a decision on the petition, filed January 18, 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 23, 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 1764 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
WASHINGTON, D.C. 20231
www.uspto.gov

DEC 12 2001

Nancy W. Vensko
Knobbe, Martens, Olson & Bear
620 Newport Center Drive, Sixteenth Floor
Newport Beach, CA 92660

In re Application of NABEL, Gary J., et al. Application No.: 09/913,909 PCT Application No.: PCT/US98/27364 International Filing Date: 23 December 1998 Priority Date: 23 December 1997 Attorney Docket No.: NIH220.001APC For: IMMUNIZATION FOR EBOLA VIRUS INFECTION	DECISION ON PETITION UNDER 37 CFR 1.137(b)

Applicants' "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office on 17 August 2001 is **GRANTED**.

BACKGROUND

On 23 December 1998, applicants filed an international application, No. PCT/US98/27364, which claimed a priority date of 23 December 1997. A copy of the application was not required as the application was filed in the United States Receiving Office (RO/US).

Applicants elected the US in a demand filed on 23 July 1999. The deadline for entering the national stage was thus thirty months from the priority date, 23 June 2000. The application went abandoned when applicants failed to make the necessary filing.

On 17 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, a petition to revive the international application; the requisite petition fee; the requisite basic national fee as required by 35 U.S.C. §371(c)(1); and a declaration as required by 35 U.S.C. §371(c)(4).

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) 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, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicants state "the entire delay in filing the required reply from the due date for the required reply until the filing of this petition under 37 CFR 1.137(b) was unintentional." As "this petition" is a grantable petition, the statement complies with 37 CFR 1.137(b)(3). The appropriate national fee, petition fee and international application have been submitted. A terminal disclaimer is not required as application was filed on 23 December 1998. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

The $130.00 surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) will be charged to counsel's Deposit Account No. 11-1410 as authorized in the transmittal letter filed 17 August 2001.

CONCLUSION

The petition to revive the application abandoned under 37 CFR 1.137(b) is **GRANTED** as to the National Stage in the United States of America. The application has an international filing date of 23 December 1998 under 35 U.S.C. §363 and a date of 17 August 2001 under 35 U.S.C. §371. This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing.

Erin M. Pender
Attorney Advisor
PCT Legal Office

Richard Cole
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

FEB 1 5 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Burns, Doane, Swecker & Mathis, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

In re Application of PACHOLIK et al	:	
U.S. Application No.: 09/913,938	:	
Int. Application No.: PCT/SE00/00066	:	DECISION
Int. Filing Date: 14 January 2000	:	
Priority Date: 02 March 1999	:	
Attorney Docket No.: 003300-817	:	
For: COPPER RECOVERY PROCESS	:	

This is in response to the papers filed 07 February 2002, including a copy of a declaration purportedly filed on 02 October 2001. The submission is being treated as a petition to treat the declaration as having been filed on 02 October 2001. No petition fee is due.

BACKGROUND

On 14 January 2000, applicants filed international application PCT/SE00/00066, which claimed priority of an earlier Sweden application filed 02 March 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 08 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 September 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 September 2001 (02 September 2001 was a Sunday preceding a Monday holiday).

On 20 August 2001, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 15 October 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 07 February 2002, applicants filed the present petition. The petition states that a declaration was filed on 02 October 2001. The petition further states that it is accompanied by a

copy of the declaration and a copy of a return postcard receipt which bears a USPTO date stamp of 02 October 2001.

DISCUSSION

MPEP 503 states, in relevant part,

> The postcard receipt will not serve as *prima facie* evidence of receipt of any item which is not adequately itemized on the postcard. . . . Each separate component should be specifically and properly itemized on the postcard.

In the present case, the copy of the return postcard receipt does not list a declaration in its itemized contents. Therefore, applicants are not entitled to the relief requested.

It is further noted that the declaration filed with the present petition is improper. Specifically, the declaration does not identify the specification to which it is directed as required by 37 CFR 1.497(a)(2).

CONCLUSION

For the reasons above, the present petition is DISMISSED without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Applicants are reminded of the requirement to respond to the Notification of Missing Requirements mailed 15 October 2001.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

FEB 2 6 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Burns, Doane, Swecker & Mathis, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

In re Application of PACHOLIK et al	:	
U.S. Application No.: 09/913,938	:	
Int. Application No.: PCT/SE00/00066	:	DECISION
Int. Filing Date: 14 January 2000	:	
Priority Date: 02 March 1999	:	
Attorney Docket No.: 003300-817	:	
For: COPPER RECOVERY PROCESS	:	

This is in response to the "Request for Reconsideration to Confirm October 2, 2001 Filing Date of Signed Declaration" filed 25 February 2002.

BACKGROUND

On 14 January 2000, applicants filed international application PCT/SE00/00066, which claimed priority of an earlier Sweden application filed 02 March 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 08 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 September 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 September 2001 (02 September 2001 was a Sunday preceding a Monday holiday).

On 20 August 2001, applicants filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, a Transmittal Letter and the basic national fee required by 35 U.S.C. 371(c)(1).

On 15 October 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 07 February 2002, applicants filed a petition along with a copy of a declaration and a copy of a return postcard receipt. The petition requested that the copy of the declaration be accorded an original filing date of 02 October 2001.

On 15 February 2002, this Office mailed a decision dismissing the 07 February 2002 petition on grounds that the copy of the return postcard did not list a declaration in its itemized contents.

On 25 February 2002, applicants filed the present request for reconsideration, which is being treated as a renewed petition. The renewed petition states that it is accompanied by a copy of a return postcard which lists a declaration in its itemized contents and bears a USPTO date stamp of 02 October 2001.

DISCUSSION

The evidence of record is sufficient to establish that the declaration was originally filed on 02 October 2001. Specifically, the copy of the return postcard, which includes an "Executed Declaration" in its itemized contents and which bears a USPTO date stamp of 02 October 2001, serves as *prima facie* evidence that the declaration was received by the USPTO on 02 October 2001.

It is noted that the copy of the declaration filed with the present petition does not explicitly identify the specification to which it is directed. The petition states that a Transmittal Letter accompanied the declaration as filed on 02 October 2001. A copy of the Transmittal Letter has been submitted (see "Exhibit A"). The copy of the return postcard, which includes a "Transmittal Letter for Missing Parts of Application" in its itemized contents, serves as *prima facie* evidence that the Transmittal Letter was received by the USPTO on 02 October 2001. A review of the Transmittal Letter reveals that International Application Number PCT/SE00/00066 and U.S. Application Number 09/913,938 are identified. Furthermore, the attorney's docket number listed on the declaration is identical to that listed on both the 02 October 2001 Transmittal Letter and the 20 August 2001 Transmittal Letter. In view of the additional identifying information, the declaration filed 02 October 2001 is deemed to comply with 37 CFR 1.497(a)(2).

CONCLUSION

For the reasons above, the present renewed petition is GRANTED.

The Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) mailed 15 October 2001 is hereby VACATED.

The present application has an International Filing Date of 14 January 2000 and a date under 35 U.S.C. 371 of 02 October 2001.

The application will be forwarded to the DO/EO/US for processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/30/09

TO SPE OF : ART UNIT 3694

SUBJECT : Request for Certificate of Correction for Appl. No.: 09913946 Patent No.: 7346582 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

LAMONTE NEWSOME
Certificates of Correction Branch
703-308-9390 ext. 112

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments: _____

3694 4/1/09

3 1 MAR 2004
UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Staas & Halsey LLP
Suite 700
1201 New York Avenue, NW
Washington, DC 20005

In re Application of
CHAE et al.
Application No. 09/913,956
PCT No.: PCT/KR99/00796
Int. Filing Date: 21 December 1999
Priority Date: 21 December 1999
Atty. Docket No.: 1546.1004
For: Arginine-Rich Anti-Vascular Endothelial Growth Factor Peptides That Inhibit Growth And Metastasis..

DECISION

This is in response to the "Request For Withdrawal Of Abandonment" filed on 24 December 2003.

BACKGROUND

This international application was filed on 21 December 1999, elected the United States, and did not claim an earlier priority date. No Demand electing the United States was filed prior to the elapse of 19 months from the priority date. The International Bureau transmitted a copy of the published international application to the USPTO on 13 September 2001. Accordingly, the 20 month time period for paying the basic national fee in the United States expired at midnight on 21 August 2001.

On 21 August 2001, applicant filed *inter alia* the basic national fee.

On 04 January 2002, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an initial or substitute computer readable form (CRF) of the "Sequence Listing."

On 24 November 2003, a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that the application had become abandoned for failure to timely reply to the Notification of Missing Requirements.

DISCUSSION

Counsel requests withdrawal of the holding of abandonment based on alleged non-receipt of the Notification of Missing Requirements mailed on 04 January 2002. As explained in MPEP 711.03(c), and following *Delgar v. Schuyler, 172 USPQ 513 (D.D.C. 1971),* an adequate showing of non-receipt of papers mailed to applicant by the Office must include (1) a statement by the practitioner that the Office action was not received by the

practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket records must also be referenced in petitioner's statement). A review of the totality of evidence now of record establishes that, within the practice under MPEP 711.03(c), petitioner has satisfied requirements (1) and (2), but has not satisfied requirement (3).

Regarding requirement (1), the petition includes an appropriate statement.

Regarding requirement (2), the petition includes an appropriate statement.

Regarding requirement (3), petitioner has not submitted copies of the appropriate docket records. Petitioner has submitted a copy of a "Patents Incoming Mail Log Per Action Mail Date," but this is not the required relevant docket record. Rather, petitioner must provide a copy of the docket record showing where the Notification of Missing Requirements would have been docketed for response had it been received - more specifically, a docket record showing all cases docketed for response on or before 04 March 2002. In the absence of such relevant docket records, it would not be appropriate to grant the petition at this time.

DECISION

The petition is **DISMISSED**, without prejudice.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

15 SEP 2004

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Staas & Halsey LLP
Suite 700
1201 New York Avenue, NW
Washington, DC 20005

In re Application of	:	
CHAE et al.	:	
Application No. 09/913,956	:	
PCT No.: PCT/KR99/00796	:	
Int. Filing Date: 21 December 1999	:	DECISION
Priority Date: 21 December 1999	:	
Atty. Docket No.: 1546.1004	:	
For: Arginine-Rich Anti-Vascular	:	
Endothelial Growth Factor Peptides	:	
That Inhibit Growth And Metastasis..	:	

This is in response to the "Response To Decision On Petition" filed on 28 April 2004.

DISCUSSION

In a decision mailed on 31 March 2004, a "Request For Withdrawal Of Abandonment" filed on 24 December 2003 was dismissed without prejudice because

> petitioner has not submitted copies of the appropriate docket records. Petitioner has submitted a copy of a "Patents Incoming Mail Log Per Action Mail Date," but this is not the required relevant docket record. Rather, petitioner must provide a copy of the docket record showing where the Notification of Missing Requirements would have been docketed for response had it been received - more specifically, a docket record showing all cases docketed for response on or before 04 March 2002. In the absence of such relevant docket records, it would not be appropriate to grant the petition at this time.

The instant renewed petition is accompanied by a copy of appropriate docket records. As such, petitioner has now provided an adequate showing under the practice described at MPEP 711.03 (c).

DECISION

The petition is **GRANTED**.

The Notification of Abandonment (Form PCT/DO/EO/909) mailed on 24 November 2003 is hereby **VACATED**.

This application is being returned to the National Stage Processing Branch for further

processing. A copy of the Notification of Missing Requirements (Form PCT/DO/EO/905) originally mailed on 04 January 2002 is attached hereto. Applicants are required to satisfy all of the requirements of the Notification of Missing Requirements within **TWO (2) MONTHS** of the mailing date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** of this application.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George M. Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

#3

NOV 08 2001

Timothy J. King
1 Patriots Park
Bedford, MA 01730

In re Application of	:	
Steven Proulx, et al.	:	
Application No: 09/913,977	:	
PCT Application No.: PCT/US99/28501	:	
International Filing Date: 02 December 1999	:	DECISION ON
Priority Date: 03 December 1998	:	PETITION
Attorney Docket No.: MCA-449 PC/US	:	UNDER 37 CFR 1.137(b)
For: FILTRATION CARTRIDGE AND	:	
PROCESS FOR FILTERING A SLURRY	:	

Applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed in the United States Patent and Trademark Office on 20 August 2001 is **GRANTED**.

BACKGROUND

On 02 December 1999, applicant filed an international application, No. PCT/US99/28501 which claimed the priority of an earlier US application filed on 03 December 1998. A copy of the application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 June 2000.

Applicant elected the US in a demand filed on 03 July 2000. On 03 June 2001, the application became abandoned when applicant failed to make the necessary filing with appropriate national fee within thirty months of the priority date.

On 20 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, a petition to revive the international application; the requisite petition fee; the requisite basic national fee as required by 35 U.S.C. §371(c)(1); and a declaration as required by 35 U.S.C. §371(c)(4).

DISCUSSION

A petition to revive an abandoned application under 37 CFR 1.137(b) must be filed without intentional delay from the time the application became abandoned and/or applicant first became aware of the abandoned status of the application. A petition under 37 CFR 1.137(b) must be accompanied by (1) 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, (2) a proposed response, (3) the petition fee required by law (37 CFR 1.17(m)), and (4) a terminal disclaimer and fee (if the international application was filed prior to June 8, 1995).

Applicant's states "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as required by 37 CFR 1.137(b)(3). The appropriate national fee, petition fee and international application have been submitted. A terminal disclaimer is not required as application was filed on 02 December 1999. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

Applicant owes $130.00 surcharge for filing the oath or declaration later thirty months from the priority date.

CONCLUSION

The petition to revive the application abandoned under 35 U.S.C. 371(d) is **GRANTED** as to the National Stage in the United States of America. Applicant's claim for priority is acknowledged. The application has an international filing date of 02 December 1999 under 35 U.S.C. §363 and a date of 20 August 2001 under 35 U.S.C. §371. This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing.

Erin M. Pender

Erin M. Pender
Attorney Advisor
PCT Legal Office

Leonard E. Smith

Leonard E. Smith
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

MAR 2 8 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Keil & Weinkauf
1101 Connecticut Avenue, N.W.
Washington, DC 20036

In re Application of DIEING, Reinhold, et al. Application No.: 09/913,980 PCT No.: PCT/EP00/01070 Int. Filing Date: 10 February 2000 Priority Date: 22 February 1999 Attorney's Docket No.: 49774 For: HAIR COSMETIC FORMULATIONS	DECISION ON REQUEST UNDER 37 CFR 1.497(d)

This is a decision on "Petition To Amend Inventorship Under 37 CFR 1.48(a)," filed on 10 January 2002, which is being treated as a request under 37 CFR 1.497(d).

BACKGROUND

On 10 February 2000, applicants filed international application PCT/EP00/01070, which claimed a priority date of 22 February 1999. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 31 August 2000. On 05 August 2000, applicants filed a demand for international preliminary examination which elected the United States, prior to nineteen months from the priority date. The deadline for entry into the national stage in the United States was midnight on 22 August 2001.

On 21 August 2001, applicants filed a submission for entry into the national stage in the United States, accompanied by, *inter alia*, the U.S. Basic National Fee and a declaration.

On 09 October 2001, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required and that the current oath or declaration was not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.

On 02 January 2002, applicants filed "Response to Notification of Missing Requirements," requesting acceptance of the earlier filed declaration and indicating that applicants believed it complied with 37 CFR 1.68.

On 10 January 2002, applicants submitted the instant request accompanied by, *inter alia*, a statement from Keith Leslie Rutherford and consent of BASF Aktiengesellshaft.

DISCUSSION

The inventors in the international application are Reinhold Dieing, Michael Gotsche, Peter Hössel, Axel Sanner, and Alfred Leinenbach. Applicants filed this request to add Mr. Keith Leslie Rutherford as an inventor in this application.

A request under 37 CFR 1.497(d) requires: (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part; (2) the processing fee set forth in §1.17(i); and (3) the written consent of the assignee, if an original named inventor has executed an assignment.

Items (1), (2) and (3) have been met. (1) Mr. Keith Leslie Rutherford states that his "previous omission as a named inventor of the subject matter of the above-mentioned patent application occurred without deceptive intention on my part." (2) The processing fee set forth in §1.17(i) has been paid. (3) The assignee is BASF Aktiengesellschaft, as evidenced by the signed assignment. Thomas Dörper signed the "Consent of Assignee to Amend Inventorship" as the "authorized representative" of BASF Aktiengesellschaft.

CONCLUSION

For the above reasons, applicants' request under 37 CFR 1.497(d) is **GRANTED**.

The application has an international filing date of 10 February 2000 under 35 U.S.C. §363 and a date of 21 August 2001 under 35 U.S.C. §371. This application is being forwarded to the National Stage Processing Division of the Office of the PCT Operations for continued processing.

Boris Milef
PCT Legal Examiner
PCT Legal Administration

Erin M. Pender
Attorney Advisor
PCT Legal Administration

Telephone: (703) 305-0455
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov
DIW 02-05

KEIL & WEINKAUF
1350 CONNECTICUT AVENUE NW
WASHINGTON DC 20036

COPY MAILED

FEB 07 2005

OFFICE OF PETITIONS

In re Application of	:	
Dieing et al.	:	
Application No. 09/913,980	:	ON PETITION
Filed: 21 August, 2001	:	
Attorney Docket No. 49774	:	

This is a decision on the petition filed on 18 January, 2005, which requests under 37 C.F.R. §1.182 that a previously filed terminal disclaimer be withdrawn. The petition fee has been received.

The petition is granted.

Petitioner asserts that the terminal disclaimer filed 27 September, 2004, is no longer required. As the examiner has concurred, the requested relief can be favorably considered.

This application is being referred to Technology Center Art Unit 1617 for correction of PALM and file records consistent with this decision.

Telephone inquiries relative to this decision should be directed to the undersigned at (571) 272-3231.

D I Wood

Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

29 AUG 2002

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Richard D. Getz
MCCORMICK, PAULDING & HUBER LLP
Cityplace II, 185 Asylum Street
Hartford, CT 06103-4102

In re Application of	:	
BUCHER, Romeo, et al.	:	
U.S. Application No.: 09/913,984	:	
PCT No.: PCT/CH00/00086	:	DECISION
International Filing Date: 02 February 2000	:	
Priority Date: 08 March 1999	:	
Attorney's Docket No.: 2821-211WOUS	:	
For: METHOD AND DEVICE FOR WELDING	:	
SHEETS	:	

This decision is issued in response to the "Request For Correction Of Filing Receipt" filed 19 March 2002 which has been treated as a petition under 37 CFR 1.181 seeking a corrected Notification Of Acceptance (Form PCT/DO/EO/903) and filing receipt indicating 22 October 2001 as the filing date for the present application.

BACKGROUND

On 02 February 2000, applicants filed international application PCT/CH00/00086 which claimed a priority date of 08 March 1999 and which designated the United States. On 14 September 2000 May 2000, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB").

On 01 September 2000, a Demand was filed with the International Preliminary Examining Authority electing the United States. The election was made prior to the expiration of nineteen months from the priority date. As a result, the deadline for payment of the basic national fee was extended to expire thirty months from the priority date, i.e., 08 September 2001.

On 17 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English. The submission did not include an executed declaration in compliance with 37 CFR 1.497.

On 12 October 2001, the DO/EO/US mailed a Notification Of Missing Requirements informing applicants that a declaration in compliance with 37 CFR 1.497 and the surcharge for filing this declaration later than thirty months after the priority date was required. The Notification provided applicants with an extendable two month deadline to respond.

On 27 December 2001, the USPTO received applicants' response to the Notification Of Missing Requirements, including an executed declaration and the required surcharge. The response included a certification that it was deposited as first class mail on 22 October 2001. Based on the certification of mailing, the response was considered a timely response to the Notification Of Missing Requirements, with no extension fees required.

On 01 February 2002, the DO/EO/US mailed a Notification Of Acceptance Of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903) identifying 27 December 2001 as the date of receipt of the 35 U.S.C. 371 requirements. Subsequently, a filing receipt was mailed to applicants. This filing receipt identified the "filing date" as 27 December 2001.

On 26 March 2002, applicant filed the "Request For Correction Of Filing Receipt" considered herein, which requests that the filing date of 27 December 2001 be changed to 22 October 2001.

DISCUSSION

The filing date set forth on the filing date corresponds with the date on which the 35 U.S.C. 371 requirements are completed, such date also being indicated on the Notification Of Acceptance (see MPEP section 1895.01). Here, the date on the Notification Of Acceptance and the filing receipt is 27 December 2001, the date on which the declaration completing the 35 U.S.C. 371 requirements was received at the USPTO. Applicants here seek to have this date changed to 22 October 2001, the date on which the declaration was deposited as first class mail with the USPTO. However, as clearly set forth in 37 CFR 1.8(a), a certification of mailing by first class mail is only used for determining whether a piece of correspondence has been timely submitted (as was done here); "[t]he actual date of receipt will be used for all other purposes." Had applicants desired the submission to be treated as having been filed on the date it was deposited with the USPS, then the "Express Mail" procedure set forth in 37 CFR 1.10 should have been followed.

Based on the above, the declaration by which applicants completed the 35 U.S.C. 371 requirements was properly accorded a filing date of 27 December 2001, the date it was received in the USPTO. Accordingly, the filing date on the filing receipt is correct.

Applicants have also noted that the city of residence on the filing receipt is incorrect for inventor Romeo BUCHER. A corrected filing receipt will be issued that indicates the proper residence city for this inventor.

CONCLUSION

For the reasons above, applicants' request to change the filing date on the filing receipt is **DISMISSED** without prejudice.

Any reconsideration on the merits of these petition(s) must be filed within **TWO (2) MONTHS** from the mail date of this decision to file a response. No petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

The application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for issuance of a corrected filing receipt that properly identifies the city of residence for inventor Romeo BUCHER as Uhwiesen, Switzerland, and it will then be forwarded to Group Art unit 3742 for examination.

Leonard Smith
Legal Examiner
PCT Legal Office

Richard Ross
Attorney-Advisor
PCT Legal Office
Tel.: (703) 308-6155
Fax: (703) 308-6459

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.
09/914,033	08/22/2001	Ieyasu Kobayashi		8235

7590 03/05/2010
Rader Fishman & Grauer
1233 20th Street N W Suite 501
Washington, DC 20036

EXAMINER
RIVERA, WILLIAM ARAUZ

ART UNIT	PAPER NUMBER
3654	

MAIL DATE	DELIVERY MODE
03/05/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MAR - 5 2010

Brian K. Dutton
RADER, FISHMAN & GRAUER PLLC
1233 20th Street NW Suite 501
Washington DC 20036

In re Application of	:	
Ieyasu KOBAYASHI et al.	:	DECISION ON PETITION
Application No. 09/914,033	:	UNDER 37 CFR §1.181
Filed: August 22, 2001	:	
For: Polyester Film Roll	:	

This is a decision on Applicant's Petition under 37 CFR 1.181 filed on November 18, 2009 to withdraw the rejection of claims 6, 9, 13-15, and 23 in the non-final Office action of September 2, 2009 (9/2/09) because the rejection used the same reference as the rejection that has already been reversed by the Board of Patent Appeals and Interferences (the Board).

The Petition is **GRANTED IN PART.**

Applicant alleges that the rejection of claims 6, 9, 13-15, and 23 in the Office action mailed 9/2/09 used the same reference that has previously been applied in a rejection and subsequently reversed by the Board.

A review of the file history reveals that a final Office action was mailed on August 10, 2004 in which claims 1-3, 16-18 were rejected under 102(b) by Sasaki et al. (U.S. patent 4,576,344), claims 4-15 and 19-24 were rejected under 103(a) by Sasaki et al. Applicant filed an appeal brief on September 5, 2006. The examiner issued an examiner's answer on October 2, 2007. The Board rendered a decision on April 30, 2009. Specifically, the Board reversed the final rejections of claims 1-24 over Sasaki (claims 1-3 and 16-18 under 35 USC 102(b) and claims 4-15 and 19-24 under 35 USC 103(a)) and entered new grounds of rejection for claims 1-5, 12, 16-22, and 24 under 102(b)/103(a) over Sasaki but with a different interpretation of the reference. Further, the Board stated that "...we emphasize that our decision does not mean the remaining claims are patentable. Rather, we merely leave the patentability determination of these claims to the Examiner." See the last paragraph on page 13 of the Board's decision.

On June 23, 2009, applicant submitted an amendment in response to the Decision on appeal by canceling claims 1-5, 7-8, 10-12, 16-22, and 24 and amending the remaining claims 6, 9, 13-15, and 23 into independent form. It is noted that claims 6, 9, 13-15 and 23 were not rejected by the Board.

In view of the Board's decision, it was deemed proper to reopen prosecution of the application. Therefore, the non-final Office action was issued on September 2, 2009 was appropriate. The non-final Office action included a rejection of claims 6 and 9 under 35 USC 103(a) over Sasaki which included appropriate portions of the Board's new grounds of rejection. The non-final Office action also included a rejection of claims 13-15 and 23 under 35 USC 103(a) over Sasaki in view of Ogawa (U.S. Patent 4,911,951); Ogawa being a new reference not previously relied upon in the final rejection. The new rejections of claims 6, and 13-15 are proper because the examiner relies on the rationales provided by the Board, and a new combination of references, respectively. For claims 6, and 13-15 the examiner acted in a manner consistent with the Board's Decision and did not reinstate a previously reviewed rejection.

However, the new rejections of claims 9 and 23 were similar to the rejections of the same claims in the final rejection which the Board has already reversed. Therefore, the rejections of claims 9, and 23 in the non-final Office action of September 2, 2009 are withdrawn. This application will be forwarded to the examiner for a new Office action.

SUMMARY: The Petition is **GRANTED IN PART.**

Any questions regarding this decision should be directed to Supervisory Patent Examiner John Q. Nguyen at 571-272-6952.

David L. Talbott, Director
Patent Technology Center 3600
571-272-5150

LM/JQN: 2/25/10
lm

20 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

OSTROLENK FABER GERB & SOFFEN
1180 Avenue of the Americas
New York, N.Y. 10036-8403

In re Application of	:	
SONG, Gye Young	:	
Application No.: 09/914,055	:	
PCT No.: PCT/KR99/00794	:	
Int. Filing Date: 21 December 1999	:	**DECISION**
Priority Date Claimed: None	:	
Attorney Docket No.: P/923-341	:	
For: PISTON SUPPORTING STRUCTURE	:	
FOR LINEAR COMPRESSION	:	

This decision is in response to applicant's "Request for Corrected Filing Receipt" submitted 15 April 2002 which has been treated as a petition under 37 CFR 1.181 and is hereby **DISMISSED** as follows:

The date in the filing date portion on the filing receipt of a national stage application is the date upon which applicants complete the requirements under 35 U.S.C. 371(c). *See* section 1895.01, *A. Filing Date as Applicant's Date of Invention*, Manual of Patent Examining Procedure (MPEP), pg. 1800-153 (August 2001)(*see also* MPEP 1893.03(b)).

A review of the above-captioned application reveals that applicant did not complete the requirements under 35 U.S.C. 371(c)(4) for national stage entry until 16 January 2002 when they submitted an executed declaration in compliance with 37 CFR 1.497(a) & (b). Moreover, the DO/EO/US mailed a Notification of Acceptance of Application under 35 U.S.C. 371 on 01 February 2002 listing a 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date and date of receipt of all 35 U.S.C. requirements of **16 January 2002**. Accordingly, the filing date appearing on the Filing Receipt is correct.

This application is being forwarded to Technology Center 3700 for further processing.

Boris Milef
PCT Legal Examiner
PCT Legal Office

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

17 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

OSTROLENK FABER GERB & SOFFEN
1180 Avenue of the Americas
New York, N.Y. 10036-8403

In re Application of	:	
SONG, Gye Young	:	
Application No.: 09/914,055	:	
PCT No.: PCT/KR99/00794	:	
Int. Filing Date: 21 December 1999	:	**DECISION**
Priority Date Claimed: None	:	
Attorney Docket No.: P/923-341	:	
For: PISTON SUPPORTING STRUCTURE	:	
FOR LINEAR COMPRESSION	:	

This decision is in response to applicant's "Request for Reconsideration of Decision on Petition for Earlier Filing Date" submitted 28 October 2002 which has been treated as a renewed petition under 37 CFR 1.181 and is hereby **DISMISSED**.

As previously indicated in the prior decision, applicant did not complete requirements under 35 U.S.C. 371(c)(4) for national stage entry until 16 January 2002 when they submitted an executed declaration in compliance with 37 CFR 1.497(a) & (b).

In this renewed petition, applicant asserts that "[a]s seen from the attached documents, the Patent Office constructively received all of the necessary filing papers by November 20, 2001." A review of the attached documents reveal a postcard receipt that is listed as being mailed on "11-20-01," but is stamped as received by the USPTO on 16 January 2002.

This situation is discussed in section 512 of the Eighth Edition of the Manual of Patent Examining Procedure (MPEP) explaining 37 CFR 1.8 which states, in part:

> Under 37 CFR 1.8, a person may state on certain papers directed to the Office (exceptions are stated in 37 CFR 1.8), the date on which the paper will be deposited in the United States Postal Service or transmitted by facsimile. If the date stated is within the period for reply, the reply in most instances will be considered to be timely. This is true even if the paper does not actually reach the Office until after the end of the period for reply . . .
>
> It should be noted, however, that the Office will continue its normal practice of stamping the date of receipt ("Office Date" Stamp) on all papers received through the mail or by facsimile except those filed under 37 CFR 1.10 (See MPEP § 513). The date stamped will also be the date which is entered on Office records and from which any subsequent periods are calculated.

Since applicants did not use Express Mail procedures pursuant to 37 CFR 1.10 with this correspondence, the 20 November 2001 date of deposit is not the date used when

determining when applicants complied with 35 U.S.C. 371(c) requirements. That date is the date of receipt by the USPTO. *See* 37 CFR 1.6.

This application is being forwarded to Technology Center 3700 for further processing.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

APR 3 0 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

John J. Kelly
Kenyon & Kenyon
One Broadway
New York, NY 10004

In re Application of	:	
MORI et al.	:	
Application No.: 09/914,112	:	DECISION ON PETITION
PCT No.: PCT/JP00/01127	:	
Int. Filing Date: 25 February 2000	:	
Priority Date: 26 February 1999	:	
Attorney Docket No.: 52433/659	:	
For: COATING COMPOSITION CAPABLE OF FORMING ALKALI-SOLUBLE LUBRICATING FILM SUITABLE FOR SHAPE FORMING AND USE THEREOF		

This decision is in response to applicants' "Response to Missing Requirements under 35 U.S.C. 371" filed 31 October 2001.

On 23 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia: the basic national fee; international search report, and a preliminary amendment.

On 09 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that the declaration was not in compliance with 37 CFR 1.497(a) and (b), and that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) along with a surcharge for providing the oath or declaration later than 30 months from the priority date were required.

On 31 October 2001, applicants filed "Response to Missing Requirements under 35 U.S.C. 371" which was accompanied by a declaration executed by the all named inventors. Additionally, counsel avers that, "[a]s set forth in the attached Inventors' Declaration, the correct English language spelling of the last name of the second inventor is Yamasaki (not Yamazaki) and the correct English language spelling of the first name of fourth inventor is Ryosuke (not Ryousuke)."

As indicated in Section 201.03 of the Manual of Patent Examining Procedure, where a typographical or transliteration error in the spelling of an inventor's name is discovered, a petition is not required. See also MPEP 605.04(b). Accordingly, applicants' explanation of the difference in the spelling of the inventors' name is accepted and noted for the record.

This application is being forwarded to the National Stage Processing Branch of the International Division for further processing with the last name of the second named inventor spelled as Makoto YAMASAKI and the first name of the fourth named inventor spelled as RYOSUKE Wake and for review of the national stage papers submitted 31 October 2001 and, if appropriate, preparation and mailing of the Notification of Acceptance of Application under 35 U.S.C. 371 (Form PCT/DO/EO/903) indicating a date of **31 October 2001** under 35 U.S.C. 371(c).

Anthony Smith
Attorney-Advisor
PCT Legal Office
Tel.: (703) 308-6314
Fax: (703) 308-6459

Leonard Smith
PCT Legal Examiner
PCT Legal 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

Blakely Sokoloff Taylor & Zafman
12400 Wilshire Boulevard
7th Floor
Los Angeles, CA 90025

MAILED

MAY 3 1 2005

Technology Center 2100

In re Application of:
Andrew Augustine WAJS
Application No. 09/914,127
Filed: August 21, 2001
For: METHOD FOR CONTROLLING THE USE OF A PROGRAM SIGNAL IN A BROADCAST SYSTEM, AND CONTROL DEVICE FOR A RECEIVER FOR CARRYING OUT SUCH A METHOD

DECISION ON REQUEST TO WITHDRAW AS ATTORNEY OR AGENT

This is a decision on the Request to Withdraw from Representation filed November 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 **GRANTED**.

All future communications from the Office will be directed to the below-listed address until otherwise notified by applicant. This correspondence address is provided by the withdrawn attorney(s). Applicant is reminded of the obligation to promptly notify the Patent and Trademark Office (Office) of any change in correspondence address to ensure receipt of all communications from the Office.

For Vincent N. Trans
Special Program Examiner
Technology Center 2100
Computer Architecture, Software, and
Information Security
571-272-3613

cc: Andre L. Marais
Schwegman, Lundberg, Woesnner & Kluth, P.A.
1600 TCF Tower
121 South Eighth Street
Minneapolis, MN 55402

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

Mailed:

BC
Paper Number 14

In re application of	:	
Michael Backer et al.	:	
Serial No. 09/914,156	:	DECISION ON
Filed: December 12, 2001	:	PETITION
For: METHOD FOR COATING A SEMICONDUCTOR MATERIAL USING HIGH REMANENT INDUCTION, COATED SEMICONDUCTOR MATERIAL AND USE THEREOF	:	

This is a decision on the PETITION FOR WITHDRAWAL OF NON-UNITY OF INVENTION, filed June 30, 2003, which requests withdrawal of the lack of unity of inventions requirement set forth in the examiner's Office actions of Paper Nos. 8 (November 18, 2002) and 12 (June 13, 2003). In the Office action of November 18, 2002, the examiner made a three-way restriction requirement under 37 CFR 1.499. The basis of this holding of lack of unity of inventions was that the Groups lack the same or corresponding special technical feature, namely the specific magnetic property of the product of Group II. The applicant provisionally elected the product claims of Group II (claims 18-23). The applicant traversed this requirement in the response of April 18, 2003 on two grounds. First, the applicant argued that the claims of Group II are dependent upon a claim contained in Group I. Second, the applicant argued that Groups I and III should be rejoined according to the provisions of MPEP 821.04. The examiner rejected the first argument by maintaining the position that the claims of Group I do not require the specific magnetic property found in Group II. The examiner failed to respond to the second argument. The present petition further includes the argument that the present scenario is "***exactly***" the situation detailed in Example 1 of Annex B Part 2 of the PCT Administrative Instructions contained in Appendix AI of the MPEP.

DECISION

Regarding the first argument, which was contained in the unity of inventions traversal of April 18, 2003, Annex B, Part 1, Section (c), defines a "dependent" claim as a claim which contains all of the features of another claim and is in the same category of claim as the other claim (the expression "category of claim" referring to the classification of claims according to the subject matter of the invention claimed for example, product, process, use or apparatus or means, etc.). As set forth in the original holding of lack of unity of inventions, the claims of Group II are drawn to a distinct "category" of claims, namely a product, whereas Groups I and III are drawn to a process of manufacturing and process of using, respectively. Accordingly, this argument is not persuasive.

Regarding the second argument, which was contained in the unity of inventions traversal of April 18, 2003, MPEP 821.04 states that if the applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined. A

review of all of the non-elected claims reveals only non-elected claim 25 is depend from or otherwise include all the limitations of the allowable product claim. Accordingly, the examiner erred by not rejoining claim 25 in the last Office action. However, none of claims 1-17, 24 or 35-42 include the magnetic property limitation of "a maximum value of remanent induction at 77 K and 0 T of at least 1100 mT." Thus, claims 1-17, 24 and 35-42 are not in condition for rejoinder.

Regarding the third argument, which was contained in the Petition of June 30, 2003, contrary to the petitioner's statement Example 1 (Annex B, Part 2, PCT Administrative Instructions) is not the same exact situation of the present application. Example 1 includes claim 1 directed to a method of manufacturing chemical substance X, claim 2 directed to substance X and claim 3 directed to the use of substance X. It is stated in Example 1 that unity exists between claims 1, 2 and 3, because the special technical feature common to all the claims is substance X. The claims of the present application includes Group I (claims 1-17 and 35-42) directed to a process of manufacturing X, Group II (claims 18-23 and 26-34) directed to substance X′ and Group III (claims 24 and 25) directed to the use of substance X (for claim 24) and X′ (for claim 25). As detailed in the original holding of lack of unity of inventions, substance X and substance X′ are two distinct special technical features. Thus, the examiner holding of lack of unity of inventions is deemed to be proper, except for claim 25, which includes the special technical feature of Group II, i.e. substance X′.

The Petition is **Granted-in-part**. Claim 25 is deemed to be in condition for rejoinder and shares the special technical feature of the elected product claims. However, claims 1-17, 24 and 35-42 are not in condition for rejoinder and do not share the special technical feature of the elected product claims. Accordingly, the Petition is denied regarding these claims. The Office action mailed on June 13, 2003 is hereby vacated, and the application file returned to the examiner for prompt preparation of a supplemental Office action, which rejoins claim 25, i.e. form paragraph 8.42. An Office action shall follow in due course.

Jacqueline Stone, Director
Technology Center 1700
Chemical and Materials Engineering

David J. Cushing
Sughrue, Mion, Zinn, Macpeak and Seas, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3213
Memphis, TN 38120-4367

31 JUL 2002
UNITED STATES PATENT AND TRADEMARK OFFICE

#9

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Dechert
Attn: Allen Bloom, Esq.
4000 Bell Atlantic Tower
1717 Arch Street
Philadelphia, PA 19103

In re Application of RUELLE	:	
U.S. Application No.: 09/914,168	:	
Int. Application No.: PCT/EP00/01468	:	DECISION
Int. Filing Date: 23 February 2000	:	
Priority Date: 26 February 1999	:	
Attorney Docket No.: BM45378	:	
For: IMMUNOGENIC COMPOUNDS	:	

This is in response to applicant's "Response to Notification of Defective Response" filed 09 May 2002, which is being treated as a petition under 37 CFR 1.182. The requisite $130.00 petition fee will be charged to Deposit Account No. 50-0258 as authorized in the petition.

BACKGROUND

On 23 February 2000, applicant filed international application PCT/EP00/01468, which claimed priority of an earlier United Kingdom application filed 26 February 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 08 September 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 28 August 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 26 August 2001.

On 23 August 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 17 October 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371, which indicated that, *inter alia*, an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 28 January 2002, applicant filed two executed declarations, one signed by Jean-Louis Ruelle and another signed by Joelle Thonnard.

On 01 April 2002, the DO/EO/US mailed a Notification of Defective Response, which indicated that the 28 January 2002 submission was improper.

On 09 May 2002, applicant filed the present petition under 37 CFR 1.182. The petition requests that the declaration signed by Joelle Thonnard be withdrawn.

DISCUSSION

A review of the transmittal letter filed 23 August 2001 and the published international application reveals that Joelle Thonnard is not listed as an inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.182 is GRANTED.

The application has an International Filing Date of 23 February 2000 and a date under 35 U.S.C. 371(c) of 28 January 2002.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.

Bryan Tung
PCT Legal Examiner
PCT Legal Office

Telephone: 703-308-6614
Facsimile: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

Seed Intellectual Property Law Group
Suite 6300
701 5th Avenue
Seattle, WA 98104-7092

COPY MAILED

OCT 10 2006

OFFICE OF PETITIONS

In re Application of :
Hui et al. :
Application No. 09/914,171 : DECISION ON PETITION
Filed: December 21, 2001 :
Attorney Docket No. 851663.430USPC :

This is a decision on the petition under 37 CFR 1.137(b), filed March 20, 2006, to revive the above-identified application. The petition was recently forwarded to the Office of Petitions for a decision on the merits. The Office apologizes for any inconvenience.

The 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 two (2) months of the Notice of Appeal filed September 19, 2005. The Office mailed a Notice of Abandonment on March 13, 2006.

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 a Request for Continued Examination (and a submission in the form of a previously filed amendment), paid the requisite fees, and made the proper statement of unintentional delay.

Accordingly, the petition is **granted.**

This matter is being referred to Technology Center Art Unit 2613.

Telephone inquiries related to this decision should be directed to the undersigned at (571) 272-3211.

C. T. Donnell

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

CANTOR COLBURN LLP
55 Griffin Road South
Bloomfield CT 06002

COPY MAILED
APR 25 2006
OFFICE OF PETITIONS

In re Application of
Barend Visser
Application No. 09/914,199
Filed: March 5, 2002
Attorney Docket No. P-1701

ON PETITION

This is a decision on the "Request for Refund", filed July 8, 2005, which is treated as a petition under 37 CFR 1.181.

The petition under 37 CFR 1.181 is **GRANTED**.

In response to a non-Final Office Action mailed February 23, 2005, a response in the form of an amendment was filed June 7, 2005, but without the benefits of an extension of time request or fee. On June 15, 2005 however, to make the June 7, 2005 response timely and to avoid abandonment, petitioner filed a request for a one month extension of time with the appropriate fees.

As indicated by petitioner, a review of the finance records reveals that a one month extension of time had been charged to petitioner's deposit account, at the large entity fee amount of $120.00 in order to make the response timely.

However, subsequent to the filing of the instant petition, the finance records were corrected on August 11, 2005 and the large entity fee amount of $120.00 for the one month extension of time was credited back to petitioner's deposit account. That fee was a duplicate payment in view of petitioner's June 15, 2005 extension of time request, and thus not necessary.

No further action is needed in this regard since petitioner's deposit account had already been credited. This decision is issued for the purposes of making the record complete.

This matter is being referred to the Publishing Division.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.

Patricia Faison-Ball

Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

23 SEP 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Roberto Roger Lorier
4 Ru Du Faisan
Harbourdin, 59320
France

In re Application of
LORIER, Roberto Roger
U.S. Application No.: 09/914,215
PCT No.: PCT/FR00/00134
Int. Filing Date: 25 February 2000
Priority Date: 25 February 1999
Attorney Docket No.: None
For: TOWABLE NAUTICAL DEVICE . . .

DECISION ON PETITION FOR REVIVAL UNDER 37 CFR 1.137(b)

Applicant's "Petition for Revival of an International Application for Patent Designating the U.S. Abandoned Unintentionally Under 37 CFR 1.137(b)" filed on 08 July 2002 in the above-captioned application is hereby **GRANTED** as follows:

The appropriate basic national fee and petition fee for a small entity have been paid. Applicant states that "[t]he entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3). A terminal disclaimer is not required. Accordingly, all requirements under 37 CFR 1.137(b) have been satisfied.

A signed oath or declaration has not yet been submitted. Accordingly, this application is being forwarded to the United States Designated/Elected Office for further processing including mailing a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee of $65.00 pursuant to 37 CFR 1.492(e) is required. A check in the amount of $65.00 or a new credit card authorization form will be required.

A review of the claims show that there are no additional charges for independent claims as is listed on the transmittal letter. Therefore, the total fees charged are the basic national fee of $445 (Fee Code 971), petition fee of $640 (Fee Code 241), and multiple dependent claim fee of $140 (Fee Code 969). A blank declaration form (PTO/SB/01) to complete is attached to this decision for your convenience.

James Thomson
Attorney Advisor
PCT Legal Office

Tel.: (703) 308-6457

PTO/SB/01 (10-01)
Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION FOR UTILITY OR DESIGN PATENT APPLICATION (37 CFR 1.63)

☐ Declaration Submitted with Initial Filing OR ☐ Declaration Submitted after Initial Filing (surcharge (37 CFR 1.16 (e)) required)

Att rn y Dock t Number	
First Named Inv nt r	
COMPLETE IF KNOWN	
Application Number	/
Filing Date	
Art Unit	
Examiner Name	

As the below named inventor, I hereby declare that:

My residence, mailing address, and citizenship are as stated below next to my name.

I believe I am the original and first inventor of the subject matter which is claimed and for which a patent is sought on the invention entitled:

(Title of the Invention)

the specification of which

☐ is attached hereto

OR

☐ was filed on (MM/DD/YYYY) ☐ as United States Application Number or PCT International Application Number ☐ and was amended on (MM/DD/YYYY) ☐ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

I hereby claim foreign priority benefits under 35 U.S.C. 119(a)-(d) or (f), or 365(b) of any foreign application(s) for patent, inventor's or plant breeder's rights certificate(s), or 365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent, inventor's or plant breeder's rights certificate(s), or any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Certified Copy Attached? YES	NO
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐

☐ Additional foreign application numbers are listed on a supplemental priority data sheet PTO/SB/02B attached hereto:

Burden Hour Statement: This form is estimated to take 21 minutes 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.

PTO/SB/01 (10-01)
Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

DECLARATION — Utility or Design Patent Application

Direct all correspondence to: ☐ Customer Number or Bar Code Label _____ OR ☐ Correspondence address below

Name		
Address		
City	State	ZIP
Country	Telephone	Fax

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

NAME OF SOLE OR FIRST INVENTOR : ☐ A petition has been filed for this unsigned inventor

Given Name (first and middle [if any])		Family Name or Surname	
Inventor's Signature			Date
Residence: City	State	Country	Citizenship
Mailing Address			
City	State	ZIP	Country

NAME OF SECOND INVENTOR: ☐ A petition has been filed for this unsigned inventor

Given Name (first and middle [if any])		Family Name or Surname	
Inventor's Signature			Date
Residence: City	State	Country	Citizenship
Mailing Address			
City	State	ZIP	Country

☐ Additional inventors are being named on the ____supplemental Additional Inventor(s) sheet(s) PTO/SB/02A attached hereto.

SPE: K. Zand

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 6/7/07

TO SPE OF : ART UNIT 2134

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/914,258 Patent No.: 7155611

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: _____

TMS 2134 6/19/07

KAMBIZ ZAND
~~SUPERVISORY PATENT EXAMINER~~
SPE

2134
Art Unit

PTO/SB/44 (02-01)
PTO/SB/44 (02-01)
Approved for use through 01/31/2004. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO : 7,155,611 Page (1) of 2

DATED : December 26, 2006

INVENTOR(S) : Wajs et al.

It is certified that errors appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

not sure

On the face page, in field (86), in column 1, line 3, delete "Feb. 8, 2002" and insert - - Aug. 21, 2001 - -, therefor.

On the face page, in field (57), under "Abstract", in column 2, line 24, after "terminals" insert - - . - -.

In column 2, line 53, delete "C_{Wn}) ," and insert - - C_{Wn}), - -, therefor.

In column 2, line 57, delete "(C_{Wi}) ," and insert - - (C_{Wi}), - -, therefor.

In column 2, line 61, after "(C_{Wi-1})" insert - - . - -.

In column 5, line 26, after "disclosure" insert - - , - -.

In column 5, line 30, delete "Pi" and insert - - P_i - -, therefor.

In column 5, line 33, delete "Pi" and insert - - P_i - -, therefor.

In column 5, line 37, delete "Cw" and insert - - C_W - -, therefor.

In column 5, line 37, delete "Ci" and insert - - C_i - -, therefor.

In column 6, line 8, in Claim 1, delete "Method" and insert - - A method - -, therefor.

In column 6, line 14, in Claim 1, after "a" delete "high". — ~~should have been included~~

In column 6, line 37, in Claim 2, delete "Method" and insert - - A method - -, therefor.

MAILING ADDRESS OF SENDER:

SCHWEGMAN, LUNDBERG, WOESSNER, & KLUTH, P.A.
P.O. BOX 2938
Minneapolis, MN 55402

Atty Docket No: 2069.013US1

PATENT NO. 7,155,611

No. of additional copies

MAR 3 1 2007

PTO/SB/44 (02-01)
PTO/SB/44 (02-01)
Approved for use through 01/31/2004. OMB 0651-0033
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.
(Also Form PTO-1050)

UNITED STATES PATENT AND TRADEMARK OFFICE
CERTIFICATE OF CORRECTION

PATENT NO : 7,155,611 Page (2) of 2

DATED : December 26, 2006

INVENTOR(S) : Wajs et al.

It is certified that errors appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In column 6, line 40, in Claim 2, delete "keys" and insert - - key - -, therefor.

In column 6, line 44, in Claim 2, after "used" insert - - , - -.

In column 6, line 50, in Claim 3, delete "Method" and insert - - A method - -, therefor.

In column 6, line 53, in Claim 4, delete "Method" and insert - - A method - -, therefor.

MAILING ADDRESS OF SENDER:

SCHWEGMAN, LUNDBERG, WOESSNER, & KLUTH, P.A.
P.O. BOX 2938
Minneapolis, MN 55402

Atty Docket No: 2069.013US1

PATENT NO. 7,155,611

No. of additional copies

3 1 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

#10

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAILED

FEB 10 2004

Office of the Director
Group 3800

William S Frommer
Frommer Lawrence & Haug
745 Fifth Avenue
New York, NY 10151

Paper No. 9

In re Application of
Taku Yokoyama
Application No. 09/914,280
Filed: February 1, 2002
For: INFORMATION TRANSMISSION SYSTEM, INFORMATION TRANSMISSION METHOD, ROBOT....

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

This is a decision on applicant's petition to withdraw the holding of abandonment filed January 23, 2004 in the United States Patent and Trademark Office.

The petition is **DISMISSED**.

A review of the file record indicates that the application was held abandoned for failure to timely file a proper response to the Office action dated March 26, 2003 and a Notice to that effect was mailed on January 8, 2004.

Petitioner states that a response was filed on April 28, 2003 by facsimile transmission. The shortened statutory period for response was set to expire April 28, 2003. The copy of the response submitted with the petition includes a Certificate of Transmission dated April 28, 2003 and a post card receipt dated May 6, 2003. The post card receipt therefore cannot be used as evidence of timely filing.

Any petition to withdraw the holding of abandonment based upon a Certificate of Transmission by facsimile must include the following requirements:

(1) A copy of the original response bearing a signed Certificate of Transmission which includes the date of signing; and

(2) A statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of transmitting the *original* response on the date indicated on the Certificate of Transmission (see 37 CFR 1.8 and MPEP 512).

While meeting requirement (1) above the petition fails, under requirement (2), to also include a statement under 37 CFR 1.8(b)(3) attesting to the personal knowledge of sending the *original* response by facsimile transmission on the date indicated on the certificate, by the person who signed the certificate.

Therefore a statement under 37 C.F.R. 1.8(b)(3), as noted above, is needed from William S. Frommer attesting to the personal knowledge of sending the *original* response by facsimile transmission on the date indicated on the certificate for the petition to be granted.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(b) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition to Withdraw the Holding of Abandonment Under 37 CFR 1.81."

Steven N. Meyers
Special Programs Examiner
Patent Technology Center 3600
(703) 308-3868

SNM/cps: 2/4/04

UNITED STATES PATENT AND TRADEMARK OFFICE

#12

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

MAILED

APR 14 2004

Office of the Director
Group 3600

William S Frommer
Frommer Lawrence & Haug
745 Fifth Avenue
New York NY 10151

In re Application of :
Taku Yokoyama :
Application No.09/914,280 :
Filed: February 1, 2002 :
For: INFORMATION TRANSMISSION SYSTEM, INFORMATION TRANSMISSION METHOD, ROBOT, INFORMATION RECORDING MEDIUM, ONLINE SALES METHOD AND SALES SERVER

DECISION ON PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT

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 February 19, 2004.

The petition is **GRANTED** in view of the following evidence of timely filing :

☐ Postcard receipt being dated_____.

☐ USPTO return facsimile receipt dated _____ which identifies the application by serial number and the type of Response that was filed on that date.

☒ Certificate of Mailing/Transmission signed on April 28, 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.

KJD/mjz: 4/6/04

Kenneth J. Dorner
KENNETH J. DORNER
SPECIAL PROGRAMS EXAMINER
TECHNOLOGY CENTER 3600

04 OCT 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Jonathan P. Osha
Rosenthal & Osha L.L.P.
1221 McKinney Street, Suite 2800
Houston, Texas 77010

In re Application of	:	
FAUSSE, Arnaud	:	
U.S. Application No. 09/914,282	:	DECISION ON PETITION
PCT No.: PCT/FR00/00483	:	UNDER 37 CFR 1.47(b)
Int. Filing Date: 25 February 2000	:	
Priority Date: 26 February 1999	:	
Attorney Docket No.: 09669/007001	:	
For: CLEANSING TOWLETTE DISPENSER	:	

This is a decision on applicant's "Petition under 37 C.F.R. 1.47(b)" filed 28 May 2002 to accept the application without the signature of inventor, Arnaud Fausse.

BACKGROUND

On 25 February 2000, applicant filed international application no. PCT/FR00/00483 which claimed a priority date of 26 February 1999. A proper Demand was filed with the International Preliminary Examination prior to the 19th month from the earliest claimed priority date. Accordingly, the thirty-month time period for submitting the requisite basic national fee in the United States of America was extended to expire 30 months from the international filing date, i.e., 26 August 2001.

On 24 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); English translation of international application; and a preliminary amendment.

On 12 October 2001, the United Stated Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed. The notification set a two-month time limit in which to respond.

On 28 May 2002, applicant filed "Petition under 37 CFR 1.47(b)" and a petition and requisite fee for a five-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR

1.47(b) applicant on behalf of and as agent for the nonsigning inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of item (1), (3), and (6) above. However, items (2), (4), and (5) have not been satisfied.

Concerning Item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition reveals that petitioner has not satisfied item (2) above, in that the applicant has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, and drawings to Arnaud Fausse. Petitioner has provided a copy of the cover letter addressed to Mr.Fausse mailed March 1, 2002 by registered mail. The registered mail letter, provided by the petitioner, is unclear as to the delivery status of the letter. Was the registered letter(s) returned as undeliverable? Was the letter(s) received by Mr. Fausse or by someone at the last known address? Were any other attempts made to locate Mr. Fausse? The single mailing of the papers to the non-signing inventor's last known address does not constitute a "diligent" effort to locate the inventor. Applicant must show that alternative means were employed, such as a search of telephone and/or Internet directories, in an attempt to locate Mr. Fausse. Furthermore, it does not appear that the petitioner has first hand knowledge of all the facts. Lastly, it is unclear whether the petitioner is asserting that the nonsigning inventor has refused to execute the application or cannot be located to execute the application.

In order to meet the requirements of 37 CFR 1.47(b) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to Mr. Fausse and when such papers were sent and that Mr. Fausse has subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

Regarding Item (4), an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has not been provided.

Concerning Item (5), petitioner has not demonstrated that applicant has a propriety interest in the invention. (See M.P.E.P., section 409.03(f))

For the reasons stated above, it would not be appropriate to accept the application without the signature of Arnaud Fausse under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition filed under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO MONTHS** from the mailing date of this decision. Extensions of time may be obtained under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Legal Affairs Division of the PCT Legal Office.

Richard Cole
PCT Legal Examiner
PCT Legal Office

Anthony Smith
Attorney-Advisor
PCT Legal Office
Telephone 703-308-6314
Fax: 703-308-6459

13 JAN 2004

#4

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Jonathan P. Osha
Rosenthal & Osha L.L.P.
1221 McKinney Street, Suite 2800
Houston, Texas 77010

In re Application of
FAUSSE, Arnaud
U.S. Application No. 09/914,282
PCT No.: PCT/FR00/00483
Int. Filing Date: 25 February 2000
Priority Date: 26 February 1999
Attorney Docket No.: 09669/007001
For: PROTECTED OPTICAL DISK AND METHOD FOR PROTECTING AN OPTICAL DISK

DECISION ON PETITION UNDER 37 CFR 1.47(b)

This decision is in response to applicant's "Request for Reconsideration" filed 03 January 2003. In a decision dated 04 October 2002, applicant's petition under 37 CFR 1.47(b) to accept the application without the signature of inventor, Arnaud Fausse, was dismissed.

The petition for status under 37 CFR 1.47(b) is moot since the declaration filed 03 January 2003 with the present renewed petition was executed by the named inventor, the previous non-signing inventor, Arnaud Fausse. The declaration filed 03 January 2003 is acceptable under 37 CFR 1.497.

CONCLUSION

For the reasons above, the renewed petition is **DISMISSED** as MOOT. The application need not be returned to this Office for any further consideration of Rule 1.47 status and no such status should be indicated on this application file.

The application has an international filing date of 25 February 2000 under 35 U.S.C. 363 and a date of 03 January 2003 under 35 U.S.C. 371(c).

This application is being returned to the United States/Elected Office for processing in accordance with this decision.

Anthony Smith

Anthony Smith
Attorney-Advisor
Office of PCT Legal Administration
Tel: (703) 308-6314
Fax: (703) 308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 07/15/08

TO SPE OF : ART UNIT 2876

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/914,315 Patent No.: 6,776,346

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

Please review COCIN dated 11/23/04 and let me know which set to uses

Delora Dillard
Certificates of Correction Branch
703-308-9250 ext. 172

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 Request for Certificate of Correction filed November 23, 2004 includes Specification that would make the scope of the invention broader and Claims that were canceled previously.

/STEVEN S. PAIK/ — **SPE**

2887 — **Art Unit**

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY OF COMMERCE AND
COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. BOX 1450
Alexandria, Va 22313- 1450
www.uspto.gov.

DATE: March 5, 2009
Patent No: 6,776,346 B1
Applicant: Sonzogni et.al
Issued: 08/14/2004

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 1.322/1.323.

Respecting the alleged errors in the specification and abstract are printed in accordance with the record. The request for Certificate of Correction filed November 23, 2004 includes specification that would make the scope of the invention broader and claims that were canceled previously. Therefore, no correction(s) is in order here under United States Codes (U.S.C.) 254 Code of Federal Regulation (C.F.R.) 1.322/1.323.

In view of the foregoing, in this matter your request is hereby denied. A Certificate of Correction will issue for all other matters.

Further consideration will be given upon receipt of a Request for Reconsideration, which should be directed to Decisions and Certificate of Correction Branch. Requests for Reconsideration should be accompanied by additional support (e.g. copy of amendments, post card receipts. PTOL 1449 OR 892,etc.), containing requested data or changes) and /or brief statements of facts, as requested.

RoChaun Johnson for
Mary Diggs, Supervisor
Decisions and Certificates of Correction
(703) 308-9390 ext. 119

CHRISTOPHER F. REGANALLEN, DYER,
DOPPELT, MILBRATH & GILCHRIST, P.A.
P.O. BOX 3791
ORLANDO, FL 32802

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 07/15/08

TO SPE OF : ART UNIT 2876

SUBJECT : Request for Certificate of Correction for Appl. No.: 09/914,315 Patent No.: 6,776,346

Please respond to this request for a certificate of correction within 7 days.

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

Please review COCIN dated 11/23/04 and let me know which set to uses

Delora Dillard
Certificates of Correction Branch
703-308-9250 ext. 172

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 Request for Certificate of Correction filed November 23, 2004 includes Specification that would make the scope of the invention broader and Claims that were canceled previously.

/STEVEN S. PAIK/ — **SPE**

2887 — **Art Unit**

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 9/28/09

TO SPE OF : ART UNIT 1624

SUBJECT : Request for Certificate of Correction for Appl. No. 09/914,315 No-6,776,346--

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

Should the change Be made?

RoChaun Johnson
Certificates of Correction Branch
703 756-1572

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: The applicant's Request for Certificate of Correction filed August 20, 2009 has been reviewed. In response to the Request, attached correction has been made.

/Steven S. Paik/
2887
SPE Art Unit

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : **1/24/2006**

TO SPE OF : ART UNIT **1600(1651)**

SUBJECT : Request for Certificate of Correction on Patent No.: **6,790,635**

A response is requested with respect to the accompanying request for a certificate of correction.

Please complete this form and return with file, within **7** days to:
Certificates of Correction Branch - PK 3-922
Palm location **7580** - Tel. No. 305-8309

With respect to the change(s) requested, correcting Office and/or Applicant's errors, should the patent read as shown in the certificate of correction? No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Okay to enter changes in the title (Item 54) as requested in C of C?

Ernest C. White, LIE305-8339
Certificates of Correction Branch

Thank You For Your Assistance

The request for issuing the above-identified correction(s) is hereby:
Note your decision on the appropriate box.

- ☒ **Approved** — **All** changes apply.
- ☐ **Approved in Part** — Specify below which changes **do not** apply.
- ☐ **Denied** — State the reasons for denial below.

Comments:

_____

_____

_____

_____

_____

SPE — **Art Unit** 1651

14 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Annette S. Parent
TOWNSEND AND TOWNSEND AND CREW, LLP
2 Embarcadero Center
8th Floor
San Francisco, CA 94111

In re Application of CONAWAY, Joan, A., et al. U.S. Application No.: 09/914,324 PCT No.: PCT/US00/04838 International Filing Date: 25 February 2000 Priority Date: 26 February 1999 Attorney's Docket No.: 021044-004600 For: NOVEL COMPONENT OF VON-HIPPEL-LINDAU TUMOR SUPPRESSOR COMPLEX AND SCF UBIQUITIN LIGASE	DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This decision is issued in response to the "Petition Under 37 CFR 1.181(a) To Withdraw Holding Of Abandonment" filed on 20 August 2002 and resubmitted on 26 December 2002. No petition fee is required.

BACKGROUND

On 25 February 2000, applicants filed international application PCT/US00/04838 which claimed a priority date of 26 February 1999 and which designated the United States.

A Demand was filed with the International Preliminary Examining Authority electing the United States prior to the expiration of 19 months from the priority date. As a result, the deadline for payment of the basic national fee was 30 months from the priority date, i.e., 26 August 2001.

On 22 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, among other materials, payment of the basic national fee and an executed declaration.

On 30 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirements Under 35 U.S.C. 371 indicating that the disclosure of the nucleotide and/or amino acid sequence in the present application was deficient.

On 23 January 2002, applicants filed a "Response To Notification Of Missing Requirements." The Response referred the USPTO to the computer readable form (CRF) of the sequence filed with the international application, and it noted that the paper copy of the sequence listing was contained in the U.S. application.

On 10 June 2002, the DO/EO/US mailed a Notification Of Abandonment indicating that the application was abandoned based on applicants' purported failure to respond to the Notification Of Missing Requirements.

On 20 August 2002, applicants filed the petition considered herein. The petition argues that the abandonment should be withdrawn based on applicants timely response to the Notification Of Missing Requirements. In the alternative, the petition seeks revival of the application under 37 CFR 1.137(b). The petition was accompanied by a substitute paper copy of the sequence and a CRF of the listing.

On 26 December 2002, applicants resubmitted the petition and accompanying materials.

DISCUSSION

As noted above, the application file contains the "Response To Notification Of Missing Requirements" filed by applicants on 23 January 2002. The Response contains a certification under 37 CFR 1.8 dated 21 December 2001, making it a timely response to the Notification Of Missing Requirements mailed on 30 October 2001. Accordingly, the Notification Of Abandonment, based as it was on applicants' purported failure to file a timely response to the Notification Of Missing Requirements is appropriately vacated.

The Response filed on 23 January 2002 Response states that a CRF of the sequence listing herein was filed with the USPTO in the international application, and it requests that this CRF of the sequence be used in the present national stage application. This is acceptable under 37 CFR 1.1821(e). Accordingly, applicants' 23 January 2002 submission is an acceptable response to the Notification Of Missing Requirements.

CONCLUSION

Applicants' petition is **GRANTED**.

The Notification Of Abandonment mailed 10 June 2002 is hereby **WITHDRAWN**

This application is being forwarded to the Scientific And Technical Information Center (STIC) to match the CRF filed in the international application with the present application.

This application will then be returned to the National Stage Processing Branch of the Office Of PCT Operations for further processing. The 35 U.S.C. 371 date is 23 January 2002.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

RMR/LS:rmr

UNITED STATES PATENT AND TRADEMARK OFFICE
10 SEP 2002
COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Vickers, Daniels & Young
50 Public Square, Suite 2000
Cleveland, OH 44113

In re Application of	:	
Hippe et al.	:	
Application No.: 09/914,326	:	
Int. App. No.: PCT/EP00/01998	:	DECISION
Int. Filing Date: 08 March 2000	:	
Priority Date: 09 March 1999	:	
Atty. Docket No.: PS-13256	:	
For: Method Of Hot-Repairing The Heating	:	
Flues Of A Coke-Oven Battery And	:	
Device For Carrying Out Said Method	:	

This decision is in response to the "Petition For Correction Of Filing Date" filed on 01 April 2002.

BACKGROUND

This international application was filed on 08 March 2000, and claimed priority of an earlier application filed on 09 March 1999. The United States was designated. A copy of the published international application was transmitted to the USPTO on 14 September 2000. A Demand electing the United States was filed on 23 September 2000, which was prior to the elapse of 19 months from the priority date. Accordingly, the period to pay the basic national fee in the United States expired on 09 September 2001.

On 23 August 2001, applicants filed, *inter alia*, the basic national fee.

On 14 March 2002, after further proceedings, a Notification of Acceptance (Form PCT/DO/EO/903) was mailed to applicants, indicating that this application was entitled to a date of 14 January 2002 under 35 U.S.C. 371. The Form further indicated that "The Date Appearing On The Filing Receipt As The "Filing Date" Is The Date On Which The Last Of The 35 U.S.C. 371 Requirements Has Been Received In The Office. This Date Is Shown Above."

Applicants filed the instant "Response... on 01 April 2002.

DISCUSSION

Review of the record, including counsel's arguments and the filing receipt, reveals that the "Filing Date" shown on the filing receipt is 14 January 2002, which is the same as the date of this application under 35 U.S.C. 371 as indicated on the

Notification of Acceptance. As noted on the Notification of Acceptance, the "Filing Date" recorded on the filing receipt of an application under 35 U.S.C. 371 is the date that the requirements of 35 U.S.C. 371 were satisfied, rather than the international filing date (*But See* 35 U.S.C. 363) and rather than the date of filing of papers to enter the national stage in the United States.

DECISION

Applicants' request is **DISMISSED**, without prejudice.

This application is being returned to the National Stage Processing Branch for further processing.. The date of this application under 35 U.S.C. 371 remains **14 January 2001**.

Richard Cole
PCT Legal Examiner
PCT Legal Office

George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

MAR 0 1 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Schlumberger Technology Corporation
110 Schlumberger Drive, MD1
Sugar Land, Texas 77478

In re Application of	:	
MAROY, Pierre et al	:	DECISION ON
Application No.: 09/914,331	:	
PCT No.: PCT/EP00/01246	:	PAPERS FILED
Int. Filing Date: 16 FEBRUARY 2000	:	
Priority Date: 25 FEBRUARY 1999	:	UNDER 37 CFR 1.42
Attorney's Docket No.: 55.0204PCT/US	:	
For: CEMENTING COMPOSITIONS AND	:	
APPLICATION OF SUCH COMPOSITIONS	:	
TO CEMENTING OIL WELLS OR THE LIKE	:	

This is a decision on the papers filed 30 November 2001, which has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 24 August 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1). Applicant, however, did not satisfy the requirement set forth by 35 U.S.C. 371(c)(4) because an executed oath or declaration was not provided.

On 01 October 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and(b), identifying the application by International application number and international filing date" must be submitted within two month from its 01 October 2001 date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application. In addition, a $130.00 surcharge for providing the oath or declaration later than the appropriate 30 months from the priority date under 37 CFR 1.492(e) is required.

To satisfy the requirements of 35 U.S.C. 371(c)(4) that an oath or declaration of the inventors be submitted, applicants submitted on 30 November 2001 a declaration signed by three (3) of the four (4) inventors. The declaration was also signed by Khuf SCHULZ as legal representative of Joachim SCHULZ (fourth inventor, now deceased)).

DISCUSSION

The declaration is unacceptable because it does not satisfy 37 CFR §1.497(b)(2). The declaration neither states the citizenship, residence, mailing address of the Khuf Schulz (the legal representatives of the estate of Joachim Schulz) nor of Joachim Schulz (the deceased inventor) as required. 37 C.F.R. §1.497(b)(2) indicates that "[i]f the person making the oath or the declaration or any supplemental or oath or declaration is not the inventor (§§1.42, 1.43, or 1.47), the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing the oath or declaration is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence and mailing address of the legal representative."

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

Applicant is required to provide an oath or declaration in compliance with 37 CFR 1.497(a)-(b) within TWO (2) MONTHS from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Rafael Bacares
Legal Examiner
PCT Legal Office

Richard Cole
Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

17 JUL 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Schlumberger Technology Corporation
110 Schlumberger Drive, MD1
Sugar Land, Texas 77478

In re Application of	:	
MAROY, Pierre et al	:	DECISION ON RENEWED
Application No.: 09/914,331	:	
PCT No.: PCT/EP00/01246	:	PAPERS FILED
Int. Filing Date: 16 FEBRUARY 2000	:	
Priority Date: 25 FEBRUARY 1999	:	UNDER 37 CFR 1.42
Attorney's Docket No.: 55.0204PCT/US	:	
For: CEMENTING COMPOSITIONS AND	:	
APPLICATION OF SUCH COMPOSITIONS	:	
TO CEMENTING OIL WELLS OR THE LIKE	:	

This is a decision on the papers filed 13 May 2002, which has been treated as a renewed request for status under 37 CFR 1.42.

BACKGROUND

In a decision from this Office on 01 March 2001, the petition filed on 30 November 2001 was dismissed. The decision stated that the petition did not comply with 37 CFR §1.497(b)(2) because the declaration was unacceptable. The decision indicated an acceptable declaration under 37 CFR §1.497(b)(2) states the citizenship, residence, mailing address of both the legal representative, Khuf Schulz, and the deceased inventor, Joachim Schulz.

On 13 May 2002, applicant filed the present renewed submission under 37 CFR § 1.42 accompanied with a declaration.

DISCUSSION

The declaration is unacceptable because it does not satisfy 37 CFR §1.497(b)(2) since it is incomplete (the other inventors are not listed) and does address the issue raised in the 01 March 2001 decision. Although the declaration states a citizenship, residence, and mailing address, it is unclear if this indication is of Khuf Schultz (the legal representatives of the estate of Joachim Schulz) or of Joachim Schulz (the deceased inventor. It is unclear because the top line of the box has the name of the deceased inventor typed but the signature line has the signature of Khuf Schulz, and below these names a citizenship, residence, mailing address is stated without indicating to whom it refers.

Applicant show fill out two separate boxes within the declaration that includes the given name, family name, citizenship and mailing addresses of both the legal representative, Khuf Schulz (this section should include her signature), and the deceased inventor, Joachim Schulz. Also, the declaration must include the names of all of the inventors to be complete. Their signatures will not be required since it was provided in the earlier declaration.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **not accepted**.

Applicant is required to provide an oath or declaration in compliance with 37 CFR 1.497(a)-(b) within TWO (2) MONTHS from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Second Renewed Submission Under 37 CFR 1.42." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Commissioner for Patents, Office of PCT Legal Administration, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Rafael Bacares
Legal Examiner
PCT Legal Office

Leonard Smith
Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

24 APR 2003

Schlumberger Technology Corporation
110 Schlumberger Drive, MD1
Sugar Land, Texas 77478

In re Application of	:	
MAROY, Pierre et al	:	DECISION ON SECOND
Application No.: 09/914,331	:	
PCT No.: PCT/EP00/01246	:	RENEWED PAPERS FILED
Int. Filing Date: 16 FEBRUARY 2000	:	
Priority Date: 25 FEBRUARY 1999	:	UNDER 37 CFR 1.42
Attorney's Docket No.: 55.0204PCT/US	:	
For: CEMENTING COMPOSITIONS AND	:	
APPLICATION OF SUCH COMPOSITIONS	:	
TO CEMENTING OIL WELLS OR THE LIKE	:	

This is a decision on the papers filed 18 September 2002 and another copy filed on 01 April 2003 (properly submitted by the registered attorney) , which has been treated as a second renewed request for status under 37 CFR 1.42.

BACKGROUND

In a decision from this Office on 17 July 2001, the request filed on 13 May 2002 was dismissed. The decision stated that the petition did not comply with 37 CFR §1.497(b)(2) because the declaration was incomplete. The decision indicated an acceptable declaration under 37 CFR §1.497(b)(2) states the citizenship, residence, mailing address of both the legal representative, Khuf Schulz, and the deceased inventor, Joachim Schulz.

On 18 September 2002 and 01 April 2003, applicant filed the present second renewed submission under 37 CFR § 1.42 accompanied with a declaration.

DISCUSSION

The renewed submission includes, a newly executed declaration signed by Anne-Marie Schulz as Legal Representative of the deceased inventor (Joachim Schulz) and the declaration now sets forth the residence, citizenship and mailing addresses of both the deceased inventor and the legal representative. Accordingly, applicants have satisfied the requirements under 37 CFR 1.42.

CONCLUSION

The renewed submission filed under 37 CFR 1.42 is **ACCEPTED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for continue processing and indicating a date of **18 September 2002** under 35 U.S.C. 371.

Rafael Bacares
Legal Examiner
PCT Legal Office
Telephone: (703) 308-6312
Facsimile: (703) 308-6459

Leonard Smith
Legal Examiner
PCT Legal Office

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No. 14

FRIEDRICH KUEFFNER
SUITE 910
317 MADISON AVENUE
NEW YORK, NY 10017

COPY MAILED
APR 0 9 2004
OFFICE OF PETITIONS

In re Application of
Reufer et al.
Application No. 09/914,344
Filed: March 19, 2002
Attorney Docket No. HM-427PCT

ON PETITION

This is a decision on the petition under 37 C.F.R. § 1.137(b), filed March 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 May 28, 2003. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, this application became abandoned on August 29, 2003. A Notice of Abandonment was mailed on December 5, 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 Technogoly 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

MAR 2 9 2002

#8

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

John V. Moriarty
Woodard, Emhardt, Naughton,
Moriarty & McNett
Bank One Center/Tower
111 Monument Circle, Suite 3700
Indianapolis, IN 46204-5137

In re Application of	:	
Kay	:	
Application No.: 09/914,366	:	DECISION On
PCT No.: PCT/GB01/02146	:	
Int. Filing Date: 16 May 2001	:	PETITION UNDER
Priority Date: 24 May 2000	:	
Attorney Docket No.: 5600-2	:	37 CFR 1.181
For: Novelty Animated Device With Synchro-	:	
nised Output, And Method For Achieving	:	
Synchronised Audio Output Therein	:	

This is a decision on applicant's petition under 37 CFR 1.181 filed on 28 February 2002.

Applicant petitions for consideration of the "Response To Notice To File Missing Parts" filed on 30 January 2002.

The original "Response To Notice To File Missing Parts" filed on 30 January 2002 is of record in the application file. Under the provisions of 37 CFR 1.8, the actual date of receipt is used for the receipt date. Consideration of the Response reveals that applicant has fully satisfied the requirements of the Notification of Missing Requirements (Form PCT/DO/EO/905) mailed on 06 December 2001.

The petition is dismissed as **MOOT**, without prejudice.

This application is being returned to the United States Designated/Elected office (DO/EO/US) for further processing. Applicant's claim of priority is acknowledged. This application has an international filing date of 16 May 2001 under 35 U.S.C. 363 and a date of **30 January 2002** under 35 U.S.C. 371.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

George Dombroske
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6721
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

NOV 21 2003

Paper No. 14

In re Application of	:	
Robert Kay	:	
Serial No. 09/914,366	:	DECISION ON PETITION
Filed: January 30, 2002	:	TO MAKE SPECIAL
For: NOVELTY ANIMATED DEVICE WITH	:	
SYNCHRONISED AUDIO OUTPUT, AND	:	
METHOD FOR ACHIEVING SYNCHRONISED	:	
AUDIO OUTPUT THEREIN	:	

Applicant's petition, filed May 19, 2003, seeks to have this application made special pursuant to the Accelerated Examination Program. The petition is GRANTED.

The petition has been reviewed and is found to be in compliance with the requirements for special status as set forth in Section 708.02(VIII) of the Manual of Patent Examining Procedures (MPEP).

Applicant is advised that the examiner's search will be restricted to the subject matter encompassed by the claims. In the event that the application receives a first action rejection, applicant is encouraged to arrange for an interview with the examiner, and to provide the examiner with a working copy of any proposed amendment one working day prior to the interview. Any amendment filed in response to a first action rejection which would require broadening of the field of search will be treated as an improper response.

PETITION GRANTED.

E. Rollins-Cross

E. Rollins-Cross, Director
Technology Center 3700

John V. Moriarty
Woodard, Emhardt, Naughton, Moriarty & McNett
111 Monument Circle, Suite 3700
Indianapolis, IN 46204

03 JUN 2003

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

GLENN PATENT GROUP
3475 Edison Way. Ste L,
Menlo Park, CA 94025

In re Application of	:	DECISION ON
Allamanche et al	:	
PCT No.: PCT/EP99/09978	:	PETITION UNDER
Application No: 09/914,371	:	
Int. Filing Date: 15 December 1999	:	
Priority Date: 24 February 1999	:	37 CFR 1.47(a)
Attorney's Docket No.: SCHO0064	:	
For: Device and Method for Producing	:	
An Encoded Audio and/or Video data Stream	:	

This is in response to the "PETITION BASED UPON UNAVAILABILITY OF INVENTOR (37 CFR.1.47/MPEP 409.03)" filed on 14 December 2001. The requisite $130 petition fee has been charged to petitioner's deposit account.

BACKGROUND

On 15 December 1999, applicants filed international application PCT/EP99/09978, which claimed priority of an earlier European application filed 24 February 1999. A DEMAND was filed on 22 September 2000 prior to the expiration of 19 months from the priority date electing the United States. Accordingly, the thirty-month (30) time period for paying the basic national fee in the United States of America expired at midnight on 24 August 2001.

On 24 August 2001, applicants filed for entry into the national stage in the United States of America. Filed with the application was, inter alia, the requisite basic national fee. No executed oath or declaration from the inventors accompanied the application at such time. A copy of the intentional application was transmitted on 31 August 2000 to the USPTO from the International Bureau.

On 19 August 2001, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a), and (b), identifying the application by International application number and international filing date" must be submitted within two months from its 19 August 2001 date of mailing or by 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 14 December 2001, petitioner filed the present petition accompanied, inter alia, an executed Declaration without the signature of one of the four inventors, i.e., without the signature of Niels Rump.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Furthermore, section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.) **Proof of Unavailability or Refusal**, the relevant sections states, in part:

INVENTOR CANNOT BE REACHED:

> Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under **37 CFR 1.47**, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made.
>
> The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under **37 CFR 1.47**.
>
> Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under **37 CFR 1.47**. **37 CFR 1.43** may be available under these circumstances. See **MPEP § 409.02**. Such a petition under **37 CFR 1.47** will be dismissed as inappropriate.
>
> The statement 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 internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included statement of facts. It is important that the statement contain facts as opposed to conclusions.

Petitioner has satisfied requirements (1), (3), and (4) of 37 CFR 1.47(a). However, requirement (2) has not been satisfied.

The averments of Fritz Schoppe are insufficient to support a finding that the nonsigning inventor, Mr. Niels Rump could not be found after diligent effort because Mr. Schoppe's declaration fails to show diligent effort to locate inventor Rump. Mr. Schoppe has not shown that he has searched for the above non-signing inventor's new address by using a broad search in the internet, which would show diligent effort by Mr. Schoppe to find the nonsigning inventor since Mr. Schoppe currently appears to have limited his search to Erlangen.

Moreover, it is not clear from the petition that it was Mr. Schoppe who performed the items listed in paragraph 2 of his declaration, and has first hand knowledge of those facts as required by MPEP Section 409.03(d). If Mr. Schoppe was not the person who performed the actions listed in paragraph 2, petitioner will need to submit statements, with specific facts on the actions referred to by paragraph 2 by persons who have first-hand knowledge of such facts.

In addition although, petitioner has submitted copies of the cover letters and returned envelopes mailed to Mr. Rump, petitioner has not provided English translations of them.

Consequently, at this time it can not be concluded that the nonsigning Mr. Rump could not be found after diligent effort.

CONCLUSION

The petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration of the merits of the petition under 37 CFR 1.47(a) is desired, applicant must file a request for reconsideration within **TWO (2) MONTHS** from the mail date of this Decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Richard Cole
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

11 SEP 2003

UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

GLENN PATENT GROUP
3475 Edison Way. Ste L,
Menlo Park, CA 94025

In re Application of	:	DECISION ON
Allamanche et al	:	
PCT No.: PCT/EP99/09978	:	PETITION UNDER
Application No: 09/914,371	:	
Int. Filing Date: 15 December 1999	:	
Priority Date: 24 February 1999	:	37 CFR 1.47(a)
Attorney's Docket No.: SCHO0064	:	
For: Device and Method for Producing	:	
An Encoded Audio and/or Video data Stream	:	

This decision is in response to applicant's " RENEWED PETITION UNDER 37 CFR 1.47(a)" filed on 24 July 2003 in response to a decision by this Office dated 03 June 2003.

BACKGROUND

The decision by this Office dated 03 June 2003 indicated that the record did not support the premise that petitioner had not submitted an affidavit or declaration from a person having firsthand knowledge on the items that were sent to Mr. Niels Rump, and that it could not be concluded that Mr. Rump could not be found or reached after diligent effort at that time.

On 24 July 2003, petitioner filed this renewed petition accompanied by, inter alia, an executed declaration by Neils Rump, the remaining nonsigning inventor.

DISCUSSION

The petition states an executed declaration by inventor Niels Rump is provided, and all the requirements have been met.

The declaration is now signed by all the inventors. Accordingly, the declaration submitted on 24 July 2003 complies with 37 CFR 1.497(a) and (b).

However, the declaration of the inventors is not acceptable at this time, in that it has been improperly altered at pages 1, 3 and 4, that is certain sections have been whiten-out. See 37 CFR 52(c)(1).

DECISION

The petition under 37 CFR 1.47(a) is **MOOT.**

A proper response to this decision is a new declaration, which must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to respond will result in the abandonment of the application. Extensions of time are available under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

JEFFREY R. KUESTER, ESQ.
THOMAS KAYDEN HORSTEMEYER & RISLEY
100 GALLERIA PARKWAY, SUITE 1750
ATLANTA, GA 30339-5948

COPY MAILED

APR 0 4 2005

OFFICE OF PETITIONS

In re Application of	:
Maria Adamczyk et al	:
Application No. 09/914,388	: DECISION ON PETITION
Filed: January 24, 2002	: UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 36968/199881	:

This is a decision on the petition under 37 CFR 1.78(a)(6), filed December 16, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 119(e) for the benefit of a prior-filed provisional Application No. 60/121,923, filed February 26, 1999, as set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

(1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
(2) the surcharge set forth in § 1.17(t); and
(3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant petition does not comply with item (1) above.

A reference to add the above-noted, prior-filed application on page one following

the first sentence of the specification has been included in a concurrently filed amendment. However, the amendment is not acceptable as drafted since it improperly incorporates by reference the prior-filed application. Petitioner's attention is directed to Dart Industries v. Banner, 636 F.2d 684, 207 USPQ 273 (C.A.D.C. 1980), where the court drew 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 applications, either specifically or by an express incorporation-by-reference of prior disclosed subject matter. Nothing in section 120 itself operates to carry forward any disclosure from an earlier application. In re deSeversky, supra at 674, 177 USPQ at 146-147. Section 120 contains no magical disclosure-augmenting powers able to pierce new matter barriers. It cannot, therefore, "limit" the absolute and express prohibition against new matter contained in section 251.

In order for the incorporation by reference statement to be effective as a proper safeguard against the omission of a portion of a prior application, the incorporation by reference statement must be included in the specification-as-filed, or in an amendment specifically referred to in an oath or declaration executing the application. *See* In re deSeversky, *supra*. *Note also* MPEP 201.06(c).

Accordingly, before the petition under 37 CFR 1.78(a)(6) can be granted, a substitute amendment[1] deleting the incorporation by reference statement, along with a renewed petition under 37 CFR 1.78(a)(6), is required.

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

---

[1] *Note* 37 CFR 1.121

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By fax: (703) 872-9306
ATTN: Office of Petitions

Any questions concerning this matter may be directed to Wan Laymon at (571) 272-3220.

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

JEFFREY K. KUESTER, ESQ.
THOMAS KAYDEN HORSTEMEYER & RISLEY
100 GALLERIA PARKWAY, SUITE 1750
ATLANTA, GA 30339-5948

COPY MAILED

MAY 23 2005

OFFICE OF PETITIONS

In re Application of	:
Maria Adamczyk et al	:
Application No. 09/914,388	: DECISION GRANTING PETITION
Filed: January 24, 2002	: UNDER 37 CFR 1.78(a)(6)
Attorney Docket No. 36968/199881	:

This is a decision on the renewed petition under 37 CFR 1.78(a)(6), filed April 18, 2005, requesting that the claim for priority be returned to the provisional application originally claimed on filing.

The petition is granted to the extent indicated *infra*.

On filing, petitioner herein claimed priority to provisional Application No. 60/121,932, filed February 26, 1999. The petition under 37 CFR 1.78(a)(6), filed on December 14, 2004, requested deletion of the claim for benefit to prior filed provisional Application No. 60/121,932 and claimed, in place thereof, priority to provisional Application No. 60/121,923, filed February 26, 1999. The petition now requests that the claim for priority be returned to the original application; i.e., provisional Application No. 60/121,932.

This case has now issued into a patent with the claim for priority to prior-filed provisional Application No. 60/121,932. Accordingly, the petition is granted to the extent that the claim for priority to provisional Application No. 60/121,923 has not been entered.

Any questions concerning this decision may be directed to Wan Laymon at (571) 272-3220.

As this application issued into Patent No. 6,891,931 on May 10, 2005, no further action is required. Accordingly, this matter is being referred to Files Repository.

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

DEC 0 6 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Colin G. Sandercock
Heller, Ehrman, White & McAuliffe, LLP
1666 K Street, NW, Suite 300
Washington, DC 20006

In re Application of	:	
BUB, et al.	:	DECISION ON PETITION
Application No.: 09/914,397	:	
PCT No.: PCT/DE00/00116	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 07 January 2000	:	
Priority Date: 08 January 1999	:	
Attorney Docket No.: 38485-0006	:	
For: MOLECULAR-BIOLOGICAL MARKER	:	
FOR ANALYTICAL ELECTRON	:	
MICROSCOPY	:	

This decision is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed 28 August 2001 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 07 January 2000, applicant filed international application PCT/DE00/00116 which claimed priority of an earlier application filed 08 January 1999. A Demand for international preliminary examination was filed on 04 August 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 08 July 2001.

On 08 July 2001, the application became abandoned for failure to pay the basic national fee for a U.S. national stage entry application.

On 28 August 2001, applicant filed the present petition accompanied by a "Transmittal Letter to the United States Designated/Elected Office (DO/EO/US) Concerning a Filing Under 35 U.S.C. 371;" payment of the basic national fee, a sequence listing and an unexecuted combined declaration and power of attorney of the inventors.

DISCUSSION

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional abandonment must be accompanied by (1) the required reply, (2) the petition fee required by law, (3) a statement that the, "entire delay in filing the required reply from

the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional" and (4) any terminal disclaimer and fee pursuant to 37 CFR 1.137(c) (where required).

With regard to Item (1), the proper response was the payment of the basic national fee. Applicants have included this payment along with the present petition.

As to Item (2), applicants have included this payment along with the present petition.

With regard to Item (3), applicant's statement that, "the entire delay in entering the U.S. national stage and paying the national application filing fee from the due date for filing and payment of the fee until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional" satisfies the requirement of 37 CFR 1.137(b)(3).

As to Item (4), the terminal disclaimer is not required since this application was filed after 08 June 1995.

A review of the application file reveals that, with the filing of the present petition and accompanying papers, a proper response has been submitted and all of the requirements of 37 CFR 1.137(b) for revival have been satisfied and revival is therefore appropriate. Applicants are still required to submit an executed oath or declaration of the inventors and translation of the International Application into English.

CONCLUSION

For the reasons stated above, the petition for revival is **GRANTED**.

This application is being returned to the DO/EO/US for processing in accordance with this decision, namely, the mailing of a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905).

Leonard Smith
Legal Examiner
PCT Legal Office

Derek A. Putonen
Petitions Attorney
PCT Legal Office
Tel: (703) 305-0130
Fax: (703) 308-6459

MAR 05 2002

#3

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Gregory C. Smith
Garvey, Smith, Nehrbass & Doody, LLC
3838 N. Causeway Blvd., Suite 3290
Metairie, LA 70002

In re Application of		
HOLCOMB, Robert C.	:	
Application No.: 09/914,402	:	DECISION ON PETITION
PCT No.: PCT/US97/11261	:	UNDER 37 CFR 1.137(b)
Int. Filing Date: 27 June 1997	:	
Priority Date: 27 June 1996	:	
Attorney Docket No.: A96158US	:	
For: WATER TREATMENT DEVICE AND METHOD	:	

The petition to revive under 37 CFR 1.137(b) filed 24 August 2001 in the above-captioned application is hereby **GRANTED** as follows:

Applicant's statement that the "entire delay in submitting the filing fee into the United States Patent and Trademark Office from due date until the filing of this petition was unintentional" meets the requirements of 37 CFR 1.137(b)(3). **The above-identified application has been abandoned for an extended period of time. The Patent and Trademark Office is relying on petitioner's duty of candor and good faith and accepting the statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR .137(b) was unintentional. See Changes to Patent and Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. 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).**

A review of the application file reveals that applicant has submitted the basic national fee of $500 and the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

This application is being forwarded to the United States Designated/Elected Office (US/DO/EO) for continued processing including the issuance of a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration is required.

Anthony Smith

Anthony Smith
Attorney-Advisor
PCT Legal Office
Telephone: (703) 308-6314
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY OF ORIGINAL MAILED 6/27/05 (7/19/05)

BELL, BOYD & LLOYD, LLC
P. O. BOX 1135
CHICAGO IL 60690-1135

In re Application of
SCHULZ, EGON
Application No. 09/914,413
Filed: August 21, 2001
For: **METHOD FOR CONTROLLING THE DIVISION OF TRANFER RATES IN A CELLULAR RADIO TELECOMMUNICATIONS SYSTEM**

DECISION ON PETITION TO WITHDRAW HOLDING OF ABANDONMENT

This is a decision on the Petition for Withdrawal of Abandonment, filed May 12, 2005, requesting the holding of abandonment be withdrawn in the above-identified application.

This application was held abandoned for failure to the non-final Office action mailed September 21, 2004. A Notice of Abandonment was mailed April 28, 2005.

Petitioner states that a response was in fact timely filed. To support this assertion, petitioner has submitted a date-stamped copy of a return postcard which acknowledges receipt by the Patent and Trademark Office of a response, request for an extension of time and a check for $450.00 on February 25, 2005. Petitioner has also submitted a copy of the items.

M.P.E.P. § 503 states that "[a] post card receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO."

The response is considered timely filed since the post card receipt bears a date of February 25, 2005, more than three months from the mailing of the Office action, where the response includes a petition for two months extension of time and certificate of mailing certifying deposit on February 22, 2005. February 21, 2005 was a federal holiday. Accordingly, the copy of the response is accepted.

In view of the above stated reasons, the Notice of Abandonment is hereby vacated and the holding of abandonment withdrawn.

The petition is **GRANTED.**

The application file will be forwarded to the Technology Center's technical support staff for entry of the copy of the response. The original check for $450.00 cannot be located. Accordingly, the fee ($450.00) for petition for extension of time for two months will be charged to applicant's Deposit Account No. 02-1818 as set forth in the transmittal accompanying the response. From there, the file will be forwarded to the examiner for appropriate action in due course.

Kenneth A. Wieder
Special Program Examiner
Technology Center 2600
Communications

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

COPY MAILED

MAY 30 2007

OFFICE OF PETITIONS

LAHIVE & COCKFIELD, LLP
ONE POST OFFICE SQUARE
BOSTON, MA 02109-2127

In re Application of :
Jesper Z. Haeggstrom et al :
Application No. 09/914,451 : ON PETITION
Filed: December 20, 2001 :
Attorney Docket No. PVZ-006US :

This is a decision on the petition under 37 CFR 1.137(b), filed December 22, 2006, to revive the above-identified application.

The petition is **GRANTED**.

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action mailed June 20, 2006, 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 September 21, 2006.

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 $510 extension of time submitted with the petition on December 22, 2006 was subsequent to the maximum extendable period for reply, this fee is unnecessary and will be credited to petitioner's deposit account.

The file does not indicate a change of address has been submitted, although the address given on the petition differs from the address of record. If appropriate, a change of address should be filed in accordance with MPEP 601.03. A courtesy copy of this decision is being mailed to the address given on the petition; however, the Office will mail all future correspondence solely to the address of record.

Telephone inquiries concerning this decision should be directed to Irvin Dingle at (571) 272-3210.

This matter is being referred to Technology Center AU 1656 for further processing.

Irvin Dingle
Petitions Examiner
Office of Petitions

cc: Lahive & Cockfield LLP
28 State Street
Boston, MA 02109

MAR 0 5 2002

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Patent Cooperation Treaty
Legal Office

Address: Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Lin B. Olsen
WEINGARTEN, SCHURGIN, GAGNEBIN & HAYES LLP
Ten Post Office Square
Boston, Massachusetts 02109

In re Application of	
ADE CORPORATION	DECISION ON
Application No.: 09/914,456	
PCT No.: PCT/US00/34806	PETITION
Int. Filing Date: 22 Dec. 2000	
Priority Date: 30 Dec. 1999	UNDER 37 CFR 1.47(a)
Attorney's Docket No.: ADE-066XQ999	
For: SPECIMEN TOPOGRAPHY RECONSTRUCTION:	

This decision is in response to applicants' petition under 37 C.F.R. 1.47 (a) to accept a declaration without an inventor's signature which was filed on 28 August 2001 with the Transmittal Letter requesting national stage entry under 35 U.S.C. 371. The required Rule 47(a) petition fee ($130) will be charged applicant's deposit account (No. 23-0804) pursuant to applicant's authorization provided in the transmittal letter.

BACKGROUND

On 22 December 2000, the applicant filed international application PCT/US00/34806 claiming priority to U.S. provisional application 60174,082, filed 30 Dec. 1999. A Demand for international preliminary examination, in which the United States was elected, was made by the 19th month from the earliest claimed priority date. Accordingly, the thirty month period for paying the basic national fee in the United States in accordance with 37 CFR 1.495(b), expires at midnight on 01 July 2002 (30 June 2002 is a Sunday).

On 28 August 2001, applicants filed a Transmittal Letter for entry into the national stage in the United States which was accompanied by the requisite basic national fee as required under 35 U.S.C. 371(c)(1) along with the present petition under 37 CFR 1.47(a) and an oath or declaration by each 37 CFR 1.47(a) inventor on his or her own behalf and on behalf of the non-signing joint inventor.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Applicants have satisfied items (1) and (4) above.

Regarding items (2) and (3) above, MPEP 409.03(d) (August 2001) states in part:

> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made.
> Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.
>
> When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.
>
> When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Regarding item (3) above, MPEP 409.03(e) (August 2001) states in part:

> An application filed pursuant to 37 CFR 1.47 must state the last known address of the non-signing inventor.
>
> That address should be the last known address at which the inventor customarily receives mail. See MPEP 605.03. Ordinarily, the last know address will be the last known residence of the nonsigning inventor.
>
> Inasmuch as a nonsigning inventor is notified that an application pursuant to 37 CFR 1.47 has been filed on his or her behalf, other addresses at which the nonsigning inventor may be reached should also be given.

The supporting documentation submitted with the Rule 47(a) petition includes a statement by associate attorney Lin B. Olsen working with Charles Gagnebin (an attorney of record) asserting an attempt to secure the signature of the inventor, Alexander Belyaev as evidenced by:

1) forwarding of the "above-identified patent application" to applicant's agent (ADE corporate attorney Keith Long) who forwarded this paperwork to Mr. Belyaev's attorney (Larry Reece);

2) Mr. Reece's recommendation to Mr. Belyaev that he not sign the application and Mr. Reece's reluctance to sign a statement concerning his recommendation;

3) forwarding of a statement to Mr.Belyaev for his signature indicating his refusal to sign the application at this time; and

4) the Affidavit of Alex Belyaev stating:

a. his former employment by ADE Corp. and his current employment by KLA-Tencor Corp.; and
b. that Mr.Belyaev was recently asked by ADE to sign a patent application regarding "Specimen Topography Reconstruction" relating to work at ADE but declined to sign because of a pending lawsuit between ADE and KLA-Tencor.

The supporting documentation is deficient in several respects.

The Rule 47(a) petition clearly fails to state the last known address of the non-signing inventor as required by MPEP 409.03(e); nor is there any evidence that a copy of the application papers was sent to Mr. Belyaev's last known address. Additionally, the circumstances of the presentation of the application papers and of the refusal of the inventor to sign are not specified in the statement of facts by the person (e.g. Mr. Reece) who presented the inventor with the application papers. Further there is no evidence of record indicating that Mr. Belyaev's refusal to

sign was made in the presence of Mr. Olsen. Finally, Mr. Belyaev's Affidavit merely mentions that he was asked to sign an application titled "Specimen Topography Reconstruction" relating to his work with ADE, but fails to elucidate whether he was actually presented with the application and, if presented, the circumstances surrounding the presentation such as the person who made the presentation and the application serial number. Accordingly, there is insufficient evidence (e.g. from a person with first hand knowledge) that a *bona fide* attempt was made to present a copy of the above-identified application to the non-signing inventor.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is DISMISSED, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner of Patents, Box PCT, Washington, D.C., 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Bennett Celsa
PCT Legal Detailee
PCT Legal Office
Telephone: (703) 305-7556
Facsimile: (703) 308-6459

Leonard Smith
PCT Legal Examiner
PCT Legal Office

24 MAY 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

WEINGARTEN, SCHURGIN, GAGNEBIN & HAYES LLP
Ten Post Office Square
Boston, Massachusetts 02109

In re Application of	:	
ADE CORPORATION	:	DECISION ON
Application No.: 09/914,456	:	
PCT No.: PCT/US00/34806	:	RENEWED PETITION
Int. Filing Date: 22 December 2000	:	
Priority Date: 30 December 1999	:	UNDER 37 CFR 1.47(a)
Attorney's Docket No.: ADE-066XQ999	:	
For: SPECIMEN TOPOGRAPHY RECONSTRUCTION	:	

This decision is in response to applicants' renewed petition under 37 C.F.R. 1.47(a) filed on 06 May 2002.

BACKGROUND

The renewed petition includes a statement that the last known address of Mr. Belyaev, the non-signing inventor, is: 707 Continental Circle, Apartment 531, Mountain View, CA 94040. The renewed petition further includes a signed affidavit by Mr. Belyaev which includes an express written refusal to sign the Declaration and Power of Attorney because of a pending lawsuit between ADE Corporation, KLA-Tencor Corporation, and Mr. Belyaev and a signed declaration by Lin Olsen.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Regarding item (1), applicants paid the required fee in the petition filed 28 August 2001 and no further fee is necessary.

MPEP 409.03(d) (August 2001) states in part:

> *Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal*

must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Accordingly, applicants have satisfied items (1) - (4) above.

CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(c), a notice of the filing of this application will be forwarded to the non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(c) will be published in the Official Gazette.

The application is being returned to the National Stage Processing Division of the Office of PCT Operations for processing as the U.S. National Stage of the above-identified international application, including according the application a date under 35 U.S.C. 371(c) of 28 August 2001.

Gregory Vidovich
PCT Legal Detailee
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-1315
Facsimile: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

KENYON & KENYON
1500 K STREET NW, SUITE 700
WASHINGTON, DC 20005

COPY MAILED

JUN 0 2 2005

OFFICE OF PETITIONS

In re Application of	:
Tomoo Yamamoto et al	:
Application No. 09/914,471	: DECISION GRANTING PETITION
Filed: August 29, 2001	: UNDER 37 CFR 1.313(c)(2)
Attorney Docket No. 29273/557	:

This is a decision on the petition, filed May 25, 2005, under 37 CFR 1.313(c)(2) to withdraw the above-identified application from issue after payment of the issue fee.

The petition is **GRANTED**.

The above-identified application is withdrawn from issue for consideration of a submission under 37 CFR 1.114 (request for continued examination). See 37 CFR 1.313(c)(2).

Petitioner is advised that the issue fee paid on May 6, 2005 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (571) 272-3218.

This matter is being referred to Technology Center AU 1773 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
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

Date : June 2, 2005

TO : Director, Office of Patent Publication

FROM : Office of the Deputy Commissioner
for Patent Examination Policy

SUBJECT : Withdrawal from Issue of **Application No. 09/914,471**

Applicant(s) : Tomoo Yamamoto et al
Application No. : 09/914,471
Filed : August 29, 2001

The above-identified application has been assigned Patent No. 6,905,789 and an issue date of June 14, 2005.

It is hereby directed that this application be withdrawn from issue at the request of the applicant. Do not refund the issue fee.

The following erratum should be published in the Official Gazette if the above-identified application is published in the OG of June 14, 2005:

"All reference to Patent No. 6,905,789 to Tomoo Yamamoto et al of Japan for MAGNETIC RECORDING MEDIUM AND MAGNETIC STORAGE DEVICE appearing in the Official Gazette of June 14, 2005 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: Paul Harrison; Crystal Park 3, Suite 441 (FAX-703-306-2737)
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

30 JUN 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

Bruce L. Adams
ADAMS & WILKS
50 Broadway - 31st Floor
New York, NY 10004

In re Application of:	:	
SUGINOYA, Mitsuru	:	
U.S. Application No.: 09/914,484	:	DECISION ON PETITION
PCT No.: PCT/JP00/01209	:	
International Filing Date: 01 March 2000	:	
Priority Date: 02 March 1999	:	
Attorney's Docket No.: S004-4374 (PCT)	:	
For: METHOD OF MANUFACTURING LIQUID	:	
CRYSTAL DISPLAY	:	

This decision is issued in response to applicant's "Request For Withdrawal And Vacation Of Notification Of Abandonment" filed 08 March 2004, which has been treated as a petition under 37 CFR 1.181 to confirm the filing of an executed declaration and surcharge payment on 10 January 2002. No petition fee is required.

BACKGROUND

On 01 March 2000, applicant filed international application PCT/JP00/01209 which claimed a priority date of 02 March 1999 and which designated the United States. On 08 August 2000, a copy of the international application was communicated to the United States Patent And Trademark Office ("USPTO") by the International Bureau ("IB"). The deadline for payment of the basic national fee was thirty months from the priority date, i.e., 02 September 2001.

On 28 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment for the basic national fee and an English translation of the international application.

On 02 April 2003, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 indicating that an oath or declaration in compliance with 37 CFR 1.497 was required.

On 01 March 2004, the DO/EO/US mailed a Notification Of Abandonment (Form PCT/DO/EO/909) indicating that the application was abandoned for failure to respond to the Notification of Missing Requirements.

On 08 March 2004, applicant filed the submission considered herein as a petition under 37 CFR 1.181. The petition asserts that on 10 January 2002, applicant filed an executed declaration and the $130 surcharge for filing this declaration later than thirty months after the

priority date. Attached to the petition are copies of the materials purportedly filed on 10 January 2002 as well as a copy of a PTO Receipt which itemizes these materials and bears a USPTO receipt stamp dated 10 January 2002.

DISCUSSION

Based on applicants' statements in the present petition, the attached return postcard, and internal USPTO records which indicate the receipt of the $130 surcharge payment on 10 January 2002, it is concluded that the materials attached to the present petition, including the executed declaration, were originally filed in the USPTO on 10 January 2002. Accordingly, the Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 02 April 2003, based as it was on applicant's purported failure to file an executed declaration, is appropriately vacated. The Notification Of Abandonment (Form PCT/DO/EO/909) mailed 01 March 2004, based as it was on the failure to respond to the now vacated Notification Of Missing Requirements, is also appropriately vacated.

A review of the declaration filed 10 January 2004 reveals that it is in compliance with 37 CFR 1.497.

CONCLUSION

Applicant's petition under 37 CFR 1.181 is **GRANTED**. The materials attached to the present petition, including the executed declaration and the surcharge payment, are considered to have been filed on 10 January 2002.

The Notification Of Missing Requirements (Form PCT/DO/EO/905) mailed 02 April 2003 is hereby **VACATED**.

The Notification Of Abandonment (Form PCT/DO/EO/909) mailed 01 March 2004 is hereby **VACATED**.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations for further processing in accord with this decision. The date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) date is 10 January 2002.

Richard M. Ross
PCT Petitions Attorney
PCT Legal Office
Telephone: (703) 308-6155
Facsimile: (703) 308-6459

MAR 2 7 2002

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

Schlumberger Resources Management
Services, Inc.
Attn.: Patent Dept
5430 Metic Place
Norcross, Georgia 30092

In re Application of	:
Christophe LELEU	: DECISION ON
Application No.: 09/914,512	:
PCT No.: PCT/FR00/00484	: PETITION
Int. Filing Date: 25 February 2000	:
Priority Date: 03 March 1999	: UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 74.0241	:
For: A Method And Apparatus For Measuring	:
... Particular An Ultrasound Signal	:

This decision is in response to applicant's "PETITION " filed on 15 June 2002, which is being treated as petition under 37 CFR 1.47(b) that seeks the acceptance of the application without the signature of the inventor Christophe LELEU.

BACKGROUND

On 25 February 2000, applicant filed international application PCT/FR00/00484, which claimed priority of an earlier French application filed 03 March 1999. A copy of the international application was transmitted to the United States from the International Bureau on 08 September 2000. A Demand was filed on 20 September 2000. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 03 September 2001.

On 29 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, inter alia,: the requisite basic national fee as required by 35 U.S.C. 371(c)(1), and a purported translation of the international application. No oath or declaration was submitted at such time.

On 12 October 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 indicating that "the oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date. The notification also indicated that the surcharge for filing the oath or declaration later than 30 months from the priority date as required by 37 CFR 1.492(e) must be filed. The notification set two month from the date of this notice or 32 months from the priority date for the application, whichever is later. Failure to properly respond will result in abandonment."

In an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4), applicant filed on 15 January 2002, the following:

1) a petition under 37 CFR 1.47(b);

2) a Declaration, Power of Attorney signed by Henri Dupont, Attorney in Fact

3) the required petition fee; and

4) a petition and fee for a two-month extension of time.

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Applicant has satisfied items (1), (3), (5) and (6), but not items (2) and (4) thus not completing the requirements under 37 CFR 1.47(b).

Applicant has satisfied item (1) since the petition fee has been charged to applicant's representative deposit account.

Regarding requirement (2), although applicant has concluded that Mr. LELEU has refused to sign the declaration the petition does not include sufficient proof to establish that inventor Mr. LELEU has refused to execute the application. The standards for proof are set forth in MPEP § 409.03(d), which provides:

> 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....
>
> Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.
>
> Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the non - signing inventor, or, if the non - signing inventor is represented by counsel, to the address of the non - signing inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

Mr. Pojunas states that Mr. LELEU refused to signed the declaration as well as the assignment, however in the present instance, it is not clear whether a complete set of application papers were presented to Mr. LELEU to sign. It is noted that no documentary evidence has been introduced into the file record that Mr. LELEU was presented with the declaration, let alone the complete application. Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor for signature. It would appear, from Mr. Pojunas' statement that Mr. LELEU was only given the declaration and the assignment to sign and not a complete copy of the application.

Regarding item (3), applicant has stated the last known address of the inventor:

Invensys Metering Systems
Turbimax Industria de Hidrometros Ltda
Rua Christiano Kilmeyers, 819-B
13.460-000 Nova Odessa, SP
Brazil

Regarding item (4) a declaration has been provided executed by Mr. Henri Dupont, Attorney in Fact, stating that he is authorized to sign on behalf of the corporation for the non-signing sole inventor, Mr. LELEU. However, the declaration fails to set forth the citizenship of the inventor.

Regarding item (5) applicant has submitted proof that applicant has sufficient proprietary interest in the application because a signed Invention Specification (Exhibit A) and its English translation has been provided with the petition. This agreement acknowledges ownership of the invention by Schlumberger Industries, S.A.

Regarding item (6) applicant has presented an adequate showing that the granting of this petition is necessary to preserve the rights of the parties or to prevent irreparable damage that will result if the present patent application is deemed abandoned for failure to submit a signed Oath or declaration of the Inventor.

Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

A review of the purported translation reveals that it is not an accurate translation of the application as original filed. For instance, on page 1, 10 Mhz is indicated in the national stage application instead of 1 Mhz as stated in the international application. Also, the discussion of DE 4017022 and 5777230 are not present in the international application.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. A translation of the international application and the $130.00 processing fee as required in response to the decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

13 FEB 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Schlumberger Resources Management
Services, Inc.
Attn.: Patent Dept
5430 Metic Place
Norcross, Georgia 30092

In re Application of	:
Christophe LELEU	: DECISION ON
Application No.: 09/914,512	:
PCT No.: PCT/FR00/00484	: RENEWED PETITION
Int. Filing Date: 25 February 2000	:
Priority Date: 03 March 1999	: UNDER 37 CFR 1.47(b)
Attorney's Docket No.: 74.0241	:
For: A Method And Apparatus For Measuring	:
... Particular An Ultrasound Signal	:

This decision is in response to applicant's "RENEWED PETITION UNDER 37 CFR 1.47(b)" faxed on 27 September 2002, that seeks the acceptance of the application without the signature of the inventor Christophe LELEU.

BACKGROUND

On 27 March 2002, a decision from this Office dismissed the petition filed on 15 June 2002. The decision indicated that applicant had not satisfied items (2) and (4) thus not completing the requirements under 37 CFR 1.47(b).

On 27 September 2002, petitioner faxed a renewed petition to satisfy the remaining 1.47(b) requirements.

It is noted that on 03 April 2002, a "Change of Correspondence Address" was filed in the present application. However, because the communication was not signed by an attorney of record, the change will not be entered under 37 CFR 1.33.

DISCUSSION

Petitioner has, now, satisfied requirement (2) under CFR 1.47(b) but requirements (4) and (5) are not satisfied because the declaration is now singed by Gerald Gallez, who has not shown that Actaris is now the current party of interest for the above application. The new declaration is signed by Gerard Gallez (the first declaration was signed by Mr. Henri Dupont on the behalf of the sole nonsigning inventor) on behalf of the sole nonsigning inventor Mr. Leleu but petitioner has not adequately established that Actaris SAS is the assignee. The agreement provided with the renewed petition establishing Schlumberger Industries S.A. transferred ownership rights in

Application S.N. 09/914,512 to Actaris S.A.S. is in French and no English translation has been provided that would verify the transfer.

Regarding item (2), the declaration provided by Mr. Straub states that a copy of the application papers (complete copy of the patent application and a Declaration form) was mailed to Mr. Leleu on August 7, 2002 and again September 09, 2002 for his signature. Mr. Straub failure to receive a reply to the two letters (application papers) mailed to the nonsigning inventor last known address and accepted by signature at that address are sufficient to show that Mr. Leleu refuses to sign the declaration form for the above referenced patent application.

Regarding item (4), the new declaration provided has been executed by Mr. Gerald Gallez, President of Actaris SAS, stating that he is authorized to sign on behalf of the corporation for the non-signing sole inventor, Mr. Leleu; but, it has not been yet established that Actaris SAS is the assignee.

Regarding item (5), applicant has not submitted proof that applicant has sufficient proprietary interest in the application because the "Agreement Establishing Schlumberger Industries S.A. Transfer of Ownership Rights in Application S.N. 09/914,512 to Actaris S.A.S." is in French and no English translation was provided. Therefore, it is unclear if the agreement acknowledges ownership of the invention to Actaris S.A.S.

Petitioner's renewed petition has satisfied items (1), (2), (3), and (6), but not items (4) and (5) thus not completing the requirements under 37 CFR 1.47(b). Accordingly, it is not appropriate to accord the national stage application status under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Second Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. A translation of the international application and the $130.00 processing fee as required in response to the decision. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.

Boris Milef
PCT Legal Examiner
PCT Legal Office

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

#11

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

20 MAY 2003

STRAUB & POKOTYLO
Attorney at Law
One Bethany Road
Suite 83, Building 6
Hazlet, New Jersey 07730

In re Application of:	:	
Christophe LELEU	:	DECISION ON
PCT No.: PCT/FR00/00484	:	
Application No.: 09/914,512	:	
Int. Filing Date: 25 February 2000	:	SECOND RENEWED
Priority Date: 03 March 1999	:	
Attorney's Docket No.: 74.0241	:	PETITION UNDER
For: A METHOD AND APPARATUS FOR ...	:	
PARTICULAR AN ULTRASOUND SIGNAL	:	37 CFR 1.47(b)

This decision is in response to applicant's "SECOND RENEWED PETITION UNDER 37 CFR 1.47(b)" submitted on 14 April 2003 in response to a decision mailed by this Office on 13 February 2003.

BACKGROUND

The decision by this Office dated 13 February 2002 indicated that requirements (4) and (5) under 37 CFR 1.47(b) were not satisfied because the declaration was signed by Gerald Gallez, who had not shown that Actaris is the current party of interest for the above application.

On October 8, 2002 petitioner allegedly filed supplemental papers to renewed petition under 37 CFR 1.47(b) originally faxed on September 27, 2002 including a declaration now executed by previously sole non-signing inventor, Christophe, LELEU.

On November 12, 2002 a second supplemental papers to renewed petition under 37 CFR 1.47(b) originally faxed September 27, 2002 included with submission, inter alia, a translation of the patent application assignment agreement.

On 14 April 2003, petitioner filed this instant petition accompanied, inter alia, by a copy of an executed declaration by the previously non-signing inventor Christophe Leleu, and a copy of the postcard showing a date of submission on 08 October 2002.

DISCUSSION

Petition filed on 08 October 2002:

The postcard lists the items submitted on 08 October 2002 and it indicates, *inter alia*, an executed declaration was submitted on such date.

MPEP 503 provides:

A postcard receipt which itemizes and properly identifies the papers which are being filed serves as *prima facie* evidence of receipt in the PTO of all the items listed thereon on the date stamped thereon by the PTO.

Petitioner's postcard receipt serves as *prima facie* evidence of receipt of the listed items, an executed declaration by inventor Christophe Leleu on 08 October 2002, by the USPTO.

Petition filed under 37 CFR 1.47(b):

The petition states that following the submission of the renewed petition, the non-signing inventor, Christophe Leleu returned to petitioner's undersigned representative, an executed declaration. Thus, the declaration is now signed by the sole non-signing inventor Christophe Leleu.

Accordingly, the declaration submitted on 08 October 2002 complies with 37 CFR 1.497(a) and (b).

CONCLUSION

The petition under 37 CFR 1.47(b) is **MOOT.**

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing consistent with this decision. The 35 USC 371 date of this application is **08 October 2002**.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office

Boris Milef
PCT Legal Examiner
PCT Legal Office

Telephone: (703) 308-6312
Facsimile: (703) 308-6459

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.
09/914,513	08/28/2001	Jacques Ladyjensky	1471.073	7942

21917 7590 05/06/2004

MCHALE & SLAVIN, P.A.
2855 PGA BLVD
PALM BEACH GARDENS, FL 33410

EXAMINER
NEGRON, ISMAEL

ART UNIT	PAPER NUMBER
2875	

DATE MAILED: 05/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09914513			

EXAMINER

ART UNIT	PAPER NUMBER

DATE MAILED:

NOTICE OF ABANDONMENT

This application is abandoned in view of:

☐ Applicant's failure to timely file a proper reply to the Office letter mailed on _____.

☐ A reply (with Certificate of Mailing or Transmission of _____) was received on _____ which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.

☐ A proposed reply was received on _____ , but it does not constitute a proper reply under 37 CFR 1.113 to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).

☐ A reply was received on _____ , but it does not constitute a proper reply, or a *bona fide* attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in the last box below).

☐ No reply has been received.

☒ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).

☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85)(or Notice of Publication Fee Due).

☐ The submitted fee of $_____ is insufficient. A balance of $ _____ is due.
The issue fee by 37 CFR 1.18 is $_____ . The publication fee, if required, by 37 CFR 1.18(d) is $_____.

☒ The issue fee and publication fee, if applicable, have not been received.

☐ Applicant's failure to timely file corrrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTOL-37).

☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.

☐ No corrected drawings have been received.

☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all the applicants.

☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon filing of a continuing application.

☐ The decision by the Board of Patent Appeals and Interferences rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

☐ The reason(s) below: _____

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

SEP 0 6 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

LISA A. HAILE
FISH & RICHARDSON P.C.
4225 EXECUTIVE SQUARE, SUITE 1400
LA JOLLA, CA 92037

In re Application of
LAM et al.
Application No.: 09/914,543
PCT No.: PCT/US97/08793
Int. Filing Date: 22 May 1997
Priority Date: 22 May 1996
Attorney Docket No.: DIVER1150W01
For: ENDOGLUCANASES

DECISION

This is a decision on applicant's 'Petition Under 37 CFR 1.137(b) for Revival of an Unintentionally Abandoned Application' filed on 18 April 2001 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 22 May 1997, applicant filed international application No. PCT/US97/08793 which claimed priority of an earlier United States application filed 22 May 1996. A copy of the international application had been communicated earlier to the United States Patent and Trademark Office from the International Bureau on 27 November 1997.

On 17 December 1997, a Demand for international preliminary examination, in which the United States was elected, was filed prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 22 November 1998. The application went abandoned for failure to pay the basic national fee.

On 18 April 2001, applicant filed a transmittal letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 along with a copy of the international application, a petition to revive, and authorization to charge fees to their deposit account .

On 23 August 2001, applicants refiled a copy of the 18 April 2001 submission via "Express Mail" to the attention of the undersigned along with the itemized date-stamped postcard receipt.

DISCUSSION

The itemized postcard receipt provided by counsel is sufficient evidence that a copy of the international application, fee calculation sheet with authorization to charge fees to applicant's deposit account and a petition to revive under 37 CFR 1.137 were filed on 18 April 2001 with the USPTO.

Application No.: 09/914,543

A petition under 37 CFR 1.137(b) requesting that the application be revived on the grounds of unintentional delay must be accompanied by (1) a proper reply, (2) the petition fee required by law, (3) a statement that the "entire delay in filing the required reply from the due date for the reply to the filing of a grantable petition pursuant to this paragraph was unintentional", and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c).

Applicant has submitted the proper reply with the submission of the basic national fee, satisfying item (1). With regard to item (2), applicant has provided the appropriate petition fee. As for item (4), since the application was filed after 08 June 1995, no terminal disclaimer is necessary in this application.

With regard to item (3), applicant's statement that "the entire delay in filing the required U.S. National Application from PCT application US97/08793, from the due date for the filing to the filing of a grantable petition pursuant to 37 C.F.R. 1.137(b) was unintentional" has been interpreted as meaning that "entire delay in filing the required reply from the due date for the reply until the filing of this petition under 37 CFR 1.137(b) was unintentional" as required by 37 CFR 1.137(b)(3) at the time of filing this petition. If this is an incorrect interpretation in view of the rules, petitioner is required to promptly notify this office.

A review of the application file reveals that the required petition fee has been charged to applicant's deposit account and all of the requirements of 37 CFR 1.137(b) have been satisfied. Therefore, the request to revive the application abandoned under 35 U.S.C. 371(d) is granted as to the National stage in the United States of America.

CONCLUSION

The petition to revive under 37 CFR 1.137(b) is **GRANTED**.

This application is being forwarded to the National Stage Processing Division of the Office of PCT Operations for continued processing including issuance of a Notification of Missing Requirements indicating that an oath or declaration executed by the inventors and the surcharge for filing the oath or declaration after the thirty month period.

Cynthia M. Kratz

Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

CMK:cmk

Telephone: (703) 306-5467

DEC 2 1 2001

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

#3

Lisa A. Haile
Gary Cary Ware & Freidenrich
43655 Executive Drive, Suite 1600
San Diego, CA 92121-2189

In re Application of Lam and Mathur Application No.: 09/959,641 PCT No.: PCT/US97/08793 Int. Filing Date: 22 May 1997 Priority Date: 22 May 1996 Attorney's Docket No.: 09010/007WO1 For: ENDOGLUCANASES	DECISION ON PETITION UNDER 37 CFR 1.137(b)

This is in response to "Petition to Revive Of An International Application For Patent Designating The U.S. Abandoned Unintentionally Under 37 C.F.R. §1.137(b)" filed on 18 April 2001.

BACKGROUND

On 22 May 1997, this international application was filed, which claimed an earliest priority date of 22 May 1996.

A Demand was filed on 19 December 1997 for the above international application. Accordingly, the deadline for paying the basic national fee in the United States under 35 U.S.C. 371 and 37 CFR 1.495 was 22 November 1998. This international application became abandoned with respect to the United States at midnight on 22 November 1998 for failure pay the basic national fee.

On 18 April 2001, applicant filed in the United States Patent and Trademark Office (PTO) the instant petition, and a transmittal letter for entry into the national stage in the U.S. under 35 U.S.C. 371, which was accompanied by, *inter alia*, the U.S. basic national fee. No executed oath or declaration accompanied the above papers.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(b) must be accompanied by (1) the required reply, unless previously filed; (2) the petition fee as set forth in § 1.17(m); and (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and (4) any terminal disclaimer (and fee as set forth in § 1.20 (d)) required pursuant to paragraph (c) of this section.

Petitioner has provided: (1) the proper reply by submitting the basic national filing fee, (2) the petition fee set forth in §1.17(m) and (3) the proper statement under 137(b)(3). In this application, no terminal disclaimer is required.

Accordingly, the petition is deemed to satisfy requirements (1), (2), (3), and (4) under 37 CFR 1.137(b).

DECISION

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application is being returned to the United States Designated/Elected Office (DO/EO/US) for continued processing.

Rafael Bacares
PCT Legal Examiner
PCT Legal Office
Tel: (703) 308-6312
Fax: (703) 308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

#3

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APR 23 2002

Robert M. Barrett
Bell, Boyd & Lloyd, LLC
P.O. Box 1135
Chicago, Illinois 60690-1135

In re Application of	:	
SHER, et al.	:	DECISION ON PAPERS
Application No.: 09/914,637	:	
PUT No.: PCT/EP00/01737	:	UNDER 37 CFR 1.42
Int. Filing Date: 28 February 2000	:	
Priority Date: 01 March 1999	:	
Attorney Docket No.: 112843-028	:	
For: FERRIC FORTIFICATION SYSTEM	:	

This is a decision on the papers filed in United States Patent and Trademark Office on 18 January 2002, which are being treated as a request for acknowledgment of status under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 28 February 2000, applicant filed the international application, which claimed a priority date of 01 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 September 2000. A Demand for international preliminary examination in which the United States was elected was filed prior to the expiration of 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 September 2001.

On 31 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the requisite basic national fee; a copy of the international application; a copy of the International Search Report; an unexecuted combined declaration and power of attorney; a copy of the International Preliminary Examination Report and a First Preliminary Amendment.

On 23 October 2001, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date and providing a surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e). Applicant was afforded two months to file the required response and advised that extensions of time were available pursuant to 37 CFR 1.136(a).

On 18 January 2002, applicant filed the present papers. The papers have been certified as having been deposited for mailing on 20 December 2001 and are therefore considered to be timely filed.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration filed 18 January 2002 is executed by Bina VADEHRA as the executor of the estate of deceased joint inventor Dharam Vir VADEHRA. However, the declaration does not set forth the residence, post office address and country of citizenship of Bina VADEHRA as required under 37 CFR 1.497(b). This information must be provided for both the deceased joint inventor, Dharam Vir VADEHRA and the executor, Bina VADEHRA.

CONCLUSION

Applicant's petition under 37 CFR 1.42 is **DISMISSED, without prejudice**.

Applicants are hereby afforded TWO (2) MONTHS from the mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b), namely, setting forth the residence, post office address and citizenship of the executor, Bina VADEHRA. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Derek A. Putonen
PCT Petitions Attorney
PCT Legal Office
Telephone 703-308-6314
Fax: 703-308-6459

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APR 23 2002

Robert M. Barrett
Bell, Boyd & Lloyd, LLC
P.O. Box 1135
Chicago, Illinois 60690-1135

In re Application of	:	
SHER, et al.	:	DECISION ON PAPERS
Application No.: 09/914,637	:	
PUT No.: PCT/EP00/01737	:	UNDER 37 CFR 1.42
Int. Filing Date: 28 February 2000	:	
Priority Date: 01 March 1999	:	
Attorney Docket No.: 112843-028	:	
For: FERRIC FORTIFICATION SYSTEM	:	

This is a decision on the papers filed in United States Patent and Trademark Office on 18 January 2002, which are being treated as a request for acknowledgment of status under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 28 February 2000, applicant filed the international application, which claimed a priority date of 01 March 1999. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 08 September 2000. A Demand for international preliminary examination in which the United States was elected was filed prior to the expiration of 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 01 September 2001.

On 31 August 2001, applicant filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the requisite basic national fee; a copy of the international application; a copy of the International Search Report; an unexecuted combined declaration and power of attorney; a copy of the International Preliminary Examination Report and a First Preliminary Amendment.

On 23 October 2001, applicant was mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" (Form PCT/DO/EO/905) informing applicant of the need to provide an oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date and providing a surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the earliest priority date. (37 CFR 1.492(e). Applicant was afforded two months to file the required response and advised that extensions of time were available pursuant to 37 CFR 1.136(a).

On 18 January 2002, applicant filed the present papers. The papers have been certified as having been deposited for mailing on 20 December 2001 and are therefore considered to be timely filed.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

"In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

The declaration filed 18 January 2002 is executed by Bina VADEHRA as the executor of the estate of deceased joint inventor Dharam Vir VADEHRA. However, the declaration does not set forth the residence, post office address and country of citizenship of Bina VADEHRA as required under 37 CFR 1.497(b). This information must be provided for both the deceased joint inventor, Dharam Vir VADEHRA and the executor, Bina VADEHRA.

CONCLUSION

Applicant's petition under 37 CFR 1.42 is [redacted] **ejudice.**

Applicants are hereby afford[redacted]mail date of this decision to file an oath or declaration in compliance with 37 CFR 1.497 (a)-(b), namely, setting forth the residence, post office address and citizenship of the executor, Bina VADEHRA. Any reconsideration request should include a cover letter entitled, "Renewed Petition Under 37 CFR 1.42." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter directed to the attention of the PCT Legal Office.

Leonard Smith
PCT Legal Examiner
PCT Legal Office

Derek A. Putonen
PCT Petitions Attorney
PCT Legal Office
Telephone 703-308-6314
Fax: 703-308-6459

21 JAN 2003

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Robert M. Barrett
Bell, Boyd & Lloyd, LLC
P.O. Box 1135
Chicago, Illinois 60690-1135

In re Application of SHER, et al. Application No.: 09/914,637 PCT No.: PCT/EP00/01737 Int. Filing Date: 28 February 2000 Priority Date: 01 March 1999 Attorney Docket No.: 112843-028 For: FERRIC FORTIFICATION SYSTEM	DECISION ON RENEWED PETITION UNDER 37 CFR 1.42

This is a decision on applicants "Renewed Petition Under 37 CFR § 1.42" filed 23 October 2002 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 23 April 2002, applicant was mailed a decision dismissing applicant's petition under 37 CFR 1.42. Applicant was afforded two months to file any request for reconsideration.

On 23 October 2002, applicant filed the present renewed petition accompanied by a petition for a four-month extension of time and payment of the appropriate extension fee. With the filing of the petition and payment of the four-month extension fee the renewed petition is considered to be timely filed.

DISCUSSION

Pursuant to 37 CFR 1.42, first sentence:

> "In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent."

As detailed in the decision mailed 23 April 2002, applicant's original petition was dismissed as the filed declaration failed to set forth the citizenship of the heiress of the deceased inventor. Applicants have currently filed a declaration which spells out the residence, post office address and country of citizenship of the deceased joint inventor Dharam Vir VADEHRA as well as that of the his heir Bina VADEHRA. As such, it is proper to grant applicant's renewed petition at this time.

The submission of the declaration executed by all of the heirs of the deceased inventor is

hereby construed as an indication that no legal representative of the deceased's estate has been appointed and that no legal representative is required by the applicable law to be appointed. If this interpretation is incorrect applicant is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

CONCLUSION

Applicant's renewed petition under 37 CFR 1.42 is **GRANTED**.

This application will be given an international application filing date of 28 February 2000 and a date of **23 October 2002** under 35 U.S.C. 371.

This application is being returned to the DO/EO/US for processing in accordance with this decision.

Richard Cole
Legal Examiner
PCT Legal Office

Derek A. Putonen
Attorney Advisor
PCT Legal Office
Tel: 703-305-0130
Fax: 703-308-6459

SPE RESPONSE FOR CERTIFICATE OF CORRECTION

Paper No.: _____

DATE : 3/23/09

TO SPE OF : ART UNIT 1636

SUBJECT : Request for Certificate of Correction for Appl. No.: 09914651 Patent No.:7074400 B1

Please respond to this request for a certificate of correction within 7 days.

FOR IFW FILES:

Please review the requested changes/corrections as shown in the **COCIN** document(s) in the IFW application image. No new matter should be introduced, nor should the scope or meaning of the claims be changed.

Please complete the response (see below) and forward the completed response to scanning using document code **COCX**.

FOR PAPER FILES:

Please review the requested changes/corrections as shown in the attached certificate of correction. Please complete this form (see below) and forward it with the file to:

Certificates of Correction Branch (CofC)
South Tower - 9A22
Palm Location 7580

You can fax the Directors/SPE response to 571-270-9990

LAMONTE NEWSOME
Certificates of Correction Branch
703-308-9390 ext. 112

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

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

WOODCOCK WASHBURN LLP
ONE LIBERTY PLACE, 46TH FLOOR
PHILADELPHIA, PA 19103

COPY MAILED

JUL 28 2004

OFFICE OF PETITIONS

In re Application of	:
Jun Kawaguchi et al	:
Application No. 09/914,701	: DECISION GRANTING PETITION
Filed: August 31, 2001	: UNDER 37 CFR 313(c)(2)
Attorney Docket No. M 6712 HST/NI PCT/US	:

This is a decision on the petition, filed July 27, 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 26, 2004 in the above-identified application cannot be refunded. If, however, the above-identified application is again allowed, petitioner may request that it be applied towards the issue fee required by the new Notice of Allowance.[1]

Telephone inquiries should be directed to the undersigned at (703) 305-8680.

This matter is being referred to Technology Center AU 1742 for processing of the request for continued examination under 37 CFR 1.114 and for consideration of the concurrently filed Information Disclosure Statement.

Frances Hicks

Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

---

[1] The request to apply the issue fee to the new Notice may be satisfied by completing and returning the new Issue Fee Transmittal Form PTOL-85(b), which includes the following language thereon: "Commissioner for Patents is requested to apply the Issue Fee and Publication Fee (if any) or re-apply any previously paid issue fee to the application identified above." Petitioner is advised that, whether a fee is indicated as being due or not, the Issue Fee Transmittal Form **must** be completed and timely submitted to avoid abandonment. Note the language in bold text on the first page of the Notice of Allowance and Fee(s) Due (PTOL-85).